

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RØDE MICROPHONES, LLC AND
FREEDMAN ELECTRONICS PTY LTD,
Petitioners

v.

ZAXCOM, INC.,
Patent Owner

Case IPR2025-00231

U.S. Patent 7,929,902

PATENT OWNER'S PRELIMINARY RESPONSE

PURSUANT TO 37 C.F.R. § 42.107(a)

TABLE OF CONTENTS

I. INTRODUCTION.....	1
II. RELATED LITIGATION AND IPRS	2
III. TECHNOLOGY BACKGROUND	3
A. Prior Art Audio Systems	3
B. Mr. Sanders and Mr. Stark Invent A New Wireless Recording System to Address Interference and Dropout Problems.....	4
IV. PERSON OF ORDINARY SKILL IN THE ART	9
V. DISCRETIONARY DENIAL OF THE PETITION IS WARRANTED	9
A. Institution Should Be Denied Pursuant to 35 U.S.C. § 314(a) Because the Same Parties, Patent, Claims, Invalidity References and Arguments Are Being Advanced in a Parallel Litigation.....	9
1. No Stay Has Been Granted and No Evidence Exists to Indicate That a Stay Will Be Granted	10
2. The Proximity of the Court’s Trial Date to the Projected Statutory Deadline for a Final Written Decision is Narrow.....	16
3. There Has Been Significant Investment in the Litigation By the Court and Parties	17
4. There Is Overlap Between Issues Raised in the Petition and in the Litigation.....	17
5. Petitioners and the Litigation Defendants Are the Same Parties.....	18
6. Other Circumstances Exist that Impact the PTAB’s Exercise of Discretion, Including the Merits.	18
VI. ZAXCOM IS NOT COLLATERALLY ESTOPPED FROM DISPUTING THE PTAB’S PRIOR FINDINGS	19
VII. CLAIM CONSTRUCTION	21
A. “locally generated audio” (Claims 1-6, 9-10) and “local audio” (Claims	

13, 16-20).....	22
B. “local audio device wearable by a creator of said locally generated audio” (Claims 1-6, 9-10).	24
C. “at least a portion of said local audio data ... is combined with said remote audio data” (Claims 13, 16) and “local audio data for each of said performers is retrieved from said local audio devices and is combined to create a single multi-track audio file” (Claims 17-20).....	26
D. “master timecode generator” (Claims 1-3, 6, 9-10) and “master timecodes” (Claims 1-3, 6, 9-10, 13, 17-20).....	31
E. “multi-track audio file” (Claims 17-20).....	32
VIII. THE PETITION FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD THAT THE CHALLENGED CLAIMS ARE UNPATENTABLE	33
A. Petitioners Fail to Demonstrate That Any Combination of the Cited References Renders Claims 1-6, 9-10, 13, 16 Obvious under § 103 (Grounds 1 and 2).....	34
1. Petitioners Do Not Demonstrate That Any Combination of the Cited References Teaches Element 1[Pre] (Claims 1-6, 9-10) or Element 1[F] (Claims 1-6).	35
2. Petitioners Fail to Demonstrate That Any Combination of the Cited References Teaches Element 1[B] (Claims 1-6 and 9-10).	38
a) Petitioners Fail to State Any Support to Show That a Strub Recording Unit Having the Features of Claims 1-6 and 9-10 is Wearable	39
b) The Strub Recording Unit is Portable, Not Wearable.	42
c) The Strub Recording Unit is Not Suitable to be Worn by a Performer. 42	
d) Strub and Woo Do Not Teach Wearing of the Local Audio Device by a Performer Who Creates the Audio Recorded by the Local Audio Device.....	44
3. Petitioners Fail to Demonstrate That Any Combination of the Cited References Teaches “a master timecode generator” (Claims 1-6 and 9-10) or “a plurality of master timecodes” (Claims 1-6, 9-10, and 13).	45

4.	Petitioners Fail to Demonstrate That Any Combination of the Cited References Teaches Element 12[E] (Claims 13 and 16).	51
B.	Petitioners Fail to Demonstrate That Claims 17-20 Are Rendered Obvious under § 103 By the Combination of Strub and Woo (Proposed Ground 3).	53
1.	Petitioners Fail to Demonstrate That a Combination of Strub and Woo Teaches 17[Pre], 17[A], and 17[B] (Claims 17-20).	53
2.	Petitioners Fail to Demonstrate That a Combination of Strub and Woo Teaches 17[D] (Claims 17-20).....	54
3.	Petitioners Fail to Demonstrate That a Combination of Strub and Woo Teaches 17[C] (Claims 17-20).	56
IX.	PETITIONERS FAIL TO DEMONSTRATE THAT A POSA WOULD BE MOTIVAED TO COMBINE THE CITED REFERENCES TO CREATE THE INVENTION OF THE CHALLENGED CLAIMS	56
A.	Petitioners Fail to Demonstrate That A POSA Would Be Motivated to Combine the Cited References to Create the Invention of Claims 1-6, 9-10, 13, or 16.....	56
1.	Petitioners Failed to Demonstrate That a POSA Would Have Been Motivated to Modify Strub With Woo, Nagai, Gleissner, or Jones to Achieve the Inventions Recited in the Challenged Claims With a Reasonable Expectation of Success.	56
2.	Strub and Woo are Non-Analogous Art to the Claimed Invention. .	58
3.	Modifying Strub With Nagai or Gleissner Would Change the Principle Operation of Strub And Render it Unsuitable for Its Intended Purpose of Low Attention, Social Recording.	60
B.	Petitioners Fail to Demonstrate That a POSA Would Have Been Motivated To Modify Strub With Woo To Achieve The Particular Methods Recited In Claims 17-20 With A Reasonable Expectation Of Success.	61
X.	CONCLUSION	62

TABLE OF AUTHORITIES

Cases

<i>Apple Inc., v. Fintiv Inc.</i> , IPR2020-00019, Paper 11 (PTAB March 20, 2020)	16, 17, 18
<i>Apple Inc., v. Fintiv Inc.</i> , IPR2020-00019, Paper 15 (PTAB May 13, 2020)	9, 10, 18
<i>Belden Techs. Inc. v. Superior Essex Commc'ns LP</i> , Civ. No. 08-63-SLR, 2010 U.S. Dist. LEXIS 90960 (D. Del. Sept. 2, 2010).....	13
<i>Bonutti Skeletal Innovations, L.L.C. v. Zimmer Holdings, Inc.</i> , C.A. No. 12-cv-1107 (GMS), 2014 U.S. Dist. LEXIS 47430 (D. Del. Apr. 7, 2014)	15
<i>Copy Prot. LLC v. Netflix, Inc.</i> , No. 14-365-LPS, 2015 U.S. Dist. LEXIS 78270 (D. Del. June 17, 2015)....	12, 14
<i>Courtesy Prods., L.L.C. v. Hamilton Beach Brands, Inc.</i> , No. 13-2012-SLR/SRF, 2015 U.S. Dist. LEXIS 116032 (D. Del. Sep. 1, 2015)	11
<i>DDR Holdings, LLC v. Priceline.com LLC</i> , 122 F.4th 911 (Fed. Cir. 2024)	19, 20
<i>Ebates Performance Marketing, Inc. dba Rakuten Rewards et al., v. International Business Machines Corp.</i> , IPR2022-00646, Paper 56 (PTAB Oct. 11, 2023).....	20
<i>Graham v. John Deere Co.</i> , 86 S. Ct. 684 (1966).....	21, 33
<i>In re Bigio</i> , 381 F.3d 1320 (Fed. Cir. 2004)	58
<i>In re Clay</i> , 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).....	58
<i>In re Gordon</i> , 733 F.2d 900 (Fed. Cir. 1984)	60

<i>In re Klein</i> , 647 F.3d 1343 (Fed. Cir. 2011)	58
<i>In re Ratti</i> , 270 F.2d 810 (CCPA 1959)	60
<i>Invensas Corp. v. Samsung Elecs. Co.</i> , Civil Action No. 17-1363-MN-SRF, 2018 U.S. Dist. LEXIS 169999 (D. Del. Oct. 2, 2018)	12
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007)	33
<i>LG Elecs., Inc. v. Toshiba Samsung Storage Tech. Korea Corp.</i> , Civil Action No. 12-1063-LPS-CJB, 2015 U.S. Dist. LEXIS 167153 (D. Del. Dec. 11, 2015)	13, 15
<i>NHK Spring Co., LTD, v. Intri-Plex Technologies, Inc.</i> , IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018)	17
<i>Novozymes N. Am. v. Danisco Us</i> , No. 1:19-cv-01902-JDW, 2020 U.S. Dist. LEXIS 261627 (D. Del. Mar. 31, 2020)	14
<i>OSRAM Sylvania, Inc. v. Am. Induction Techs., Inc.</i> , 701 F.3d 698 (Fed. Cir. 2012)	33
<i>Pacing Techs., LLC v. Garmin Int’l, Inc.</i> , 778 F.3d 1021 (Fed. Cir. 2015)	26
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	17, 21, 26
<i>Plas-Pak Indus. v. Sulzer Mixpac AG</i> , 600 F. App’x 755 (Fed. Cir. 2015)	59, 61
<i>SkyHawke Techs., LLC v. DECA Int’l Corp.</i> , 828 F.3d 1373 (Fed. Cir. 2016)	19, 20

<i>Toshiba Samsung Storage Tech. Korea Corp. v. LG Elecs., Inc.</i> , 193 F. Supp. 3d 345 (D. Del. 2016).....	11, 13
--	--------

<i>Twinstand Biosciences, Inc. v. Guardant Health, Inc.</i> , Civil Action No. 21-1126-GBW-SRF, 2023 U.S. Dist. LEXIS 45701 (D. Del. Mar. 17, 2023).....	15
--	----

Statutes

35 U.S.C. § 312(a)(3).....	38, 45, 52, 53, 54
35 U.S.C. § 314(a)	9
35 U.S.C. § 316(e).	18

Other Authorities

Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Litigation (June 21, 2022)	2
--	---

USPTO News & Updates, <i>USPTO rescinds memorandum addressing discretionary denial procedures</i> , https://www.uspto.gov/about-us/news-updates/uspto- rescinds-memorandum-addressing-discretionary-denial-procedures (last visited March 7, 2025).....	19
---	----

Regulations

37 C.F.R. § 42.4	9
------------------------	---

PATENT OWNER’S EXHIBIT LIST

<u>Exhibit Number</u>	<u>Description</u>
2001	Filed Complaint (ECF No. 1)
2002	Filed Amended Complaint (ECF No. 99)
2003	Notice of Service of Claim Charts (ECF No. 79)
2004	Substantial Completion of Document Production (ECF No. 120)
2005	Notice of Service of Invalidity Contentions (ECF No. 103)
2006	Joint Claim Construction Charts (ECF No. 127)
2007	Court Schedule and Order (ECF No. 98)
2008	Policies of Judge John F. Murphy
2009	March 26, 2021 Cease and Desist Letter and Exhibits
2010	Court Order for Alternative Service of Process (ECF No. 44)
2011	Federal Circuit Appeal Statistics
2012	Court Order Denying Narrowing of Asserted Claims (ECF No. 128)
2013	Federal Register, Vol. 83, No. 197
2014	Federal Agencies Digital Guidelines Initiative Defining “Multitrack Recording”
2015	Declaration of James M. DeFilippis
2016	Curriculum Vitae of James M. DeFilippis
2017	Notice of Allowance for the ’443 Patent
2018	Nagra V Non-Patent Literature
2019	American Heritage Dictionary, Definition of “Master”

2020	Electro-Voice, “Wireless Microphone Basics” Publication Defining “Body Pack”
2021	Declaration of Jack Norflus
2022	Curriculum Vitae of Jack Norflus
2023	Stipulation to Amend the Scheduling Order (ECF No. 132)
2024	Zaxcom TRX900AA Data Sheet
2025	Sennheiser SK2000 Data Sheet
2026	Lectrosonics SM Series Data Sheet

