

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NEW WORLD MEDICAL, INC.,  
Petitioner,

v.

MICROSURGICAL TECHNOLOGY, INC.,  
Patent Owner.

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IPR2020-01573, Patent 9,107,729 B2  
IPR2020-01711, Patent 9,358,155 B2  
IPR2021-00017, Patent 9,820,885 B2  
IPR2021-00065, Patent 10,123,905 B2  
IPR2021-00066, Patent 9,999,544 B2<sup>1</sup>

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Before JAMES A. TARTAL, JAMES A. WORTH,  
ROBERT A. POLLOCK, RYAN H. FLAX, and  
DEVON ZASTROW NEWMAN *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

ORDER  
Granting Request for Final Hearing  
*37 C.F.R. § 42.70*

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<sup>1</sup> Because this Order applies to each of these related *inter partes* review proceedings, we use this caption for efficiency. The parties are not authorized to follow this practice, but may request such authorization.

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IPR2021-00066, Patent 9,999,544 B2

New World Medical, Inc. (“Petitioner”) filed a Petition for an *inter partes* review in: IPR2020-01573 challenging claims of Patent 9,107,729 B2; IPR2020-01711 challenging claims of Patent 9,358,155 B2; IPR2021-00017 challenging claims of Patent 9,820,885 B2; IPR2021-00065 challenging claims of Patent 10,123,905 B2; and IPR2021-00066 challenging claims of Patent 9,999,544 B2. *See, e.g.*, Paper 1 of IPR2020-01573; *see also* respective Petitions of other noted proceedings.<sup>2</sup>

MicroSurgical Technology, Inc. (“Patent Owner”) is the Patent Owner in each of these proceedings. Trial has been instituted in each of these *inter partes* review proceedings. *See, e.g.*, Paper 22 in IPR2020-01573.

The parties each request a final oral argument in the aforementioned, related proceedings. Papers 47, 48. Further, the parties indicate that “[c]ounsel for Patent Owner conferred with counsel for Petitioner in advance of filing [each] Request and the Parties agree to one hour per side for all five related *Inter Partes* Review proceedings.” *See, e.g.* Paper 47, 1.

A. TIME AND FORMAT

The final hearing will be conducted remotely for all participants. The oral hearing will commence at **10:00 AM Eastern Time on January 10, 2022**, by video.<sup>3</sup> *See* Paper 27 (revising Scheduling Order). The parties are directed to contact the Board at least ten (10) days in advance of the hearing

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<sup>2</sup> For efficiency, we cite to the record from IPR2020-01573; the records in the related proceedings are similar.

<sup>3</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.

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if there are any concerns about disclosing confidential information. The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing.

The parties have agreed to and requested an hour of oral argument each for all of the above-captioned proceedings, collectively, therefore, each party will have **60 minutes** of total time to present arguments in the above-identified proceedings. Petitioner will proceed first to present its case with regard to the challenged claims and grounds set forth in the Petitions. Thereafter, Patent Owner may respond to Petitioner's case. Petitioner may reserve up to 15 minutes for rebuttal regarding Patent Owner's opening arguments. *See Consolidated Trial Practice Guide*<sup>4</sup> ("CTPG"). Patent Owner may also reserve up to 15 minutes to use for sur-rebuttal, to respond to Petitioner's rebuttal arguments. *Id.* The parties are reminded that arguments made during rebuttal and sur-rebuttal periods must be responsive to arguments the opposing party made in its immediately preceding presentation.

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 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

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<sup>4</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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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 no later than five (5) days prior to the hearing.<sup>5</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).

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<sup>5</sup> 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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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 (and evidentiary exhibit) 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 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>6</sup> Any objection to demonstratives that is not timely presented will be considered waived.

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<sup>6</sup> If time permits, the Board may schedule a conference call with the parties to discuss any filed objections.

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