

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.

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).

<b>Claim(s) Challenged</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>
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).

also presents a reasonable likelihood of prevailing on the challenge of at least one claim of the '053 patent.

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, citing and discussing the *General Plastic* factors. Prelim. Resp. 1, 11–20 (citing *General Plastic Indust. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016- 01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i) (“*General Plastic*”). However, Petitioner argues that the *General Plastic* factors support granting joinder, given that Petitioner seeks to join as a party to IPR612 and take an inactive or understudy role. Mot. 6–12.

As explained in further detail below, Petitioner’s understudy argument is not persuasive here where the copied Petition is Petitioner’s third challenge to the patent, and should Bose settle, Petitioner would stand in to continue a proceeding that would otherwise be terminated. This would be the kind of serial attack that *General Plastic* was intended to address. *General Plastic*, Paper 19 at 17 (“Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.”).

As established in *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 at 4–5 (PTAB Oct. 28, 2020) (precedential) (“Uniloc”), that Petitioner seeks to join IPR612 does not obligate us to institute this proceeding without first considering whether to exercise discretion under Section 314(a). The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

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’ institution under § 314,” and then whether to “exercise . . . discretion to decide whether to ‘join as a party’ the joinder applicant”). Under 35 U.S.C. § 315(c), the discretion of the Director to join a party to an ongoing IPR is premised on the Director’s determination that the petition warrants institution. That determination is not limited to determining whether the merits of the petition meet the reasonable likelihood threshold for at least one challenged claim. Under *General Plastic*, the Board may deny a petition based on the Director’s discretionary authority of § 314(a). *General Plastic*, Paper 19 at 15. Thus, before determining whether to join Petitioner as a party to IPR612, 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 Section 314(a).

#### *A. General Plastic Factors*

In *General Plastic*, the Board recognized certain goals of the AIA but also “recognize[d] the potential for abuse of the review process by repeated attacks on patents.” *General Plastic*, Paper 19 at 16–17. The Board’s decision in *General Plastic* articulates a non-exhaustive list of factors to be considered in evaluating whether to exercise discretion, under 35 U.S.C.

§ 314(a), to deny a petition that challenges a patent that was previously challenged before the Board. These factors are:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

*General Plastic*, Paper 19 at 9–10.

*B. Assessment of the Factors*

The Petition in the instant proceeding is undeniably the third petition Petitioner has filed challenging the '053 patent. Patent Owner urges that we exercise discretion to deny the Petition and deny joinder because of Petitioner's repeated challenges and because, in the year since the denial of the first petition, Petitioner has had the benefit of Patent Owner's filings in prior IPRs, and Petitioner has failed to explain the timing of its third petition



and its knowledge of the asserted prior art. Prelim. Resp. 1–2, 16–17.

Accordingly, we address each of the factors below.

1. “*whether the same petitioner previously filed a petition directed to the same claims of the same patent*”

As stated above, this is the third petition Petitioner has filed challenging the claims of the ’053 patent. Prelim. Resp. 1. Collectively, the first two Petitions challenged all but claim 7 of the ’053 patent. IPR546, Paper 2, 1–2; IPR626, Paper 3, 1–2; Prelim. Resp. 11–12. Here, in Petitioner’s third petition, Petitioner challenges all of the ’053 claims (1–56). Pet. 6.

The fact that Petitioner would undertake an “understudy” role in the IPR612 does not affect this factor. *Uniloc*, Paper 9 at 8. As stated earlier, the *General Plastic* factors are relevant to our determination whether denial is warranted under § 314(a), even when the petition filed is a follow-on petition and Petitioner is not seeking an active role in the ongoing IPR. Accordingly, there is an almost total overlap in challenged claims, and we conclude that this first *General Plastic* factor weighs in favor of denying institution of the proceeding.

2. “*whether at the time of filing of the first [two] petition[s] the petitioner knew of the prior art asserted in the [third] petition or should have known of it*”<sup>12</sup>

Petitioner asserts that it was not aware of U.S. Patent No. 7,072,686 B1 (“Schrager”), the primary reference that forms the basis of six of the fourteen grounds of IPR612, when it filed its IPR546 Petition. Mot. 3, 6.

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<sup>12</sup> Our restatement of the *General Plastic* factors reflects, where applicable, the fact that two prior Petitions were filed.

Petitioner does not represent that it was unaware of the other eight references relied on by Bose in IPR612, including for the eight grounds not involving Schrage. Petitioner also does not dispute that it was aware of Schrage, and Bose's reliance on that reference, when it filed its second IPR626 Petition on March 17, 2021, fourteen days after Bose filed its IPR612 Petition.

Patent Owner argues that Petitioner "clearly knew" of the prior art cited here at the time it filed its second IPR626, and maintains that Petitioner's assertion that it was unaware of Schrage when it filed its first IPR546 Petition "is not credible." Prelim. Resp. 13–14. Patent Owner submits evidence that Petitioner had previously cited the Schrage reference to the Patent Office "over 100 times in its own patent applications." *Id.* at 3, 7, 15 (citing Ex. 2002, 10–16; Ex. 2003, 20; Ex. 2004, 107). Patent Owner further argues that Petitioner has not explained why it could not have known of the Schrage reference *via* a reasonable search when it filed its first Petition. *Id.* at 15–16.

