

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

KOSS CORPORATION,
Patent Owner.

Case IPR2021-00600
U.S. Patent No. 10,298,451

JOINT MOTION TO TERMINATE

Pursuant to 35 U.S.C. § 327(a) and 37 C.F.R. § 42.72, Apple Inc. (“Petitioner”) and Koss Corporation (“Patent Owner”) jointly move for termination of the *inter partes* review (“IPR”) of U.S. Patent No. 10,298,451 (“the ’451 Patent”), Case No. IPR2021-00600, with the United States Patent and Trademark Office. This Joint Motion was authorized by the Board pursuant to its email dated July 27, 2022. The parties have settled their dispute, and have reached agreement to terminate this IPR. The Settlement Agreement has been made in writing and was executed by Petitioner and Patent Owner on July 23, 2022. A true copy of the Settlement Agreement in accordance with 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(b) is being submitted concurrently herewith as Exhibit 2030. There are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this IPR. Submitted concurrently herewith is a request by Petitioner and Patent Owner that the Settlement Agreement be treated as business confidential information, be kept separate from the file of the involved patents, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c).

Patent Owner alleged that Petitioner infringed the ’451 Patent in a lawsuit captioned *Koss Corp. v. Apple Inc.*, Case No. 6:20-cv-00665-ADA (consolidated with *Apple Inc. v. Koss Corp.*, 6:21-cv-00495-ADA) before the United States

District Court for the Western District of Texas, Waco Division. According to the court's Order of Dismissal, "all claims for relief asserted against APPLE INC. by KOSS CORPORATION herein are dismissed, with prejudice, and all claims/counterclaims for relief against KOSS CORPORATION by APPLE INC. are dismissed without prejudice." D.I. 304 (W.D. Tex. July 23, 2022). The '451 Patent is involved in the following currently pending matter involving the parties: *Apple Inc. v. Koss Corp.*, IPR2021-00255 (PTAB) (final written decision issued May 31, 2022; notice of appeal due August 2, 2022). There are no other litigations or proceedings involving the '451 Patent.

Despite the fact that the Oral Hearing for this IPR was held June 1, 2022, termination is appropriate in view of the foregoing. *See Clio USA, Inc. v. Procter and Gamble Co.*, IPR2013-00438, Paper 54 (PTAB Oct. 31, 2014) (termination after oral argument); *Petroleum Geo-Services, Inc. v. Westerngeco, LLC*, IPR2016-00407, Paper 29 (PTAB July 5, 2019) (terminated after oral hearing and five days before statutory deadline for issuing a final written decision). For at least these reasons, termination of this IPR is proper under 35 U.S.C. § 327(a) and 37 C.F.R. § 42.74(a). Should this joint motion to terminate be denied, Petitioner would not continue to participate in this proceeding.

Dated: July 28, 2022

Respectfully submitted,

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CERTIFICATION OF SERVICE

I hereby certify that on July 28, 2022, I caused a true and correct copy of the foregoing to be served on the following counsel for Petitioner by electronic mail to the following email addresses:

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