

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GRÜNENTHAL GMBH,
Petitioner,

v.

ANTECIP BIOVENTURES II LLC,
Patent Owner.

Case PGR2019-00026 (Patent 9,931,352)
Case PGR2019-00027 (Patent 10,039,774)
Case PGR2019-00028 (Patent 10,052,338)¹

Before GRACE K. OBERMANN, CHRISTOPHER M. KAISER, and
WESLEY B. DERRICK, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER
Granting Requests for Oral Hearing
37 C.F.R. § 42.70

¹ This Order addresses issues common to all three proceedings. The parties are not authorized to use this style heading in any papers.

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I. HEARING AND ATTENDANCE

Both Petitioner and Patent Owner request an oral hearing pursuant to 37 C.F.R. § 42.70 in each of the three proceedings identified in the caption. Paper 17, 18.² The requests are *granted* subject to the conditions set forth in this Order.

Oral argument(s) will commence at **1:00 PM Eastern Time on April 24, 2020**, by video. The parties are directed to contact the Board at least 10 days in advance of the hearing 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.

If at any time during the proceeding, you encounter technical or other difficulties that fundamentally undermine your ability to adequately represent your client, please let the panel know immediately, and adjustments will be made.³

To facilitate planning, each party must contact PTAB Hearings at (571) 272-9797 five (5) business days prior to the oral 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 to be used 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

² Petitioner filed the same, and Patent Owner filed substantially the same, requests in each proceeding. For convenience, paper numbers refer to papers filed in PGR2019-00026.

³ For example, if a party is experiencing poor video quality, the Board may provide alternate dial-in information.

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provided with dial-in connection information, and the oral hearing will be conducted telephonically.

If one or both parties would prefer to participate in the oral hearing telephonically, they should notify PTAB Hearings at the above telephone number five (5) business days prior to the hearing to receive dial-in connection information.

Petitioner requests that all “three proceedings be heard at the same time and requests a total of ninety minutes per side.” Paper 17, 1. “Patent Owner agrees with Petitioner’s request that oral argument in all three matters should be heard at the same time, and that each side should have a total of ninety minutes in which to present.” Paper 18, 1. The cases shall be heard in a consolidated hearing in which each side will have ninety (90) minutes to present. These proceedings, however, are not consolidated. The parties are directed to prevent blurring of the evidence between proceedings (for example, by referring to an exhibit filed in one proceeding while advancing argument in another proceeding in which the same exhibit is not of record).

Petitioner will present its case first. Patent Owner will then present its case. Next, Petitioner may use any time it has reserved for rebuttal, not to exceed half the time allotted to it for argument, to respond to issues raised during Patent Owner’s argument. Lastly, Patent Owner may use any time it has reserved for sur-rebuttal, not to exceed thirty (30) minutes, to address issues raised during Petitioner’s rebuttal.

The Board expects lead counsel for each party to be present by video at the oral hearing. However, any counsel of record may present a party’s argument as long as that counsel is present by video. If either party expects

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that its lead counsel will not be attending the oral argument, the parties should initiate a joint telephone conference with the Board no later than two (2) business days prior to the oral hearing to discuss the matter.

II. DEMONSTRATIVE EXHIBITS

Under 37 C.F.R. § 42.70(b), demonstrative exhibits must be served at least seven (7) business days before the hearing. The parties also shall provide the demonstrative exhibits to the Board at least two (2) business days prior to the hearing by emailing them to Trials@uspto.gov. Despite the requirement in § 42.70(b) for parties to file demonstratives, the parties shall *not* file any demonstrative exhibits in these cases without prior authorization from the Board.

Demonstrative exhibits used at the oral hearing are aids to oral argument and not evidence, and should be clearly marked as such. For example, each slide of a demonstrative exhibit may be marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. Demonstrative exhibits cannot be used to advance arguments or introduce evidence not previously presented in the record. *See Dell Inc. v. Accelaron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) (noting that the “Board was obligated to dismiss [the petitioner’s] untimely argument . . . raised for the first time during oral argument”). Each demonstrative must include a citation to the page number(s) of the paper(s) where the argument or evidence that is the subject of the demonstrative was advanced by a party.

The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041, Paper 65 (PTAB Jan. 27, 2014), regarding the appropriate content of

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demonstrative exhibits. The Board expects that the parties will meet and confer in good faith to resolve any objections to demonstrative exhibits, but 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 should identify with particularity which portions of the demonstrative exhibits 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 schedule a conference call if deemed necessary. Otherwise, the Board will reserve ruling on the objections. Any objection to demonstrative exhibits that is not timely presented will be considered waived.

The panel will have access to all papers filed with the Board, as well as demonstratives submitted via email according to the above instructions. During the oral hearing, the parties must identify clearly and specifically each demonstrative referenced (e.g., by slide or screen number) to ensure the clarity and accuracy of the court reporter's transcript. The Board requests identification for *all* exhibits discussed during oral argument in the interest of providing a clear record. In addition, the parties are requested to identify themselves each time they speak. Further, the remote nature of the oral hearing may also result in an audio lag. Accordingly, counsel should observe a pause prior to speaking, so as to avoid speaking over others. Please unmute yourself only when speaking.

Per the Office Patent Trial Practice Guide, either party may request a pre-hearing conference. *See* Office Patent Trial Practice Guide, 84 Fed.

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