GLOSSARY OF TERMS

TERM	DEFINITION
“’207 Patent”	U.S. Patent No. 10,276,207 issued April 30, 2019
“’307 Patent”	U.S. Patent No. 9,336,307 issued May 10, 2016
“’443 Patent”	U.S. Patent No. 7,711,443 issued May 4, 2010
“’444 Patent”	U.S. Patent No. 12,051,444 issued on July 30, 2024
“’605 Patent”	U.S. Patent No. 11,610,605 issued on March 21, 2023
“’814 Patent”	U.S. Patent No. 8,385,814 issued February 26, 2013
“’902 Patent”	U.S. Patent No. 7,929,902 issued April 19, 2011
“Asserted Claims”	Claims asserted in <i>Zaxcom, Inc. v. RODE Microphones, LLC, et al.</i> , No. 1:23-cv-01245-JFM (D. Del.), as identified in Ex-2006.
“Board”	USPTO Patent Trial and Appeal Board
“CAFC”	U.S. Court of Appeals for the Federal Circuit
“Challenged Claims”	Claims 1-6, 9-10, 13, 16-20
“Cited References”	Strub, Woo, Nagai, Gleissner, and Jones
“District Court”	United States District Court for the District of Delaware
“ECF”	Electronic Case File
“Freedman”	Freedman Electronics Pty Ltd
“Freedman/Rode IPR Petitions”	Petitions filed in IPR2025-00230, IPR2025-00231, IPR2025-00232, IPR2025-00557, collectively
“FWD”	PTAB Final Written Decision
“Gleissner”	United States Patent Publication No. 2004/0028241
“IPR”	<i>Inter Partes</i> Review
“Jones”	U.S. Patent No. 7,493,437
“Lectrosonics IPRs”	The “Prior ’902 IPR”), the “Prior ’814 IPR, and the Prior ’307 IPR, collectively
“Litigation”	<i>Zaxcom, Inc. v. RODE Microphones, LLC, et al.</i> , No. 1:23-cv-01245-JFM (D. Del.)
“Nagai”	United States Publication No. 2002/0159179
“Parties”	Patent Owner and Petitioners
“Patent Owner or Zaxcom”	Zaxcom, Inc.
“Patents-in-Suit”	Collectively, the following patents: (i) the ’443 Patent; (ii) the ’902 Patent; (iii) the ’814 Patent (iv) the ’307 Patent;

	(v) the '207 Patent; (vi) the '605 Patent; and (vii) the '444 Patent
“Petition”	The Petition filed in IPR2025-00231
“Petitioners”	Rode Microphones, LLC and Freedman Electronics Pty Ltd.
“POSA”	Person of ordinary skill in the art at the time of the invention
“PTAB”	USPTO Patent Trial and Appeal Board
“Prior '307 IPR”	IPR2018-00972
“Prior '814 IPR”	IPR2018-01130
“Prior '902 IPR”	IPR2018-01129
“Rode”	RØDE Microphones, LLC
“Strub”	United States Patent No. 6,825,875
“SJ”	Summary Judgement
“Woo”	United States Patent No. 5,479,351

I. INTRODUCTION

The Petition attempts to invalidate the Challenged Claims under three obviousness grounds citing to various combinations of Strub, Woo, Nagai, Gleissner, and Jones, but fails to make such arguments with sufficient particularity as required under 35 U.S.C. § 312(a)(3). Further, the Petition fails to construe any terms of the Challenged Claims and analyzes them in direct contradiction to the language thereof and the '902 Specification. Accordingly, it is left to the Board and Zaxcom to decipher the proper claim construction, how the Cited References are combined, and the motivation of a POSA to make such a combination.

Instead, Petitioners repeatedly state that Zaxcom is collaterally estopped from making any arguments that differ from the rulings of the Lectrosonics IPRs, despite CAFC case law that unequivocally states that collateral estoppel is not appropriate when a different claim construction standard is applied in the two proceedings, as is the case here. Petitioners fail to cite any case law supporting collateral estoppel in these circumstances, thereby ignoring clear and binding precedent. As such, the Petition fails to show a reasonable likelihood that the Petitioners would prevail at trial with respect to at least one Challenged Claim of the '902 Patent.

Further, the Parties have spent considerable resources litigating the validity of the '902 Patent and six other patents in a parallel Litigation, and in accordance

with the *Fintiv* Factors (*infra* § V.A), the Board should deny institution under 35 U.S.C. § 314(a). Petitioners’ arguments against such a denial due to the USPTO memorandum entitled Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Litigation (June 21, 2022) (the “Memorandum”) and corresponding case law relating to this Memorandum should be ignored in light of the USPTO’s revocation of both on February 28, 2025 (*infra* § V.A.6), For all the above reasons, the Board should deny institution of the Petition.

II. RELATED LITIGATION AND IPRS

On October 31, 2024, Zaxcom filed a complaint in Delaware District Court (Ex-2001, ECF1), which was amended on November 14, 2024, alleging Petitioners’ infringement of the Patents-in-Suit. Ex-2002, ECF99. On August 30, 2024, Zaxcom provided Petitioners initial claim charts detailing the Asserted Claims in the Litigation. Ex-2003, ECF79.

The Parties substantially completed document production on February 5, 2025 (Ex-2004, ECF120), and over 350,000 documents have been produced by Petitioners. Invalidity contentions were served on December 6, 2024 (Ex-2005, ECF103), and a final joint claim construction chart was filed with the District Court on February 21, 2025. Ex-2006, ECF127. Fact discovery closes on August 15, 2025, expert discovery closes on January 23, 2026, and all SJ and Daubert

briefing are scheduled to conclude by April 10, 2026. Ex-2007, ECF98. A trial date has not been set as the District Court’s Judge’s policy is to set a trial date “after the close of discovery ... [or] after resolution of the summary judgment.” Ex-2008, Judge Murphy’s Policies and Procedures.

IPR petitions directed toward the ’443 and ’207 Patents were filed by Petitioners on December 4, 2024, and an IPR petition directed toward the ’444 Patent was filed on February 7, 2025, and are currently pending.

The ’902, ’814, and ’307 Patents were involved in the Lectrosonics IPRs, and all challenged claims were held patentable after amendment. Ex-1014, p. 65; Ex-1017, p. 74; Ex-1018, p. 94.

III. TECHNOLOGY BACKGROUND

A. Prior Art Audio Systems

Prior art audio systems “include a multi-track audio recorder wired to one or more microphones.” Ex-1001, 1:34-35 “[O]ne or more performers performing on a sound stage are recorded by one or more microphones that are directly wired to the multi-track recorder. The multi-track recorder combines the single track of audio received from each microphone to create one multi-track audio file.” *Id.* at 1:36-40.

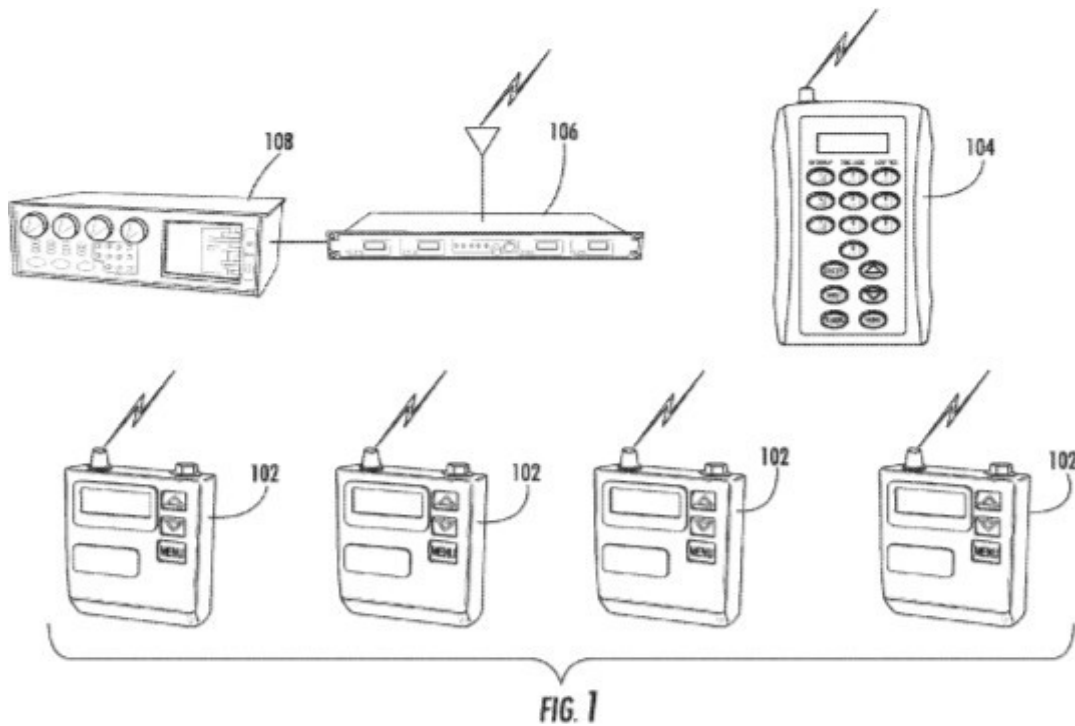
Other prior art systems “include a multi-track audio recorder and an associated audio receiver that receive audio wirelessly from one or more wireless

transmitters.” *Id.* at 1:49-51. An “audio receiver receives each performer’s audio from the performer’s respective body pack via an analog or digital wireless transmission and transmits it to the audio recorder.” *Id.* at 1:53-56. “The audio recorder then combines the wireless transmissions received from all body packs to create one multi-track audio file.” *Id.* at 1: 56-58.

The ’902 Patent inventors recognized that the prior art systems had problems with “the occurrence of wireless transmission errors such as dropouts.” *Id.* at 1:59-60. Moreover, the use of redundant receivers in the prior art did “not prevent loss of data due to interference.” *Id.* at 2:1-2. “Upon the occurrence of interfering signals, audio created during a performance (e.g., a live performance) may simply be lost due to the inability of the receiver to receive a clean audio signal.” *Id.* at 2:3-6.

B. Mr. Sanders and Mr. Stark Invent A New Wireless Recording System to Address Interference and Dropout Problems.

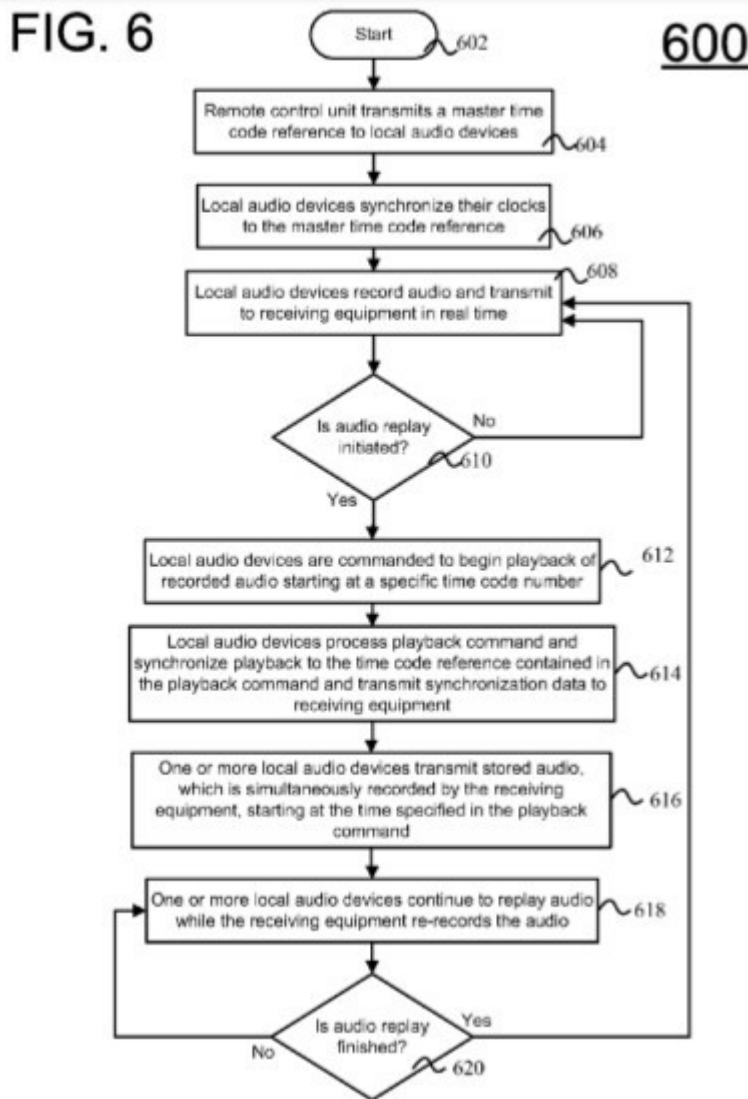
The ’902 Patent addresses the prior art’s deficiencies with a wireless recording system including wearable local audio devices 102, remote control unit 104, remote receiver 106, and remote recorder 108 as shown in FIG. 1:



