

## **Kneiseisen, Mark G.**

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**From:** Trials <Trials@USPTO.GOV>  
**Sent:** Wednesday, October 06, 2021 12:49 PM  
**To:** Kneiseisen, Mark G.  
**Cc:** holt2@fr.com; ipr50095-0018ip1@fr.com; ptabinbound@fr.com; AXF-PTAB; ipr50095-0018ip1@fr.com; IPR50095-0020IP2; Roberto Devoto; IPR50095-0021IP2; Joel Henry; IPR50095-0022IP2@fr.com; IPR50095-0019IP2; Weaver, Michelle L.; Bozzo, Brian P.; Murray, Laurén S.; Ghabrial, Ragae  
**Subject:** RE: Apple Inc. v. Koss Corp. IPRs (Case Nos. IPR2021-00592, -00600, -00626, -00679, -00693)

Counsel, in IPR2021-00592, -00600, -00686, and -00693, the panels grant Patent Owner's requests for authorization to refile the motions (identical to the ones that it served on Petitioner) with the parties proceeding with the applicable deadlines as if the motions were filed timely. The parties must file this email chain authorizing the motions as an exhibit with each motion and reference the email chain in the motion in a footnote or otherwise. No teleconference is necessary.

Thank you,  
Eric W. Hawthorne  
Supervisory Paralegal Specialist  
Patent Trial and Appeal Board

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**From:** Kneiseisen, Mark G. <Mark.Kneiseisen@klgates.com>  
**Sent:** Tuesday, October 5, 2021 11:15 AM  
**To:** Trials <Trials@USPTO.GOV>  
**Cc:** holt2@fr.com; ipr50095-0018ip1@fr.com; ptabinbound@fr.com; AXF-PTAB <AXF-PTAB@fr.com>; ipr50095-0018ip1@fr.com; IPR50095-0020IP2 <IPR50095-0020IP2@fr.com>; Roberto Devoto <devoto@fr.com>; IPR50095-0021IP2 <IPR50095-0021IP2@fr.com>; Joel Henry <jhenry@fr.com>; IPR50095-0022IP2@fr.com; IPR50095-0019IP2 <IPR50095-0019IP2@fr.com>; Weaver, Michelle L. <Michelle.Weaver@klgates.com>; Bozzo, Brian P. <Brian.Bozzo@klgates.com>; Murray, Laurén S. <Lauren.Murray@klgates.com>; Ghabrial, Ragae <ragae.ghabrial@klgates.com>  
**Subject:** RE: Apple Inc. v. Koss Corp. IPRs (Case Nos. IPR2021-00592, -00600, -00626, -00679, -00693)

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Honorable Board,

The parties met and conferred in response to your email and report as follows:

- Patent Owner intended to, and thought that it did, file the Motions for Additional Discovery for each of the IPRs on the following dates:
  - o IPR2021-00592 – September 16, 2021
  - o IPR2021-00600 – September 17, 2021
  - o IPR2021-00626 – September 21, 2021

- IPR2021-00686 – September 17, 2021
  - IPR2021-00693 – September 16, 2021
- To that end, Patent Owner served, and Petitioner received, services copies of each motion on the date that the motion was filed. As such, Petitioner acknowledges that it is not prejudiced by Patent Owner's filing snafu, and Petitioner is prepared to file responses to the motions according to the time set forth in 37 CFR 42.25(a)(1).
- Patent Owner does not know the reason for the filing problem. Patent Owner filed a sixth motion, in IPR2021-00679 on September 22, using the same procedure as the five listed above, and that motion was successfully filed. Patent Owner apologizes for any inconvenience.

Accordingly, Patent Owner respectfully requests authorization to refile the motions (identical to the ones that it served on Petitioner) and the parties will proceed with the applicable deadlines as if the motions were filed on the dates indicated above. One exception, however, is IPR2021-00626. That IPR was denied in the meantime and Patent Owner does not intend to refile the motion for that IPR.

The parties are available for teleconference if necessary today (10/5) from 3-4:30pET; tomorrow (10/6) from 3-5pET; Thursday (10/7) from 12p-3pET and 4p-5pET; and Friday (10/8) from 12:30p-2pET and 2:30-5pET.

