

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

KOSS CORPORATION,
Patent Owner.

IPR2021-00592
Patent 10,469,934 B2

Before PATRICK R. SCANLON, DAVID C. McKONE, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

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

I. INTRODUCTION

Apple, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–3, 5, 7, 9–11, 14–16, 19, 21, 23–25, 28, 30, 32–37, 39, 42–43, 45–48, and 51–57 of U.S. Patent No. 10,469,934 (Ex. 1001, “the ’934 patent”). Paper 2 (“Pet.”). Koss Corporation (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314. Upon considering the record developed thus far, for reasons discussed below, we institute *inter partes* review.

II. BACKGROUND

A. Real Parties in Interest

Petitioner states it is the real party-in-interest. Pet. 74. Patent Owner states that it is the real party in interest. Paper 3 (“Mandatory Notice by Patent Owner”), 1; *see also* Papers 6 and 7 (updates).

B. Related Matters

Both parties list the related lawsuit alleging infringement of the ’892 patent, *Koss Corporation v. Apple Inc.*, Case No. 6:20-cv-00665 (W.D. Tex.) (“District Court” or “District Court Lawsuit”). Pet. 74; Paper 3, 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 3 (updated in Papers 6 and 7), 1–2.

1. Other Lawsuits

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

v. Bose Corp., Case No. 6-20-cv-00661 (W.D. Tex); *Bose Corporation v. Koss Corp.*, Case No. 1-20-cv-12193 (D. Mass.); and *Apple Inc. v. Koss Corp.*, Case No. 4:20-cv-05504 (N.D. Cal.). Paper 3, 1. In addition, Patent Owner identifies *Koss Corp. v. Skullcandy, Inc.*, Case No. 2:21-cv-00203 (D. Utah). Paper 7, 1.

2. *United States Applications*

Patent Owner lists the following applications listed 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 3, 1.

3. *Inter Partes Review Proceedings*

Patent Owner lists the following *inter partes* review proceedings¹ challenging patents that claim priority to the PCT Application and the Provisional Application:

Bose Corp. v. Koss Corp., IPR2021-00297 challenging US Patent 10,368,155 B2; *Apple Inc. v. Koss Corp.*, IPR2021-00305, filed December 15, 2020, challenging US Patent 10,506,325 B1); *Apple Inc. v. Koss Corp.*, IPR2021-00381, filed January 4, 2021, challenging US Patent 10,491,982 B1; *Apple Inc. v. Koss Corp.*, IPR2021-00546, filed February 22, 2021, challenging US Patent 10,206,025 B1; and *Apple Inc. v. Koss Corp.*, IPR2021-00612 challenging U.S. Patent 10,206,025, filed March 3, 2021. Paper 3, 1–2.

¹ Additional *inter partes* review proceedings involving these same parties include *Apple Inc. v. Koss Corporation*, IPR2021-00255 ("255 IPR"), filed December 15, 2020, and *Apple Inc. v. Koss Corporation*, IPR2021-00600, filed March 7, 2021, both challenging US Patent 10,298,451 B1.

Patent Owner adds the following to its list of *inter partes* review proceedings which also claim priority to the PCT Application and the Provisional Application: *Apple Inc. v. Koss Corp.*, IPR2021-00626, filed March 17, 2021, challenging US Patent 10,206,025 B1; *Apple Inc. v. Koss Corp.*, IPR2021-00679, filed March 22, 2021, challenging US Patent 10,506,325 B1; and *Apple Inc. v. Koss Corp.*, IPR2021-00686, filed March 22, 2021, challenging US Patent 10,491,982 B1. Paper 6, 2.

Two *inter partes* review proceedings are directed to claims of the '934 patent not challenged here, including: *Bose Corp. v. Koss Corp.*, IPR2021-00680 (“’680 IPR”); and *Apple Inc. v. Koss Corp.*, IPR2021-00693 (“’693 IPR”), both filed March 17, 2021.

C. The '934 Patent

The application for the '934 patent's earliest priority dates are April 7, 2009, to the PCT Application and April 8, 2008, to the Provisional Application. Ex. 1001, code (63).

1. Background Technology

The '934 patent explains that wired headphones interconnecting headphones and a data storage unit are “cumbersome.” Ex. 1001, 1:42–51. Cordless headphones that connect wirelessly via IEEE 802.11, e.g., via Bluetooth connection, to a WLAN-ready laptop or personal computer have been proposed but “such headphones are also quite large and not in-ear type phones.” *Id.* at 1:58–62; *see also* Ex. 1003 ¶ 29 (Cooperstock Declaration describing Bluetooth as a wireless communication employing 802.11 (WiFi)).

2. The '934 Patent's Wireless Earphones

The '934 patent describes and claims a wireless earphone that receives streaming audio data from a data source such as an audio player or computer via 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. 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 or WAN (including the Internet).” *Id.* at 3:6–11.

The earphone has a body and an ear canal portion for insertion into the canal of the user of the earphone. Ex. 1001, 3:17–20, 3:54–56. In some embodiments there may be “two discrete wireless earphones,” one in each ear. *Id.* at 3:47–49. Figure 2A of the '934 patent is reproduced below.

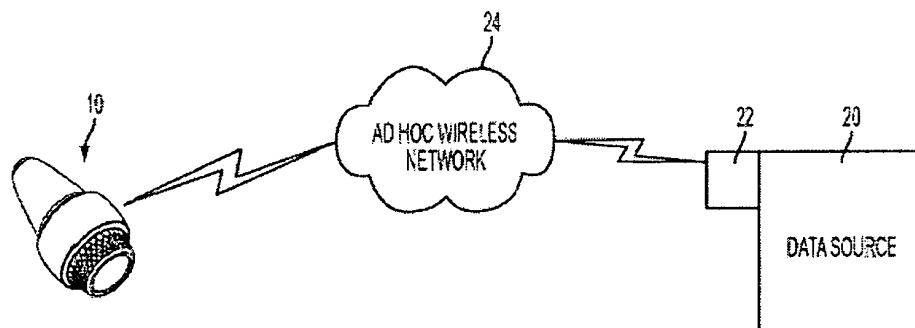


FIG. 2A

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