

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PHILIP MORRIS PRODUCTS, S.A.,
Petitioner,

v.

RAI STRATEGIC HOLDINGS, INC.,
Patent Owner.

IPR2020-01602
Patent 9,901,123 B2

Before JO-ANNE M. KOKOSKI, ELIZABETH M. ROESEL, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

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

I. ORAL ARGUMENT

Philip Morris Products, S.A. (“Petitioner”) and RAI Strategic Holdings, Inc. (“Patent Owner”) each requested oral argument pursuant to 37 C.F.R. § 42.70(a). Papers 26, 27. Petitioner’s and Patent Owner’s requests are *granted* subject to the procedures set forth below.

A. Time and Format

Oral arguments will commence at 10:00 am Eastern Time on January 6, 2022 by video. The Board will provide a court reporter for the hearing, and the reporter’s transcript will constitute the official record of the hearing.

Each party will have a total of sixty (60) minutes of argument time. 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 Guide¹ (“CTPG”), issued in November 2019, Patent Owner may request to reserve time for a brief sur-rebuttal. *See* CTPG 83.

The parties may request a pre-hearing conference by December 17, 2021, as set forth in the Scheduling Order. Paper 10, 12; CTPG 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.” CTPG 82. If either party desires a pre-hearing

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

conference, an email should be sent to Trials@uspto.gov including several dates and times of availability for one or both parties, as appropriate, that are generally no later than three business days prior to the oral hearing. We direct the parties to the CTPG for more information on the pre-hearing conference.

B. Demonstratives

As set forth in 37 C.F.R. § 42.70(b), any demonstratives shall be served on opposing counsel at least seven (7) business days before the hearing date and filed with the Board, as a separate Exhibit in accordance with 37 C.F.R. § 42.63, at least one (1) business day before the hearing date.² The parties should consider the information regarding demonstrative materials discussed in the CTPG.

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. Accelaron, 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

² 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 ten (10) business days before the hearing date.

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 *at least two (2) business days* before the hearing. The objections shall: identify with particularity which portions of the demonstratives are subject to objection; include a copy of the objected-to portions; and include a one 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.³ 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.

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 Details⁴

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.

³ If time permits, the Board may schedule a conference call with the parties to discuss any filed objections.

⁴ 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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