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**From:** Knedeisen, Mark G. <Mark.Knedeisen@klgates.com>  
**Sent:** Tuesday, August 10, 2021 2:42 PM  
**To:** David Holt; IPR50095-0020IP1; PTAB Inbound; AXF-PTAB; Roberto Devoto; IPR50095-0022IP1; IPR50095-0019IP1; Hyun Jin In; IPR50095-0021IP1; IPR50095-0018IP1; IPR50095-0020IP2; Joel Henry; IPR50095-0021IP2; IPR50095-0022IP2; IPR50095-0019IP2; IPR50095-0018IP2  
**Cc:** Bozzo, Brian P.; Weaver, Michelle L.; Ghabrial, Ragae; Murray, Laurén S.  
**Subject:** RE: Apple v Koss IPRs - Routine Discovery  
**Attachments:** IPR2021-00255 - 451 Patent - Document Requests\_USW\_Active01\_505041917\_1.DOCX; IPR2021-00305 - 325 Patent - Document Requests\_USW\_Active01\_505041898\_1.DOCX; IPR2021-00381 - \_982 Patent - Document Requests\_USW\_Active01\_505041881\_1.DOCX

Counsel,

Patent Owner disagrees that Patent Owner's requests are neither specific nor known by Petitioner to be contradictory to its positions. The requests are specific because they seek sales information about a limited number of specific products. The requests seek information known by Petitioner to be contradictory to its positions because Petitioner takes the position that the challenged claims are obvious; significant sales are evidence of commercial success; and commercial success is relevant to nonobviousness. If Petitioner nevertheless refuses to produce the information through routine discovery, please advise whether Petitioner agrees to the following additional discovery under 37 CFR 42.51(b)(2). Specifically, in IPRs 2021-00255, 2021-00305 and 2021-00381, Patent Owner seeks, within 14 of days:

- For IPR2021-00255, sales revenue and quantity of units sold, by calendar quarter, for the HomePod and HomePod Mini since the commercial introduction of those products;
- For IPR2021-00305, sales revenue and quantity of units sold, by calendar quarter, for the Powerbeats Pro since the commercial introduction of that product; and
- For IPR2021-00381, sales revenue and quantity of units sold, by calendar quarter, for the AirPods (1<sup>st</sup> and 2<sup>nd</sup> generations) and AirPods Pro since the commercial introduction of those products.

If Petitioner does not agree to this additional discovery, Patent Owner intends to move the Board for the additional discovery under 37 CFR 42.51(b)(2). Attached are document requests that Patent Owner intends to file with the motions.

This website (<https://www.businessofapps.com/data/apple-statistics/>) estimates that Apple has sold at least 15 million Apple AirPods units per year since 2017 (and more than 100 million in 2020); and that Apple has sold at least 4 million HomePod units per year since 2018. This website (<https://www.patentlyapple.com/patently-apple/2019/11/apple-airpods-powerbeats-pro-is-keeping-apple-in-the-hearables-market-leadership-with-over-50-market-share-1.html>) says that the "market share of their new premium models, such as Beat Powerbeats Pro in May [2019], have increased significantly, boosted by favorable market reviews of sound quality and design by customers." Thus, there is more than a possibility and mere allegation that Apple experienced significant sales of these products. Further:

- The request do not seek Petitioner's litigation positions;
- Apple does not publicly disclose sales figures for these products;
- The requests are easy to understand; and

- The requests are not overly burdensome to answer.

Please let us know if Petitioner agrees to the additional discovery and/or whether Petitioner opposes the motions for additional discovery.

Regards,

**K&L GATES**

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**From:** David Holt <DTH@fr.com>

**Sent:** Wednesday, July 28, 2021 5:08 PM

**To:** Knedeisen, Mark G. <Mark.Knadeisen@klgates.com>; IPR50095-0020IP1 <IPR50095-0020IP1@fr.com>; PTAB Inbound <PTABInbound@fr.com>; AXF-PTAB <AXF-PTAB@fr.com>; Roberto Devoto <devoto@fr.com>; IPR50095-0022IP1 <IPR50095-0022IP1@fr.com>; IPR50095-0019IP1 <IPR50095-0019IP1@fr.com>; Hyun Jin In <in@fr.com>; IPR50095-0021IP1 <IPR50095-0021IP1@fr.com>; IPR50095-0018IP1 <IPR50095-0018IP1@fr.com>; IPR50095-0020IP2 <IPR50095-0020IP2@fr.com>; Joel Henry <jhenry@fr.com>; IPR50095-0021IP2 <IPR50095-0021IP2@fr.com>; IPR50095-0022IP2 <IPR50095-0022IP2@fr.com>; IPR50095-0019IP2 <IPR50095-0019IP2@fr.com>; IPR50095-0018IP2 <IPR50095-0018IP2@fr.com>

**Cc:** Bozzo, Brian P. <Brian.Bozzo@klgates.com>; Weaver, Michelle L. <Michelle.Weaver@klgates.com>; Ghabrial, Ragae <ragae.ghabrial@klgates.com>; Murray, Laurén S. <Lauren.Murray@klgates.com>

