

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PROLLENIUM US INC.,  
Petitioner,

v.

ALLERGAN INDUSTRIE, SAS,  
Patent Owner.

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IPR2019-01505, Patent 8,450,475 B2<sup>1</sup>  
IPR2019-01506, Patent 8,357,795 B2  
IPR2019-01508, Patent 9,238,013 B2  
IPR2019-01509, Patent 9,358,322 B2  
IPR2019-01617, Patent 8,822,676 B2  
IPR2019-01632, Patent 8,357,795 B2  
IPR2020-00084, Patent 9,089,519 B2

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*Before* GRACE KARAFFA OBERMANN, JOHN G. NEW,  
SHERIDAN K. SNEDDEN, and ROBERT A. POLLOCK,  
*Administrative Patent Judges.*

NEW, *Administrative Patent Judge.*

ORDER  
Setting Oral Argument  
*37 C.F.R. § 42.70*

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<sup>1</sup> The combined caption is for administrative convenience only and does not indicate a joined case or an expanded panel. The parties are not authorized to use this caption absent express permission of the Board.

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## I. ORAL ARGUMENT

### A. Background

We instituted *inter partes* review on March 19, 2020. Paper 18.<sup>2</sup> Prolenium US Inc. (“Petitioner”) and Allergan Industrie, SAS. (“Patent Owner”) separately request an oral hearing pursuant to 37 C.F.R. § 42.70(a). *See* Papers 48, 49, respectively. The requests are *granted*, with hearing date set for January 12, 2021. *See* Paper 19 (“Joint Scheduling Order”).

### B. Time and Format

The hearing will be conducted *remotely by video for all participants*. The hearing will commence at 1:00 PM EST, on January 12, 2021. The Board will provide a court reporter for the hearing, and the reporter’s transcript will constitute the official record of the hearing. If at any time during the hearing, a party encounters technical or other difficulties that fundamentally undermine its ability to adequately represent its client, please let the panel know immediately, and adjustments will be made.<sup>3</sup>

To facilitate planning, each party must contact PTAB Hearings at [PTABHearings@uspto.gov](mailto:PTABHearings@uspto.gov) no later than five (5) business days prior to the

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<sup>2</sup> For purposes of convenience, we use the paper numbers of IPR2019-01505, the senior case in this family.

<sup>3</sup> For example, if a party is experiencing poor video quality, the Board may provide alternate dial-in information.

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date of the oral hearing to receive video set-up information. As a reminder, all arrangements and expenses involved with appearing by video, such as the selection of the facility from which a party will attend by video, must be borne by that party. If a video connection cannot be established, the parties will be provided with dial-in connection information, and the oral hearing will be conducted telephonically. Should a party prefer to participate in the oral hearing telephonically, they should notify PTAB Hearings at the above email address five (5) business days prior to the hearing to receive dial-in connection information.

Each party will have a total of two (2) hours to present its case.<sup>4</sup> Petitioner bears the ultimate burden of demonstrating that the claims as challenged in the petition are unpatentable. Thus, Petitioner will open the hearing by presenting its case regarding the unpatentability of the challenged claims. Patent Owner will follow with its response to Petitioner's presentation. Petitioner may reserve rebuttal time (of no more than half their total presentation time) to reply to Patent Owner's arguments. Likewise, Patent Owner may reserve sur-rebuttal time (of no more than half its total presentation time) to reply to Petitioner's rebuttal. *See Office Consolidated Trial Practice Guide*, November 2019 Edition, 83, available at <https://www.uspto.gov/TrialPracticeGuideConsolidated> ("CTPG"); *see also*

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<sup>4</sup> The parties' two-hour presentation time includes all of the captioned proceedings. The parties may allocate a portion of their allotted time to the motions to exclude evidence.

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84 Fed. Reg. 64,280 (Nov. 21, 2019). A party may only present argument and evidence at the hearing for which a proper foundation exists in the record.

Unless ordered otherwise, the parties are to refrain from disclosing any confidential information during the hearing or including any confidential information in a demonstrative exhibit.

The parties may request a pre-hearing conference in advance of the hearing. “The purpose of the pre-hearing conference is to afford the parties the opportunity to preview (but not argue) the issues to be discussed at the hearing, and to seek the Board’s guidance as to particular issues that the panel would like addressed by the parties.” *Id.* If either party desires a pre-hearing conference, the parties should jointly contact the Board at [Trials@uspto.gov](mailto:Trials@uspto.gov) at least seven (7) business days before the hearing date to request a conference call for that purpose.

### C. Demonstratives

Demonstratives are not a mechanism for making new arguments. Demonstratives also are not evidence, and will not be relied upon as evidence. Rather, demonstratives are visual aids to a party’s oral presentation regarding arguments and evidence previously presented and discussed in the papers. Accordingly, demonstratives shall be clearly marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. *See Dell Inc. v. Acceleron, LLC*, 884 F.3d 1364,

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1369 (Fed. Cir. 2018) (holding that the Board is obligated under its own regulations to dismiss untimely argument “raised for the first time during oral argument”). “[N]o new evidence may be presented at the oral argument.” CTPG 85; *see also St. Jude Med., Cardiology Div., Inc. v. The Bd. of Regents of the Univ. of Mich.*, IPR2013-00041, Paper 65, 2–3 (PTAB Jan. 27, 2014) (explaining that “new” evidence includes evidence already of record but not previously discussed in any paper of record).

Furthermore, because of the strict prohibition against the presentation of new evidence or arguments at a hearing, it is strongly recommended that each demonstrative include a citation to a paper in the record, which allows the Board to easily ascertain whether a given demonstrative contains “new” argument or evidence or, instead, contains only that which is developed in the existing record.

Due to the nature of the Board’s consideration of demonstratives and the opportunity afforded for the parties to reach an agreement without involving the Board, the Board does not anticipate that objections to demonstratives are likely to be sustained. Nevertheless, to the extent that a party objects to the propriety of any demonstrative, the parties shall meet and confer in good faith to resolve any objections to demonstratives prior to filing the objections with the Board. If such objections cannot be resolved, the parties may file any objections to demonstratives with the Board no later than the time of the hearing. The objections shall identify with particularity which portions of the demonstratives are subject to objection (and should

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