

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Petitioner,

v.

AUTO TELEMATICS LTD.,
Patent Owner.

Case IPR2023-00518
U.S. Patent No. 9,633,487 B2

PATENT OWNER'S REQUEST FOR ORAL HEARING

Pursuant to 37 C.F.R. § 42.70(a), Patent Owner, Auto Telematics Ltd. (“Patent Owner”), requests the opportunity to present oral argument in this matter. The oral argument is presently scheduled for June 20, 2024. *See* Scheduling Order, Paper 11, at 11.

The parties conferred as to whether a remote video or in-person oral hearing is preferred. However, no agreement was reached. Patent Owner’s preference is for an in-person oral hearing at the Patent Trial and Appeal Board’s Alexandria’s office, located at 600 Dulany Street, Alexandria, VA 22314.

The issues to be argued with respect to IPR2023-00518 include the following:

1. Whether Petitioner has met its burden of proving the Challenged Claims 1, 2, 5, 9, and 11-13 of the ’487 Patent are unpatentable as obvious under 35 U.S.C. § 103 over Curry in view of Rabu.
2. Whether Petitioner has met its burden of proving the Challenged Claims 3 and 4 of the ’487 Patent are unpatentable as obvious under 35 U.S.C. § 103 over Curry in view of Rabu and Balachandran.
3. Whether Petitioner has met its burden of proving the Challenged Claims 6-8 of the ’487 Patent are unpatentable as obvious under 35 U.S.C. § 103 over Curry in view of Rabu and Katayama.

4. Whether Petitioner has met its burden of proving the Challenged Claim 10 of the '487 Patent is unpatentable as obvious under 35 U.S.C. § 103 over Curry in view of Rabu and Tamir.
5. Whether Petitioner has met its burden of proving the Challenged Claims 1, 2, 12 and 13 of the '487 Patent are unpatentable as obvious under 35 U.S.C. § 103 over Forstall in view of Rabu and Langle2009.
6. Whether Petitioner has met its burden of proving the Challenged Claims 3 and 4 of the '487 Patent are unpatentable as obvious under 35 U.S.C. § 103 over Forstall in view Rabu and Langle2009.
7. Whether Petitioner has met its burden of proving the Challenged Claims 6-8 of the '487 Patent are unpatentable as obvious under 35 U.S.C. § 103 over Forstall in view of Rabu, Langle2009 and Katayama.
8. Whether Petitioner has met its burden of proving the Challenged Claims 5, 9, and 11 of the '487 Patent are unpatentable as obvious under 35 U.S.C. § 103 over Forstall in view of Rabu, Langle2009 and Warren.
9. Whether Petitioner has met its burden of proving the Challenged Claim 10 of the '487 Patent is unpatentable as obvious under 35 U.S.C. § 103 over Forstall in view of Rabu, Langle2009 and Tamir.
10. Any claim construction disputes raised by the parties.

11. Any motions to exclude evidence raised by the parties.

12. Any additional issues on which the Board seeks clarification.

Patent Owner will address any issues raised by Petitioner, or questions raised by the Board during presentation. Patent Owner also respectfully reserves the right to supplement and/or amend the foregoing statement of issues to the extent the Rules permit.

The parties have agreed to request that the argument provide for a total of sixty (60) minutes for each side's combined arguments addressing the '487 Patent, with the opportunity to reserve a portion of that time for rebuttal.

Dated: May 10, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned counsel certifies that on May 10, 2024, this paper – Patent Owner’s Request for Oral Hearing – was served via electronic mail upon the following counsel of record for Petitioner:

Via Email Only (by consent):

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Respectfully submitted,

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