
From: Kyle D. Wallenberg <kwallenberg@niro-mcandrews.com>
Sent: Thursday, November 11, 2021 1:19 PM
To: Bailey Benedict
Cc: Thad Kodish; Joon Chung; dherman@giffinwinning.com; mtrapp@giffinwinning.com; Raymond P. Niro, Jr.; Brian P. Lynch
Subject: Re: Apalone, Inc. v. Schutt Sports, LLC - Motion to Stay

Bailey,

Based upon information publicly available to Plaintiff, Plaintiff contends that, at this time, the accused helmets infringe only claims 7 and 10 of the '167 patent. As is standard practice in any patent litigation case (especially where, as here, the case schedule provides for the service of initial *and* final infringement contentions), Plaintiff reserves the right to supplement or modify the asserted claims of the '167 patent as new information becomes available through discovery or other investigation.

In any event, based on the parties' representations below, this confirms the parties' agreement that: (1) all current case deadlines (excepting MSJ-related deadlines), including service of initial and final infringement and invalidity contentions, should be stayed (a) as to the '167 patent pending resolution of the IPR and (b) as to the '817 patent until resolution of Defendants' MSJ on that patent; and (2) the currently scheduled trial date should be vacated and rescheduled for a later date.

Finally, please advise when Defendants will file the IPR on the '167 patent and, in turn, circulate the draft motion(s) to stay.

Thanks,

Kyle

Kyle D. Wallenberg

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From: Bailey Benedict <benedict@fr.com>
Date: Thursday, November 11, 2021 at 11:37 AM
To: "Kyle D. Wallenberg" <kwallenberg@niro-mcandrews.com>
Cc: Thad Kodish <TKodish@fr.com>, Joon Chung <chung@fr.com>, "dherman@giffinwinning.com" <dherman@giffinwinning.com>, "mtrapp@giffinwinning.com" <mtrapp@giffinwinning.com>, Raymond Niro

<rnirojr@niro-mcandrews.com>, Brian Lynch <blynch@niro-mcandrews.com>

Subject: RE: Apalone, Inc. v. Schutt Sports, LLC - Motion to Stay

Thanks, Kyle. Based on your "at least" usage, we can only assume that this is a placeholder for potential new information that could come out in discovery. We do not understand what new information you think could come out since you presumably have the accused helmet in your possession, and the claim scope is purely mechanical. Thus, we can only reasonably conclude that Apalone will assert no more than claims 7 and 10. If that is incorrect, and you have identified other claims, including dependent claims that you would assert, we request that you make those claim numbers known now. We reserve the right to object to any additional claims being alleged in the future.

We will circulate the draft motion after we have filed the IPR.

-Bailey

Bailey Benedict :: Principal :: Fish & Richardson P.C.

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From: Kyle D. Wallenberg <kwallenberg@niro-mcandrews.com>

Sent: Thursday, November 11, 2021 10:55 AM

To: Bailey Benedict <benedict@fr.com>

Cc: Thad Kodish <TKodish@fr.com>; Joon Chung <chung@fr.com>; dherman@giffinwinning.com; mtrapp@giffinwinning.com; Raymond P. Niro, Jr. <rnirojr@niro-mcandrews.com>; Brian P. Lynch <blynch@niro-mcandrews.com>

Subject: Re: Apalone, Inc. v. Schutt Sports, LLC - Motion to Stay

Bailey,

Plaintiff agrees to your conditions below and states that it asserts at least claims 7 and 10 of the '167 patent.

Please circulate the unopposed draft motion(s) at your earliest opportunity.