We agree with Patent Owner that Petitioner has not adequately explained why it should not have known of the Schrage reference prior to filing its first Petition. Although the fact that Petitioner had cited the Schrage reference on numerous previous occasions does not give rise to an inference that those involved on Petitioner's behalf here were actually aware of the reference, it is indicative that Petitioner should have known of the reference. In any event, Petitioner was aware of Schrage when the second Petition was filed. Moreover, Schrage was only one of nine references, used for only six of fourteen grounds, forming the basis of the current, third,

Petition. We conclude that this second *General Plastic* factor weighs in favor of denying institution of the proceeding.

3. “*whether at the time of filing of the [third] petition the petitioner already received the patent owner’s preliminary response[s] to the first [two] petition[s] or received the Board’s decision[s] on whether to institute review in the first [two] petition[s]*”

The Preliminary Responses for IPR546 and IPR612 were filed June 10 and July 9, 2021, respectively — over three to four months before the present Petition was filed. IPR546, Paper 8; IPR626, Paper 8. The decisions not to institute *inter partes* review were entered on September 7 and 30, 2021, respectively — also prior to this Petition. IPR546, Paper 10; IPR626, Paper 10.

Petitioner argues that Bose filed the IPR612 Petition “just nine days after [Petitioner] filed its IPR546 Petition], which is so close in time as to be all but indistinguishable procedurally from a simultaneously-filed petition,” which therefore “could not reasonably have provided Bose substantial benefit in preparing its petition.” Mot. 7.

Petitioner’s argument is unpersuasive because the third *General Plastic* factor addresses whether Petitioner had access to a Board decision or a preliminary response concerning prior petitions, such that Petitioner would have been in a position to gain a benefit from having that information before filing its third petition. The timing of events here shows that Petitioner indeed had the benefit of two Preliminary Responses and two Board decisions concerning its prior petitions. Consequently, we conclude that the third *General Plastic* factor weighs in favor of denying institution of the proceeding.

4. *“the length of time that elapsed between the time the petitioner learned of the prior art asserted in the [third] petition and the filing of the [third] petition”*

As discussed above, Petitioner was aware of the prior art asserted here at least by the time Bose filed the IPR612 Petition on March 3, 2021 — more than seven months prior to filing the present Petition. Prelim. Resp. 17.

Petitioner argues that “the period of time between Bose’s filing of the 612 Proceeding and [Petitioner’s] filing of the present petition and motion for joinder should not be relevant, as it does not affect the schedule of the 612 Proceeding or substantially prejudice [Patent Owner].” Mot. 8. Again, this argument is not persuasive because, per *Uniloc*, before determining whether to join Petitioner as a party to IPR612, 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 Section 314(a). *Uniloc*, Paper 9 at 8.

We conclude that, given the unexplained seven-month delay, this fourth *General Plastic* factor weighs in favor of denying institution of the proceeding.

5. *“whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent”*

For the same reasons stated above in connection with the fourth *General Plastic* factor, we conclude that this fifth *General Plastic* factor also weighs in favor of denying institution.

6. “*the finite resources of the Board*”

Petitioner argues that this last *General Plastic* factor weighs against denial of institution because “this Joinder Petition will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings.” Mot. 8.

However, citing *Uniloc*, Patent Owner argues “[i]f this proceeding is instituted and joined with the Bose IPR, and Bose and Patent Owner settle the Bose IPR, ‘Apple would stand in to continue a proceeding that would otherwise be terminated,’” which would allow Petitioner to ‘continue a proceeding, even after settlement with the primary petitioner [here, Bose], based on a [third] attempt by Apple.’” Prelim. Resp. 19 (quoting *Uniloc*, Paper 9 at 12).

Although a joinder request is ordinarily an efficient mechanism by which to become a petitioner in an IPR, in this case, Petitioner’s understudy role argument is not persuasive. Rather, we agree with Patent Owner that because this is Petitioner’s third petition, should Bose settle, Petitioner would stand in to continue a proceeding that would otherwise be terminated. Joinder in this circumstance would allow Petitioner to continue a proceeding, even after settlement with the primary petitioner, based on a third attempt by Petitioner. Therefore, we conclude that this sixth *General Plastic* factor weighs in favor of denying institution of the proceeding.

7. “*the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review*”

Like the sixth *General Plastic* factor, the seventh factor, “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not

later than 1 year after the date on which the Director notices institution of review,” implicates an efficiency consideration. Because there is no evidence or persuasive argument towards this factor, we determine this factor’s weight is neutral.

### *C. Conclusion*

After a holistic review of the *General Plastic* factors and the arguments presented for and against the exercise of discretionary denial, we conclude that the factors weigh in favor of denying institution of the proceeding. On balance and in view of the policy goals articulated in *General Plastic*, we conclude that it is appropriate here to exercise our discretion under 35 U.S.C. § 314(a) to deny the Petition.

### IV. DENIAL OF MOTION FOR JOINDER

As stated above, the Director may join a party to an ongoing IPR only if the filed petition warrants institution under § 314. 35 U.S.C. § 315(c). Because we are exercising discretion to deny institution under Section 314, we deny Petitioner’s Motion for Joinder.

### V. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), the Petition is denied; and

FURTHER ORDERED that the Motion For Joinder is denied.

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