

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE, INC.,  
Petitioner,

v.

KOSS CORP.,  
Patent Owner.

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IPR2021-00693  
Patent 10,469,934 B2

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Before KARL D. EASTHOM, PATRICK R. SCANLON, and  
DAVID C. McKONE, *Administrative Patent Judges*.

Opinion for the Board by *Administrative Patent Judges* SCANLON and  
McKONE, *per curiam*.

Opinion dissenting filed by *Administrative Patent Judge* EASTHOM.

DECISION  
Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314

## I. INTRODUCTION

Apple, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–6, 8, 10–20, 22–29, 31–36, 38–42, 44, and 58–62 ( of U.S. Patent No. 10,469,934 B2 (Ex. 1001, “the ’934 patent”). Paper 2 (“Pet.”). Koss Corp. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 6. Upon considering the preliminary record, for reasons discussed below, we decline to institute *inter partes* review.

## II. BACKGROUND

### A. *Real Parties in Interest*

Petitioner states that it is the real party-in-interest. Pet. 76. Patent Owner states that it is the real party in interest. Paper 4 (“Mandatory Notice by Patent Owner”), 1; *see also* Paper 6 (update).

### B. *Related Matters*

Both parties list the related lawsuit alleging infringement of the ’934 patent, *Koss Corp. v. Apple Inc.*, Case No. 6:20-cv-00665 (W.D. Tex.) (“District Court” or “District Court Lawsuit”). Pet. 76; Paper 4, 1. Patent Owner lists other lawsuits involving the ’934 patent, United States applications to which the ’934 patent claims priority, and pending *inter partes* reviews as related matters. Paper 4 (updated in Papers 6 and 7), 1–2.

#### 1. *Other Lawsuits*

Patent Owner identifies several other lawsuits involving the ’934 patent: *Koss Corp. v. Skullcandy, Inc.*, No. 6:20-cv-00664 (W.D. Tex.); *Koss Corp. v. Plantronics, Inc.*, No. 6-20-cv-00663 (W.D. Tex.); *Koss Corp. v. Bose Corp.*, No. 6-20-cv-00661 (W.D. Tex.); *Bose Corp. v. Koss Corp.*,

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No. 1-20-cv-12193 (D. Mass.); and *Apple Inc. v. Koss Corp.*, No. 4:20-cv-05504 (N.D. Cal.). Paper 4, 1.

## 2. *United States Applications*

Patent Owner lists the following applications as related applications to which the '934 patent claims priority: PCT application No. PCT/US2009/039754, filed April 7, 2009 (the "PCT Application"), and provisional application Serial No. 61/123,265, filed April 8, 2008 (the "Provisional Application"). Paper 4, 2.

## 3. *Inter Partes Review Proceedings*

Patent Owner lists the following *inter partes* review proceedings challenging patents that claim priority to the PCT Application and the Provisional Application:<sup>1</sup>

*Bose Corp. v. Koss Corp.*, IPR2021-00297, filed December 7, 2020, challenging U.S. Patent No. 10,368,155 B2; *Apple Inc. v. Koss Corp.*, IPR2021-00305, filed December 15, 2020, challenging U.S. Patent No. 10,506,325 B1; *Apple Inc. v. Koss Corp.*, IPR2021-00381, filed January 4, 2021, challenging U.S. Patent No. 10,491,982 B1; *Apple Inc. v. Koss Corp.*, IPR2021-00546, filed February 22, 2021, challenging U.S. Patent No. 10,206,025 B1; *Apple Inc. v. Koss Corp.*, IPR2021-00612, filed March 3, 2021, challenging U.S. Patent No. 10,206,025; *Apple Inc. v. Koss Corp.*, IPR2021-00626, filed March 17, 2021, challenging U.S. Patent No. 10,206,025 B1; *Apple Inc. v. Koss Corp.*, IPR2021-00679, filed March 22, 2021, challenging U.S. Patent No. 10,506,325 B1; and *Apple Inc. v. Koss*

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<sup>1</sup> Additional *inter partes* review proceedings involving these same parties include *Apple Inc. v. Koss Corp.*, IPR2021-00255, filed November 25, 2020, and *Apple Inc. v. Koss Corp.*, IPR2021-00600, filed March 7, 2021, both challenging U.S. Patent No. 10,298,451 B1.