Thanks,

Kyle

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From: Bailey Benedict <benedict@fr.com>
Date: Wednesday, November 10, 2021 at 2:30 PM
To: "Kyle D. Wallenberg" <kwallenberg@niro-mcandrews.com>
Cc: Thad Kodish <TKodish@fr.com>, Joon Chung <chung@fr.com>, "dherman@giffinwinning.com" <dherman@giffinwinning.com>, "mtrapp@giffinwinning.com" <mtrapp@giffinwinning.com>, Raymond Niro <rnirojr@niro-mcandrews.com>, Brian Lynch <blynch@niro-mcandrews.com>
Subject: RE: Apalone, Inc. v. Schutt Sports, LLC - Motion to Stay

Kyle,

Thank you for confirming. We expect to obtain our clients' agreement to stay all current case deadlines as you propose (excepting MSJ-related deadlines), including service of initial and final infringement and invalidity contentions, provided that 1) the parties agree that the currently scheduled trial date should be vacated and rescheduled for a later date; and 2) Plaintiff tomorrow provides its list of '167 patent asserted claims (though not the charts and cover pleading). Please confirm that Plaintiff agrees to these conditions, and we will circulate the unopposed draft motion(s).

Thanks,

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From: Kyle D. Wallenberg <kwallenberg@niro-mcandrews.com>
Sent: Wednesday, November 10, 2021 12:05 PM
To: Bailey Benedict <benedict@fr.com>
Cc: Thad Kodish <TKodish@fr.com>; Joon Chung <chung@fr.com>; dherman@giffinwinning.com; mtrapp@giffinwinning.com; Raymond P. Niro, Jr. <rnirojr@niro-mcandrews.com>; Brian P. Lynch <blynch@niro-mcandrews.com>
Subject: Re: Apalone, Inc. v. Schutt Sports, LLC - Motion to Stay

[This email originated outside of F&R.]

Bailey,

Further to my email below, after consulting with our client, this confirms that Plaintiff will not oppose the proposed motions to stay set forth in your email below, so long as the parties agree that all current case deadlines (other than the briefing schedule on Defendants' motion for summary judgment set by the Court on October 26, 2021) should be stayed, including service of initial and final infringement and invalidity contentions.

Please confirm that this is acceptable to Defendants.

Thanks,

Kyle

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From: "Kyle D. Wallenberg" <kwallenberg@niro-mcandrews.com>

Date: Tuesday, November 9, 2021 at 9:01 PM

To: Bailey Benedict <benedict@fr.com>

Cc: Thad Kodish <TKodish@fr.com>, Joon Chung <chung@fr.com>, "dherman@giffinwinning.com" <dherman@giffinwinning.com>, "mtrapp@giffinwinning.com" <mtrapp@giffinwinning.com>, Raymond Niro <rnirojr@niro-mcandrews.com>, Brian Lynch <blynch@niro-mcandrews.com>

Subject: Re: Apalone, Inc. v. Schutt Sports, LLC - Motion to Stay

Bailey,

Subject to our client's approval, Plaintiff will not oppose the proposed motions to stay set forth in your email, so long as the parties agree that all current case deadlines (including service of initial and final infringement and invalidity contentions) should be stayed.

Please confirm that this is acceptable to Defendants.

Thanks,

Kyle

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From: Bailey Benedict <benedict@fr.com>
Date: Tuesday, November 9, 2021 at 8:15 AM
To: "Kyle D. Wallenberg" <kwallenberg@niro-mcandrews.com>
Cc: Thad Kodish <TKodish@fr.com>, Joon Chung <chung@fr.com>, "dherman@giffinwinning.com" <dherman@giffinwinning.com>, "mtrapp@giffinwinning.com" <mtrapp@giffinwinning.com>, Raymond Niro <rnirojr@niro-mcandrews.com>, Brian Lynch <blynch@niro-mcandrews.com>
Subject: RE: Apalone, Inc. v. Schutt Sports, LLC - Motion to Stay

Kyle,

As I previewed at the initial case management conference, Certor plans to file an IPR petition on the '167 patent soon. Once we file the Petition, we will move to stay the litigation. Will you agree to a motion to stay? In particular, we will move for the following:

- 1) A motion to stay the litigation as to the '167 patent pending resolution of the IPR
- 2) A motion to stay the litigation as to the '817 patent until resolution of our motion for summary judgment on that patent.

Please let us know if you will oppose either, or both, of those proposed stays.

Sincerely,

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