Each local audio device 102 is worn by a performer, and these components operate together to store local audio generated by each performer in the performer's wearable local audio device 102 as local audio data, to create stamped and unstamped local audio data wherein the stamped local audio data includes at least one timestamp to reference at least a portion of the local audio data to one of the master timecodes, to transmit the same local audio from each local audio device 102 to a remote receiver 106/recorder 108, to record the same local audio at the remote receiver 106/recorder 108 received from each performer as remotely recorded audio data/remote audio data, to create a multi-track audio file at the receiver 106/recorder 108 that includes each performer's local audio, and, when a

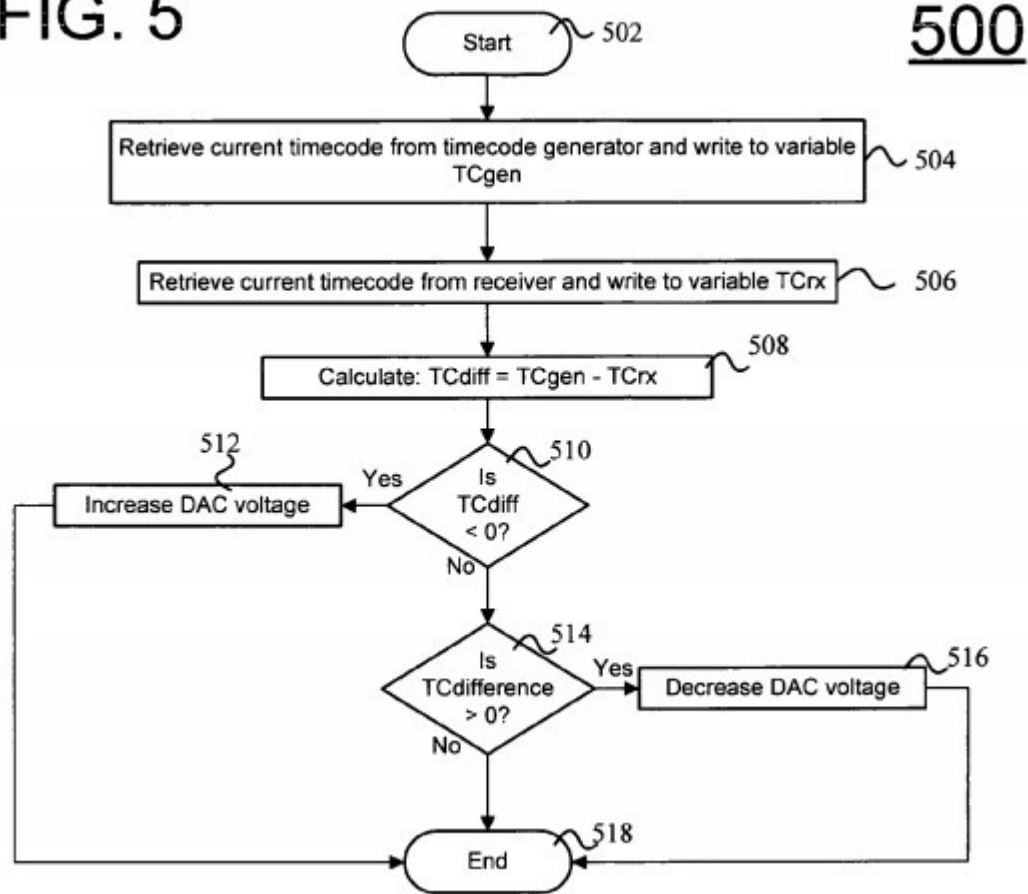
wireless transmission error causes a defect in the remotely recorded audio data or multi-track audio file, to combine the local audio data at the wearable local audio device 102 with the remotely recorded audio data at the remote receiver 106/recorder 108 to replace or repair the data lost or corrupted due to the wireless transmission error. In this manner, segments of audio that were not received properly at the remote receiver 106/recorder 108 (*e.g.*, dropouts) because of wireless transmission errors can be replaced with corresponding segments of local audio data retrieved from the respective local audio device 102 or such local audio data may be combined into the corrupted multi-track audio file to repair such file.

This repair and replacement of data is facilitated via highly accurate timestamps on the local audio data and the remotely recorded audio data. FIG. 6 “depicts a process for recording audio and for replaying and re-recording segments of missed audio.” *Id.* at 3:46-48:



In step 606, “local audio devices synchronize their clocks to the master time code reference.” In steps 616 and 618, the local audio devices may transmit audio for re-recording of missed audio by the receiving equipment. “FIG. 5 depicts a process for modifying the speed of a local timecode generator as necessary to maintain its synchronization with a master timecode generator.” *Id.* at 3:53-55:

FIG. 5



Zaxcom has received significant industry praise for these inventions including, but not limited to, an Emmy award and a Technical Achievement Award from the Academy of Motion Picture Arts and Sciences. In the Lectrosonics IPRs, the Board evaluated this and other industry praise along with evidence of long-felt need for repairing dropouts and the failure of others to implement dropout repair and found a nexus between the evidence of secondary considerations and claims related to the Dropout Repair Embodiment. Ex-1017, pp. 61-65 (“[C]onsidering the totality of evidence before us, we determine that Patent Owner has established

a nexus between the evidence of industry praise and long-felt need and the “replacing” limitation of the proposed substitute claims.”); Ex-1014, p. 56; Ex-1018, p. 55.

IV. PERSON OF ORDINARY SKILL IN THE ART

A POSA for the '902 Patent would have a bachelor's degree in electrical engineering or a related subject and two to five years' experience working with multi-track audio and wireless communications systems in the professional performance industry. Less education may be compensated for by a higher level of work experience. Ex-2015, ¶ 15; *see also* Ex-2021, ¶ 11.

V. DISCRETIONARY DENIAL OF THE PETITION IS WARRANTED

A. Institution Should Be Denied Pursuant to 35 U.S.C. § 314(a) Because the Same Parties, Patent, Claims, Invalidity References and Arguments Are Being Advanced in a Parallel Litigation.

Pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4, the Director has discretion to deny institution of an IPR that is an inefficient use of PTAB resources in view of the state of a parallel district court proceeding in which Petitioner(s) have raised the same invalidity challenges for the same patent claims. *See Apple Inc., v. Fintiv Inc.*, IPR2020-00019, Paper 15 at 7 (PTAB May 13, 2020) (precedential). “In exercising the Director’s discretion under 35 U.S.C. § 314(a), the Board may consider ‘events in other proceedings related to the same patent, either at the Office, in district courts, or the ITC.’” *Apple Inc.*, Paper 15 at 7

(quoting Consolidated Trial Practice Guide November 2019 (“TPG”) at 58).

The PTAB may consider the following when considering a discretionary denial due to a parallel proceeding: (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision; (3) investment in the parallel proceeding by the court and parties; (4) overlap between issues raised in the petition and the parallel proceeding; (5) whether Petitioner(s) and the defendant in the parallel proceeding are the same party(ies); and (6) other circumstances that impact the Board’s exercise of discretion, including the merits (the “*Fintiv* Factors”). *Apple Inc.*, Paper 15 at 5-6.

Here, every *Fintiv* Factor favors discretionary denial of this Petition due to the parallel Litigation. Further, the USPTO’s revocation of the Memorandum, and its instruction that “[t]o the extent any other PTAB or Director Review decisions rely on the Memorandum, the portions of those decisions relying on the Memorandum shall not be binding or persuasive on the PTAB,” further weighs in favor of denial.

1. No Stay Has Been Granted and No Evidence Exists to Indicate That a Stay Will Be Granted

A stay has not been requested in the Litigation, and, if requested, it’s unlikely to be granted. In Delaware, the following factors determine whether to grant a stay: “(1) whether granting the stay will simplify the issues for trial; (2) the

status of the litigation ...; and (3) whether a stay would cause the non-movant to suffer undue prejudice from any delay or allow the movant to gain a clear tactical advantage.” *Courtesy Prods., L.L.C. v. Hamilton Beach Brands, Inc.*, No. 13-2012-SLR/SRF, 2015 U.S. Dist. LEXIS 116032, at *4 (D. Del. Sep. 1, 2015).

Factor (1) weighs against a stay when the pending IPRs address only a portion of the claims at issue in the parallel proceeding. *See Courtesy Prods., L.L.C.*, at *1-2 (denying a motion to stay where, *inter alia*, the IPR proceedings only covered all asserted claims of one of three asserted patents, only two asserted claims of the second patent, and no asserted claims of the third, such that "the parties' dispute [would] not be fully resolved by the IPRs, regardless of the outcome"); *see also Toshiba Samsung Storage Tech. Korea Corp. v. LG Elecs., Inc.*, 193 F. Supp. 3d 345, 348-49 (D. Del. 2016) (denying a stay and stating “it is important ... that a much greater percentage of the '106 patent's claims that are now at issue here will *not* be at issue in the IPR proceeding ... the PTAB could at most invalidate 50% of those claims ... Thus, a PTAB decision that is totally favorable to LG will leave behind a lot to ... be litigated here”).

The Freedman/Rode IPR Petitions only seek review of 4 of the 7 patents asserted in the Litigation, and 65 of the 131 Asserted Claims. Ex-2006, ECF127. Even if all Freedman/Rode IPR Petitions are instituted and decisions are issued completely favorable to Petitioners, the District Court must still assess the validity

of the remaining 3 patents and 66 claims in the Litigation. Accordingly, factor one weighs against a stay.

The advanced status of the Litigation (*supra* § II) also weighs against a stay. “[T]he status of the case weighs against a stay because fact discovery is substantially underway and claim construction briefing is complete.” *Invensas Corp. v. Samsung Elecs. Co.*, Civil Action No. 17-1363-MN-SRF, 2018 U.S. Dist. LEXIS 169999 at *10 (D. Del. Oct. 2, 2018); *see also Copy Prot. LLC v. Netflix, Inc.*, No. 14-365-LPS, 2015 U.S. Dist. LEXIS 78270 at *3 (D. Del. June 17, 2015) (denying a stay where the parties “engaged in a substantial amount of discovery and are set to complete claim construction briefing shortly.”). Here, the Parties substantially completed document production on February 5, 2025, Ex-2004, ECF120, during which over 350,000 documents were produced by Petitioners, and are set to complete claim construction briefing shortly on June 20, 2025. Ex-2023, ECF132. Fact discovery closes on August 15, 2025, expert discovery closes on January 23, 2026, and all SJ and Daubert briefing is scheduled to conclude by April 10, 2026. *Id.* A trial date has not been set due to the Judge’s policy (Ex-2008 at 7), but trial is likely to occur in 2026. Since substantial work has been and will be completed prior to the resolution of the Freedman/Rode IPR Petitions, which will occur at earliest, September 2026, and at latest March 2028 (depending on extensions and/or appeals) (*infra* § V.A.2.), factor (2) weighs against granting of a

stay.

As to undue prejudice, Delaware courts consider three subfactors: (1) the timing of the request(s) for review and a stay; (2) the status of review proceedings; and (3) the relationship of the parties. *See Toshiba Samsung Storage Tech. Korea Corp.*, at 350-352.

The Petition was filed 14 months after the Complaint, Ex-2001, ECF1, was filed, and 44 months after Zaxcom notified Petitioners of its patent portfolio in a cease-and-desist letter. Ex-2009. A stay has not been requested. The District Court will likely rule that Petitioners' delay in filing the Freedman/Rode IPR Petitions and a motion to stay, is a strategy employed by Petitioners that is "less focused on facilitating an orderly review of patent claim validity, and more focused on simply disrupting the progression of the non-movant's case for disruption's sake." *LG Elecs., Inc. v. Toshiba Samsung Storage Tech. Korea Corp.*, Civil Action No. 12-1063-LPS-CJB, 2015 U.S. Dist. LEXIS 167153, at *16 (D. Del. Dec. 11, 2015) (citing *Belden Techs. Inc. v. Superior Essex Commc'ns LP*, Civ. No. 08-63-SLR, 2010 U.S. Dist. LEXIS 90960, at *2 (D. Del. Sept. 2, 2010) (denying a motion to stay whereby the various reexaminations were requested approximately 17-20 months after the commencement of litigation)).

Petitioners have a history of unnecessary delay, presumably for tactical advantage. Freedman refused to accept service after its subsidiary, Rode, had been

served, forcing Zaxcom to motion the District Court to allow service on Freedman by electronic mail, which motion was granted. Ex-2010, ECF44. In his motion decision, Judge Murphy clarified that Rode’s counsel “plainly stated in a letter to counsel for Zaxcom that he represented *both* Rode and Freedman in regard to the operative complaint ... Zaxcom has made several attempts to serve Freedman by varyingly more traditional means ... but at this point, the only real stakes here are whether **Freedman’s counsel ought to be able to inject further delay into this case.**” *Id.* at footnote 1 (emphasis added).

