

ESTTA Tracking number: **ESTTA761545**

Filing date: **07/29/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92059069
Party	Plaintiff Apple Inc.
Correspondence Address	ROBERT POTTER KILPATRICK TOWNSEND & STOCKTON LLP 1114 AVENUE OF THE AMERICAS, 21ST FL NEW YORK, NY 10036 UNITED STATES rpotter@ktslaw.com, cgenteman@kilpatricktownsend.com, JPetersen@ktslaw.com
Submission	Other Motions/Papers
Filer's Name	Robert N. Potter
Filer's e-mail	rpotter@ktslaw.com, cgenteman@kilpatricktownsend.com, JPetersen@ktslaw.com, agarcia@ktslaw.com, tadmin@ktslaw.com
Signature	/Robert N. Potter/
Date	07/29/2016
Attachments	Apple v. Jupiter IP - Can. 92059069 - Declaration of R. Potter ISO Motion to Compel Respondent to Appear for Noticed Depositions.pdf(417799 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Supplemental Registration Nos. 4,464,325 and 4,464,326
For the marks: **APPLECORE** and **AN APPLECORE A DAY KEEPS THE TANGLES AWAY**
Registered on the Supplemental Register: January 7, 2014

-----X	:	
APPLE INC.,	:	
	:	Cancellation No. 92059069
Petitioner,	:	
	:	
v.	:	
	:	
JUPITER IP, LLC,	:	
	:	
Respondent.	:	
-----X	:	

**DECLARATION OF ROBERT POTTER IN SUPPORT OF PETITIONER’S
MOTION TO COMPEL RESPONDENT TO APPEAR FOR NOTICED DEPOSITIONS**

I, Robert Potter, hereby declare as follows:

1. I am a partner at the law firm of Kilpatrick Townsend & Stockton LLP, attorneys for Petitioner Apple Inc. (Apple), in this cancellation action. I make this Declaration based on my personal knowledge in support of Petitioner’s Motion to Compel Respondent to Appear for Noticed Depositions. I am over the age of twenty-one and am competent to make this Declaration.
2. In addition to the two attorneys who have formally represented Jupiter in this action, two other attorneys have participated in settlement discussions on Jupiter’s behalf without formally appearing in this proceeding.
3. Apple served a 30(b)(6) notice on Respondent Jupiter IP, LLC (“Jupiter”) and on Jupiter’s principal Robin Peng on June 19, 2016, noticing both depositions for July 29, 2016. These were the Fifth Amended Deposition Notices served by Apple; prior and identical notices had been served five times before, on January 14, 2015, February 13, 2015, February 24, 2015, December 1,

2015, and March 1, 2016. True and correct copies of the Fifth Amended Deposition Notices are attached as **Exhibits A & B**.

4. On July 18, 2016, I sent Jupiter, through Mr. Peng, an email to confirm the July 29, 2016 deposition dates, and to seek certain related stipulations. Mr. Peng replied that he was “on vacation” and that Jupiter would be responding to Apple’s request through new counsel. A true and correct copy of that email correspondence is attached as **Exhibit C**.

5. On July 19, 2016, David Turcotte emailed me to advise that he would now be representing Jupiter, and to propose a 45-day suspension for settlement discussions. Mr. Turcotte’s email further stated that Jupiter and Mr. Peng would not be appearing for the July 29, 2016 depositions as scheduled. A true and correct copy of that email correspondence is attached as **Exhibit D**.

6. On both July 25 and July 26, 2016, I sent Mr. Turcotte emails attempting to schedule a call to discuss the noticed depositions, among other things. Because Mr. Turcotte has not filed a Notice of Appearance in this proceeding, I copied Jupiter (through its principal Mr. Peng) on all correspondence with Mr. Turcotte, requesting that Jupiter let Apple know immediately if Mr. Turcotte was not authorized to speak on its behalf. Mr. Peng made no reply. *See Exhibit D*.

7. On July 27, 2016, Mr. Turcotte responded by reiterating that Jupiter would not appear for the noticed depositions and stated that Jupiter would not be available for deposition until an Apple executive is deposed. Mr. Turcotte did not respond to my request for a call. *See Exhibit D*.

