

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Michael J. Koss, et al.
U.S. Patent No.: 10,491,982 Attorney Docket No.: 50095-0019IP1/0019IP2
Issue Date: November 26, 2019
Appl. Serial No.: 15/528,701
Filing Date: August 1, 2019
Title: SYSTEM WITH WIRELESS EARPHONES

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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PETITIONER'S NOTICE RANKING PETITIONS
AND EXPLAINING MATERIAL DIFFERENCES BETWEEN
PETITIONS AGAINST U.S. PATENT NO. 10,206,025

Apple now has two concurrent petitions challenging the validity of all claims of U.S. Patent No. 10,491,982 (“the ’982 patent”): IPR2021-00381 filed January 4 and IPR2021-00686 filed March 22 (herewith). As explained below, each petition challenges a different set of the 20 claims Koss asserted against Apple in the co-pending litigation. APPLE-1014. Pursuant to the Board’s July 2019 Trial Practice Guide Update, Apple submits this paper to “identify: (1) a ranking of the Petitions in the order in which it wishes the Board to consider the merits..., and (2) a succinct explanation of the differences between the Petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions.”

I. Ordering of Petitions

Apple believes that both petitions are meritorious and justified, especially because (as explained further below), both petitions are necessary to address the 56 claims that Koss asserted against Apple in the co-pending district court litigation. Nonetheless, to the extent required, Apple requests that the Board consider the petitions in the following order:

Rank	PTAB Case No.	Challenged Claims
1	IPR2021-00381 (First Petition)	1-5, 14-20

Rank	PTAB Case No.	Challenged Claims
2	IPR2021-00686 (Second Petition)	6-13

II. Material Differences that Compel Permitting Multiple Petitions

The Board’s “Trial Practice Guide” notes that “the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims.” Consolidated TPG at 59 (Nov. 2019). This case presents a prototypical case where “patent owner has asserted a large number of claims.” As explained in both petitions, Koss has taken no steps to narrow the dispute, and has instead asserted all 20 claims of the ’982 patent against Apple in the co-pending litigation.

Each of the petitions of the first and second petitions cover different claims. Specifically, the first petition challenges claims 1-5 and 14-20, which is all claims except those dependent claims that recite that “the headphones transition to play digital audio content received wirelessly from the second digital audio source via a second wireless communication link based on, at least in part, a signal strength for the second wireless communication link” (i.e., the “signal strength claims”). The second petition relies upon the disclosure of Seshadri, in addition to the prior art relied upon in IPR2021-00381, with the intent of demonstrating the unpatentability

of the signal strength claims (i.e., claims 6-13). Given the dependencies of the signal strength claims, however, the primary difference between the first and second petitions is found in sections of the second petition that address the signal strength claims. This is a concise addition to deal with the 8 signal strength claims, the inclusion of which was entirely precipitated by Koss's allegation that Apple infringes all 20 claims of the '982 patent. APPLE-1014. Apple has judiciously moderated any increase in burden from the two petitions, such that any increase in burden is a direct result of Koss's conduct in the co-pending litigation.

Lastly, in an effort to avoid any prejudice to Koss, Apple is willing to subscribe to two scheduling adjustments in IPR2021-00381 and IPR2021-00686 relative to the model scheduling order: (1) in IPR2021-00686, the deadline for Petitioner's reply (DUE DATE 2) is shortened by 6 weeks; and (2) in IPR2021-00381, the deadline for Patent Owner's sur-reply (DUE DATE 3) is lengthened to fall on the same day as the deadline for Petitioner's reply (DUE DATE 2) in the present proceeding. In this way, Koss's sur-reply in IPR2021-00305 and Petitioner's reply in IPR2021-00686 are due on the same day, eliminating any possibility of Apple gaining any advantage due to the timing differences between the two proceedings.

For each of these reasons, Apple respectfully requests institution of both of its concurrently filed IPR petitions against the '982 patent.

Respectfully submitted,

Dated 3/22/21

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