The Parties have expended significant time and resources in the Litigation having produced over 350,000 pages of documents, having prepared all invalidity and claim construction positions, and are well into claim construction briefing, which will conclude on June 20, 2025. *Supra* § II. The late filing of the Freedman/Rode IPR Petitions and failure to file a motion to stay weigh against a stay, particularly in view of Petitioners’ previous delay tactics. Similar to *Novozymes N. Am. V. Danisco Us*, Zaxcom has tried to move this litigation forward, despite Petitioners delay tactics, and if a stay were granted, it would result in “prolonging the final resolution of the dispute and thereby may result in some inherent prejudice to the plaintiff.” *Novozymes N. Am. v. Danisco Us*, No. 1:19-cv-01902-JDW, 2020 U.S. Dist. LEXIS 261627, at *5-6 (D. Del. Mar. 31, 2020) (citing *Copy Prot. LLC* at *1 (D. Del. June 17, 2015)).

Regarding the review proceedings, the last Freedman/Rode IPR Petition was filed on February 7, 2025, and it will not likely resolve until sometime between September 1, 2026 through July 1, 2028, depending upon extensions and/or appeals. *Infra* § V.A.2. Therefore, a Litigation stay until the conclusion of all Freedman/Rode IPR Petitions would result in a very lengthy, prejudicial delay in Zaxcom's resolution of the significant number of patents and claims not challenged in the Freedman/Rode IPR Petitions. *Supra* p. 11 (only 65 of 131 Asserted Claims and 4 of 7 patents are subject to an IPR). Comparatively, denying institution and allowing the Litigation to resolve all invalidity and infringement issues will bring this case to conclusion likely during 2026 (*supra* pp. 12-13). See *Twinstrand Biosciences, Inc. v. Guardant Health, Inc.*, Civil Action No. 21-1126-GBW-SRF, 2023 U.S. Dist. LEXIS 45701, at *9 (D. Del. Mar. 17, 2023) (finding the Patent Owner would be prejudiced by a stay because "trial would be delayed by at least a year, and possibly longer, because the decisions will not truly be final until the exhaustion of appellate rights."). This subfactor weighs against a stay.

Further, courts are "hesit[ant] to grant stays where the parties are direct competitors." *LG Elecs., Inc.*, at *19 (quoting *Bonutti Skeletal Innovations, L.L.C. v. Zimmer Holdings, Inc.*, C.A. No. 12-cv-1107 (GMS), 2014 U.S. Dist. LEXIS 47430, at *4 (D. Del. Apr. 7, 2014)). Because it is not yet determined whether the Parties are direct competitors, this factor is neutral, but at least two of the three

undue prejudice subfactors weigh against a stay. Therefore, a Litigation stay is very unlikely, which favors discretionary denial of institution.

2. The Proximity of the Court's Trial Date to the Projected Statutory Deadline for a Final Written Decision is Narrow.

A trial date has not been set for the reasons discussed (*supra* § V.A.1), but briefing is scheduled to conclude by April 10, 2026 (Ex-2007, ECF98), and, as such, it is reasonable that the trial will occur during 2026. *Supra* § V.A.1. In comparison, the statutory deadline for the last FWD of the Freedman/Rode IPR Petitions is one year from the date of potential institution thereof, which would occur about three months after the filing of Zaxcom's Preliminary Response. The PTAB has not yet accorded a filing date to the '444 IPR Petition, therefore, this date will be no earlier than the filing hereof (i.e., March 18, 2025), setting Zaxcom's Preliminary Response due on June 18, 2025, with an institution decision expected about September 18, 2025, and a FWD one year later on September 18, 2026 (or potentially March 18, 2027, if an extension is taken). If appealed, another 483.5 days is added, on average, which pushes resolution of the Freedman/Rode IPR Petitions to sometime between September 18, 2027, to July 18, 2028, well after the Litigation should be resolved. Ex-2011. This factor weighs in favor of denying institution.

3. There Has Been Significant Investment in the Litigation By the Court and Parties

The “more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Apple Inc.*, IPR2020-00019, Paper 11 at 10 (PTAB March 20, 2020) (precedential). The Parties have expended significant time and resources in the Litigation. *Supra* § V.A.1, which was necessitated by Petitioners’ delay in filing its IPR Petitions until the eve of the statutory deadlines, despite knowledge of Zaxcom’s claims for over 44 months prior thereto. *Id.* Petitioners have not justified this delay, and have caused the Parties to heavily invest in the Litigation. If this IPR is instituted, an expensive duplication of effort will be required. Factor three favors discretionary denial.

4. There Is Overlap Between Issues Raised in the Petition and in the Litigation.

There is 100% overlap between the Petition and Litigation issues, which rely on identical prior art references and arguments. Further, the claim construction standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc) (the “*Phillips* Standard”), applies here and in the Litigation. *Infra* § VI.

Petitioners state, without support, “it is highly likely that many of the Challenged Claims will not be asserted in the Delaware Litigation.” Petition, pp.

77. This is pure speculation as shown by Petitioners' failed "Motion to Compel [Zaxcom] To Narrow Asserted Claims..." (Ex-2007, ECF98, p. 1), and the District Court's recent continued refusal to force Zaxcom to narrow its claims. Ex-2012, ECF128. "[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial." *Apple Inc.*, Paper 11 at 10; *see also NHK Spring Co., LTD, v. Intri-Plex Technologies, Inc.*, IPR2018-00752, Paper 8 at 19-20 (PTAB Sept. 12, 2018) (precedential).

5. Petitioners and the Litigation Defendants Are the Same Parties.

Petitioners and the Litigation Defendants are the same Parties, which "weighs in favor of discretionary denial." *Apple Inc.*, Paper 15 at 15.

6. Other Circumstances Exist That Impact the PTAB's Exercise of Discretion, Including the Merits.

Whether discretionary denial is appropriate requires a "balanced assessment of all the relevant circumstances in the case, including the merits . . . if the merits of a ground raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present." *Apple Inc.*, Paper 11 at 14-15. In an IPR, "the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence." 35 U.S.C. § 316(e).

As explained herein, the merits of the grounds in the Petition are not a close call, and other factors favoring denial are present including an advanced Litigation that has 100% overlap with the issues in this Petition, but also includes 3 additional patents and 66 additional claims. *Supra* § V.A.1. Further, the Petition fails to prove unpatentability by a preponderance of the evidence and does not meet the particularity requirement of 35 U.S.C. § 312 (a)(3).

Petitioners argue that, under the Memorandum, “the PTAB will not deny institution based on *Fintiv* if there is compelling evidence of unpatentability...” Petition p. 75. The USPTO’s revocation of the Memorandum, which eliminates “compelling evidence of patentability” as a criterion for refusing to deny institution, moots Petitioners’ argument. Also, case law cited in the Petition (*see* Petition pp. 8-13) should be disregarded by the PTAB pursuant to the Commissioner’s instructions “that any portions of PTAB or Director Review decisions that relied on the rescinded memorandum are no longer considered binding or persuasive on the PTAB.” UPSTO News & Updates, *USPTO rescinds memorandum addressing discretionary denial procedures*, <https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures> (last visited March 7, 2025).

VI. ZAXCOM IS NOT COLLATERALLY ESTOPPED FROM DISPUTING THE PTAB’S PRIOR FINDINGS

Petitioners agree collateral estoppel only applies if “the issue was actually

litigated in the first action.” Petition, p. 9. “Because the Board applie[d] the broadest reasonable construction of the claims . . . the issue of claim construction under *Phillips* . . . has not been actually litigated.” *SkyHawke Techs., LLC v. DECA Int’l Corp.*, 828 F.3d 1373, 1376 (Fed. Cir. 2016). *See also DDR Holdings, LLC v. Priceline.com LLC*, 122 F.4th 911, 918-19 (Fed. Cir. 2024) (citing to *id.* at 1376) (“‘Because the Board applies the broadest reasonable construction of the claims while the district courts apply a different standard of claim construction as explored in *Phillips*,’ a party is not collaterally estopped in district court proceedings by the Board’s constructions during IPR”). Where a first IPR is decided under the BRI standard, and a second IPR concerning the same patent is to be decided under the *Phillips* Standard, “collateral estoppel . . . is not appropriate.” *Ebates Performance Marketing, Inc. dba Rakuten Rewards et al., v. International Business Machines Corp.*, IPR2022-00646, Paper 56 at 10 (PTAB Oct. 11, 2023).

The rule change replacing the BRI standard with the *Phillips* Standard became effective on November 13, 2018 (“Effective Date”) and applies to all IPR petitions filed on or after this date. Ex-2013, Federal Register, Vol. 83, No. 197 (Oct. 11, 2018) (final rule). All Lectrosonics IPRs were interpreted “using the broadest reasonable construction in light of the specification of the patent in which they appear.” Exhibit 1017 at 6-7; *see also* Exhibit 1014 at 6-7; *see also* Exhibit 1018 at 6-7. Specifically, in the Prior ’902 IPR, the broadest reasonable

interpretation (“BRI”) standard was applied to construe “local audio data . . . is combined with said remote audio data,” “wearable,” and “master timecode generator.” Ex-1017, pp. 7-14.

Because the Petition was filed after the Effective Date, the *Phillips* Standard applies to claim construction in this proceeding, and no claim construction has been made regarding any of the disputed claim terms under the *Phillips* Standard, and therefore, “the issue of claim construction under *Phillips* . . . has not been actually litigated.” *SkyHawke Techs.* at 1376; *see also DDR Holdings, LLC v. Priceline.com LLC*, 122 F.4th 911 (Fed. Cir. 2024). As a finding of obviousness requires a court to ascertain the differences between the prior art and the claims at issue, pursuant to *Graham v. John Deere Co.*, 86 S. Ct. 684, 694 (1966), the issues regarding obviousness, which rely on such claim constructions, have also not been litigated. Therefore, Zaxcom is not collaterally estopped from disputing the findings of the Lectrosonics IPRs regarding: (1) the presence of claim elements or any materially identical elements in the Cited References; (2) the obviousness of combining the Cited References; or (3) the objective indicia of non-obviousness.

VII. CLAIM CONSTRUCTION

Under the *Phillips* Standard, claim terms are given their ordinary and customary meaning as understood by a POSA at the time of the invention and in the context of the entire patent disclosure. *See Phillips*, 415 F.3d at 1312-14. It is critical

that claim terms are “read in view of the specification,” which is highly relevant, usually dispositive, and “the single best guide to the meaning of a disputed term.” *Phillips*, 415 F.3d at 1315 (citations omitted).

A. “locally generated audio” (Claims 1-6, 9-10) and “local audio” (Claims 13, 16-20).

The ‘902 Specification, including its title, references the multitrack nature of the invention, i.e., “Virtual Wireless **Multitrack** Recording System” Ex-1001, Title (emphasis added), Abstract. A POSA understands that multitrack recording captures the voices of individual performers independently on separate, isolated tracks of audio to allow audio engineers to independently edit each track during and after recording. *See* Ex-2021, ¶¶ 12, 14-16. “A multitrack recording consists of multiple, separate streams of sound ... During a typical music-recording session, **individual instruments or voices will be recorded on separate tracks.**” Ex-2014, p. 1 (Federal Agencies Digital Guidelines Initiative, Glossary) (emphasis added); Ex-2015, ¶ 31; *see also* Ex-2021, ¶ 13.

Accordingly, “locally generated audio” and “local audio” mean “audio created by the wearer of the local audio device receiving the locally generated audio, such audio suitable for use as an independent track of audio,” as this definition requires each performer to create an individual, isolated audio track to be used and independently edited in the resultant multitrack recording. Any definition of these terms that collects all event audio on a single track of mixed audio without

individual, isolated tracks of audio per performer/audio source directly contradicts the requirement for “multitrack” recording (Ex-2021, ¶¶ 14, 20-21), as it lacks the discrete, individual, isolated audio sources (e.g., an audio track per performer) required for creation of a multitrack recording and as taught by the ’902

Specification:

- (i) “[S]ystems and methods for wirelessly recording **multi-track** audio files ... each performer is equipped with a local audio device capable of locally recording **the respective performer's audio**” (Ex-1001, Abstract);
- (ii) “[P]erformers may each don a local audio device ... audio from multiple local audio devices may be transmitted to a **multi-track** recorder for recording of the audio event while each local audio device locally records **its performer's audio**” (Ex-1001, 13:47-48, 14:45-48); and
- (iii) “[A]udio received from each of the local audio devices (e.g., **the local audio device of each performer**) may be combined to create one or more **multi-track** audio files,” (Ex 1001, 16:50-53) (emphasis added).

See also Ex-2015, ¶ 32.

