

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ST. JUDE MEDICAL, CARDIOLOGY DIVISION, INC.,
Petitioner,

v.

THE BOARD OF REGENTS OF THE UNIVERSITY OF MICHIGAN,
Patent Owner.

Case IPR2013-00041
Patent No. 5,746,775

Before MICHAEL J. FITZPATRICK, RAMA G. ELLURU, and
CHRISTOPHER L. CRUMBLEY, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

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

A conference call was held on January 24, 2014, at approximately 10:30 a.m., among William Mentlik representing Petitioner, St. Jude Medical, Cardiology Division Inc. (“St. Jude”), David Casimir representing Patent Owner, The Board of Regents of the University of Michigan (“University of Michigan”),

and Judges Fitzpatrick, Elluru, and Crumbley. St. Jude requested the call via e-mail¹, to provide the Board with its objections to the demonstrative exhibits University of Michigan proposes to use at the upcoming oral hearing in this proceeding.

I. Demonstrative Exhibits

As instructed in the Board's January 15, 2014 Order – Trial Hearing, the parties filed proposed demonstrative exhibits with the Board two business days before the hearing. University of Michigan originally filed 36 proposed demonstratives; in view of the Board's January 24, 2014 Decision – Motions to Seal, demonstrative number 36 was withdrawn and the remaining 35 exhibits were re-filed. Paper 64.

St. Jude objects to 25 of University of Michigan's 35 demonstrative exhibits: slides 7-15, 17-28, 30, and 33-35. Ex. 3003. According to St. Jude, the demonstratives go beyond the guidelines set forth in *CBS Interactive Inc. v. Helferich Patent Licensing LLC*, IPR2013-00033 (PTAB Oct. 23, 2013) (Paper 118), which we advised the parties to consider in our Trial Order. St. Jude contends that the demonstratives contain argumentative characterizations of the record and present additional argument not contained in any prior briefing to the Board. Ex. 3003.

During the call, the Board explained to the parties that demonstrative exhibits are not evidence; as such, the exhibits cannot add new evidence to the record of the proceeding. Nor can the exhibits rely on evidence that, although it is

¹ During the call, we cautioned the parties against using e-mail to convey substantive argument to the Board, as such communications are not automatically made part of the record of the proceeding and, therefore, may deprive the public of full knowledge of the arguments made in the case. We will enter St. Jude's January 21, 2014 email to the Board as Exhibit 3003.

in the record, was never specifically discussed in any paper before the Board. Similarly, demonstrative exhibits are not an opportunity for additional briefing. Arguments that have not been made previously cannot be made at the trial hearing, and thus, cannot be in a demonstrative exhibit.

Nevertheless, demonstrative exhibits are intended to be visual aids to assist a party in making its oral presentation. The Board is capable of distinguishing evidence in the record from argument contained in a demonstrative exhibit. Some characterization of the evidence in a demonstrative is, therefore, permissible—assuming such characterization was made previously in a paper. Impermissible, however, are mischaracterizations of the record, or citations to the record that do not support the content of a demonstrative exhibit.

During the call, the parties were given the opportunity to represent their respective positions. After conferring among the panel, the Board determined that it would take St. Jude's objections under advisement. Counsel for St. Jude then suggested that, rather than strike University of Michigan's demonstratives, the Board could permit the demonstrative exhibits to be used at the hearing, but then expunge them from the record of the case.

Upon consideration, we determine that several of St. Jude's objections to University of Michigan's demonstrative exhibits have merit. Upon questioning by the Board during the call, University of Michigan admitted that some slides include characterizations of evidence that are not found in the citations provided. For example, slide 18 includes the statement that "[e]arly calcification is *likely* caused by infection, thrombus, and/or damage to the tissue during implantation." (emphasis added). The slide, however, cites two deposition transcripts (Ex. 2031 and Ex. 2033) and the Gabbay 1982 reference (Ex. 1033), which University of Michigan conceded did not include the "likely" characterization.

Several other slides contain characterizations that are not supported adequately by the citations to the record appearing on the slides, or arguments supported only by citations to University of Michigan's Observations on Cross-Examination.² *See, e.g.*, slide 23. Other slides contain argument without showing how such arguments were previously presented to the Board. Slide 13, for instance, cites only to the Gong reference (Ex. 1015), but then contains two bullet-point arguments regarding the reference's alleged teaching away.

Parsing every objected-to demonstrative exhibit, to determine whether each included argument was previously presented or characterization is fully supported, is not an efficient use of the Board's resources. University of Michigan's demonstrative exhibits constitute a single paper, and thus the Board has determined that all of the slides of the demonstratives stand or fall together. This rule properly places the responsibility of ensuring that all proposed demonstrative exhibits are permissible on the party offering the exhibits, rather than on the Board. *See CBS Interactive*, IPR2013-00033 (Paper 118) at 5 ("In light of the number of the non-compliant slides involved, and the inefficiencies of sorting through all of the slides, one by one, the Board exercised discretion to not allow presentation of any [slides].").

Given the circumstances of this case, however, we exercise our discretion to allow University of Michigan's demonstrative exhibits. St. Jude has indicated that expunging each party's demonstrative exhibits from the record of the proceeding would mitigate any potential prejudice that would arise from University of Michigan's proposed demonstratives. As demonstratives are not evidence in the proceeding, and are intended only to assist the parties in presenting their oral

² Argumentative observations on cross-examination are not permitted. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48755, 48768 (Aug. 14, 2012).

arguments to the Board, we discern no prejudice from expunging the demonstratives from the record.

In view of this ruling, the parties are cautioned that references to demonstrative exhibit slide numbers at the trial hearing will not provide a meaningful reference in the official transcript of the hearing. Thus, if counsel wishes a citation to appear in the record in a meaningful way, it should provide citations to the record.

II. Audio Visual Equipment

During the call, the parties also requested certain audio visual equipment to be provided by the Board for use at the oral hearing. St. Jude requested the use of two easels for displaying blown-up versions of its demonstratives, as well as an ELMO projector. University of Michigan requested the use of a projector that may be connected to counsel's laptop computer. The Board will supply the requested equipment; counsel for the parties should arrive to the hearing room early enough to familiarize themselves with the equipment and ensure there are no technical problems.

For the foregoing reasons, it is

ORDERED that Petitioner's objections to Patent Owner's Demonstrative Exhibits are *overruled*; and

FURTHER ORDERED that Petitioner's Demonstrative Exhibits (Paper 61) and Patent Owner's Demonstrative Exhibits (Paper 64) will be expunged from the record of the proceeding following oral argument.

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