

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

CANFIELD SCIENTIFIC, INC.,  
Petitioner,

v.

MELANOSCAN, LLC,  
Patent Owner.

---

Case IPR2017-02125  
Patent 7,359,748

---

Before JOHN C. KERINS, MICHAEL W. KIM, and SCOTT C. MOORE,  
*Administrative Patent Judges.*

KERINS, *Administrative Patent Judge.*

ORDER  
Trial Hearing  
37 C.F.R. § 42.70

Petitioner requests oral hearing pursuant to 37 C.F.R. § 42.70. Paper 41.  
Upon consideration, the request for oral hearing is *granted*.

The oral hearing will commence at 1:00 PM, Eastern Time, on December 5, 2018, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia. The hearing will be open to the public for in-person attendance that will be accommodated on a first-come, first-served basis. The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing. Petitioner requests sixty (60) minutes of oral argument time. The request is granted. Each party will have sixty (60) minutes of total time to present arguments.

As the party with the burden of proof and persuasion, on all issues except Patent Owner's Motion to Exclude, Petitioner will proceed first to present its case with regard to the challenged claims and grounds set forth in the Petition, and on any other relevant issue in this proceeding. Thereafter, Patent Owner may respond to Petitioner's case. Thereafter, Petitioner may use any of its remaining time for rebuttal regarding Patent Owner's arguments regarding the challenged claims. And, thereafter, Patent Owner may use any of its remaining time for sur-rebuttal, to respond to Petitioner's rebuttal arguments.

At least five (5) business days prior to the hearing, each party shall serve on the other party any demonstrative exhibit(s) it intends to use during the hearing. *See* 37 C.F.R. § 42.70(b). At least two (2) business days prior to the hearing, the parties shall provide the demonstrative exhibits to the Board by emailing them to Trials@uspto.gov. The parties shall not file any demonstrative exhibits in this case, 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. Acceleron, 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”).

The parties should attempt to work out any objections to demonstratives prior to involving the Board. Should either party disagree with the propriety of any of the opposing parties’ demonstratives, the party may send, contemporaneously with their own slides two (2) business days prior to the hearing, an email to [Trials@uspto.gov](mailto:Trials@uspto.gov) including a paper limited to identifying the opposing parties’ slide(s) objected to, and brief sentence as to the general basis of the objection. No further argument is permitted in that paper. The Board will then take the objections under advisement, and if the content is inappropriate, it will not be considered. Any objection to demonstrative exhibits that is not timely presented will be considered waived. The Board asks the parties to confine demonstrative exhibit objections to those identifying egregious violations that are prejudicial to the administration of justice. The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, Case IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits. In general, if the content on a slide cannot be readily associated with an argument made, or evidence referenced, in a substantive paper, it is inappropriate. The best practice is to indicate on each slide where support may be found in a substantive paper and/or an exhibit of record in this proceeding.

The parties are reminded that each presenter must identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number) referenced during the hearing to ensure the clarity and accuracy of the reporter's transcript. The parties also should note that at least one member of the panel may be attending the hearing electronically from a remote location, and that if a demonstrative is not served in the manner described above or otherwise made fully available or visible to all judges at the hearing, that demonstrative will not be considered. If the parties have questions as to whether demonstrative exhibits would be sufficiently visible and available to all of the judges, the parties are invited to contact the Board at (571) 272-9797.

The Board expects lead counsel for each party to be present in person at the hearing. If a party anticipates 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 business days prior to the oral hearing to discuss the matter. Any counsel of record, however, may present the party's arguments.

Per the recent update to the Office Patent Trial Practice Guide, either party may request a pre-hearing conference. Office Patent Trial Practice Guide, August 2018 Update, 83 Fed. Reg. 39,989 (Aug. 13, 2018) (found at the following link to the USPTO website: <https://go.usa.gov/xU7GP>). Requests for a pre-hearing conference must be made by November 27, 2018. To request such a conference, an email should be sent to [Trials@uspto.gov](mailto: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. Please refer to the Guide for more information on the pre-hearing conference.

Requests for audio-visual equipment are to be made at least five business days in advance of the date of the hearing by sending the request to

IPR2017-02125  
Patent 7,359,748

Trials@uspto.gov. If the request is not received timely, the equipment may not be available on the day of the hearing.

IPR2017-02125  
Patent 7,359,748

PETITIONER:

Julianne M. Hartzell  
Sandip H. Patel  
MARSHALL, GERSTEIN & BORUN LLP  
jhartzell@marshallip.com  
spatel@marshallip.com  
PATENT OWNER:

Mark D. Giarratana  
Kevin L. Reiner  
McCARTER & ENGLISH LLP  
mgiarratana@mccarter.com  
kreiner@mccarter.com