

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SPECTRA LOGIC CORPORATION  
Petitioner,

v.

OVERLAND STORAGE INC.  
Patent Owner.

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Case IPR2013-00357  
Patent 6,328,766

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Before KEVIN F. TURNER, JAMES A. TARTAL, and  
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

A conference call was held on July 21, 2014, at 1:30 PM EDT. The participants of the call were respective counsel for the parties and Judges Turner, Tartal, and Clements. Counsel for Petitioner initiated the call to seek guidance from the Board regarding the appropriate content of demonstrative exhibits at final oral hearing, which is scheduled for 2:00 PM EDT, July 23, 2014.

According to Petitioner, it raised objections over some of Patent Owner's demonstratives in a conference call with Patent Owner, and Patent Owner did not raise any objections to Petitioner's demonstratives prior to or in the conference call. The parties were not able to reach a consensus on objections over the demonstratives and requested the above-cited conference call.

Petitioner objects to slides 3-15 and 17-23 primarily for: (1) new picture of Figure 2 that wasn't presented identically in the trial history; and (2) lines which have been altered in that figure. Petitioner alleged that the slides provide media transporters moving light gray boxes, which may be tape cartridges, and then added a new host computer that's not in Figure 2. Similar arguments with respect to slides 24 and 25, vis-à-vis Figure 3, are also made, as well as objections to slides 43 and 44. Petitioner also argues that slides 30 and 42 are new in that they also contain arguments that are new or new in form.

Patent Owner argues that portions of the objected to slides are intended to be a tutorial on the patent at issue and are based on descriptions in its brief. While Patent Owner acknowledges that the graphics in the slides do not appear in the brief or other papers, the slides are based on Figure 2 and all of the functionalities depicted are described in the brief. Patent Owner also argues

that there was nothing wrong with the other slides that provide arguments already made in the brief.

Unlike trials conducted in district courts, a trial before the Board is conducted on paper. By the time the proceeding reaches final oral hearing, nothing new can be presented, no new evidence, no new arguments. *Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). At that stage the final oral hearing is not an opportunity to add anything to a party's case. Whatever a party desires to present, for whatever reason, should have already been presented in the party's petition, response, opposition, motion, reply, declarations, observations on cross-examination, or other exhibits presented at an appropriate time during the trial prior to final oral hearing.

We issued instructions on the conference call and commemorate them here for the parties. The panel agrees that many of the demonstratives are not necessary and go beyond to present material that is not necessarily evidence. The panel prefers that the parties hew closer to patent drawings. As such, the panel directs that slides 3-15, 17-25, 43, 44, and 51 of Patent Owner's demonstratives be taken out or not used during the oral hearing. It is up to the discretion of the Patent Owner whether it wants to substitute Figures 2 or 3 for some of the slides to be omitted, or Patent Owner may simply skip over those particular slides during the hearing.

In terms of other slides, i.e., those objected to by Petitioner for containing arguments, the panel does not have an issue with those slides since they were made in the brief, even if restated in a slightly different fashion.

Order

It is

ORDERED that the Patent Owner may not, at final oral hearing, use the slides numbered 3-15, 17-25, 43, 44, and 51, contained in its Exhibit 2007, as demonstrative exhibits;

FURTHER ORDERED that Patent Owner is permitted to provide substitute slides for the prohibited slides, based solely on the Figures of the subject patent or other illustration provided in the filed papers; any such substitute slides must be filed with the Board using PRPS at least two hours prior to the start of the oral hearing; and

FURTHER ORDERED that either party may, at oral hearing, use any page from the record as a demonstrative exhibit, so long as the content of the page has been specifically discussed in an appropriate paper in the proceeding.

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