UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

KOSS CORPORATION,
Patent Owner.

Case IPR2021-00381
Patent 10,491,982

PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

In its POPR (Paper 10), Koss argues that factor 4 of the *Fintiv* framework "weighs in favor of denying institution" based on an alleged potential overlap of issues because "[e]ach of the Challenged Claims is presently asserted in the Texas Litigation." Paper 10, 12-16. However, *Fintiv* explains that Factor 4 addresses whether "the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding." IPR2020-00019, Paper 11 at 12. Each of these elements either differs between the concurrent proceedings or any overlap is unascertainable until well after institution.

First, there is no overlap of grounds. Apple has stipulated that, unless the Board denies or later vacates institution of this petition, Petitioner will not seek resolution in the district court invalidity based on any ground "that utilizes, as a primary reference, US Patent Application Publication No. 2008/0076489 ("Rosener"), which is the primary reference in the grounds asserted in" this IPR. KOSS-2022, 1. As grounds will differ, so too will arguments and evidence. Second, the parties will not decide on the claims that will be at issue in the district court trial until well after institution. Paper 10, 12. Thus, factor 4 supports institution.

Koss challenges Apple's stipulation as not broad enough to preclude overlap. Paper 6, 16-17. Whether or not it includes "all permutations of the asserted prior art," the stipulation sufficiently "reduces the risks posed by the overlap between the proceedings," such that factor 4 of *Fintiv* "weighs against the exercise of discretion

to deny review." IPR2020-01113, Paper 12, 15-19. As endorsed by the Board in *Tide*, the district court is fully capable of interpreting and enforcing the stipulation, as the meaning of "primary reference" is case-specific, and in this context, it is clear Rosener may not be used in the same way as used in the underlying IPR petition. IPR2020-00019, Paper 11; *see In re Mouttet*, 686 F.3d 1322, 1333 (Fed. Cir. 2012). Further, even assuming such speculative future efforts in the district court are relevant at all, the efforts of the parties in parallel proceedings are not relevant to factor 4. IPR2020-01602, Paper 9 at 13-14 (PTAB Apr. 2, 2021).

Koss argues that because a petitioner in a different IPR proceeding issued a broader stipulation, Apple should do so here. But, such a one-size-fits-all rule is counter to *Fintiv*'s guidance. When evaluating the *Fintiv* factors, "the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review," and, "[i]n many cases, weighing the degree of overlap is highly fact dependent." IPR2020-00019, Paper 11, 6, 13. There are numerous cases where the Board has rightly found that stipulations of equal or narrower breadth weigh against discretionary denial. *See, e.g.*, IPR2019-01393, Paper 24, 11-12; IPR2020-01113, Paper 12, 15-19; IPR2020-01208, Paper 13, 18; IPR2020-01428, Paper 10, 12. And where the Board has held otherwise, there were other mitigating facts, such as a much sooner and more certain trial date. *See, e.g.*, IPR2020-00870, Paper 16, 9-18; IPR2020-01317, Paper 15, 11-24. A similarly holistic analysis of the present facts weighs against discretionary denial.

Respectfully submitted,

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/W. Karl Renner/

W. Karl Renner, Reg. No. 41,265
Roberto Devoto, Reg. No. 55,108
Ryan Chowdhury, Reg. No. 74,466
Fish & Richardson P.C.
3200 RBC Plaza, 60 South Sixth Street
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on May 7, 2021, a complete and entire copy of this Petitioner's Reply to Patent Owner's Preliminary Response was provided via email, to the Patent Owner by serving the correspondence addresses of record as follows:

Mark G. Knedeisen
Laurén Shuttleworth Murray
Brian P. Bozzo
K&L GATES LLP
K&L Gates Center, 210 Sixth Avenue
Pittsburgh, PA 15222

Email: mark.knedeisen@klgates.com
Email: lauren.murray@klgates.com
Email: brian.bozzo@klgates.com

/Edward G. Faeth/
Edward G. Faeth
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
(202) 626-6420