

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)
IPR2021-00600 (Patent 10,298,451 B1)¹

Before PATRICK R. SCANLON, DAVID C. MCKONE,
GREGG I. ANDERSON, and NORMAN H. BEAMER,
*Administrative Patent Judges.*²

ANDERSON, *Administrative Patent Judge.*

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ This Order addresses issues that are the same in all identified proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties, however, are not authorized to use this style heading in subsequent papers.

² This is not an expanded panel. Rather, the four listed judges represented overlapping three-judge panels on the above-captioned proceedings.

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I. INTRODUCTION

Petitioner and Patent Owner (“Parties”) have requested that the above-identified *inter partes* review proceedings (“’592 IPR” and “’600 IPR,” respectively) be terminated. ’592 IPR, Paper 54; ’600 IPR, Paper 47.³ On July 27, 2022, we authorized via email the Parties to file joint motions to terminate the above-identified proceedings. On July 28, 2022, the Parties filed a Joint Motion to Terminate in each of the above-identified proceedings (“Motions”).⁴ *Id.* Along with the Motions, the Parties filed a copy of a Settlement and License Agreement in each of the above-identified proceedings (“Settlement Agreement”). ’592 IPR, Exs. 2053, 2054 (Ex. A to Settlement Agreement); ’600 IPR, Exs. 2030, 2031 (Ex. A to Settlement Agreement) The Parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the involved patent and be pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) in each of the above-identified proceedings (“Joint Requests”). ’592 IPR, Paper 55; ’600 IPR, Paper 48.

II. DISCUSSION

In the Motions, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceedings, the Settlement Agreement constitutes the entire

³ Citations are to Papers and Exhibits filed in IPR2021-00592, unless otherwise indicated. Parties filed a similar paper in IPR2021-00600. Paper 47.

⁴ The Motions request termination “[p]ursuant to 35 U.S.C. § 327(a).” Paper 54, 1. 35 U.S.C. § 327(a) applies to settlement for post-grant review. 35 U.S.C. § 317(a) applies to settlement for *inter partes* review, the type of proceeding at issue here. We deem this harmless error and understand the parties to request termination pursuant to 35 U.S.C. § 317(a).

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understanding and agreement between the Parties, and true copies of the Settlement Agreement have been filed. '592 IPR, Paper 54, 1; '600 IPR, Paper 47. The Parties further represent that the Settlement Agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving Patent 10,469,934 B2 in the '592 IPR and Patent 10,298,451 B1 in the '600 IPR. '592 IPR, Paper 54, 1; '600 IPR, Paper 47.

We instituted a trial in the '592 IPR on August 23, 2021 (Paper 9) and instituted a trial in the '600 IPR on September 1, 2021 (Paper 9). We have not yet decided the merits on all claims and grounds for either of these proceedings, and a final written decision addressing all claims and grounds has not been entered in these proceedings. Notwithstanding that these proceedings have moved beyond the preliminary stage, the Parties have shown adequately that the termination of these proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate these proceedings with respect to the Parties.

The Parties also filed Joint Requests that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the patents involved in these *inter partes* proceedings. '592 IPR, Papers 55, 56; 600 IPR, Papers 48, 49. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

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III. ORDER

Accordingly, it is

ORDERED that the Joint Motions to Terminate the above-identified proceedings are *granted* and the above-identified proceedings are *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72;

FURTHER ORDERED that the Joint Requests that the Settlement Agreement, including Exhibit A attached thereto, be treated as business confidential information and kept separate are *granted*, and the Settlement Agreement shall be kept separate from the files of Patent 10,298,451 B1 and Patent 10,469,934 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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