8. That same day, I responded to Mr. Turcotte through an email explaining that Jupiter had not noticed a deposition of Apple and that, with only two days remaining in discovery, the time for doing so had passed. I proposed a 45-day extension of the discovery period for the limited purpose of taking the two noticed depositions and to continue to discuss settlement. I also requested twice within my email that we schedule a call to discuss the depositions. I copied Jupiter’s principal

on this email and asked him to let me know immediately if Mr. Turcotte did not speak on behalf of Jupiter. *See Exhibit D.*

9. On July 28, 2016, I sent another email following up on the proposal for an extension and also requesting a call to discuss the depositions. *See Exhibit D.*

10. Later that same day, Mr. Turcotte responded that he did not agree to the extension and stated that Jupiter intends to take additional discovery and notice Apple's depositions if the dispute is not settled. *See Exhibit D.*

11. As of the time of the filing of this motion, Jupiter still has not served a deposition notice on Apple.

12. As of the time of the filing of this motion, Mr. Turcotte has not filed a notice of appearance in this proceeding.

13. I have made a good faith effort by correspondence to settle the issues raised in Apple's Motion to Compel. Specifically, I followed up with Jupiter regarding the deposition dates nearly two weeks in advance of the depositions, I requested a telephone conference with Jupiter in four emails, and I proposed a consent agreement to take the depositions outside the discovery period. Due to Jupiter's refusal to cooperate, the parties have been unable to reach an agreement.

I declare under penalty of the laws of the United States that the foregoing is true and correct.

This 29th day of July, 2016.

/s/ Robert N. Potter
Robert N. Potter

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing DECLARATION OF ROBERT POTTER IN SUPPORT OF PETITIONER'S MOTION TO COMPEL RESPONDENT TO APPEAR FOR NOTICED DEPOSITIONS was served on Respondent on July 29, 2016 via first class mail to:

Robin Peng
Jupiter IP, LLC
9515 S 560 W
Sandy, Utah 84070

/s/ Robert N. Potter
Robert N. Potter
Attorney for Petitioner

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true copy of the foregoing DECLARATION OF ROBERT POTTER IN SUPPORT OF PETITIONER'S MOTION TO COMPEL RESPONDENT TO APPEAR FOR NOTICED DEPOSITIONS is being filed electronically with the TTAB via ESTTA on this day, July 29, 2016.

/s/ Robert N. Potter
Robert N. Potter
Attorney for Petitioner

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Supplemental Registration Nos. 4,464,325 and 4,464,326
For the marks: **APPLECORE** and **AN APPLECORE A DAY KEEPS THE TANGLES AWAY**

Registered on the Supplemental Register: January 7, 2014

-----X		
APPLE INC.,	:	
	:	Cancellation No. 92059069
Petitioner,	:	
	:	
v.	:	
	:	
JUPITER IP, LLC,	:	
	:	
Respondent.	:	
-----X		

**FIFTH AMENDED NOTICE OF RULE 30(b)(6) DEPOSITION
OF JUPITER IP**

To: Robin Peng
Jupiter IP, LLC
9515 S 560 W
Sandy, Utah 84070

Petitioner Apple Inc., through counsel and pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure and § 404.05 of the Trademark Trial and Appeal Board Manual of Procedure, hereby gives notice that it will take the deposition of one or more officers, directors, or managing agents, or other persons who consent to testify on behalf of Respondent Jupiter IP, who shall testify as to matters known or reasonably available to the organization with respect to the subjects listed in the attached Schedule A.

The deposition shall commence at **1:00 pm on July 29, 2016** at the offices of Tempest Reporting, 175 S Main Street, Suite 710, Salt Lake City, Utah 84111, continuing thereafter from day to day until completed.

The deposition will take place pursuant to the Federal Rules of Civil Procedure, before a

notary public or other officer duly authorized to administer oaths and before a court reporter authorized by law to take depositions, and may be videotaped. The parties to this action, as represented by their attorneys of record in this action (if applicable), are invited to be present.

This the 27th day of June, 2016.