Respectfully, Mark Knedeisen  
Counsel for Patent Owner, Koss Corporation

**K&L GATES**

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**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Sent:** Thursday, September 30, 2021 9:20 AM  
**To:** Knedeisen, Mark G. <[Mark.Knedeisen@klgates.com](mailto:Mark.Knedeisen@klgates.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** [holt2@fr.com](mailto:holt2@fr.com); [jpr50095-0018ip1@fr.com](mailto:jpr50095-0018ip1@fr.com); [ptabinbound@fr.com](mailto:ptabinbound@fr.com); AXF-PTAB <[AXF-PTAB@fr.com](mailto:AXF-PTAB@fr.com)>; [jpr50095-0018ip1@fr.com](mailto:jpr50095-0018ip1@fr.com); IPR50095-0020IP2 <[IPR50095-0020IP2@fr.com](mailto:IPR50095-0020IP2@fr.com)>; Roberto Devoto <[devoto@fr.com](mailto:devoto@fr.com)>; IPR50095-0021IP2 <[IPR50095-0021IP2@fr.com](mailto:IPR50095-0021IP2@fr.com)>; Joel Henry <[jhenry@fr.com](mailto:jhenry@fr.com)>; [IPR50095-0022IP2@fr.com](mailto:IPR50095-0022IP2@fr.com); IPR50095-0019IP2 <[IPR50095-0019IP2@fr.com](mailto:IPR50095-0019IP2@fr.com)>; Weaver, Michelle L. <[Michelle.Weaver@klgates.com](mailto:Michelle.Weaver@klgates.com)>; Bozzo, Brian P. <[Brian.Bozzo@klgates.com](mailto:Brian.Bozzo@klgates.com)>; Murray, Laurén S. <[Lauren.Murray@klgates.com](mailto:Lauren.Murray@klgates.com)>; Ghabrial, Ragae <[ragae.ghabrial@klgates.com](mailto:ragae.ghabrial@klgates.com)>  
**Subject:** RE: Apple Inc. v. Koss Corp. IPRs (Case Nos. IPR2021-00592, -00600, -00626, -00679, -00693)

Counsel: According to our records, Patent Owner attempted to file Motions for Additional Discovery in IPR2021-00592, -600, -626, -686, and -693, but no supporting documentation was submitted in any of these proceedings. The parties are directed to meet and confer and report to the Board: 1) whether Motions for Additional Discovery were filed and an explanation as to why no supporting documentation was filed; 2) whether Patent Owner served Petitioner with copies of

the Motions for Additional Discovery in each of these proceedings; and 3) if served, whether Petitioner is prepared to file responses to the motions according to the time set forth in 37 C.F.R. 42.25(a)(1). After receiving this information, the Board will determine whether to provide the parties with additional guidance or whether a teleconference will be necessary.

Thank you,

*Maria King*  
Deputy Chief Clerk for Trials  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
703-756-1288

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**From:** Knedeisen, Mark G. <[Mark.Knedeisen@klgates.com](mailto:Mark.Knedeisen@klgates.com)>  
**Sent:** Tuesday, September 7, 2021 5:03 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** [holt2@fr.com](mailto:holt2@fr.com); [ipr50095-0018ip1@fr.com](mailto:ipr50095-0018ip1@fr.com); [ptabinbound@fr.com](mailto:ptabinbound@fr.com); AXF-PTAB <[AXF-PTAB@fr.com](mailto:AXF-PTAB@fr.com)>; [ipr50095-0018ip1@fr.com](mailto:ipr50095-0018ip1@fr.com); IPR50095-0020IP2 <[IPR50095-0020IP2@fr.com](mailto:IPR50095-0020IP2@fr.com)>; Roberto Devoto <[devoto@fr.com](mailto:devoto@fr.com)>; IPR50095-0021IP2 <[IPR50095-0021IP2@fr.com](mailto:IPR50095-0021IP2@fr.com)>; Joel Henry <[jhenry@fr.com](mailto:jhenry@fr.com)>; [IPR50095-0022IP2@fr.com](mailto:IPR50095-0022IP2@fr.com); IPR50095-0019IP2 <[IPR50095-0019IP2@fr.com](mailto:IPR50095-0019IP2@fr.com)>; Weaver, Michelle L. <[Michelle.Weaver@klgates.com](mailto:Michelle.Weaver@klgates.com)>; Bozzo, Brian P. <[Brian.Bozzo@klgates.com](mailto:Brian.Bozzo@klgates.com)>; Murray, Laurén S. <[Lauren.Murray@klgates.com](mailto:Lauren.Murray@klgates.com)>; Ghabrial, Ragae <[ragae.ghabrial@klgates.com](mailto:ragae.ghabrial@klgates.com)>  
**Subject:** Apple Inc. v. Koss Corp. IPRs (Case Nos. IPR2021-00592, -00600, -00626, -00679, -00693)

