

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YMAX CORPORATION
Petitioner

v.

FOCAL IP, LLC
Patent Owner

Case: IPR2016-01260
U.S. Patent No. 8,457,113

**PETITIONERS' REQUEST FOR ORAL ARGUMENT
PURSUANT TO 37 C.F.R. § 42.70(a)**

Pursuant to 37 C.F.R. § 42.70(a), Petitioner YMax Corporation

(“Petitioner”) requests an oral hearing in IPR Nos. IPR2016-01256; IPR2016-01258; and IPR2016-01260. The Board has set Due Date 7 for September 19, 2017 for these IPRs. Paper No. 13 at 4, 6. Petitioner requests (without any intent to waive consideration of any issue not requested) a total of 90 minutes for the Petitioner to address the following issues at the oral hearing for these IPRs:

1. The unpatentability of claim 1 of U.S. Patent No. 8,155,298 (“the ‘298 patent”) from instituted Ground 1 (U.S. Patent No. 6,463,145 to O’Neal *et al.* (“O’Neal”) in view of U.S. Patent No. 5,809,128 to McMullin (“McMullin”), the Admitted Prior Art and the knowledge and skill of a person of ordinary skill in the art (“POSA”) in May 2000), and claim 20 of the ‘298 patent from Ground 2 (O’Neal in view of U.S. Patent No. 5,958,016 to Chang *et al.* (“Chang”), the Admitted Prior Art and the knowledge and skill of a POSA in May 2000) as relied upon in the Petition in IPR2016-01256;
2. The unpatentability of claims 18, 23, 25, 26, 29–31, 37, 38, 41, and 45 of U.S. Patent No. 7,764,777 (“the ‘777 patent”) from instituted Ground 1 (Anticipation by O’Neal), and claims 21 and 28 of the ‘777 patent from Ground 2 (O’Neal in view of the knowledge and skill of a POSA in May 2000) as relied upon in the Petition in IPR2016-01258;

3. Whether Patent Owner has met its burden to demonstrate the patentability of proposed substitute claims 47 and 48 of the ‘777 patent in view of the teachings of O’Neal, Lamb, Admitted Prior Art, Burke, Blaze, Fuentes, Deschaine, Hanmer, McLampy, Allen, Elliot, Wegner, Schumacher, Scherer, Russell, and Andrews and combinations of the teachings of such references in view of the knowledge and skill of a POSA, and the state of the art, in May 2000 in IPR2016-01258;
4. The unpatentability of claims 1, 2, 8, 15, 18, and 19 of U.S. Patent No. 8,457,113 (“the ‘113 patent”) from Ground 1 (Anticipation by International Published Application No. WO 99/14924 (“Schtivelman”)), claims 1, 2, 8, 18, and 19 of the ‘113 patent from Ground 2 (Anticipation by O’Neal), claims 1, 11, and 15-17 of the ‘113 patent from Ground 3 (O’Neal in view of the knowledge and skill of a POSA in May 2000), and claims 1, 2, 8, 11, and 15–19 of the ‘113 patent from Ground 4 (Schtivelman in view of O’Neal and the knowledge and skill of a POSA in May 2000) as relied upon in the Petition in IPR2016-01260;
5. Whether Patent Owner has met its burden to demonstrate patentability of proposed substitute claim 183 of the ‘113 Patent in view of the

teachings of O’Neal, Lamb, Burke, Blaze, Fuentes, Deschaine, Hanmer, McLampy, Allen, Elliot, Voit, Russell, and Andrews and combinations of the teachings of such references in view of the knowledge and skill of a POSA, and the state of the art, in May 2000 in IPR2016-01260;

6. Responses to any issues identified in Patent Owner’s Request for Oral Argument; and
7. Any other issues the Board deems necessary for issuing a final written decision.

In coordination with Bright House Networks, LLC, WideOpenWest Finance, LLC, Knology of Florida, Inc., and Birch Communications, Inc. (Petitioner in IPR2016-01259, IPR2016-01261, IPR2016-01262, and IPR2016-01263) (“BHN”), Cisco Systems, Inc. (Petitioner in IPR2016-01254 and IPR2016-01257) (“Cisco”), and the Patent Owner, Petitioner also proposes the following order for the oral hearings on September 19, 2017:

1. BHN’s IPRs where each side has 90 minutes;
2. Cisco’s IPRs where each side has 30 minutes; and
3. Petitioner’s IPRs where each side has 90 minutes.

Petitioner additionally requests that the Board provide audio-visual equipment to display demonstrative exhibits, including a projector to be connected to a laptop, and an ELMO for displaying documents of record. In accordance with the Trial Practice Guide, Fed. Reg. Vol. 77, No. 157, at 48768, Petitioner will contact the Board Trial Division paralegal to discuss this request.

Date: August 21, 2017

Respectfully submitted,

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