Similarly, Claims 1-6 and 9-10 require “at least one local audio device

wearable by a creator of said locally generated audio.” Ex-1001, 23:40-41, 23:55-56. That is, the locally generated audio is created by the person wearing the local audio device. Similarly, Claims 17-20 require “locally recording said **local audio** as local audio data ... wherein said local audio data **of each of said performers** is retrieved from said local audio devices subsequent to said audio event and is combined to create a single **multi-track** audio file.” Ex-1001, 27:11, 27:15-18 (emphasis added). “[C]reation of a multi-track file can only happen when independent tracks of each of the performer’s voices exist.” Ex-2015, ¶ 33; *see also* Ex-2021, ¶¶ 14-16.

B. “local audio device wearable by a creator of said locally generated audio” (Claims 1-6, 9-10).

“Local audio device wearable by a creator of said locally generated audio,” requires “a local audio device suitable to be worn by the performer who creates the audio that is recorded by that performer’s local audio device.” The ’902 Specification describes the wearability of the local audio devices: 1) local audio devices “are worn by the performers of the audio event” (Ex-1001, 10:40-41); 2) “each performer is equipped with a local audio device capable of locally recording the respective performer’s audio” (Ex-1001, Abstract); and 3) “allowing a wireless recorder 108 ... to accurately combine multiple independent tracks of audio, wherein each independent track of audio is received from one of the performer’s local audio device 102.” Ex-1001, 11:46-50. Claims 1-6 and 9-10 also require the

local audio device to include “at least one audio input port for receiving locally generated audio from an audio input device,” where the audio input device is (e.g., a microphone) worn by the performer and connects to the performer’s local audio device to allow it to capture the isolated audio of the specific performer wearing the local audio device. Ex-1001, 23:45-46, 24:60-61, 6:47-51, 10:7-10 (“[L]ocal control unit 310 receives recordable audio from local audio input device 312, which may be worn by the performer and connects to local audio device 102...”).

The ’902 Patent is a continuation-in-part of application No. 11/181,062, which issued as the ’443 Patent. The ’443 Patent prosecution history clarifies that “wearable” requires the local audio device to be “suitable to be worn by the performer” and excludes devices that are merely portable (e.g., able to be carried in a backpack). In the ’443 Patent’s Notice of Allowance, Examiner Elbin included a statement of reasons for allowance that distinguished between “portable” and “wearable”: “the closest prior art of record (Nagra-V) teaches a **portable** audio recorder ... The prior art fails to teach or suggest ... wherein the device is ‘**wearable** by a creator of said locally generated audio.’” Ex-2017, p. 2 (emphasis added). The Nagra-V is portable, having dimensions of 11.4” x 8.6” x 4.5,” weighing approximately 7.6 to 9 pounds, and sold with a soft carrying case. Ex-2018, p. 2. The Nagra-V can be carried in a backpack, or its soft carrying case, yet the Examiner found that it was not “wearable.” As such, a proper construction of

“local audio device wearable by a user for storing locally generated audio”

excludes devices that are merely portable (e.g., carried in a backpack).

C. “at least a portion of said local audio data ... is combined with said remote audio data” (Claims 13, 16) and “local audio data for each of said performers is retrieved from said local audio devices and is combined to create a single multi-track audio file” (Claims 17-20).

“At least a portion of said local audio data ... is combined with said remote audio data” (the “Local/Remote Combination Claim Term”) requires “combining local audio data and remotely recorded/remote audio data to replace data lost due to a transmission error, where the local audio data is obtained from the local audio device of the performer that created and originally recorded the local audio data that is replacing the remotely recorded/remote audio data.” That is, this definition: 1) is limited to dropout repair; 2) does not include multitrack creation; and 3) requires dropout repair to use the local audio data of the same performer whose local audio was lost during transmission to the remote receiver/recorder.

In contrast, “said local audio data for each of said performers is retrieved from said local audio devices and is combined to create a single multi-track audio file” (the “Local/Local Combination Claim Term”) requires “local audio data from each local audio device is combined with the local audio data of other local audio devices to create a single multi-track data file.” This term always refers to multitrack creation and never refers to dropout repair.

“[When] the patent describes multiple embodiments, every claim does not need to cover every embodiment. This is particularly true [when] the plain language of a limitation of the claim does not appear to cover that embodiment.” *Pacing Techs., LLC v. Garmin Int’l, Inc.*, 778 F.3d 1021, 1026 (Fed. Cir. 2015). Under the *Phillips* Standard, the Board should start with the claim language and then interpret it in light of the teachings of the specification and the understanding of a POSA. *See Phillips*, 415 F.3d at 1312-14.

In the Lectrosonics IPR, the term “local audio data ... is combined with said remote audio data” was construed to encompass two embodiments: “an embodiment of repairing a dropout (i.e., a loss of audio data during a wireless transmission is remedied through the replacement of data)” (the “Dropout Repair Embodiment”) and a “multi-track embodiment ... where separate audio tracks are combined to form a multitrack audio file,” (the “Multitrack Creation Embodiment”). Ex-1017, pp. 9-10. This construction is not binding on Zaxcom in this IPR proceeding because it used the BRI standard. *Supra* § VI. Under the *Phillips* Standard, “at least a portion of said local audio data ... is combined with said remote audio data” is properly construed as being limited to the Dropout Repair Embodiment. This Local/Remote Combination Claim Term never covers a Multitrack Creation Embodiment because it requires a combination of local audio data with local audio data or local audio with local audio. Ex. 2015, ¶ 42; *see also*

Ex-1001, 5:10-19 (“Synchronization is essential to ensure that **each performer's audio** is synchronized with **all other performers' audio** ... Such synchronization must maintain a high accuracy for **each performer's timestamps** with respect to all **other performers' timestamps** ... when the multiple audio recordings are **combined** to create one single recording.”) (emphasis added). The '902 Specification makes clear that a multitrack file is never created by combining local audio data with remotely recorded/remote audio data, as required by the Local/Remote Combination Claim Term, because this type of combination has no practical purpose other than dropout repair. Ex-2015, ¶ 42; *see also* Ex-2021, ¶¶ 17-18.

Remotely recorded/remote audio data is local audio or locally generated audio that is wirelessly received and recorded at a remote receiver/recorder. Ex-1001, 16:46-58. Therefore, remotely recorded/remote audio data and a remote multi-track audio file never exist unless and until local audio or locally generated audio is received and recorded by a local audio device, and transmitted to, and recorded by, the remote receiver/recorder. Ex-1001, 10:34-40. The remote receiver/recorder creates a multi-track file by combining the local audio or locally generated audio (not the local audio data) received from each performer (i.e., “Remote Multitrack Creation”). Ex-1001, 11:45-50.

The '902 Specification describes a second method of creating a multi-track file in which the local audio data of each performer is removed from the performer's local audio device and placed into a multi-memory unit 800 to combine each performer's local audio data with the local audio data of other performers (Ex-1001, 19:9-17) ("Local Multitrack Creation"), as referred to in the Local/Local Combination Claim Term. In a Local Multitrack Creation, there is no "remote audio data" - the multi-track file is created by, for example, a multi-memory unit instead of a remote receiver/recorder. Since there is no "remote audio data," there can be no combination of "local audio data" with "remote audio data" as required by the Local/Remote Combination Claim Term.

Remote Multitrack Creation and Local Multitrack Creation are the only methods of multitrack creation taught by the '902 Specification, and neither involves combining "local audio data" with "remote audio data." Because the remotely recorded/remote audio data and local audio data are both recordings of the exact same audio (i.e., local audio or locally generated audio), there is never a reason to combine them unless the remotely recorded/remote audio data has been damaged (i.e., a Dropout Repair Embodiment). Ex-2015, ¶ 45-46. Common sense dictates that there is no benefit obtained by combining identical audio data, and the '902 Specification never describes a combination of "local audio data" and "remote audio data" for any reason other than repair or replacement of "remote

audio data” that is lost or damaged due to, e.g., a wireless transmission error.

Under the *Phillips* Standard, it is inappropriate to construe this claim term inconsistent with the teachings of the ’902 Specification and the knowledge of a POSA. *Id.* Accordingly, “local audio data” is never combined with “remote audio data” to create a multitrack audio file, and the Local/Remote Combination Claim Term is properly construed to be limited to the Dropout Repair Embodiment.

Additionally, the local audio data used to repair the remotely recorded/remote audio data must be obtained from the same local audio device of the performer that created and originally recorded the local audio data because the ’902 Specification only describes multitrack systems (Ex-1001, Title, Abstract, 13:47-48, 14:45-48, 16:50-53), which requires an independent audio track per performer (*infra* VII.E). The ’902 Specification teaches that a track of a respective performer’s audio can only be repaired with the local audio data recorded by the respective performer. Ex-1001, 13:4-10 (“memories 332 may be removed from each local audio device 102 such that locally recorded data may be retrieved and used to repair the corruption of the audio file). Ex-2015, ¶ 47.

The multitrack aspect of the ’902 Specification eliminates any construction of this claim term in which audio is combined from two or more recorders, who records all audio from an event on a single track of mixed audio that does not include individual, isolated tracks of audio per performer/audio source, as such a

recording eliminates the ability of an audio engineer to independently edit each audio source, which is the essence of a multitrack system. Ex-1001, 11:46-50; Ex-2015, ¶ 47.

D. “master timecode generator” (Claims 1-3, 6, 9-10) and “master timecodes” (Claims 1-3, 6, 9-10, 13, 17-20).

The claim elements “master timecode generator” and “master timecodes” mean “a producer of a master time reference signal that controls at least one other timecode generator” and “a time reference signal used to synchronize at least one device,” respectively.

The term “master” requires “[one] that has control over another or others.” Ex-2019, p. 3 (The American Heritage Dictionary, Third Edition, Houghton Mifflin Company, 1993). Figure 5 of the '902 Specification discloses modifying the speed of a local timecode generator as necessary to maintain synchronization with a master timecode generator. Ex-1001, Fig. 5, 3:53-55, 15:26-29. That is, the master timecode generator controls the local timecode generator by modifying its speed to maintain synchronization between devices. Figure 6 describes the master timecode generator’s use of a master timecode, or time reference signal used to synchronize at least one device: “[a]t 604, a master unit ... transmits master timecodes to each local audio device, and ... each local audio device synchronizes (e.g., jam syncs) its respective on board local timecode generator with the master timecodes received from the master unit,

thereby synchronizing all local audio device timecode generators with the master timecode generator.” Ex-1001, 16:30-37. That is, the master timecode generator creates master timecodes that are used to control the speed of the local timecode generator to ensure the two timecode generators are synchronized. Ex-1001: 5:7-14, 6:27-37, 10:57-60, 14:9-16, and 16:30-37. Both the claim language and the ’902 Specification support Zaxcom’s proposed constructions.

E. “multi-track audio file” (Claims 17-20).

“Multi-track audio file” means “a data file consisting of multiple, separate streams of sound with individual instruments or voices recorded on separate tracks.” A POSA would have known at the time of filing of the ’902 Patent that a multitrack recording “consists of multiple, separate streams of sound . . . [and] individual instruments or voices will be recorded on separate tracks.” Ex-2014, p. 1; Ex-2015, ¶ 53; *see also* Ex-2021, ¶ 13.

The ’902 Specification explains that “[t]he audio received **from each of the local audio devices** (e.g., the local audio device **of each performer**) may be **combined to create one or more multi-track audio files**.” Ex-1001, 16:50-53 (emphasis added). “[A]udio from multiple local audio devices may be transmitted to a **multi-track** recorder for recording of the audio event while each local audio device locally records **its performer's audio**.” Ex-1001, 14:45-58 (emphasis added).

Claims 17-20 further support this definition: “local audio data for **each of said performers** is retrieved from said local audio devices subsequent to said audio event and **is combined to create a single multi-track audio file.**” Ex-1001, 27:15-18 (emphasis added). That is, the locally generated audio of each performer is locally recorded by the performer’s local audio device and is combined to create a multitrack audio file consisting of multiple, separate streams of sound from each performer. Any construction inconsistent with multitrack recording is inappropriate as it would be inconsistent with the ’902 Specification.

VIII. THE PETITION FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD THAT THE CHALLENGED CLAIMS ARE UNPATENTABLE

Petitioners’ invalidity analysis is inherently flawed due to their failure to construe any claim terms. Also, Petitioners’ reliance on the Lectrosonics IPRs’ claim construction is misplaced because the BRI claim construction standard was applied therein, rather than the *Phillips* standard to be applied here. *Supra* § VI. Petitioners have failed to state a proper obviousness analysis in their Petition as their combinations of the Cited References fail to disclose every element of the Challenged Claims, and the Petition fails to show sufficient motivation for combining the Cited References.

