

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOPEWELL PHARMA VENTURES, INC.,
Petitioner,

v.

MERCK SERONO S.A.,
Patent Owner.

IPR2023-00480 (Patent 7,713,947 B2)
IPR2023-00481 (Patent 8,377,903 B2)¹

Before ZHENYU YANG, ROBERT A. POLLOCK, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

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

¹ This Order addresses issues that are the same in the identified proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not, however, authorized to use this style heading.

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I. ORAL ARGUMENT

We instituted *inter partes* review in the above-identified proceedings on September 22, 2023. Paper 10.² The Scheduling Order sets the date for oral argument as June 25, 2024, if requested by the parties and granted by the Board. Paper 11, 12. On May 9, 2024, and May 10, 2024, Petitioner and Patent Owner each filed a request for oral argument, respectively. Papers 48 and 49. The parties agree that oral argument for IPR2023-00480 and IPR2023-00481 should be conducted in one consolidated hearing. *Id.* Petitioner's and Patent Owner's requests for oral argument are *granted*.

A. Time and Format³

Oral arguments will commence at **1:00 PM Eastern Time on June 25, 2024**, on the ninth floor of the Madison Building East, 600 Dulany Street, Alexandria, Virginia, in **Hearing Room A**.⁴ The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing.

As requested by the parties, Petitioner will have **a total of sixty (60) minutes** to present argument and Patent Owner will have **a total of sixty (60) minutes** to respond (i.e., total argument time for the consolidated hearing will not exceed two hours absent further allowance from the Board). Paper 48, 1; Paper 49, 1. Petitioner will open the hearing by presenting its

² All citations are to IPR2023-00480 with the understanding that corresponding papers were entered in IPR2023-00481.

³ If a party is no longer able to appear for the hearing, the party must contact PTABHearings@uspto.gov as soon as possible.

⁴ If there are any concerns about disclosing confidential information, and such concerns are not otherwise addressed in this Order, the parties must contact the Board at Trials@uspto.gov at least ten (10) business days before the hearing date.

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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 Guide⁵

("CTPG"), issued in November 2019, Patent Owner may request to reserve time for a brief sur-rebuttal. *See* CTPG 83. Neither party may reserve more than fifteen (15) minutes from the time allotted for their respective rebuttal or sur-rebuttal.

The parties may request a pre-hearing conference in advance of the hearing. *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.

If the parties anticipate disclosing information that is alleged to be confidential during oral argument, the parties should segregate, if possible, such disclosure of confidential information to a certain portion of their respective presentations. The parties should inform the Board during the argument, and before such disclosure is made, that they intend to argue a point or cite an exhibit that requires disclosure of confidential or potentially confidential information so that the Board may take appropriate action to safeguard such information. The parties should also consider whether it is

⁵ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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possible to make their oral arguments without specific disclosure of confidential information (e.g., referring to the evidence generally, and directing the Board’s attention to papers and/or exhibits to which the Board and parties have access, but which are presently filed subject to a motion to seal). Objections during the other party’s portions of oral argument are generally not expected, except to the extent necessary to preserve information as confidential. These efforts will assist the Board in maintaining, to the full extent possible, these proceedings as open to the public, consistent with our rules. 37 C.F.R. § 42.14.

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. Demonstratives also must be filed no later than three (3) business days before the hearing date.⁶

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

⁶ 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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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 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 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 two (2) business days before 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

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