Respectfully submitted,

KILPATRICK TOWNSEND & STOCKTON LLP

By: / Robert Potter _____

Joseph Petersen	Crystal C. Genteman
Robert Potter	1100 Peachtree Street
The Grace Building	Suite 2800
1114 Avenue of the Americas	Atlanta, Georgia 30309
New York, New York 10036	Telephone: (404) 815-6500
Telephone: (212) 775-8700	Facsimile: (404) 815-6555
Facsimile: (212) 775-8800	

Attorneys for Petitioner Apple Inc.

SCHEDULE A

DEFINITIONS

- A. “Petitioner” refers to Apple Inc.
- B. “Petitioner’s Marks” shall refer individually and collectively to Petitioner’s family of APPLE-based word marks and its Apple Logo including but not limited to the marks underlying the registrations in Paragraph 10 of Petitioner’s April 21, 2014 Consolidated Petition for Cancellation of Registration.
- C. “Petitioner’s Goods and Services” shall refer individually and collectively to all goods and services offered, sold, or promoted under or in connection with Petitioner’s Marks.
- D. “Respondent” refers to Respondent Jupiter IP, each of its predecessors, successors, parents, divisions, affiliates, or wholly-owned or partially-owned subsidiaries, and each of their officers, directors, employees, representatives, or agents.
- E. “Respondent’s Marks” means the trademarks shown in Supplemental Registration Nos. 4,464,325 and 4,464,326 of APPLECORE and AN APPLECORE A DAY KEEPS THE TANGLES AWAY, respectively.
- F. “Respondent’s Goods and Services” shall refer individually and collectively to all goods and services offered, sold, or promoted under or in connection with Respondent’s Marks or any mark which incorporates the term APPLECORE.
- G. “Respondent’s Website” means the website available at <http://apple-cores.com/>.
- H. “Channels of Trade” means the areas of commerce and means by which goods or services are marketed or sold. Channels of Trade include, but are not limited to, the sales agents, dealerships, distributors, or other outlets through which any goods or services are or have been sold.

I. The terms “any” and “all” shall be mutually interchangeable and shall not be construed to limit any Request.

J. The term “including” shall mean “including without limitation.”

K. The term “concerning” shall be interpreted broadly, including both explicit and implicit reference, and meaning, without limitation, relating to, regarding, referring to, constituting, defining, discussing, containing, construing, embodying, evidencing, supporting, refuting, reflecting, stating, dealing with, prepared in contemplation of, prepared in connection with, prepared as a result of, or in any way pertaining to.

TOPICS

1. Respondent’s corporate structure and history as it relates to the adoption and use of Respondent’s Mark.

2. The business of Respondent.

3. Any applications filed by or on behalf of Respondent to register any name, mark, or designation which consists of or incorporates the term APPLE or an apple design, including but not limited to U.S. Trademark Application Serial Nos. 85/263,334, 77/747,815, 86/041,604, and 86/041,521.

4. All circumstances concerning the selection, adoption, use, and intended use of Respondent’s Marks, including but not limited to any other names or marks that were considered; how and why Respondent’s Marks were selected; all steps taken by Respondent to determine whether Respondent’s Marks were available for use and registration prior to adoption; when, where, and how Respondent’s Mark are used and/or intended to be used.

5. The date Respondent's Marks were first used in commerce and the products on which they were used.
6. Any searches, investigations, or inquiries conducted by or for Respondent relating to Respondent's right to use and/or register Respondent's Marks.
7. When and how Respondent first became aware of Petitioner and Petitioner's Marks.
8. Respondent's knowledge of Petitioner's Goods and Services.
9. All goods or services for which Respondent has used or intends to use Respondent's Marks, including but not limited to Respondent's Goods and Services.
10. All licenses, assignments, or other agreements concerning Respondent's Marks.
11. Business, franchise, or marketing plans concerning any actual and/or planned use of Respondent's Marks.
12. The channels of trade through which Respondent distributes, has distributed, or intends to distribute, any goods or services under or in connection with Respondent's Marks, including but not limited to the sales agents, dealerships, distributors, or other outlets through which any goods or services are or have been sold.
13. Respondent's typical or target customers of goods or services sold under Respondent's Marks.
14. The distribution and sale of goods and services under Respondent's Marks, including the revenues and profits or losses from such sales or otherwise associated with use of Respondent's Marks.
15. Advertising, promotion, marketing of goods or services sold or to be sold under Respondent's Marks or otherwise featuring Respondent's Marks.

