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Paper No. 9
Date: April 14, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

KOSS CORP.,
Patent Owner.

IPR2022-00188
Patent 10,469,934 B2

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

EASTHOM, *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

Apple Inc. ("Petitioner" or "Apple") filed a Petition for *inter partes* review of claims 1–22, 32–41, 47, and 49–62 of U.S. Patent No. 10,469,934 B2 (Ex. 1001, "the '934 patent"). Paper 2 ("Pet."). Petitioner also filed a Motion for Joinder with *Bose Corp. v. Koss Corp.*, IPR2021-00680 (the "'680 IPR"). Paper 3 ("Mot." or "Joinder Motion"). Koss Corp. ("Patent Owner") filed a Preliminary Response opposing institution and joinder. Paper 7 ("Prelim. Resp.").[1] We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . 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 deny the Petition and Joinder Motion and do not institute an *inter partes* review of the challenged claims.

II. RELATED PROCEEDINGS

The parties indicate that the '934 patent is the subject of several court proceedings, the '680 IPR filed by Bose Corp. ("Bose"), and two prior petitions for *inter partes* review filed by Petitioner. Pet. 2–3; Paper 5, 1–2. Based on Apple's first petition, the '934 patent was the subject of *Apple Inc. v. Koss Corp.*, IPR2021-00592 (the "'592 IPR"), where the Board granted institution of *inter partes* review. Paper 5, 2. Based on Apple's second petition, the '934 patent also was the subject of *Apple Inc. v. Koss Corp.*,

[1] Patent Owner did not file an Opposition to the Joinder, but asserts in the Preliminary Response that "the Board should deny institution of the Third Apple IPR and Petitioner's motion for joinder." Prelim. Resp. 11.

IPR2021-00693 (the "'693 IPR"), where the Board denied institution of *inter partes* review. *Id.*

The instant Petition challenges the same claims in the '934 patent on the same grounds as Bose's petition in the '680 IPR. *See* Pet. 5–6. The Board instituted an *inter partes* review of claims 1–22, 32–41, 47, and 49–62 of the '934 patent based on the following asserted prior art and grounds in Bose's '680 IPR petition, as summarized in the following table:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–3, 5, 7, 9–11, 32–37, 39, 47, 49, 51–57	103(a)	Schrager,[2] Goldstein[3]
4, 6, 8, 12, 13, 38, 40, 41, 58–62	103(a)	Schrager, Goldstein, Harada[4]
14–16, 19, 21, 49–51	103(a)	Schrager, Goldstein, Skulley[5]
17, 18, 20, 22	103(a)	Schrager, Goldstein, Skulley, Harada
1–3, 5, 7, 9–11, 14–16, 19, 21, 47, 49–53	103(a)	Rezvani-446,[6] Rezvani-875,[7] Skulley, Hind[8]
4, 6, 8, 12, 13, 17, 18, 20, 22, 58–62	103(a)	Rezvani-446, Rezvani-875, Skulley, Hind, Harada
32–37, 39, 54–57	103(a)	Rezvani-446, Rezvani-875, Oh,[9] Hind

[2] US 7,072,686 B1, issued July 4, 2006 (Ex. 1101).
[3] US 2008/0031475 A1, published Feb. 7, 2008 (Ex. 1026).
[4] US 2006/0229014 A1, published Oct. 12, 2006 (Ex. 1098).
[5] US 6,856,690 B1, issued Feb. 15, 2005 (Ex. 1017).
[6] US 2007/0136446 A1, published June 14, 2007 (Ex. 1097).
[7] US 2007/0165875 A1, published July 19, 2007 (Ex. 1016).
[8] US 7,069,452 B1, issued June 27, 2006 (Ex. 1019).
[9] WO 2006/098584 A1, published Sept. 21, 2006 (Ex. 1099).

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
38, 40, 41	103(a)	Rezvani-446, Rezvani-875, Oh, Hind, Harada

Bose Corp. v. Koss. Corp., IPR2021-00680, Paper 15 at 8, 43 (PTAB Oct. 13, 2021) (institution decision) ("'680 Dec.").

III. WHETHER TO INSTITUTE *INTER PARTES* REVIEW

As indicated above, the Petition here asserts the same grounds of unpatentability as those upon which the Board instituted review in the '680 IPR. *Compare* Pet. 6, *with* '680 Dec. 8, 43. Petitioner verifies that the Petition "is substantively identical to the ['680] petition." Pet. 5.

Based on institution in the '680 IPR, the substantively identical showing here by Petitioner warrants institution if the institution decision considers only the merits of the prior art challenges. Notwithstanding the merits, however, Patent Owner argues that we should exercise our discretion to deny institution under 35 U.S.C. § 314(a) and, accordingly, deny joinder, based on the *General Plastic* factors and the Board's most recent precedential position on joinder. Prelim. Resp. 9–21 (citing *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i) and *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 at 4–7 (PTAB Oct. 28, 2020) (precedential as to discretionary denial of joinder) ("*Uniloc*")).

Petitioner argues that the *General Plastic* factors support granting joinder and that the facts in the Petition are substantially different than those in *Uniloc*. Mot. 6, 10. As explained in further detail below, Petitioner's arguments are not persuasive. The "me-too" Petition here is Petitioner's

third challenge to the '934 patent. Should Bose settle, Petitioner would be able to continue a proceeding that would otherwise be terminated. *See Uniloc*, Paper 9 at 4 ("[S]hould Microsoft settle, Petitioner would stand in to continue a proceeding that would otherwise be terminated. In effect, it would be as if Apple had brought the [third] challenge to the patent in the first instance."); *General Plastic*, Paper 19 at 17 ("Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.").

Under the precedential decision in *Uniloc*, deciding to join Apple as a party to the '680 IPR first involves considering whether to exercise discretion under § 314(a). *See Uniloc*, Paper 9 at 5 ("[B]efore determining whether to join Apple as a party to the 023 IPR, even though the Petition is a 'me-too petition,' we first determine whether application of the *General Plastic* factors warrants the exercise of discretion to deny the Petition under § 314(a).").

The statutory provision governing joinder in *inter partes* review, 35 U.S.C. § 315(c), follows:

> If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

See also Facebook, Inc. v. Windy City Innov., LLC, 973 F.3d 1321, 1332 (Fed. Cir. 2020) (determining that § 315(c) requires "two different decisions," first "whether the joinder applicant's petition for IPR 'warrants'

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