

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MCAFEE, INC.,

Petitioner,

v.

CAP CO., LTD.,

Patent Owner.

Case IPR2016-00216
Patent RE42,196

Paper 32

PETITIONER'S REQUEST FOR ORAL ARGUMENT

November 2, 2016

Petitioner McAfee, Inc. hereby requests an oral hearing pursuant to 37 C.F.R. § 42.70 and the Board's Scheduling Order dated May 6, 2016 (Paper 9), providing for an oral argument, if requested, on December 7, 2016. Petitioner requests the oral argument to discuss the issues raised in the parties' filings under the on-going review, including but not limited to, the following items:

1. Whether claim 2 of U.S. Patent No. RE42,196 (the "'196 Patent") is obvious over the disclosures of Hodges in view of Butt and Kephart under 35 U.S.C. § 103(a);
2. Whether claim 7 of the '196 Patent is obvious over the disclosures of Hodges in view of Butt under 35 U.S.C. § 103(a);
3. If claim(s) 2 and/or 7 is/are held to be invalid, whether the corresponding proposed substitute claim(s) 37 and 38 in Patent Owner's Conditional Motion to Amend satisfies the written description and enablement requirements under 35 U.S.C. § 112 and the requirements under 37 C.F.R. § 42.121(b).
4. If claim 1 of the '196 Patent is held to be invalid and proposed substitute claim 36 is held to satisfy the written description and enablement requirements under 35 U.S.C. § 112 and the requirements under 37 C.F.R. § 42.121(b), whether substitute claim 36 in Patent Owner's Conditional Motion to Amend is obvious over the disclosures of Hodges in view of Butt, Hodges in view

of Butt and Kephart, Lee in view of Butt, or Lee in view of Butt and Kephart III.

5. If claim 2 of the '196 Patent is held to be invalid and substitute claim 37 is held to satisfy the written description and enablement requirements under 35 U.S.C. § 112 and the requirements under 37 C.F.R. § 42.121(b), whether proposed substitute claim 37 in Patent Owner's Conditional Motion to Amend is obvious over the disclosures of Hodges in view of Butt and Kephart or Lee in view of Butt and Kephart under 35 U.S.C. § 103(a);

6. If claim 7 of the '196 Patent is held to be invalid and substitute claim 38 is held to satisfy the written description and enablement requirements under 35 U.S.C. § 112 and the requirements under 37 C.F.R. § 42.121(b), whether proposed substitute claim 38 in Patent Owner's Conditional Motion to Amend is obvious over the disclosures of Hodges in view of Butt, Hodges in view of Butt and Kephart, Hodges in view of Butt, Kephart, and Kephart III, Lee in view of Butt, Lee in view of Butt and Kephart, or Lee in view of Butt, Kephart, and Kephart III under 35 U.S.C. § 103(a);

7. Rebuttal to the Patent Owner's presentation on all issues or arguments raised by it in its Response (Paper 16), Conditional Motion to Amend (Paper 15), or that may be raised by it before the Board; and

8. Any other issues related to invalidity that the Board deems necessary for issuing a final written decision.

Additionally, Petitioner requests permission to use audio/visual equipment to display demonstratives and exhibits.

Petitioner asks the Board to decide the length of time needed for requested oral argument for each party, and suggests that 75 minutes per side should be adequate to cover all the arguments in this case and the related matter of PTAB Case No. IPR2015-01855, IPR2015-01877 and IPR2016-00222 regarding additional but related claims (1, 3-5, 8-12, and 14-15) in the '196 Patent.

Petitioner currently plans to bring 5 individuals to the hearing.

This request is timely filed by Due Date 4 pursuant to the Scheduling Order dated May 6, 2016 (Paper 9).

Dated: November 2, 2016

Respectfully submitted,

/s/ James F. Valentine

Lead Counsel

James F. Valentine, Reg. No. 39,053

Back-up Counsel

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing PETITIONER'S REQUEST FOR ORAL ARGUMENT was served in their entirety this 2nd day of November 2016 by electronic mail on the Patent Owner via its attorneys of record:

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/s/ James F. Valentine

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