16. The contents of Respondent's Website from the first date of its operation to the present.

17. All instances of which Respondent has actual or hearsay knowledge, directly or indirectly, of any communication, suggestion, or inquiry concerning an association, connection, or affiliation between Respondent, Respondent's Marks, or Respondent's Goods and Services, on the one hand, and Petitioner, Petitioner's Marks, or Petitioner's Goods and Services, on the other hand.

18. All instances of which Respondent has actual or hearsay knowledge of any inquiry, complaint, or other communication concerning Respondent's business or any other inquiry, complaint, or other communication by any person concerning the qualities, advantages, or lack of quality of Respondent's Goods and Services.

19. Conversations or other communications Respondent, including any of its representatives, has had with Petitioner or any of Petitioner's representatives.

20. Any conversations or other communications Respondent, including any of its representatives, have had with any third party concerning Petitioner and the claims made in the instant matter.

21. Respondent's Answer to Petitioner's Petition for Cancellation, including all allegations and defenses therein.

22. Respondent's Initial Disclosures.

23. Respondent's responses to the Interrogatories, Requests for Production, and Requests for Admission served by Petitioner in this matter.

24. Efforts to locate, collect, and produce documents responsive to the Requests for Production of Documents served by Petitioner in this matter.

25. Respondent's document and email retention policies and practices.
26. All testimony given by Respondent Jupiter IP at its January 10, 2013 deposition, taken by Petitioner Apple Inc. in T.T.A.B. Opposition No. 91203784.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Supplemental Registration Nos. 4,464,325 and 4,464,326
For the marks: **APPLECORE** and **AN APPLECORE A DAY KEEPS THE TANGLES AWAY**

Registered on the Supplemental Register: January 7, 2014

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APPLE INC.,	:	
	:	Cancellation No. 92059069
Petitioner,	:	
	:	
v.	:	
	:	
JUPITER IP, LLC,	:	
	:	
Respondent.	:	
-----X	:	

CERTIFICATE OF SERVICE

This is to certify that the foregoing FIFTH AMENDED NOTICE OF RULE 30(b)(6) DEPOSITION OF JUPITER IP was served on counsel for Respondent by depositing a true and correct copy in the first class mail, postage pre-paid, addressed as follows:

Robin Peng
Jupiter IP, LLC
9515 S 560 W
Sandy, Utah 84070

This the 27th day of June, 2016.

/Robert Potter _____
Robert Potter
Attorney for Petitioner Apple Inc.

EXHIBIT B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Supplemental Registration Nos. 4,464,325 and 4,464,326
For the marks: **APPLECORE** and **AN APPLECORE A DAY KEEPS THE TANGLES AWAY**

Registered on the Supplemental Register: January 7, 2014

-----X	:	
APPLE INC.,	:	
	:	Cancellation No. 92059069
Petitioner,	:	
	:	
v.	:	
	:	
JUPITER IP, LLC,	:	
	:	
Respondent.	:	
-----X	:	

FIFTH AMENDED NOTICE OF DEPOSITION OF ROBIN PENG

To: Robin Peng
Jupiter IP, LLC
9515 S 560 W
Sandy, Utah 84070

Petitioner Apple Inc., through counsel and pursuant to Rule 30 of the Federal Rules of Civil Procedure and § 404 of the Trademark Trial and Appeal Board Manual of Procedure, hereby gives notice that it will take the deposition of Robin Peng, Principal, Jupiter IP, for purposes of discovery, use at trial, and any other purpose in accordance with the Federal Rules of Civil Procedure and Evidence and the Trademark Trial and Appeal Board Manual of Procedure. The deposition shall commence at **10:00 am on July 29, 2016** at the offices of Tempest Reporting, 175 S Main Street, Suite 710, Salt Lake City, UT 84111, continuing thereafter from day to day until completed.