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*Corp.*, IPR2021-00686, filed March 22, 2021, challenging U.S. Patent No. 10,491,982 B1. Paper 4, 2.

Two *inter partes* review proceedings involve claims of the '934 patent, including claims challenged and not challenged here: *Bose Corp. v. Koss Corp.*, IPR2021-00680, filed March 17, 2021; and *Apple Inc. v. Koss Corp.*, IPR2021-00592, Paper 2 (March 2, 2021) (the "'592 petition"), Paper 9 (Aug. 23, 2021) (Institution Decision) (the "'592 Inst. Dec.") (generally, the "'592 IPR").

### C. *The '934 Patent*

The '934 patent's priority dates are April 7, 2009, based on the PCT Application, and April 7, 2008, based on the Provisional Application. Ex. 1001, codes (60), (63).

#### 1. *Background Technology*

The '934 patent characterizes prior art wired headphones that interconnect a headphone with a data storage unit as "cumbersome." Ex. 1001, 1:42–51. The '934 patent also characterizes prior art wireless headphones connected via IEEE 802.11 (e.g., a Wi-Fi connection) to a WLAN-ready laptop or personal computer as "quite large and not in-ear type phones." *Id.* at 1:58–62.

#### 2. *The '934 Patent's Wireless Earphones*

The '934 patent describes a wireless earphone that receives streaming audio data from a data source such as an audio player or computer via an ad hoc wireless network and infrastructure wireless networks, and that transitions seamlessly between wireless networks. Ex. 1001, 1:66–2:3. The '934 patent describes an "ad hoc wireless network" as "a network where two . . . wireless-capable devices, such as the earphone and a data source,

communicate directly and wirelessly, without using an access point.” *Id.* at 3:3–6.<sup>2</sup> An ad hoc network is in contrast to an “infrastructure wireless network,” which is “a wireless network that uses one or more access points to allow a wireless capable device, such as the wireless earphone, to connect to a computer network, such as a LAN [local area network] or WAN [wide area network] (including the Internet).” *Id.* at 3:6–11.

The earphone has a body and an ear canal portion for insertion into the ear canal of the user of the earphone. Ex. 1001, 3:17–20, 3:54–56. Some embodiments employ “two discrete wireless earphones,” one in each ear. *Id.* at 3:47–49. Figure 2A of the ’934 patent follows:

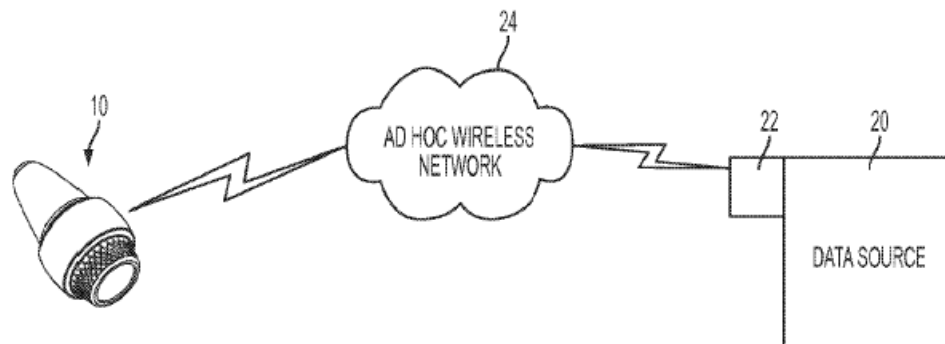


FIG. 2A

Figure 2A illustrates earphone 10 communicating over ad hoc wireless network 24 with data source 20. *Id.* at 4:26–32. The earphone’s transceiver

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<sup>2</sup> The art sometimes refers to ad hoc networks as piconets, of which a Bluetooth network is an example. *See, e.g.*, Ex. 1003 ¶¶ 27, 29, 41; Ex. 1007 ¶ 6; Pet. 24 (“piconet connection (i.e., an ad hoc network, such as Bluetooth)”). For purposes of this Decision, we use “ad hoc network,” “Bluetooth,” and “piconet” interchangeably, as any differences in these terms do not affect the outcome of this proceeding.

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