The question of obviousness is resolved on underlying factual determinations including: (1) the scope and content of the prior art; (2) any

differences between the claimed subject matter and the prior art; and (3) the level of skill in the art. *See Graham v. John Deere Co.*, 86 S. Ct. 684 at 693-695; *see also KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 399 (2007). A petition claiming invalidation due to obviousness must demonstrate that a “skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.” *OSRAM Sylvania, Inc. v. Am. Induction Techs., Inc.*, 701 F.3d 698, 706 (Fed. Cir. 2012). The Petition’s evidence must also address every element of every challenged claim.

The Board should decline to institute any ground of this IPR because the Petition failed to: (i) set forth a proper obviousness analysis because it did not identify a primary reference, the claim elements that are allegedly missing from the primary reference, or the elements allegedly taught by the secondary references; (ii) demonstrate that a POSA would have been motivated to combine the teachings of the Cited References to achieve the claimed invention with a reasonable expectation of success; and (iii) demonstrate that any proposed combination of the Cited References teaches every element of any of the Challenged Claims.

A. Petitioners Fail to Demonstrate That Any Combination of the Cited References Renders Claims 1-6, 9-10, 13, 16 Obvious under § 103 (Grounds 1 and 2).

1. Petitioners Do Not Demonstrate That Any Combination of the Cited References Teaches Element 1[Pre] (Claims 1-6, 9-10) or Element 1[F] (Claims 1-6).

Petitioners do not argue whether Element 1[Pre] is limiting, nor do they define “locally generated audio.” Petitioners nonetheless claim that Element 1[Pre], namely “[a] system for recording locally generated audio” and Element 1[F], namely, “at least one control unit electrically coupled to said local audio device receiver, said audio input device, and said memory for creating local audio data from said locally generated audio and storing said local audio data in said memory” are taught by both Strub and Woo. Petition, pp. 26-30, 42-44.

“Locally generated audio,” is “audio created by the wearer of the local audio device receiving the locally generated audio, such audio suitable for use as an independent track of audio,” as is required for incorporation of “locally generated audio” in a multitrack recording as described in the ’902 Specification. *Supra* § VII.A. The “locally generated audio” is the audio created by the performer wearing the local audio device. The ’902 Specification teaches “at least one audio input port for receiving locally generated audio from an audio input device,” where the audio input device is worn by the performer and connected to the performer’s local audio device to capture only, or primarily, the audio created by the performer wearing the local audio device so that this audio may be recorded as its own independent, isolated track. This individual track of audio is then combined with

other performers' independent, isolated tracks of audio to create a multi-track audio file that includes all performers' audio tracks. Ex-1001, Abstract, 13:47-48, 14:45-48, 16:50-53.

Strub and Woo teach the opposite of “locally generated audio,” as the audio of Strub and Woo is locally “received” or “heard” by a recorder (i.e., the person in Strub who records the audio) – not generated, or created, by the recorder. Ex-1003, 22:16-33. *see also* Ex-1004, 5:3-5. That is, the audio recorded by Strub's recording units 105-108, 200, and 300, and Woo's recorders 14 is the sound *heard* by the recorder, which is a single track of mixed audio without individual, isolated tracks of audio per performer/audio source. “This received, ‘heard’ audio is not suitable for multi-track recording because it does not include individual, isolated tracks of audio per performer that can be independently edited.” Ex-2015, ¶ 60; *see also* Ex-2021, ¶ 15 (“Multitrack recording is meant to record multiple sound sources where each source is recorded to its own individual track.”)

Strub's specification repeatedly details receipt of a single track of mixed audio from an event (including the combined audio of all performers) by a recorder, rather than generation of audio by a performer that is recorded on a dedicated, isolated track:

- (i) “[I]t is believed preferable to bias the audio recording in favor of recording sound from in front of the recorder for several reasons: i)

a person or persons with whom a recorder is having a conversation will typically be in front of the recorder; ii) a recorder will typically face the parties participating in a conversation that does not include, but is of interest to, the recorder; iii) a recorder will often face the source of other sounds in which the recorder has an interest; and iv) conversations that occur behind a recorder are typically either conversations which the recorder does not want to hear or are conversations which the parties to the conversation may not intend the recorder to hear,” (Ex-1003, 22:21-32);

(ii) “Mounting at or just above chest level also enables the audio data acquisition device to pick up spatial imaging of the audio that is similar to that which is experienced by the recorder's ears,” (Ex-1003, 22:59-63); and

(iii) “[U]se of a directional microphone ... has been found to enhance the ability to record the voices of other people, particularly when those people are relatively distant from the recorder,” (Ex-1003, 23:8-11).

Similarly, Petitioners’ citations to Woo relative to Elements 1[Pre] and 1[F] (Petition, pp. 29-30, 44), also prove that the person in Woo who is creating the audio that is recorded (i.e., the performer) does not wear the Woo recording unit.

Rather, from independent vantage points, Woo's recorders obtains recordings of the audio generated by the performer: "[s]ystem 10 is used to record the live performance of a performer 12 ... recorder 14 captures the performance from its vantage point while another recorder 16 independently captures the same performance from its own vantage point." Ex-1004, 5:1-5. That is, Woo does not teach "locally generated audio" because Woo's audio is not "**created** by the wearer of the local audio device receiving the locally generated audio, such audio suitable for use as an independent track of audio." *Supra* § VII.A (emphasis added).

Further, the single track of mixed audio received by a Strub or Woo recorder cannot be used for multitrack recording as required by the '902 Specification, because it does not record each performer on an individual, dedicated, isolated audio track. Neither Strub nor Woo discloses creating independent, isolated tracks of performer audio, multi-track recording, or creating a multi-track audio file. As such, Petitioners have failed to show that any Cited Reference discloses limitations 1[Pre] or 1[F].

2. Petitioners Fail to Demonstrate That Any Combination of the Cited References Teaches Element 1[B] (Claims 1-6 and 9-10).

Petitioners do not define "local audio device wearable by a creator of said locally generated audio," but nonetheless state this limitation 1[B] is taught by Strub and Woo. Petition, pp. 32-34.

a) Petitioners Fail to State Any Support to Show That a Strub Recording Unit Having the Features of Claims 1-6 and 9-10 is Wearable

Petitioners must “identif[y] ... with particularity ... the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); *see also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016).

Strub discloses different variations of recording units – some with basic recording capabilities (the “Basic Strub Recording Unit”) and some with transmitter/receiver capabilities (the “Advanced Strub Recording Unit”). Strub’s recording units 105-108 are described as Basic Strub Recording Units without any mention of having a transmitter, a receiver, or an ability to transmit or receive data. Ex-1003, 8:13-29. Similarly, Strub’s recording unit 200 is also described as a Basic Strub Recording Unit including only system controller 201, data acquisition device 202, data storage device 203, and control interface device 204 – no transmitter or receiver. Ex-1003, Fig. 2. In contrast, Strub’s recording unit 300 is an Advanced Strub Recording Unit that includes a transmitter 309 and receiver 310, and for which a data acquisition is performed via two devices (video data acquisition device 302 and audio data acquisition device 303) instead of the one data acquisition device of the Basic Strub Recording Unit 200. Ex-1003, 11:48-50, 12:13-16.

The Petition repeatedly equates the ‘902 Patent’s local audio device to Strub’s recording unit 300, presumably because it includes a receiver, as required for the local audio device of Claims 1-6, 9, and 10. Petition, pp. 32-33, 65; Ex-1001, 23:42. However, Petitioners only refer to Fig. 1 to prove wearability, i.e., “Strub discloses at least one audio device—*e.g.*, one of recording units 105-108, **200, and 300**—which are worn by a plurality of users as depicted in Ex-1003, **Fig. 1.**” Petition, p. 32 (emphasis added). This statement is blatantly incorrect – the only recording units shown in Fig. 1 are recording units 105-108 – recording units 200 and 300 are NOT shown in Fig. 1. Without a receiver, recording units 105-108 cannot be equated to the local audio device of the Challenged Claims. Although the Petition refers to aspects of recording units 200 and 300, these units are irrelevant to any citation to Fig. 1. As such, Petitioners have made no showing that Strub teaches wearable recording units including a receiver as required by the Challenged Claims. The additional support cited by Petitioners for same (i.e., Ex-1003, 8:10-29, 8:50-53, 11:32-50, 12:13–21, 25:35–49) also does not teach such a device. Petition, p. 52.

Petitioners’ additional support to show Strub’s disclosure of Element 1[B] (Petition, p. 32), is equally unpersuasive and proves that the Strub device is not wearable. Strub at 4:21-31 teaches a Basic Strub Recording Unit with no receiver. Strub at 14:59-15:11 and 16:66-17:24 discuss wearability of the visual acquisition

device – not the recording unit – and proves that the visual acquisition device of a Strub recording unit is not wearable because it must be attached to a “wearable apparatus,” e.g., “helmet, headband, or head harness ... that is worn by the recorder” or “mating VelcroTM strips ... can be used to attach the visual data acquisition device ... on headgear, and armband, a legband, or other wearable apparatus.” Ex-1003, 17:1, 7-24. The “wearable apparatus” is wearable, but the visual data acquisition device is not, hence the need to attach it to a “wearable apparatus.”

“Strub at 38:65-39:11 only pertains to wearability of an ‘audio communication device’ – not a recording unit.” Ex-2015, ¶ 71. Strub at 66:33-51 does not describe wearability of a recording unit with a receiver because it describes a “data acquisition device” which is used in the Basic Strub Recording Unit. *See* Ex-1003, Figs. 2 and 3, 66:33-51. And, the lead in to Strub at 66:33-51 clarifies that this Basic Strub Recording Unit without a receiver may not even be wearable: “it is desirable to ‘package’ the recording unit components in any manner that achieves some or all of the desired characteristics of a recording unit ..., e.g., small size, low weight, unobtrusiveness, and capability of being mounted on a recorder (**or, at least, capability of being easily carried by the recorder**).” Ex-1003, 66:27-32 (emphasis added). “In other words, even the Strub specification questions whether a Basic Strub Recording Unit without a receiver is actually

wearable.” Ex-2015, ¶ 71.

Strub at 67:54-68:10 and 72:9-19 refer to the wearability of a Basic Strub Recording Unit 700 with no receiver. Ex-1003, 68:11-14. Accordingly, Petitioners have not pled any facts to show that Strub discloses a wearable device having all features required by Claims 1-6, 9 and 10, and Petitioners have failed to meet the particularity requirements of 35 U.S.C. § 312(a)(3), which require Petitioners to prove that a Strub recording unit with a receiver is wearable – the burden never shifts to the Board or Zaxcom to prove that such a unit is not wearable.

b) The Strub Recording Unit is Portable, Not Wearable.

“Fig. 6 illustrates a recording unit . . . Most of the components of the recording unit are enclosed within a backpack 601” and “a recording unit as shown in Fig. 6 . . . weighs about 24 pounds.” Ex-1003, 67:30-33, 45-47. If Strub’s recording unit was “wearable,” it would not require a backpack to attach it to a recorder’s body. “The Strub recording unit is not worn – it is carried within a backpack. One might send a child to school with a sandwich in the child’s backpack – this does not make the sandwich wearable.” Ex-2015, ¶ 73. A proper claim construction of Element 1[B] excludes portable devices. *Supra* § VII.B.

c) The Strub Recording Unit is Not Suitable to be Worn by a Performer.

Neither Strub nor Woo disclose a local audio device, nor a local audio device that is “suitable to be worn by a performer.” The ’902 Specification describes a

recording system that “wirelessly records audio events such as performances, movie takes, etc.,” and the local audio devices “are worn by the performers of the audio event.” Ex-1001, 4:12-14, 10:40-41.

In 2005, when the parent application of the ‘902 Patent was filed, a bodypack transmitter used in the motion picture industry weighed between 2.7 to 6 ounces. Ex-2024, p.1; *see also* Ex-2025, p. 14; *see also* Ex-2026, p. 20. Zaxcom’s TRX900 transmitter is depicted in Fig. 3B. *See* Ex-1001, Fig. 3B, 3:48-49, 12:1-16.

Strub’s recording units are not “local audio devices suitable to be worn by a performer,” as they are too large, visible, heavy, and imposing to be worn during the filming of performances. Strub’s recording units purpose of “social recording” (Ex-1003, Abstract), and to “facilitate later reminiscence” (Ex-1003, 2:63), does not require the same portability and discreteness as a device used to record performance audio as required by the ‘902 Specification. Ex-1001, 4:12-14 (“Recording system 100 wirelessly records audio events, such as performances, movie takes, etc. having one or more performers.”). Local audio devices must be of a size, weight, and shape that can be worn by performers without distracting the audience from the visual performance of the events, or “breaking the fourth wall.” Ex-2021, ¶ 22. The weight, size, and shape of the Strub recording unit prohibits such application. Figure 6 of Strub teaches a Basic Strub Recording Unit without a receiver that “weighs about 24 pounds.” Ex-1003, 67:45-47; Ex-1001, 23:42.

