

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BAYERISCHE MOTOREN WERKE AKTIENGESELLSCHAFT &  
BMW OF NORTH AMERICA, LLC,  
Petitioner,

v.

PAICE LLC & THE ABELL FOUNDATION, INC.,  
Patent Owner.

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IPR2020-01386  
Patent 7,237,634 B2

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Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and  
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

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

## I. ORAL ARGUMENT

We instituted a trial for the instant proceeding on February 5, 2021. Paper 13. Patent Owner and Petitioner have requested oral argument pursuant to 37 C.F.R. § 42.70(a). Paper 27; Paper 29. Upon consideration, the requests for oral argument are *granted*.

### A. *Time and Format*

Oral arguments will commence at **9 am Eastern Time on November 9, 2021**, by video.<sup>1</sup> The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing.

Petitioner will have **a total of sixty (60) minutes** to present argument in this case and Patent Owner will have **a total of sixty (60) minutes** to respond. Petitioner will open the hearing by presenting its case regarding the challenged claims for which the Board instituted trial. Thereafter, Patent Owner will respond to Petitioner's argument. Petitioner may reserve rebuttal time to respond to arguments presented by Patent Owner. In accordance with the Consolidated Trial Practice Guide<sup>2</sup> ("CTPG"), issued in November 2019, Patent Owner may request to reserve time for a brief sur-rebuttal. *See* CTPG 83.

Either party may request a pre-hearing conference. *See* Office Consolidated Trial Practice Guide at 82; *see also* 84 Fed. Reg. 64,280 (Nov. 21, 2019). Requests must be made by October 26, 2021. *See* Paper 14, 11 (Due Date 6). To request such a conference, the parties should jointly contact the Board at [Trials@uspto.gov](mailto:Trials@uspto.gov) and include several dates and times

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<sup>1</sup> If there are any concerns about disclosing confidential information, the parties must contact the Board at [Trials@uspto.gov](mailto:Trials@uspto.gov) at least ten (10) business days before the hearing date.

<sup>2</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

of availability that are generally no later than three business days prior to the oral hearing.

*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 no later than November 8, 2021.<sup>3</sup>

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; *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

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<sup>3</sup> The parties may stipulate to an alternative schedule for serving demonstratives but must file the demonstratives no later than the dated specified in this Order.

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 November 8, 2021. The objections shall identify with particularity which portions of the demonstratives are subject to objection (and should include a copy of the objected-to portions) and include a one (1) sentence statement of the reason for each objection. No argument or further explanation is permitted. The Board will consider any objections, and may reserve ruling on the objections.<sup>4</sup> Any objection to demonstratives that is not timely presented will be considered waived.

Finally, the parties are reminded that each presenter should identify clearly and specifically each paper (e.g., by slide or screen number for a demonstrative) referenced during the hearing to ensure the clarity and accuracy of the court reporter’s transcript and for the benefit of all participants appearing electronically.

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<sup>4</sup> If time permits, the Board may schedule a conference call with the parties to discuss any filed objections.

*C. Presenting Counsel*

The Board generally expects lead counsel for each party to be present at the hearing. *See* CTPG 11. Any counsel of record may present the party's argument as long as that counsel is present by video.

*D. Video Hearing Details<sup>5</sup>*

To facilitate planning, each party must contact the Board at PTABHearings@uspto.gov at least five (5) business days prior to the hearing date to receive video set-up information. As a reminder, all arrangements and the 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 hearing will be conducted telephonically.

If one or both parties would prefer to participate in the hearing telephonically, they must contact the Board at PTABHearings@uspto.gov at least five (5) business days prior to the hearing date to receive dial-in connection information.

Counsel should unmute only when speaking. The panel will have access to all papers filed with the Board, including demonstratives. During the hearing, the parties are reminded to identify clearly and specifically each paper referenced (e.g., by slide or screen number for a demonstrative) to ensure the clarity and accuracy of the court reporter's transcript and for the

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<sup>5</sup> USPTO facilities remain closed to the public. If and when conditions allow in-person hearing attendance, the parties will be notified and will be permitted to submit a joint request to convert the current video hearing to an in-person hearing. The requests will be considered on a case-by-case basis, and subject to resource availability.

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