

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED and
ZYXEL COMMUNICATIONS CORPORATION¹
Petitioner,

v.

UNM RAINFOREST INNOVATIONS,
Patent Owner.

IPR2021-00375 (Patent 8,265,096 B2)
IPR2021-00377 (Patent 8,249,204 B2)
IPR2021-00582 (Patent 8,565,326 B2)²

Before KRISTEN L. DROESCH, BARBARA A. PARVIS, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

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

¹ ZyXEL Communications Corporation was joined as a petitioner in these proceedings based on petitions and motions for joinder filed in IPR2021-00734, IPR2021-00739, and IPR2021-00741, respectively.

² This Order addresses overlapping issues in the cases listed above. Therefore, we issue one Order to be filed in each case. The parties, however, are not authorized to use this style of filing.

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I. ORAL ARGUMENT

The parties filed separate requests for oral argument in each of these proceedings. *See* Papers 45, 46.³ Petitioner requested a consolidated argument for all three proceedings listed in the caption, with two hours argument time allotted for each party for a total of four hours of argument time. Petitioner further requests, that if a consolidated argument is not held, that each party be allotted 45 minutes of argument time for a total of 90 minutes for each *inter partes* review listed in the caption. *See* Paper 46, 1. Patent Owner requests a total of 30 minutes to present its arguments in each proceeding listed in the caption. *See* Paper 45, 1.

A. *Time and Format*

Oral arguments will commence at 12:00 pm ET on May 20⁴, 2022, by video.⁵ The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing. For each *inter partes* review, Petitioner will have a total of 45 minutes to present its arguments, and Patent Owner will have a total of 45 minutes to respond. The hearing for IPR2021-00375 will commence at 12:00 pm ET, the hearing for IPR2021-00377 will commence at approximately 1:30 pm ET, and the hearing for IPR2021-00582 will commence at approximately

³ Unless otherwise notes, we cite to the papers filed in IPR2021-00375. Similar Papers were filed in IPR2021-00377 and IPR2021-00582.

⁴ The date for oral arguments was changed in the Third Revised Scheduling Order (Paper 47).

⁵ 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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3:00 pm ET. Upon agreement, however, the parties may present arguments for each *inter partes* review in a different agreed-upon order. For each *inter partes* review, Petitioner will open the hearing by presenting its case regarding the challenged claims for which the Board instituted trial and Patent Owner's Motion to Amend. Thereafter, Patent Owner will respond to Petitioner's arguments. Petitioner may reserve rebuttal time to respond to arguments presented by Patent Owner. In accordance with the Consolidated Trial Practice Guide⁶ ("CTPG"), Patent Owner may request to reserve time for a brief sur-rebuttal. *See* CTPG 83.

The parties may request a pre-hearing conference in advance of the hearing. *See* 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." *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 no later than five (5) business days before the hearing.⁷

⁶ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

⁷ 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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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 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

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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 two (2) business days before 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.⁸ 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.

⁸ If time permits, the Board may schedule a conference call with the parties to discuss any filed objections.

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