

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
v.

MARK A. BARRY
Patent Owner

Case IPR2015-00780
Patent 7,760,358 B2
Case IPR2015-00783
Patent 7,776,072 B2¹

Before DONNA M. PRAISS, BRIAN J. McNAMARA, and JEREMY M. PLENZLER, Administrative Patent Judges.

McNAMARA, *Administrative Patent Judge*.

CONDUCT OF THE PROCEEDING
37C.F.R. § 42.5

¹ This Order addresses issues that are identical in related cases. Therefore, we exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in any subsequent papers.

On May 11, 2016, at the request of Medtronic Inc. (“Petitioner”) we conducted a teleconference to consider Petitioner's objections to the use of certain demonstratives by Mark A. Barry (“Patent Owner”) during the oral hearing scheduled to take place on May 17, 2016. Prior to the call, Patent Owner submitted copies of the demonstrative slides at issue (slides 4–6, 8, 26, 28, 29, 33, and 58). During the call, the parties were given the opportunity to present their respective positions. The parties also indicated that in a “meet and confer” prior to the conference with the Panel, the parties stipulated that any demonstratives used during the hearing would be expunged from the record after the oral argument. A court reporter was also present on the call.

Demonstrative slides are visual aids to a party’s oral presentation. *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, Case No. IPR2013-00033, slip op. at 3, (PTAB Oct. 23, 2013)(Paper 118). Demonstrative exhibits are not evidence and as such, the exhibits cannot add new evidence to the record of the proceeding. *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, Case No. IPR2013-00041, slip op. at 2 (PTAB Jan. 27, 2014) (Paper 65). Demonstrative exhibits are not an opportunity for additional briefing. *Id.* at 3.

We begin with demonstrative slides 8 and 58. Demonstrative slide 8 is a reproduction of the abstract of one of the patents at issue in these proceedings, i.e., U.S. Patent No. 7,760,358 B2 (the ’358 patent). The ’358 patent is Exhibit 1020 in IPR2015-00780. Petitioner contends that although the ’358 patent is cited extensively in the record, Patent Owner did not cite specifically to this Abstract. Demonstrative slide 58 is a reproduction of a portion of the license agreement Patent Owner produced as Exhibit 2043. Patent Owner sites to page 2 of this license agreement in the Patent Owner Response. PO Resp. 58. The material

Patent Owner seeks to include on demonstrative slide 58 actually appears on page 3 of Exhibit 2043 as part of the license agreement paragraph numbered (1) that begins on page 2. Petitioner contends that Patent Owner did not cite specifically to the subject matter on page 3.

Exhibits cannot rely on evidence that, although it is in the record, was never specifically discussed in any paper before the board. *St. Jude Medical*, at 2–3. Petitioner would have us extend this principle to prohibit demonstratives from citing to any passage of an exhibit not cited in a pleading, even if the exhibit itself is cited. We do not adopt such a sweeping rule. In this particular case, Patent Owner’s citation to the Abstract of the ’358 Patent does not in any way prejudice Petitioner. Similarly, citing to material on the next page of the license agreement that is part of a paragraph beginning on the previous page in no way prejudices Petitioner. Therefore, Patent Owner will be permitted to use demonstrative slides 8 and 58.

We next turn to demonstrative slides 4–6. Petitioner objects to these slides as improperly presenting new argument and expanding upon Patent Owner's reliance on declaration testimony, in a manner not already previously presented. *CBS Interactive*, at 2, 4–5. The subject matter of demonstrative slides 4–6 concerns arguments made in the Patent Owner Response that Patent Owner invented the claimed subject matter and was diligent in reducing the invention to practice, so as to antedate the reference. PO Resp. 29–30. The arguments in the Patent Owner Response are general in nature and do not address specifics, such as machining slots in the end of anti-torque stabilizer tools and placing the rod through slots on adjacent handles, discussed in demonstrative slides 4–6. Thus, we agree with Petitioner that slides 4–6 introduce new argument and may not be presented at the oral hearing.

Patent Owner's demonstrative slides 26, 28, 29, and 33 all reference testimony taken by Petitioner during cross examination of Patent Owner's expert witness, Dr. Walid Yassir. During the teleconference, Petitioner cited *CBS Interactive* for the proposition that Patent Owner may not cite to the cross examination testimony of its declarant in a demonstrative slide or during oral argument because that would constitute new argument. According to Petitioner, citing such testimony is new argument because it has not been said that way before in a previous paper. However, taken literally, Petitioner's position is that anything said during oral argument that is not a direct quote from a previously filed paper is new argument because it has not been said that way before.

CBS Interactive states that a party may not "expand" the development of testimony already presented if there is no more responsive paper to be filed under applicable rules. *CBS Interactive* at 4–5. The final oral hearing is not an opportunity for a party to expand upon its reliance on declaration testimony in a manner not already presented. *Id.* at 5. Nor is it an opportunity to present a sur-reply. However, *CBS Interactive* does not invite a party to cite testimony in a way that takes a witness's statements out of context or incompletely characterizes a witness's testimony, without providing the other party an opportunity to respond.² We do not read *CBS Interactive* to bar Patent Owner from citing to testimony that is consistent with or provides context to arguments already made by Patent Owner or disputes characterizations made by Petitioner during the cross examination or in the Petitioner Reply, as long as the cited testimony does not "expand" the arguments made in the Patent Owner Response.

² We do not suggest that is the case in this proceeding.

Patent Owner's demonstrative slide 26 cites to six lines of testimony immediately preceding several lines of testimony cited in the Petitioner Reply. The subject matter cited in this demonstrative merely provides context to the testimony cited by Petitioner. Patent Owner's demonstrative slide 28 cites to testimony where the witness disagrees with a characterization of a reference in a question posed by Petitioner's counsel during cross examination. Patent Owner's demonstrative slide 29 contains the witness's response to a question from Petitioner's counsel concerning the system in the reference. Patent Owner's demonstrative slide 33 reflects the witness's disagreement with another proposition advanced by Petitioner's counsel during the cross examination. It is not clear at this point whether any of the subject matter in Patent Owner's demonstrative slides 26, 28, 29 and 33 expands the declaration testimony of the witness. Therefore, we exercise our discretion and permit these slides to be used at the oral hearing.

In consideration of the above it is

ORDERED that Patent Owner's demonstrative slides 4–6 may not be used at the oral hearing;

FURTHER ORDERED that Patent Owner's demonstrative slides 8, 26, 28, 29, 33, and 58 may be used at the oral hearing; and

FURTHER ORDERED that Petitioner file a copy of the transcript of the telephone conference.

IPR2015-00780; IPR2015-00783
Patent 7,760,358 B2; 7,776,072 B2

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