The deposition will take place pursuant to the Federal Rules of Civil Procedure, before a notary public or other officer duly authorized to administer oaths and before a court reporter

authorized by law to take depositions, and may be videotaped. The parties to this action, as represented by their attorneys of record in this action (if applicable), are invited to be present.

This the 27th day of June, 2016.

Respectfully submitted,

KILPATRICK TOWNSEND & STOCKTON LLP

By: /Robert Potter

Joseph Petersen	Crystal C. Genteman
Robert Potter	1100 Peachtree Street
The Grace Building	Suite 2800
1114 Avenue of the Americas	Atlanta, Georgia 30309
New York, New York 10036	Telephone: (404) 815-6500
Telephone: (212) 775-8700	Facsimile: (404) 815-6555
Facsimile: (212) 775-8800	

Attorneys for Petitioner Apple Inc.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Supplemental Registration Nos. 4,464,325 and 4,464,326
For the marks: **APPLECORE** and **AN APPLECORE A DAY KEEPS THE TANGLES
AWAY**

Registered on the Supplemental Register: January 7, 2014

-----X
APPLE INC., :
 : Cancellation No. 92059069
Petitioner, :
 :
v. :
 :
JUPITER IP, LLC, :
 :
Respondent. :
-----X

CERTIFICATE OF SERVICE

This is to certify that the foregoing FIFTH AMENDED NOTICE OF DEPOSITION OF ROBIN PENG was served on counsel for Respondent by depositing a true and correct copy in the first class mail, postage pre-paid, addressed as follows:

Robin Peng
Jupiter IP, LLC
9515 S 560 W
Sandy, Utah 84070

This the 27th day of June, 2016.

/Robert Potter
Robert Potter
Attorney for Petitioner Apple Inc.

EXHIBIT C

Genteman, Crystal

From: Robin Peng <robin@designengine.org>
Sent: Tuesday, July 19, 2016 2:07 PM
To: Potter, Rob
Cc: Genteman, Crystal; 0820228 - US TM: POT OPP V. JUPITER IP L...
Subject: Re: Apple Inc. v. Jupiter IP, LLC

Hi Rob, thanks for checking in. I'm on vacation. My general counsel has been working on the response. He will get back to you very soon. Thanks again for your patience.

Best,

Robin

From: Potter, Rob <RPotter@kilpatricktownsend.com>
Sent: Monday, July 18, 2016 12:01:38 PM
To: Robin Peng
Cc: Genteman, Crystal; 0820228 - US TM: POT OPP V. JUPITER IP L...
Subject: RE: Apple Inc. v. Jupiter IP, LLC

Hi Robin,

The parties' suspension for settlement purposes is scheduled to end on July 23. We have not received any proposal from you during this suspension, nor did your new general counsel contact me last week, and so we need to move forward with the proceeding.

As you know, we have noticed depositions for Jupiter, and for you individually, for July 29, 2016 (i.e. a week from Friday; notices attached). Please confirm that you will be available on this date.

To allow these depositions to go as quickly as possible, and to avoid further depositions during the testimony period, we would appreciate your consent on three points:

- 1) Please confirm that we may take the July 29 depositions by video, which would save us having to travel to Utah.
- 2) As previously discussed, we would like to introduce as evidence in this proceeding the transcript from the prior deposition we took on January 10, 2013 – this will allow us to avoid asking all of those questions again, and will save considerable time at the July 29 depositions.
- 3) We would appreciate your consent to allow both parties to introduce their trial testimony by written affidavit, rather than by taking more depositions during the trial period.

If you consent to point one above (video deposition on July 29), please just let us know as soon as possible. If you consent to points 2 and 3, please confirm that we may submit the attached stipulation with your digital signature.

Please let us know as soon as you possible can so we can make appropriate arrangements for July 29.

Thanks,

Rob

EXHIBIT D

Genteman, Crystal

From: Dave Turcotte <dgtlegal@gmail.com>
Sent: Thursday, July 28, 2016 3:53 PM
To: Potter, Rob
Cc: jadamson@kunzlerlaw.com; Robin Peng; Genteman, Crystal; 0820228 - US TM: POT OPP V. JUPITER IP L...
Subject: Re: Subject: Re: Apple Inc. v. Jupiter IP, LLC -- 0820228 - US TM

I will send our Settlement Proposal, we can each decide how to proceed from there. Enjoy the rest of your week.