**Subject:** RE: Apple v Koss IPRs - Routine Discovery

Counsel,

“Routine discovery under 37 C.F.R. § 41.51(b)(1)(iii) is narrowly directed to specific information known to the responding party to be inconsistent with a position advanced by that party in the proceeding, and not broadly directed to any subject area in general within which the requesting party hopes to discover such inconsistent information.” *Garmin Int’l, Inc. v. Cuozzo Speed Tech. LLC*, IPR2012-00001, Paper 26, slip. op. 4 (PTAB Mar. 5, 2013) (informative). The information identified in Patent Owner’s request is neither specific nor known by Petitioner to be contradictory to any positions advanced in the petitions. Indeed, Petitioner is not currently aware of any specific information that is inconsistent with the positions advanced in the petitions. However, if Patent Owner is aware of specific information that it knows is inconsistent with the positions advanced in the petition, please identify that information and Petitioner will consider such a request.

Sincerely,

**David Holt**

Principal

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**From:** Knedeisen, Mark G. <[Mark.Knedeisen@klgates.com](mailto:Mark.Knedeisen@klgates.com)>**Sent:** Monday, July 26, 2021 5:09 PM**To:** IPR50095-0020IP1 <[IPR50095-0020IP1@fr.com](mailto:IPR50095-0020IP1@fr.com)>; PTAB Inbound <[PTABInbound@fr.com](mailto:PTABInbound@fr.com)>; AXF-PTAB <[AXF-PTAB@fr.com](mailto:AXF-PTAB@fr.com)>; Roberto Devoto <[devoto@fr.com](mailto:devoto@fr.com)>; IPR50095-0022IP1 <[IPR50095-0022IP1@fr.com](mailto:IPR50095-0022IP1@fr.com)>; IPR50095-0019IP1 <[IPR50095-0019IP1@fr.com](mailto:IPR50095-0019IP1@fr.com)>; David Holt <[DTH@fr.com](mailto:DTH@fr.com)>; Hyun Jin In <[in@fr.com](mailto:in@fr.com)>; IPR50095-0021IP1 <[IPR50095-0021IP1@fr.com](mailto:IPR50095-0021IP1@fr.com)>; IPR50095-0018IP1 <[IPR50095-0018IP1@fr.com](mailto:IPR50095-0018IP1@fr.com)>; IPR50095-0020IP2 <[IPR50095-0020IP2@fr.com](mailto:IPR50095-0020IP2@fr.com)>; Joel Henry <[jhenry@fr.com](mailto:jhenry@fr.com)>; IPR50095-0021IP2 <[IPR50095-0021IP2@fr.com](mailto:IPR50095-0021IP2@fr.com)>; IPR50095-0022IP2 <[IPR50095-0022IP2@fr.com](mailto:IPR50095-0022IP2@fr.com)>; IPR50095-0019IP2 <[IPR50095-0019IP2@fr.com](mailto:IPR50095-0019IP2@fr.com)>; IPR50095-0018IP2 <[IPR50095-0018IP2@fr.com](mailto:IPR50095-0018IP2@fr.com)>**Cc:** Bozzo, Brian P. <[Brian.Bozzo@klgates.com](mailto:Brian.Bozzo@klgates.com)>; Weaver, Michelle L. <[Michelle.Weaver@klgates.com](mailto:Michelle.Weaver@klgates.com)>; Ghabrial, Ragae <[ragae.ghabrial@klgates.com](mailto:ragae.ghabrial@klgates.com)>; Murray, Laurén S. <[Lauren.Murray@klgates.com](mailto:Lauren.Murray@klgates.com)>**Subject:** Apple v Koss IPRs - Routine Discovery

[This email originated outside of F&R.]

Counsel – Rule (37 CFR) 42.51(b)(1)(iii) states that, as part of routine discovery, “a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contain the inconsistency.” In IPR2021-00255, IPR2021-00305, IPR2021-00381, IPR2021-00546, IPR2021-00592, IPR2021-00600, IPR2021-00626, IPR2021-00679, IPR2021-00686 and IPR2021-00693, Petitioner took the position that the Challenged Claims are obvious in these IPR petitions. Commercial success is relevant to assessing obviousness. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Sales are relevant to commercial success. *J.T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed.Cir.1997). Accordingly, Patent Owner requests that you produce sales information (U.S. and worldwide) under Petitioner’s routine discovery obligations per Rule 42.51(b)(1)(iii) for the following products of Petitioner:

- HomePod and HomePod Mini (for IPR2021-00255 and IPR2021-00600)
- Beats PowerBeats Pro (for IPR2021-00305 and IPR2021-00679)
- Apple AirPods 1<sup>st</sup> Generation, Apple AirPods 2<sup>nd</sup> Generation and AirPods Pro (for IPR2021-00381, IPR2021-00546, IPR2021-00592, IPR2021-00626, IPR2021-00686, and IPR2021-00693).

The sales information should include sales by year by product since the first date of sale of each above-identified product. Petitioner’s response should also include any and all additional documents and information inconsistent with Petitioner’s positions.

Please confirm promptly that Petitioner will produce the routine discovery requested above by **August 13, 2021**. If you have questions or issues with this request, we are available to meet and confer this week.



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