

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 CORPORATION,  
Patent Owner.

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IPR2022-00053  
Patent 10,206,025 B2

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Before PATRICK R. SCANLON, DAVID C. MCKONE,  
and NORMAN H. BEAMER, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

DECISION

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

Denying Motion for Joinder  
*35 U.S.C. § 315(c); 37 C.F.R. § 42.122*

## I. INTRODUCTION

On December 15, 2021, Apple, Inc. (“Petitioner”) filed a Petition (“Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–56 of U.S. Patent No. 10,206,025 B2 (Ex. 1001, “the ’025 patent”). Paper 2. Petitioner also filed a Motion For Joinder (“Mot.”) pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), seeking to join the proceeding with *Bose Corporation v. Koss Corporation*, IPR2021-00612 (“IPR612”). Paper 3. On January 13, 2022, Koss Corporation (“Patent Owner”) filed a Preliminary Response (“Prelim. Resp.”), which included an opposition to the Motion For Joinder. Paper 8.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and any preliminary response shows that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons described below, we do not institute an *inter partes* review of the challenged claims and deny Petitioner’s Motion For Joinder.

## II. RELATED PROCEEDINGS

As the parties indicate, the ’025 patent is the subject, *inter alia*, of several court proceedings, in particular including district court actions with allegations of infringement of the ’025 patent filed July 22, 2020 against Petitioner and Bose.<sup>1</sup> Pet. 2; Prelim. Resp. 8; Paper 5, 1–2.

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<sup>1</sup> *Koss Corp. v. Apple Inc.*, 6:20-cv-00665 (WD Tex.); *Koss Corp. v. Bose Corp.*, 6:20-cv-00661 (WD Tex.). Exs. 1121, 1055.

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Also, in regard to the above-referenced IPR612 proceeding, Bose filed the IPR612 petition challenging the '053 patent on March 3, 2021. IPR612, Paper 2. The Board granted that petition and instituted IPR612 on September 15, 2021. IPR612, Paper 15 (PTAB Sept. 15, 2021) (“IPR612 Decision” or “IPR612 Dec.”).

In addition, Petitioner has filed two prior petitions for *inter partes* review. Pet. 10; Paper 5, 2. In particular, the '025 patent was the subject of *Apple Inc. v. Koss Corp.*, IPR2021-00546 (“IPR546”), filed February 22, 2021, and *Apple Inc. v. Koss Corp.*, IPR2021-00626 (“IPR626”), filed March 17, 2021. IPR546, Paper 2; IPR626, Paper 3. On September 7 and 30, 2021, respectively, the Board issued decisions not to institute *inter partes* review because the evidence and arguments presented failed to meet substantively the reasonable likelihood threshold required for institution. IPR546, Paper 10; IPR626, Paper 10.

We further note that, in the timeline of events, after July 22, 2021, Petitioner would have been barred from filing any further petitions (absent an accompanying joinder motion) against the '053 patent because, as referenced above, Patent Owner had served Petitioner with a district court complaint alleging infringement of the '025 patent one year prior to that date. *See* 35 U.S.C. § 315(b).

### III. WHETHER TO INSTITUTE *INTER PARTES* REVIEW

In the Bose IPR612, we instituted an *inter partes* review of all claims (claims 1–56) of the '025 patent based on the following asserted prior art and grounds:<sup>2</sup>

<b>Claim(s) Challenged</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>
1–3, 6, 8, 11–13, 16, 18, 20–22, 25, 27, 39, 52, 54–56	103(a)	Rezvani-446, <sup>3</sup> Rezvani-875. <sup>4</sup> Skulley <sup>5</sup>
4, 5, 7, 9, 14, 15, 17, 19, 23, 24, 26, 28	103(a)	Rezvani-446, Rezvani-875, Skulley, Harada <sup>6</sup>
10, 38	103(a)	Rezvani-446, Rezvani-875, Skulley, Hind <sup>7</sup>
29–31, 34, 36, 53	103(a)	Rezvani-446, Rezvani-875, Skulley, Davis <sup>8</sup>
32, 33, 35, 37	103(a)	Rezvani-446, Rezvani-875, Skulley, Davis, Harada
40–43, 46, 48	103(a)	Rezvani-446, Rezvani-875, Skulley, Davis, Oh <sup>9</sup>
44, 45, 47, 49, 50	103(a)	Rezvani-446, Rezvani-875, Skulley, Davis, Oh, Harada

<sup>2</sup> Because the application leading to the '053 patent was filed before March 16, 2013, our patentability analysis was governed by the version of 35 U.S.C. § 103 preceding the Leahy-Smith America Invents Act (“AIA”), Pub L. No. 112–29, 125 Stat. 284 (2011).

<sup>3</sup> US 2007/0136446 A1, published June 14, 2007 (IPR612, Ex. 1097).

<sup>4</sup> US 2007/0165875 A1, published July 19, 2007 (IPR612, Ex. 1016).

<sup>5</sup> US 6,856,690 B1, issued Feb. 15, 2005 (IPR612, Ex. 1017).

<sup>6</sup> US 2006/0229014 A1, published Oct. 12, 2006 (IPR612, Ex. 1098).

<sup>7</sup> US 7,069,452 B1, issued June 27, 2006 (IPR612, Ex. 1019).

<sup>8</sup> US 5,761,298, issued June 2, 1998 (IPR612, Ex. 1033).

<sup>9</sup> WO 2006/098584 A1, published Sept. 21, 2006 (IPR612, Ex. 1099).

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
51	103(a)	Rezvani-446, Rezvani-875, Skulley, Davis, Oh, Hind
1–3, 6, 8, 10–13, 16, 18, 38–43, 46, 48, 51, 52, 54, 56	103(a)	Schrager, <sup>10</sup> Goldstein <sup>11</sup>
4, 5, 7, 9, 14, 15, 17, 19, 23, 24, 26, 28, 44, 45, 47, 49, 50	103(a)	Schrager, Goldstein, Harada
29–31, 34, 36, 51, 53, 55	103(a)	Schrager, Goldstein, Davis
32, 33, 35, 37	103(a)	Schrager, Goldstein, Davis, Harada
20–22, 25, 27, 39, 54–56	103(a)	Schrager, Goldstein, Skulley
23, 24, 26, 28	103(a)	Schrager, Goldstein, Skulley, Harada

IPR612 Dec. 8–9. The Petition in this proceeding asserts the same grounds of unpatentability as those upon which we instituted review in IPR612.

Pet. 6.

Petitioner contends that “[t]he Joinder Petition is substantively the same as the petition filed in the 612 Proceeding,” and Patent Owner agrees that “[t]he grounds and prior art asserted in this proceeding are identical to the grounds and prior art asserted in the Bose IPR.” Mot. 5; Prelim. Resp. 6. We agree that the Petition here asserts challenges and evidence identical to those asserted in the IPR612. Having already considered the merits of those challenges and evidence *vis-à-vis* the threshold of institution for *inter partes* review in our IPR612 Decision, we would determine that the Petition here

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<sup>10</sup> US 7,072,686 B1, issued July 4, 2006 (IPR612, Ex. 1101).

<sup>11</sup> US 2008/0031475 A1, published Feb. 7, 2008 (IPR612, Ex. 1026).

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