On Thu, Jul 28, 2016 at 1:49 PM, Potter, Rob <RPotter@kilpatricktownsend.com> wrote:

Understood. We will unfortunately have to take this up with the Board through motion practice.

Regards,

Rob

Rob Potter

Kilpatrick Townsend & Stockton LLP

The Grace Building | 1114 Avenue of the Americas | New York, NY 10036-7703

office [212 775 8733](tel:2127758733) | cell [917 392 1066](tel:9173921066) | fax [212 775 8816](tel:2127758816)

rpotter@kilpatricktownsend.com | [My Profile](#) | [vCard](#)

From: Dave Turcotte [mailto:dgtlegal@gmail.com]

Sent: Thursday, July 28, 2016 3:48 PM

To: Potter, Rob

Cc: jadamson@kunzlerlaw.com; Robin Peng; Genteman, Crystal; 0820228 - US TM: POT OPP V. JUPITER IP L...

Subject: Re: Subject: Re: Apple Inc. v. Jupiter IP, LLC -- 0820228 - US TM

No, I do not agree. We fully expect to take additional discovery and should we not settle, we will Notice up Depositions for your client.

DGT

On Thu, Jul 28, 2016 at 1:46 PM, Potter, Rob <RPotter@kilpatricktownsend.com> wrote:

Thank you Dave. Just to be absolutely clear, the 45-day extension of discovery is for the sole and limited purpose of allowing Apple to take the previously-noticed depositions of Jupiter and of Robin Peng, and no other discovery will be allowed. Agreed? Thanks.

Rob Potter

Kilpatrick Townsend & Stockton LLP

The Grace Building | 1114 Avenue of the Americas | New York, NY 10036-7703

office [212 775 8733](tel:2127758733) | cell [917 392 1066](tel:9173921066) | fax [212 775 8816](tel:2127758816)

rpotter@kilpatricktownsend.com | [My Profile](#) | [vCard](#)

From: Dave Turcotte [mailto:dgtlegal@gmail.com]

Sent: Thursday, July 28, 2016 3:45 PM

To: Potter, Rob

Cc: jadamson@kunzlerlaw.com; Robin Peng; Genteman, Crystal; 0820228 - US TM: POT OPP V. JUPITER IP L...

Subject: Re: Subject: Re: Apple Inc. v. Jupiter IP, LLC -- 0820228 - US TM

Thank you for our email. Yes, Jupiter consents and agrees to the extension of time, an additional 45 days for discovery in this matter. Thank you. I will try to find a time early tomorrow when we can get on a call to discuss the issues.

DGT

On Thu, Jul 28, 2016 at 1:28 PM, Potter, Rob <RPotter@kilpatricktownsend.com> wrote:

Dear Robin and Dave,

I am following up on my email below. Please let me know if you are able to speak in the next couple of hours or tomorrow morning regarding our proposed extension of discovery, the noticed depositions, and related settlement issues. We would like not to have to approach the Board on this, and are hopeful we can resolve this amongst ourselves. Absent your consent to our proposed extension, however, and in light of tomorrow's close of discovery, we will have to move the Board for appropriate relief as soon as tomorrow.

Thanks,

Rob

Rob Potter

Kilpatrick Townsend & Stockton LLP

The Grace Building | 1114 Avenue of the Americas | New York, NY 10036-7703

office [212 775 8733](tel:2127758733) | cell [917 392 1066](tel:9173921066) | fax [212 775 8816](tel:2127758816)

rpotter@kilpatricktownsend.com | [My Profile](#) | [vCard](#)

From: Potter, Rob

Sent: Wednesday, July 27, 2016 1:20 PM

To: 'Dave Turcotte'; jadamson@kunzlerlaw.com; 'Robin Peng'

Cc: Genteman, Crystal; 0820228 - US TM: POT OPP V. JUPITER IP L...