Accordingly, a Strub recording unit having all features of the challenged claims will exceed 24 pounds. “While one might carry in excess of 24 pounds for recreational filming, performers (e.g., those performing in motion pictures, concerts, news reporting, opera, etc.) are unable to carry such a weight while delivering such a performance, particularly without disturbing their hair, makeup, and costumes.” Ex-2015, ¶ 76; *see also* Ex-2021, ¶ 22-23. Furthermore, Strub’s disclosure that the “components of the recording unit are positioned **within a backpack** that is worn by the recorder” is not feasible in the performance industry, as it would impair the visual aspects of the performance. Ex-1003, 16:51-54 (emphasis added), Fig. 1, Fig. 6, Figs. 8A-C; *see also* Ex-2021, ¶ 24-25. The ’902 Specification requires a local audio device “suitable to be worn by a performer,” including those “manufactured in the form of body-packs, such as those typically worn by news announcers, performers, and the like.” Ex-1001, 8:65-67. Such bodypacks may be worn on a belt or otherwise hidden on the performer (e.g., in a pocket). Ex-2020, pg. 5.

d) Strub and Woo Do Not Teach Wearing of the Local Audio Device by a Performer Who Creates the Audio Recorded by the Local Audio Device.

Element 1[B] requires “a local audio device suitable to be worn by the performer who creates the audio that is recorded by that performer’s local audio device.” *Supra* § VII.B. Whereas the ’902 Specification teaches a local audio

device that records the isolated tracks of audio **created** by the performer who is wearing the local audio device, the Strub and Woo recording units record mixed audio that the recorder **hears**. *Supra* § VIII.A.1. Strub's and Woo's recording units both record mixed event audio, not performer audio, wherein the event audio is the mixed audio of multiple sources participating in the event occurring in front of the Strub or Woo recorder. *See* Ex-1003, 8:8-16, 22:21-32; Ex-1004, 5:1-5. This negates the ability of Strub or Woo to create a multitrack recording because there are no independent, isolated tracks of each audio source that may be independently manipulated during or after creation of a multi-track audio file.

3. Petitioners Fail to Demonstrate That Any Combination of the Cited References Teaches “a master timecode generator” (Claims 1-6 and 9-10) or “a plurality of master timecodes” (Claims 1-6, 9-10, and 13).

Petitioners claim that Element 1[A], namely, “at least one master timecode generator for generating a plurality of master timecodes” is taught by both Strub and Woo but proposes no definition of “at least one master timecode generator” or “plurality of master timecodes.” Petition, p. 31.

Petitioners must “identif[y] ... with particularity ... the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d at 1363. Petitioners' claim that “Strub also discloses synchronizing an internal clock with GPS or SMPTE timecodes (‘master timecodes’),” is completely

unsupported, and, as such, should be wholly disregarded. It is not the Board's or Zaxcom's task to decipher unsupported assertions.

Petitioners support their assertion that a "master timecode generator," is a "GPS satellite or SMPTE timecode source" by citing to Strub at 62:53-54, 63:50-60; 79:63-80:7, and 75:25-57 ("SMPTE time code input"), however, none of these citations disclose "a producer of a master time reference signal that controls at least one other timecode generator." Strub at 62:53-54 states "[f]or example, when the position sensing device is a GPS receiver, as described further below," which has no bearing on the construction of Element 1[A]. Strub at 63:50-60 states:

Though the recording unit must not be constantly blocked from GPS satellites in order for the recording unit to receive such time signals, the recording unit need only be exposed to a GPS satellite for about a minute to enable the time signals to begin. Further, after that point, clock drift occurs slowly, even if the recording unit is blocked from the GPS satellites for a period of time. Additionally, a recording unit according to the invention typically also includes an internal clock, as described above, that, while not as accurate as the GPS time signals, can also be used to accurately time-stamp data.

Ex-1003, 63:50-60.

Strub at 79:63-80:7 discloses:

[A] recording unit according to the invention typically includes a clock that is used to time-stamp recording data as the recording data is acquired. However, the clocks of different recording units may not be adequately synchronized to enable use of the time-stamps associated with the recordings obtained from different recording units to synchronize those recordings. (If recording units according to the invention each include a GPS receiver, such mis-synchronization will only exist to an appreciable degree if one or more recording units are shielded from a GPS transmitter system for an extended period of time, e.g., several hours.)

Ex-1003, 79:63-80:7.

The aforementioned sections discuss scenarios “in which either GPS time signals **or** the internal clock are used for time data, but neither section discloses a master timecode generator that is ‘a producer of a master time reference signal that **controls** at least one other timecode generator,’” as required by a proper construction of Element 1[A]. Ex-2015, ¶ 88.

Strub explicitly discloses “the recording units may not include clocks for enabling time-stamping of the recordings.” Ex-1003, 80:8-10. While Strub discloses that the GPS time signals time stamp the recording units, those recording units do not include clocks to be synchronized with a master

timecode. Ex-2015, ¶ 89.

Significantly, Strub clearly states that a synchronization pulse is used for synchronization (Ex-1003, 38:30-39), in sharp contrast to the '902 Specification, which discloses the production of timecodes having sufficient data to synchronize audio segments. Ex-1001, 5:7-14, 6:27-37, 10:20-32, 10:56-61, 14:9-17, 15:10-29, 16:30-37; *see also* Ex-2015, ¶ 90.

Petitioners' reliance on Strub's disclosure of an SMPTE time code input at 75:25-57 (Petition, p. 31) is also misplaced because "Strub does not disclose that the SMPTE time code input is used to control a timecode generator in a recording unit." Ex-2015, ¶ 91. Rather, Strub's discussion of a SMPTE time code states that the "SMPTE time code input can be used with professional camcorders or portable dockable videotape recorders (VTRs) ... to enable synchronization with an external device." Ex-1003 at 75:47-52. As per the declaration of Mr. DeFilippis, "[s]uch a synchronization would not entail the SMPTE timecode source controlling at least one other timecode generator in the camcorder or videotape recorder, rather, connection of an SMPTE time code input thereto would merely allow the recorder to use the SMPTE time code as its time code source, rather than using its own internal clock. This is typically done by setting the camcorder to 'External Timecode' or a similar option." Ex-2015, ¶ 91. Accordingly, this section of Strub would not have taught a master timecode

generator for generating a plurality of master timecodes because the SMPTE timecode source is not “a producer of a master time reference signal that controls at least one other timecode generator” as required by Claims 1-6 and 9-10. *Supra* § VII.D.

Woo does not compensate for Strub’s deficiencies. “Woo’s ‘master clock’ is not a ‘master timecode generator for generating a plurality of master timecodes.’” Ex-2015, ¶¶ 92, 93. Indeed, there is no mention of any such secondary timecode generator in Woo, let alone those that are controlled by Woo’s master clock. *See e.g.*, Ex-1004, cols. 4-8.

Rather, Woo discloses that “[t]he clock output 128 is conventionally formatted and structured, and is preferably compatible with present-day commercially-available equipment that have master clock input ports.” *Id.* at 8:1-4. As explained by Mr. DeFilippis, “[t]he mere disclosure of a master clock and master clock input ports on commercially-available equipment does not nearly meet the requirements of the claimed ‘master timecode generator’ that is a producer of a master time reference signal that controls at least one other timecode generator and produces a time reference signal used to synchronize at least one device.” Ex-2015, ¶ 94. Indeed, Woo clearly states that the time output of a GPS receiver must be combined with a pulse to perform synchronization. Ex-1040, 8:13-18. In contrast, the ’902 Patent teaches timecodes having

sufficient data to synchronize audio segments. Ex-1001. That is, “Woo needs to use a highly accurate pulse because the output of the GPS receiver is insufficient to achieve synchronization.” Ex-2015, ¶ 95.

The GPS-based characteristics of the Woo timecodes prevent the GPS satellite from producing a continuous master time reference signal that is capable of controlling at least one other timecode generator, as this requires transmission and reception of a series of signals for the synchronization to, and control by, a master time reference signal used to synchronize at least one device. Ex-1004, 9:5-20. Furthermore, a POSA knows that audio equipment is not capable of receiving GPS-based timecodes or other satellite signals in many filming locations e.g., government buildings, recording studios, subways or other underground locations. “[A]ny GPS or satellite reception of time code is unreliable and not a viable solution for the transmission or reception of timecode. There are many instances where receiving a GPS signal would just not be possible.” Ex-2021, ¶ 27. In contrast, the wireless transmission of signals taught by the ’902 Specification provides for accurate transmission of master timecodes in all locations including those not accessible by satellite signals, as it is industry standard for the production crew to “bring in [their] own master timecode generator” as taught in the ’443 Specification. Ex-2021, ¶ 27; *see also* Ex-1003, 1:33-48.

4. Petitioners Fail to Demonstrate That Any Combination of the Cited References Teaches Element 12[E] (Claims 13 and 16).

Petitioners purport that both Strub and Woo disclose claim limitation 12[E], namely, “wherein at least a portion of said local audio data is retrieved during or subsequent to said audio event and is combined with said remote audio data.”

Petition, pp. 55-56. Petitioners admit this combination is synonymous with replacement of remotely recorded/remote audio data with local audio data. “Strub discloses combining said remote audio data with said local audio data by **replacing** a portion of said remote audio data with said local audio data. *Id.* at 55 (emphasis added).

Petitioners further cite to Strub at “37:18-40 (recorders ‘exchange recording data after the event is over’),” 85:28-41, 87:61-63 and references the fact that Strub discloses that “[t]he time-stamps can be used...to enable post-event synchronization of the display of recordings obtained by different recording units.” Petition, pp. 55-56. None of these citations support Strub’s disclosure of a combination of local and remote audio data.

Strub at 37:18-40 merely describes that “it will often be the case that the recorders have a sufficiently close relationship that the recorders can, and will, exchange recording data after the event is over...” Ex-1003, 37:22-27. In other words, recorders can exchange each other’s video files, but there is no reference in

this section to any sort of combination of audio files, never mind replacement of one audio file's data with another audio file's data to repair a dropout. Strub at 85:28-41 and 87:61-63 also make no reference to any combination of data, or replacement of one audio file's data with another audio file's data to repair a dropout. Furthermore, even if such disclosures were made, the audio files of Strub cannot be used to repair a dropout via replacement of audio data as "[t]he audio track of a specific performer could not be repaired with the audio from another performer or any other source." Ex-2021, ¶ 19. As such, Petitioners fail to show that Strub discloses Element 12[E].

Petitioners' arguments regarding Woo are equally unavailing. Petitioners must "identif[y] ... with particularity ... the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim." 35 U.S.C. § 312(a)(3); *see also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d at 1363. Petitioners state that "Woo teaches using software and timecode information to synchronize and 'blend' two different recordings from different microphones to generate a third, composite recording which is a combination of the first two." Petition, p. 56. This "argument" fails to state how each of these two recordings qualifies as either "local audio data" or "remote audio data," and makes no attempt to tie Woo's disclosure to actual claim language. It is not the Board's or Zaxcom's responsibility to figure out Petitioners' argument when they fail to state

it with particularity. The '902 Specification never discloses combining two recordings to create a third composite recording. When the '902 Specification discloses combining local audio data with remotely recorded/remote audio data, it always refers to a Dropout Repair Embodiment. *Supra* § VII.C. Petitioners have failed to demonstrate Strub or Woo's disclosure of a Dropout Repair Embodiment and have failed to show that Claims 13 and 16 are obvious over any combination of the Cited References.

B. Petitioners Fail to Demonstrate That Claims 17-20 Are Rendered Obvious under § 103 By the Combination of Strub and Woo (Proposed Ground 3).

1. Petitioners Fail to Demonstrate That a Combination of Strub and Woo Teaches 17[Pre], 17[A], and 17[B] (Claims 17-20).

Petitioners must “identif[y] ... with particularity ... the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d at 1363. The Petition does not define “local audio,” but it claims that Strub and Woo disclose Elements 17[Pre], 17[A], and 17[B] by referring to the Petition's arguments regarding Elements 1[Pre], 1[B], 1[D], and 1[E] and Ex-1002, ¶¶ 286-288. However, none of the referenced arguments mention “local audio,” as required by Claims 17-20. As such, the Petition fails to show how Strub and Woo disclose Elements 17[Pre], 17[A], and 17[B].

