

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

SKULLCANDY, INC.,
Petitioner,

v.

EARIN AB,
Patent Owner.

IPR2025-00690
Patent 9,402,120 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

DECISION
Referring the Petition to the Board

Earin AB (“Patent Owner”) filed a request for discretionary denial (Paper 6, “DD Req.”) in the above-captioned case, and Skullcandy, Inc. (“Petitioner”) filed an opposition (Paper 7, “DD Opp.”).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in this proceeding. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, the challenged patent issued nine years ago, creating strong settled expectations. While ordinarily that counsels for discretionary denial, Petitioner persuasively explains that the patent examiner materially erred during prosecution of the challenged patent. DD Opp. 8–9. The patent examiner identified a “wherein” clause listing various structural features of an earbud housing as the reason for allowance of the challenged claims. Ex. 1009, 6; *see also* Ex. 1001, 12:54–64 (claim 1, with the “wherein” limitation listing the various structural features). The challenged claims (claims 20 and 21), however, do not recite those features. Ex. 1001, 14:50–15:15 (claim 20, missing the “wherein” clause). Petitioner appears to show a material error by the Office, and it is an appropriate use of Board resources to review the potential error.

Although certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petition is referred to the Board to handle the case in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *denied*;

FURTHER ORDERED that the Petition is referred to the Board; and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

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