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Honorable Board,

Patent Owner, Koss Corporation, requests authorization to file a motion for additional discovery under 37 CFR 42.51(b)(2) in each of the following IPRs where Apple Inc. is Petitioner and Koss Corporation is Patent Owner:

- IPR2021-00592 (for Patent 10,469,934) (instituted Aug. 23, 2021)
- IPR2021-00600 (for Patent 10,298,451) (instituted Sept. 1, 2021)
- IPR2021-00626 (for Patent 10,206,025) (no institution decision)
- IPR2021-00679 (for Patent 10,506,325) (no institution decision)
- IPR2021-00686 (for Patent 10,491,982) (no institution decision)
- IPR2021-00693 (for Patent 10,469,934) (no institution decision)

Through the additional discovery, Patent Owner seeks sales data for products of Petitioner that Patent Owner asserts have experienced commercial success, which is a factor in assessing obviousness, which is an issue in each of the IPRs. The products for which Patent Owner seeks sales data vary based on the patent at issue in the IPR as follows:

Case No.	Information Sought by Patent Owner Through Additional Discovery
IPR2021-00592	Sales revenue and quantity of units sold, by calendar quarter, for AirPods (1 <sup>st</sup> & 2 <sup>nd</sup> gen) and AirPods Pro since the commercial introduction of these products.

IPR2021-00600	Sales revenue and quantity of units sold, by calendar quarter, for HomePod and HomePod Mini since the commercial introduction of those products
IPR2021-00626	Sales revenue and quantity of units sold, by calendar quarter, for AirPods (1 <sup>st</sup> & 2 <sup>nd</sup> gen) and AirPods Pro since the commercial introduction of those products
IPR2021-00679	Sales revenue and quantity of units sold, by calendar quarter, for Beats Powerbeats Pro since the commercial introduction of those products
IPR2021-00686	Sales revenue and quantity of units sold, by calendar quarter, for AirPods (1 <sup>st</sup> & 2 <sup>nd</sup> gen) and AirPods Pro since the commercial introduction of those products
IPR2021-00693	Sales revenue and quantity of units sold, by calendar quarter, for AirPods (1 <sup>st</sup> & 2 <sup>nd</sup> gen) and AirPods Pro since the commercial introduction of those products

Patent Owner consulted with Petitioner about the requests. Petitioner does not oppose the requests for authorization under the following terms:

- If authorized, Patent Owner files the motions within 14 days of authorization from the Board;
- The time for oppositions and replies would be governed by 37 CFR 42.25(a), and the replies will be limited to responsive arguments only, without new evidence;
- Patent Owner will not use any evidence that may eventually be produced under this additional discovery process in any IPRs where Patent Owner sought similar additional discovery and the Board denied the requests (namely IPR2021-00255, IPR2021-00305 and IPR2021-00381); and
- Petitioner will not oppose any of the motions as being premature.

While Petitioner does not oppose Patent Owner's requests for authorization under these terms, Petitioner intends to oppose the motions for the additional discovery.

Counsel for the parties are available for a teleconference with the Board this week at the following days/times:

- Thursday, September 9, 12pm to 1pm eastern;
- Friday, September 10, 12:30pm eastern to 1pm eastern, 2:30pm eastern to 3pm eastern, and 4pm to 5pm eastern; and
- Monday, September 13, 11am eastern to 2pm eastern.

Respectfully, Mark Knedeisen  
Counsel for Patent Owner, Koss Corporation

**K&L GATES**

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