

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Michael J. Koss, et al.
U.S. Patent No.: 10,469,934 Attorney Docket No.: 50095-0018IP1/0018IP2
Issue Date: November 5, 2019
Appl. Serial No.: 16/375,879
Filing Date: April 5, 2019
Title: SYSTEM WITH WIRELESS EARPHONES

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PETITIONER'S NOTICE RANKING PETITIONS
AND EXPLAINING MATERIAL DIFFERENCES BETWEEN
PETITIONS AGAINST U.S. PATENT NO. 10,469,934

Petitioner, Apple Inc. (“Apple”), now has two concurrent petitions challenging the validity of all claims of U.S. Patent No. 10,469,934 (“the ’934 patent”): IPR2021-00592 filed March 2 and IPR2021-00693 filed March 23 (herewith). As explained below, each petition challenges a different set of the 62 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 62 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	IPR2021-00592 (First Petition)	1-3, 5, 7, 9-11, 14- 16, 19, 21, 23-25, 28, 30, 32-37, 39,

		42-43, 45-48, and 51-57
2	IPR2021-00693 (Second Petition)	1-6, 8, 10-20, 22- 29, 31-36, 38-42, 44, 58-62

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 Section V of both petitions, Koss asserted all 62 claims of the ’934 Patent against Apple in the co-pending litigation.

Each of the first and second petitions cover different claims. Specifically, the first petition challenges claims 1-3, 5, 7, 9-11, 14-16, 19, 21, 23-25, 28, 30, 32-37, 39, 42-43, 45-48, and 51-57, which is all claims except those claims that recite that “the headphone assembly transitions to play digital audio content received wirelessly from a second digital audio source . . . based on, at least, a signal strength level . . .” (i.e., the “signal strength claims”). The second petition relies

upon the disclosure of Seshadri-818, in addition to the prior art relied upon in IPR2021-00592, with the intent of demonstrating the unpatentability of the signal strength claims (i.e., claims 4, 6, 8, 12, 13, 17, 18, 20, 22, 26, 27, 29, 31, 38, 40, 41, 44, and 58-62). Given the dependencies of the signal strength claims, however, there is substantial overlap between the first and second petitions. As a result, the primary difference between the first and second petitions is an approximately six page section of the second petition that addresses the signal strength limitation (*see* pp. 28-33 of the second petition addressing limitation 58[i]). This is a concise addition to deal with the signal strength claims, the inclusion of which was entirely precipitated by Koss's allegation that Apple infringes all 62 claims of the '934 patent—a number of claims that could not reasonably be addressed in a single petition. APPLE-1014. Thus, Apple has judiciously moderated any increase in burden from the two petitions, and such increase in burden is a direct result of Koss's conduct in the co-pending litigation.

In cases like this one where a patent owner asserts more than 30 claims against a petitioner, the Board has regularly allowed for the filing of multiple petitions to challenge the excessive number of asserted claims. *See, e.g., Apple Inc. v. Seven Networks, LLC*, IPR2020-00707, Paper 11 at 19-21 (PTAB Oct. 22, 2020) (granting two petitions filed against 44 asserted claims); *Dolby Laboratories, Inc. v. Intertrust Technologies Corp.*, IPR2020-01106, Paper 12 at 19-21 (PTAB Jan 5,

2021) (granting two petitions filed against 18 claims); *Adobe Inc. v. Synkcloud Technologies, LLC*, Paper 8 at 8-10 (PTAB Mar. 11, 2021) (granting two petitions filed against 20 “lengthy” and “complex” asserted claims). Further, the petitions of IPR2021-00592 and IPR2021-00693 were each filed relatively close in time (approximately three weeks apart), providing the Board an opportunity to gain efficiencies by issuing a single scheduling order that sets the same due dates for both proceedings, ultimately culminating in a consolidated oral hearing. *See id.* Thus, Apple submits that any additional burden on the finite resources of the Board is reasonable in light of the circumstances.

For each of these reasons, Apple respectfully requests institution of both of its concurrently filed IPR petitions against the '934 patent.

Respectfully submitted,

Dated March 23, 2021

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