Subject: RE: Subject: Re: Apple Inc. v. Jupiter IP, LLC -- 0820228 - US TM

Dave,

Thank you for your email. Apple remains open to exploring an amicable resolution here, and—as you suggested—I think it would be helpful to speak by phone today about settlement, and about this matter generally. Please let me know if you are available sometime this afternoon.

As to Friday's depositions, you represented in your email that "we will not be participating in any depositions this week." As you have not appeared as counsel of record in the TTAB proceeding (Can. No. 92059069), formal communications should be made through Robin Peng, copied here, who is listed as the point of contact for this proceeding. Based on Mr. Peng's prior correspondence advising that you will be representing him, however, and absent any contrary statement by Mr. Peng, we will assume that you are speaking on behalf of Jupiter IP and Mr. Peng when you say that "we" will not be participating in depositions this week (and we ask that you file a notice of appearance as soon as possible). **Robin** - please let us know immediately if this is not the case.

As you may be aware, discovery is set to close in this matter on Friday. Accordingly, and since you will not participate in the depositions we have properly noticed for this Friday (see attached), we must make arrangements to take Mr. Peng's and Jupiter's depositions outside of the discovery period. To that end, we propose a consented 45-day extension of the discovery period for the limited purpose of taking these two depositions. The parties can then use this time to discuss settlement, and we will only need to take these depositions if our negotiations are unsuccessful.

There can be no deposition of any witnesses from Apple at this point, as discovery closes in two days and Jupiter never noticed any such deposition during the discovery period.

Please let us know as soon as possible if Jupiter will consent to a 45-day extension of discovery for the sole purpose of taking the already-noticed depositions of Jupiter and of Mr. Peng (and please copy Mr. Peng on any such correspondence). I am happy to discuss this directly if you are free to speak today. Of course, if Jupiter does not consent to the extension, Apple reserves the right to seek appropriate relief from the Board, including through a motion to compel the noticed depositions.

All that said, we look forward to receiving your settlement proposal on Friday, but reiterate that we think it would be helpful to discuss various issues in this matter before then. Again, please let me know if you have availability for a call later today.

Best,

Rob

Rob Potter

Kilpatrick Townsend & Stockton LLP

The Grace Building | 1114 Avenue of the Americas | New York, NY 10036-7703
office [212 775 8733](tel:212-775-8733) | cell [917 392 1066](tel:917-392-1066) | fax [212 775 8816](tel:212-775-8816)
rpotter@kilpatricktownsend.com | [My Profile](#) | [vCard](#)

From: Dave Turcotte [<mailto:dgtlegal@gmail.com>]
Sent: Wednesday, July 27, 2016 10:39 AM
To: Potter, Rob; jadamson@kunzlerlaw.com
Cc: Genteman, Crystal; 0820228 - US TM: POT OPP V. JUPITER IP L...
Subject: Re: Subject: Re: Apple Inc. v. Jupiter IP, LLC -- 0820228 - US TM

I add Jeremy Adamson to our email chain, Jeremy will be participating in litigating this matter should our Settlement Offer be rejected.

As I indicated, we will not be participating in any depositions this week. Please adjust your plans accordingly. I provided our reasoning in my prior email and won't revisit those details today.

I have conferred with my Client and a formal Settlement Proposal will be provided by Close of Business Friday.

If you are not inclined to settle, please identify the Apple Executive you will designate to testify under oath regarding this matter. We will do that deposition first, before proceeding with our client for a second bite at the apple.

I look forward to your response to our Settlement Proposal.

Please excuse any typos, sent from a mobile Device.

On Jul 26, 2016, at 4:15 PM, Potter, Rob <RPotter@kilpatricktownsend.com> wrote:

Dave – Following up on the below. Please let me know when you are free to speak tomorrow, in advance of Friday’s scheduled depositions.

Rob

Rob Potter

Kilpatrick Townsend & Stockton LLP

The Grace Building | 1114 Avenue of the Americas | New York, NY 10036-7703
office [212 775 8733](tel:2127758733) | cell [917 392 1066](tel:9173921066) | fax [212 775 8816](tel:2127758816)
rpotter@kilpatricktownsend.com | [My Profile](#) | [vCard](#)

From: Potter, Rob
Sent: Monday, July 25, 2016 2:57 PM
To: 'Dave Turcotte'
Cc: Genteman, Crystal; 0820228 - US TM: POT OPP V. JUPITER IP L...
Subject: RE: Subject: Re: Apple Inc. v. Jupiter IP, LLC -- 0820228 - US TM

Hi Dave,

Thank you for your email. I am happy to speak tomorrow or Wednesday, and am generally free except 1:30-2:30 pm Eastern tomorrow, and 2:00-3:00 pm Eastern on Wednesday. Please let me know a time that works for you.