Also, Element 17[B] requires “locally recording said local audio as local audio data in at least one memory of at least one local audio device,” yet none of the referenced arguments regarding Elements 1[Pre], 1[B], 1[D], and 1[E] makes any reference to recording or storing any type of data. Therefore, Petitioners have failed to demonstrate that a combination of Strub and Woo teaches Elements 17[Pre], 17[A], and 17[B] and has failed to state their case of obviousness with sufficient particularity pursuant to 35 U.S.C. § 312(a)(3).

Strub and Woo fail to teach Elements 17[Pre], 17[A], and 17[B] because they fail to disclose “local audio.” *Supra* § VII.A; *see also supra* § VIII.A.1. As “local audio” has the same definition as “locally generated audio,” Strub and Woo do not disclose Elements 17[Pre] and 17[B] for the same reasons that Strub and Woo do not disclose Elements 1[Pre] and 1[F] as discussed (*supra* § VII.A, § VIII.A.1.), wherein the “creating local audio data from said locally generated audio and storing said local audio data in said memory” of Element 1[F] is equivalent to “locally recording said local audio as local audio data in at least one memory” of Element 17[B]. *Supra* § VII.A.

2. Petitioners Fail to Demonstrate That a Combination of Strub and Woo Teaches 17[D] (Claims 17-20).

The Petition does not define “multi-track” or “multi-track audio file,” yet claims Element 17[D] “is taught by Strub and Woo. *Supra* 12[E]. In addition, Woo

teaches using software and timecode information to synchronize and ‘blend’ two different recordings from different microphones to generate a third, composite recording which is a combination of the first two. *Supra* 12[E]; Ex-1002, ¶ 290.” Petition, p. 71.

Petitioners must “identif[y] ... with particularity ... the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); *see also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d at 1363. Any 12[E] argument is wholly inapplicable to Element 17[D] because Element 12[E] involves “**local** audio data ...combined with said **remote** audio data,” i.e., a Local/Remote Combination (*supra* § VII.C.), and, Element 17[D] combines the “**local** audio data for each of said performers” with no reference to remotely recorded/remote audio data, i.e., a Local/Local Combination. *Supra* § VII.C.

A POSA would understand that combining two different recordings of the same event to create a composite recording, wherein each of the original recordings includes all of the audio sources in the event, does not result in the creation of a multi-track audio file as such a file requires an independent track of audio for each audio source (e.g., performer). *Supra* § VIII.A.1; *see also* Ex-2015, ¶ 128; Ex-2021, ¶ 21. Neither multi-track audio file generation nor the creation of individual performer audio is disclosed in either Strub or Woo. The Petition fails to demonstrate that a

combination of Strub and Woo teaches Element 17[D].

3. Petitioners Fail to Demonstrate That a Combination of Strub and Woo Teaches 17[C] (Claims 17-20).

Neither Strub nor Woo teach Element 17[C] for the same reasons Strub and Woo do not teach “a master timecode generator” or a “plurality of master timecodes.” *Supra* § VII.D; *see also Supra* § VIII.A.3.

IX. PETITIONERS FAIL TO DEMONSTRATE THAT A POSA WOULD BE MOTIVAED TO COMBINE THE CITED REFERENCES TO CREATE THE INVENTION OF THE CHALLENGED CLAIMS

A. Petitioners Fail to Demonstrate That A POSA Would Be Motivated to Combine the Cited References to Create the Invention of Claims 1-6, 9-10, 13, or 16.

1. Petitioners Failed to Demonstrate That a POSA Would Have Been Motivated to Modify Strub With Woo, Nagai, Gleissner, or Jones to Achieve the Inventions Recited in the Challenged Claims With a Reasonable Expectation of Success.

The Petitioners have failed to show why a POSA would attempt to solve a dropout problem of a “Virtual Wireless Multitrack Recording System” (Ex-1001, Title), by combining Strub and Woo, as neither teach multi-track recording nor the capture of individual, isolated sources of audio as required for multi-track recording. To the contrary, both Strub and Woo capture single tracks of mixed audio that do not include individual tracks of audio per performer/audio source.

Petitioners’ motivation to combine Strub and Woo is rooted in forbidden hindsight analysis and merely makes conclusory statements that “each of the local

audio devices of Strub and Woo wirelessly receives master timecodes from a master timecode generator and uses the timing information from the master timecodes to stamp the local audio.” Petition, p. 22.

As explained by Mr. DeFilippis, “[i]t is unclear how the teachings of Strub and Woo could be combined as suggested by the Petitioners to achieve the claimed invention with a reasonable expectation of success, because the references disclose methods that substantially differ from each other and the claimed invention.” Ex-2015, ¶ 111. The ’902 Patent includes a master timecode generator that is “a producer of a master time reference signal that controls at least one other timecode generator,” and creates a “a time reference signal used to synchronize at least one device,” wherein this time reference signal is non-GPS-based and is used to coordinate the various tracks of a multi-track recording system.

Strub discloses a GPS time signal that produces time stamps but does not control another timecode generator and does not produce a time reference signal used to synchronize at least one device. “A GPS receiver can also be used to receive a signal representing the current time that can be used as a clock to generate time-stamps for the recording data.” Ex-1003, 63:40-49; Ex-2015, ¶ 113. Quite differently, Woo discloses a “master clock 120 compris[ing] a GPS navigation satellite receiver 122 and a digital signal processor 124 for accumulating and averaging code epochs.” Ex-1004 at 8:60-63.

Indeed, it is Mr. DeFilippis’s opinion that a POSA “would not have been motivated to combine Strub and Woo, since they use different approaches, and it is not clear that the outcome of this combination improves anything, never mind solving the problem of dropouts in multi-track recording systems as neither Strub nor Woo teach multi-track recording or capture individual sources of audio as required for multi-track recording.” Ex-2015, ¶ 114.

A POSA would not have been motivated to combine Strub and Woo because “Strub already discloses a solution to post-production editing (i.e., participants share their locally recorded audio after a recorded event). Ex-2015, ¶ 115;; *see also* Ex-1003, 80:52-58. Therefore, applying the Woo solution in post-production in Strub would have been unnecessary. “A POSA would not have been motivated to change Strub’s simple system used by recreational recorders with a complex technical solution requiring multiple GPS receivers, video sync generators, delay circuitry, commands and requests, etc., especially because doing so would dramatically increase the size, weight and battery requirements of the Strub recording units, making them even more unwieldy, cumbersome and impractical than they already were.” Ex-2015, ¶ 115.

2. Strub and Woo are Non-Analogous Art to the Claimed Invention.

A reference that is not analogous art to the claimed invention may not be used in an obviousness rejection. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir.

2004). A reference is analogous art to the claimed invention only if it is: (i) from the same field of endeavor; or (2) reasonably pertinent to the problem faced by the inventor. *Id* at 1325. A reference is not "reasonably pertinent" to the problem unless it "logically [] commended itself to an inventor's attention in considering his problem. " *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011) (*quoting In re Clay*, 966 F.2d 656,658, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992)).

Strub and Woo are not in the same field as the claimed invention, and their disclosures are not reasonably pertinent to the problem faced by the '902 Patent inventors because they are not in the field of multi-track recording, nor are they capable of multi-track recording as they do not record individual, isolated sources of audio. Rather, Strub is in the field of low attention, social recording and Woo discloses a "GPS receiver [that] comprises a data output port for communicating time code information formatted according to standards." Ex-1004, Abstract.

The '902 Specification does not mention any "GPS satellite or receiver; it instead relates to using a master timecode generator to control other timecode generators in other recorders and 'to accurately stamp its recorded audio ... [which] allows multiple individually recorded audio tracks to be combined into one or more multi-track audio files.'" Ex-2015, ¶ 116 (citing Ex-1001, 4:16-25). GPS signals are known to be incompatible with performance recording as many recording locations (e.g., subways or other underground locations, government

buildings, professional recording studios) are not capable of receiving satellite signals. Ex-2021, ¶ 27. As such, a POSA, “would not have looked to Strub or Woo to address the problem identified in the ’902 Patent.” Ex-2015, ¶ 116.

3. Modifying Strub With Nagai or Gleissner Would Change the Principle Operation of Strub And Render it Unsuitable for Its Intended Purpose of Low Attention, Social Recording.

The Petition fails to show obviousness of the Challenged Claims via a combination of the Cited References because the proposed modification of a reference: (1) cannot change the principle operation of a reference; and (2) cannot render the reference unsuitable for its intended purpose. *See Plas-Pak Indus. v. Sulzer Mixpac AG*, 600 F. App'x 755, 758 (Fed. Cir. 2015) (“[C]ombinations that change the ‘basic principles under which the [prior art] was designed to operate ... or that render the prior art ‘inoperable for its intended purpose ... may fail to support a conclusion of obviousness.”) (quoting *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959) and *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984), respectively).

The Petition fails to identify the primary reference, how it is modified, or what elements of the claims are missing from the primary reference. Based upon the Petition’s assertion that “Woo itself provides express motivations to use its synchronization methods in a wireless, multi-recorder system such as Strub’s” (Petition, p. 22), Zaxcom will assume the reference being modified is Strub.

Strub’s intended purpose is low attention, social recording that allows

multiple recorders to record the same event from multiple viewpoints. Ex-1003, Abstract. Modifying Strub with Element 1[D] as suggested in the Petition at pages 38-39 would cause each Strub recorder to record only the recorder's audio via the "at least one audio input port for receiving locally generated audio from an audio input device." Thereafter, to obtain complete event audio, each recorder's audio recording (of the recorder's personal audio) would be combined into a single multitrack recording of the event – which would result in only one audio recording for any given event despite the number of recorders or possible viewpoints. Such an outcome changes the principle operation of Strub and renders it unsuitable for its intended purpose because Strub no longer performs "social recording," i.e., recording in which multiple participants in an event are recording the event" from multiple viewpoints. Ex-1003, Abstract. Since the modification of Strub with the teachings of Nagai and Gleissner would change the principle operation of Strub and render it unsuitable for its intended purpose, there is no suggestion or motivation to make the proposed combination. *See Plas-Pak Indus. v. Sulzer Mixpac AG*, 600 F. App'x at 758.

B. Petitioners Fail to Demonstrate That a POSA Would Have Been Motivated To Modify Strub With Woo To Achieve The Particular Methods Recited In Claims 17-20 With A Reasonable Expectation Of Success.

A POSA would not have been motivated to modify Strub with Woo to achieve the methods recited in Claims 17-20 for the same reasons a POSA

would not have been motivated to modify Strub with Woo to achieve the systems recited in Claims 1-6 and 9-10 and the methods of Claims 13 and 16. *Supra* § IX.A. The Petition fails to demonstrate that Claims 17-20 are obvious over a combination of Strub and Woo.

X. CONCLUSION

For all the reasons expressed herein, the Petitioners did not show that there is a reasonable likelihood that at least one of the Challenged Claims is unpatentable on any of the proposed grounds of rejections. Accordingly, the Petition should be denied.

Date: March 18, 2025

Respectfully Submitted,

By: /Rita C. Chipperson/

Rita C. Chipperson

Reg. No. 54,031

CHIPPERSON LAW GROUP, P.C.

163 Madison Avenue, Suite 220-40

Morristown, NJ 07960

T: (973) 845-9071

F: (973) 845-6176

rcc@chippersonlaw.com

www.chippersonlaw.com

*Counsel for Patent Owner,
Zaxcom, Inc.*

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I certify that this Preliminary Response contains 13,899 words, as determined by Microsoft Word, excluding the portions exempted by 37 C.F.R. § 42.24(a)(1). More specifically, the portions exempted from this word count are the title page, table of contents, table of authorities, table of exhibits, glossary of terms, this certificate, and the certificate of service.

Accordingly, this Preliminary Response complies with the requirements of 37 C.F.R. § 42.24(b)(1).

Dated: March 18, 2025

/Rita C. Chipperson/
Rita C. Chipperson (Reg. No. 54,031)
CHIPPERSON LAW GROUP, P.C
Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that on December 23, 2024, a complete and entire copy of the foregoing “PATENT OWNER’S PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. § 42.107(a)” is being served on the petitioners at the electronic addresses shown below per consent.

jeffrey.plies@dechert.com

greg.chuebon@dechert.com

michael.fisher@dechert.com

megan.gentleman@dechert.com

all-rode-dechert@dechert.com

Dated: March 18, 2025

/Rita C. Chipperson/

Rita C. Chipperson (Reg. No. 54,031)
CHIPPERSON LAW GROUP, P.C
Counsel for Patent Owner