

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

CARBYNE BIOMETRICS, LLC,
Patent Owner

IPR2024-00334
U.S. Patent 11,514,138

PETITIONER'S REQUEST FOR ORAL ARGUMENT

In accordance with 37 C.F.R. § 42.70(a), Petitioner hereby requests oral argument in the present *inter partes* review. Per the Board's Scheduling Order (Paper 11), the oral argument is scheduled for April 16, 2025.

The Scheduling Order indicates that the parties may request that oral argument be held in-person at the USPTO headquarters in Alexandria, Virginia. ***Petitioner hereby requests oral argument be held in-person at USPTO headquarters in Alexandria, Virginia.*** The parties have met and conferred, and Patent Owner has indicated through counsel that it does not agree to in-person argument. Petitioner understands the Scheduling Order to indicate that PTAB will only conduct an in-person hearing when it is requested by all parties. However, Petitioner requests reconsideration of that policy in view of changes to the Board's practices that have occurred since the Scheduling Order or that may occur prior to the setting of oral argument.

Petitioner requests 45 minutes of total oral argument per side.

I. Issues to be Presented at Oral Argument

During the oral argument, Petitioner requests the opportunity to present oral argument on all of the issues raised in the papers pertaining to the instituted grounds, including:

- the unpatentability of claims 1-3, 7-8, 12-15, 19, and 24-25 as obvious

under 35 U.S.C. §103(a) over Kesanupalli and Brown;

- the unpatentability of claims 10 and 22 as obvious under 35 U.S.C. §103(a) over Kesanupalli and Brown further in view of Cheng;
 - the unpatentability of claims 11 and 23 as obvious under 35 U.S.C. §103(a) over Kesanupalli and Brown further in view of Challenger;
 - the unpatentability of claims 5 and 17 as obvious under 35 U.S.C. §103(a) over Kesanupalli and Brown further in view of Headley;
 - any issue raised in the Board's Institution Decision (Paper 10);
 - any argument raised in Patent Owner's Response (Paper 13),
Petitioner's Reply (Paper 16), or Patent Owner's Sur-reply (Paper 17), including parties' claim construction and/or prior art arguments;
 - any issue raised in any paper of record in this proceeding;
 - any issue raised by Patent Owner in its request for oral argument;
- and
- any issue raised by the Board during the oral argument or for which the Board seeks clarification.

II. Request for Use of the Board's Large Hearing Room

Petitioner respectfully asks that the hearing be scheduled in the Board's large hearing room "A," if possible, to accommodate all of the individuals who desire to attend and observe the hearing.

III. Conclusion

If the Board has any questions for the parties, the undersigned attorney respectfully requests a telephone conference.

Respectfully submitted,

Date: March 3, 2025
HAYNES AND BOONE, LLP
2801 N. Harwood Street, Suite 2300
Dallas, TX 75201

/David W. O'Brien/
David W. O'Brien, Reg. No. 40,107
Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6, that
service was made on the Patent Owner as detailed below.

Date of service March 3, 2025

Manner of service Electronic Mail: rkamprath@mckoolsmith.com;
gfishback@mckoolsmith.com;
Carbyne_Apple@mckoolsmith.com

Documents served **Petitioner's Request for Oral Argument**

Persons served Richard A. Kamprath
MCKOOL SMITH, P.C.
300 Crescent Court, Suite 1500
Dallas, Texas 75201

George Fishback
MCKOOL SMITH, P.C.
303 Colorado Street, Suite 2100
Austin, Texas 78701

/David W. O'Brien/
David W. O'Brien, Reg. No. 40,107
Counsel for Petitioner