

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3M COMPANY, MERCK & CO., INC. and
MERCK SHARP & DOHME CORP.,
Petitioner,

v.

APTAR FRANCE S.A.S. and APTARGROUP, INC.,
Patent Owner.

Cases¹

IPR2018-01054 (Patent No. 8,936,177 B2)
IPR2018-01055 (Patent No. 9,370,631 B2)

Before HYUN J. JUNG, SCOTT A. DANIELS, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

ORDER
Trial Hearing
37 C.F.R. § 42.70

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

The parties requested oral argument pursuant to 37 C.F.R. § 42.70 in the above-captioned proceedings. *See* Papers 38, 40 in Case IPR2018-01054; Papers 38, 40 in Case IPR2018-01055. The parties' requests are *granted*.

Oral argument for the proceeding will commence at 1:00 PM Eastern Time on August 12, 2019, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia 22314. The hearing will be open to the public for in-person attendance, and in-person attendance 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.

Each party will have ninety (90) minutes of total argument time for both cases. The parties may use their argument time to present their arguments as they see fit. If the panel requires a lengthy examination of a party's argument, the panel may extend argument time. If the panel extends argument time for one party, the panel will extend argument time for the other party by an equal amount.

Petitioner bears the ultimate burden of proof that the claims at issue are unpatentable. Therefore, at the hearing, Petitioner will proceed first to present its arguments with regard to the challenged claims and grounds on which basis we instituted trial in this proceeding. Petitioner may reserve rebuttal time. Thereafter, Patent Owner will argue its opposition to Petitioner's case and present the issues for which it bears the ultimate burden. Patent Owner may also reserve rebuttal time. To the extent Petitioner reserves rebuttal time, Petitioner then may make use of its rebuttal time responding to Patent Owner. To the extent Patent Owner reserves

rebuttal time, Patent Owner then may make use of its rebuttal time responding to Petitioner.

Under 37 C.F.R. § 42.70(b), demonstrative exhibits must be served at least *seven business days* before the hearing. The parties also shall file a copy of the demonstratives as an exhibit at least *seven business days* prior to the hearing. Each party shall provide a hard copy of its demonstratives to the court reporter at the hearing. The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits. The parties shall meet and confer to discuss any objections to demonstrative exhibits at least *three business days* before the hearing. If any issues regarding demonstratives remain unresolved after the parties meet and confer, the parties shall file jointly a one-page list of objections to the demonstrative exhibits at least *two business days* before the hearing. For each objection, the list must identify with particularity the demonstratives subject to the objection and include a short, one-sentence statement explaining the objection. The panel will consider the objections and schedule a conference call if necessary. Otherwise, rulings on the objections will be reserved until the hearing or after the hearing. Any objection to demonstrative exhibits not presented timely will be considered waived.

The parties are reminded that demonstrative exhibits are visual aids to oral argument and not evidence, and should be clearly marked as such. For example, each slide may be marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. Demonstrative exhibits may not 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”). Instead, demonstrative exhibits should cite to the briefs and evidence in the record.

Requests for a pre-hearing conference must be made by July 29, 2019. To request such a 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. Please refer to the Guide for more information on the prehearing conference.

The Board expects lead counsel for each party to be present in person at the hearing. Lead or backup counsel, however, may present the party’s argument. If either party anticipates that its lead counsel will not be attending the hearing, that party should initiate a joint telephone conference with the other party and the panel no later than *three business days* prior to the hearing to discuss the matter.

A party may request remote video attendance for one or more of its other attendees to view the hearing from any USPTO location. The available locations include the Texas Regional Office in Dallas, Texas; the Rocky Mountain Regional Office in Denver, Colorado; the Elijah J. McCoy Midwest Regional Office in Detroit, Michigan; and the Silicon Valley Office in San Jose, CA. To request remote video viewing, a party must send an email message to Trials@uspto.gov *ten business days* prior to the hearing, indicating the requested location and the number planning to view the hearing from the remote location. The Board will notify the parties if the request for video viewing is granted. Note that it may not be possible to grant the request due to the availability of resources.

Requests for audio-visual equipment are to be made *five business days* in advance of the hearing date. A party may also indicate any special requests related to appearing at an in-person oral hearing, such as a request to accommodate physical needs that limit mobility or visual or hearing impairments, and indicate how the PTAB may accommodate the special request. The request is to be sent to Trials@uspto.gov. If the request is not received timely, the equipment may not be available on the day of the hearing.

It is

ORDERED that oral argument in the above-captioned proceedings will commence at 1:00 PM Eastern Time on August 12, 2019, in Alexandria, Virginia.

IPR2018-01054 (Patent No. 8,936,177 B2)

IPR2018-01055 (Patent No. 9,370,631 B2)

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