In the meantime, and unless and until we can reach an alternative agreement, this Friday’s depositions of Robin and of Jupiter must remain on the schedule.

Thanks,

Rob

Rob Potter

Kilpatrick Townsend & Stockton LLP

The Grace Building | 1114 Avenue of the Americas | New York, NY 10036-7703

office [212 775 8733](tel:2127758733) | cell [917 392 1066](tel:9173921066) | fax [212 775 8816](tel:2127758816)

rpotter@kilpatricktownsend.com | [My Profile](#) | [vCard](#)

From: Dave Turcotte [<mailto:dgtlegal@gmail.com>]

Sent: Tuesday, July 19, 2016 7:24 PM

To: Potter, Rob

Subject: Subject: Re: Apple Inc. v. Jupiter IP, LLC -- 0820228 - US TM

Mr. Potter, my name is David Turcotte, I am an attorney in Utah that is going to be assisting Robin Peng in this matter internally.

I have reviewed the original complaint in this matter, the bulk of the correspondence between you and Mr. Peng and believe it is clear that he has taken a very conciliatory settlement approach to date. Quite frankly I struggle with the allegations of the underlying action, but I have no intention of derailing the parties good faith desire to settle this case. Even so, there is a lot to take into consideration here and I am hoping to avoid bringing in our Patent/Trademark litigation associated firm should we not be able to stay on the settlement track. As to your three questions in your last email,

1) Please confirm that we may take the July 29 depositions by video, which would save us having to travel to Utah.

Generally, I do not object to video depositions to save time/travel costs. However, we are not able to proceed in the 29th of January and I do not think that is appropriate. Schedule conflicts and prep time are an issue, but, I do believe that before my client proceeds with further depositions, your client should identify and produce a witness for Mr. Peng to depose. I believe we need some testimony from Apple under oath regarding the allegations of this action and settlement discussions are difficult where we only possess naked allegations from the pleadings. Please identify who has the knowledge, capacity and timing to appear for a deposition in this matter should we desire to proceed outside of these settlement negotiations.

2) As previously discussed, we would like to introduce as evidence in this proceeding the transcript from the prior deposition we took on January 10, 2013 – this will allow us to avoid asking all of those questions again, and will save considerable time at the July 29 depositions.

Please see my above response regarding depositions. Notwithstanding, you will not need to ask questions again, because you have already asked them. If you have new questions, seeking additional information, we can answer those if we do in fact do another deposition after the deposition of your clients' designee.

3) We would appreciate your consent to allow both parties to introduce their trial testimony by written affidavit, rather than by taking more depositions during the trial period.

I am uncomfortable with agreeing to this where you have cross examined my client, and we have done no depositions. Regardless, we can revisit this depending on where our settlement discussions wind up.

It is also my understanding that you had proposed a Confidentiality Agreement regarding these proceedings, or, a Confidential Settlement Agreement. I do not have that document and want to be sure I have the correct version to review. As a courtesy, I ask you to send me any agreement you have sent to my client for review and consideration. I will get a quick and timely response to you so that we may move forward quickly.

I would suggest that we extend the period of time for settlement discussions for at least another 45 days. I am going to prepare a formal settlement offer, given my review of this case and your communications. As I have said, my client has been very conciliatory and he continues to desire to settle amicably.

It has taken some time to review and get to the background of this case. I have no desire to cause unwarranted delays and hope to produce a formal settlement offer for you by January 29, 2016. I will confer with my client, review his understanding of your oral communications pertaining to settlement. Even better, if you would like to schedule a call for Tues or Wed next week, I would be happy to accommodate.

Please advise as to your availability to talk on Tuesday or Wed, next week.

Thank you,