

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., AND MEDTRONIC VASCULAR, INC.,
Petitioner,

v.

TELEFLEX LIFE SCIENCES LIMITED,
Patent Owner.

IPR2020-01341 (Patent 8,142,413 B2)
IPR2020-01342 (Patent 8,142,413 B2)
IPR2020-01343 (Patent RE46,116 E)
IPR2020-01344 (Patent RE46,116 E)

Before SHERIDAN K. SNEDDEN, JAMES A. TARTAL, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.¹

SNEDDEN, *Administrative Patent Judge*.

ORDER
Setting Oral Argument
37 C.F.R. §§ 42.5, 42.70

¹ This Order addresses issues that are identical in each of the above-captioned proceedings. We therefore exercise our discretion to issue one Order to be filed in each proceeding. The proceedings have not been consolidated, and the Parties are not authorized to use this style heading in any subsequent papers.

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I. ORAL ARGUMENT

Petitioner and Patent Owner both request oral argument. Paper 69 (Patent Owner’s Request); Paper 70 (Petitioner’s Request).² The parties’ requests for oral argument are granted. Oral argument will commence at **1:00 PM ET on November 18, 2021**, by video, and will follow the format discussed below.³ The Board will provide a court reporter for the hearing, and the reporter’s transcript will constitute the official record of the hearing.

A. Time and Format of the Hearing

In their requests, the parties disagree as to how much time should be allotted between the patentability issues and conception and reduction to practice issues disputed by the parties during the course of this proceeding. Specifically, in each of the above-captioned cases, the parties address unpatentability under 35 U.S.C. § 102 and/or § 103. In IPR2020-01341 and IPR2020-01343, Patent Owner argues that the subject matter of the challenged claims was conceived and reduced to practice prior to the September 23, 2005, effective filing date of U.S. Patent No. 7,736,355 (“Itou”), thereby removing this reference as prior art under 35 U.S.C. § 102. Paper 24, 17–37.

In its Request, Petitioner “requests a total of five hours for a one-day hearing to be evenly split per side to address: (1) the consolidated

² For convenience, we cite to Papers and Exhibits filed in IPR2020-00141. Similar Papers and Exhibits were filed in each of the above-captioned cases.

³ If there are any concerns about disclosing confidential information, the parties must contact the Board at Trials@uspto.gov at least ten (10) business days before the hearing date.

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conception and reduction to practice issues for the patents challenged in IPR2020-01341, and -01343; and (2) the instituted grounds of invalidity in all four instituted IPRs in IPR2020-01341, -01342, -01343, and -01344.”
Paper 70, 1.

Patent Owner requests 30 minutes of argument time per side to address the conception and reduction to practice issues and additionally 45 minutes per side to address unpatentability under 35 U.S.C. § 102 and/or § 103. Paper 69, 1.

Upon review of the record and the parties’ requests, we grant each party a total of 90 minutes to present argument during the hearing, those 90 minutes to be allocated between the conception and reduction to practice issues and other issues briefed by the parties during the course of the proceeding according to the following schedule:⁴

Issue	Petitioner	Patent Owner
Conception/RTP	30 mins	30 mins
Other issues raised by the parties	60 mins	60 mins

For the issues of conception and reduction to practice, Patent Owner will open by presenting its case regarding these issues. Thereafter, Petitioner will respond to Patent Owner’s arguments. As the opening party, Patent Owner may reserve rebuttal time and Petitioner may, in accordance

⁴ The panel contemplates taking a short break after each issue is argued.

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with the Consolidated Trial Practice Guide, request to reserve time for a brief sur-rebuttal. *See* CTPG 83.

For the remaining issues, Petitioner will open by presenting its case regarding the challenged claims for which the Board instituted trial. Thereafter, Patent Owner will respond to Petitioner's arguments. As the opening party, Petitioner may reserve rebuttal time and Patent Owner may, in accordance with the Consolidated Trial Practice Guide, request to reserve time for a brief sur-rebuttal.

The parties may request a pre-hearing conference in advance of the hearing. *See id.* at 82. "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 oral 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 at least seven (7) business days before the hearing date to request a conference call for that purpose.

B. Demonstratives

As set forth in 37 C.F.R. § 42.70(b), demonstratives shall be served on opposing counsel at least seven (7) business days before the hearing date and filed at least two days before the hearing.⁵ Additionally, in regard to filing demonstrative exhibits, and in contrast to what is expressly stated in

⁵ The parties may stipulate to an alternative schedule for serving and filing demonstratives, and request that the Board modify the schedule for filing and serving demonstratives at least seven (7) business days before the hearing date.

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§ 42.70(b), the parties shall file the demonstrative exhibits no later than two business days before the hearing to allow the panel sufficient time to review the materials.

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, 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 85-86; *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

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