

October 28, 2024

VIA ELECTRONIC MAIL

Jeffrey S. Edwards
Dechert LLP
Cira Centre
2929 Arch Street
Philadelphia, PA 19104-2808
Jeffrey.edwards@dechert.com

RE: Zaxcom, Inc. v. Rode Microphones, LLC et al, 1:23-cv-01245-JFM

Dear Jeffrey,

We write in response to your letter of October 21, 2024, in which Defendants Rode Microphones, LLC and Freedman Electronics PTY, Ltd. (collectively "RODE") request that Zaxcom, Inc., ("Zaxcom"), limit the number of asserted claims to 20 by November 8, 2024. Zaxcom will not agree to do so.

Initially, Zaxcom is willing to limit the number of asserted claims prior to the commencement of expert discovery in this matter and after the Court issues its claim construction opinion. That provides ample time for the parties to narrow the issues prior to dispositive motion practice in this case. Your letter provides no reasons why this proposal is unworkable.

Moreover, the Court did not "resolve" this dispute in Rode's favor. In fact, the Court rejected Rode's request to impose Judge Connolly's Scheduling Order in this matter with Rode's proposed additional narrowing events. As you correctly note, the Scheduling Order entered by the Court (D.I. 60) did not specifically put a narrowing event in the schedule. Rather, the Court included Judge Andrews' scheduling order language which states that the Court may consider narrowing before or after claim construction. The circumstances in this case strongly favor a narrowing of the claims after claim construction.

First, all of the asserted patents are related patents and have common disclosures. As a result, there is no reason why the normal claim construction procedure would be unwieldy in this case.¹

¹ Zaxcom provided Rode with infringement contentions for U.S. Patent 12,051,444 (the '444 patent"). However, Rode did not provide invalidity contentions as to the asserted claims because Zaxcom has not, as yet, amended the Complaint to assert that patent. Amendments to the Complaint are due on November 2, 2024. Zaxcom will provide Rode with a proposed amended Complaint later this week asserting the '444 patent.

Second, Zaxcom provided its initial claim charts to Rode on August 30, 2024, in which 116 claims from the original patents-in-suit were charted. Rode waited almost two full months and served its invalidity contentions before making this request to Zaxcom. If the parties have been able to follow the schedule with the current number of asserted claims, there is no reason that the parties should not be able to engage in the claim construction process.

Third, Rode's invalidity contentions rely on the same prior art against all asserted claims. That further indicates that the claim construction process will not be unwieldy given the commonality of Rode's invalidity theory.

Finally, Rode has a statutory IPR filing deadline that is fast approaching. Before making a decision on claim reduction, Zaxcom is entitled to know: (1) whether Rode files IPRs; (2) if so, the patents against which Rode files IPRs; and (3) whether the USPTO institutes IPRs as to some or all of Rode's filings. An institution decision as to some of the patents but not others may affect which claims Zaxcom pursues in this case.

In light of the foregoing, Zaxcom will not agree to narrow the number of asserted claims at this time.

Very truly yours,

/s/ Gerard M. O'Rourke

Gerard M. O'Rourke

Cc: All counsel of record