

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.

IPR2025-00231

Patent 7,929,902

**MOTION TO TERMINATE IPR2025-00231
UNDER 35 U.S.C. §315(B)**

TABLE OF AUTHORITIES

Cases

Applications in Internet Time, LLC v. RPX Corp.,

897 F.3d 1336 (Fed. Cir. 2018).....2, 4-7

Commscope, Inc. v. TQ Delta, LLC,

No. IPR2022-00352, Paper 13 (Aug. 19, 2022).....2

Kloster Speedsteel AB v. Crucible Inc.,

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Power Integrations, Inc. v. Semiconductor Components Industries, LLC,

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Taylor v. Sturgell,

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VMWARE, Inc. v. Good Technology Software, Inc.,

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35 U.S.C. §315(b).....*passim*

Other Authorities

Consolidated Trial Practice Guide.....1, 5

EXHIBIT LIST

Exhibit No.	Description
2027	Complaint of Zaxcom, Inc. v. Lectrosonics, Inc., No. 1:17-cv-03408-NGG-RER (E.D.N.Y. filed June 6, 2017)
2028	Affidavit of Service of Zaxcom, Inc. v. Lectrosonics, Inc., No. 1:17-cv-03408-NGG-RER (E.D.N.Y. filed June 6, 2017)
2029	Final Written Decision in IPR2018-01129
2030	[REDACTED] [REDACTED]
2031	[REDACTED] [REDACTED]
2032	Email accompanying the [REDACTED]
2033	[REDACTED]
2034	[REDACTED]
2035	[REDACTED] [REDACTED]
2036	[REDACTED]
2037	[REDACTED] (May 2025)
2038	Lectrosonics Press Release
2039	IPR2018-01129 Petition

Pursuant to the May 20, 2025, Board’s Order, Patent Owner Zaxcom, Inc. (“Patent Owner” or “Zaxcom”) submits this Motion to Terminate IPR2025-00231 under 35 U.S.C. §315(b)(“Motion to Terminate”). Petitioners RØDE Microphones, LLC and Freedman Electronics Pty Ltd (“Petitioners” or individually, “RØDE” or “Freedman”) are time-barred from maintaining this inter partes review (“IPR”) against U.S. Patent No. 7,929,902 (the “’902 Patent”) under 35 U.S.C. §315(b).

35 U.S.C. §315(b) states an IPR “may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, RPI, or privy of the petitioner is served with a complaint alleging infringement of the patent.” The Board may not institute this IPR if Lectrosonics, Inc. (“Lectrosonics”) is an RPI or privy of Petitioners, because the December 4, 2024 IPR filing date is more than one year after the June 12, 2017 date on which Lectrosonics was served with a complaint alleging infringement of the ‘902 Patent in *Zaxcom, Inc. v. Lectrosonics, Inc.*, No. 1:17-cv-03408-NGG-RER (E.D.N.Y. filed June 6, 2017))(the “Lectrosonics Litigation”). *See* Exs-2027 and 2028.

Lectrosonics is an RPI. “Whether a party who is not a named participant in a given proceeding nonetheless constitutes a ‘real party-in-interest’ or ‘privy’ to that proceeding is a highly fact-dependent question” *See* Consolidated Trial Practice Guide (“CTPG”) at 13. Further, an acquisition of an entity establishes RPI status on the entity. *See Power Integrations, Inc. v. Semiconductor Components*

Industries, LLC, 926 F.3d 1306, 1316 (Fed. Cir. 2019), “Fairchild became an RPI at least by the time its merger with ON closed.” *See also Commscope, Inc. v. TQ Delta, LLC*, No. IPR2022-00352, Paper 13 at 14 (Aug. 19, 2022), “the Federal Circuit in *Power Integrations* held that ‘the parties were RPIs once the merger closed.’” (citing *Power Integrations*, 926 F.3d at 1318).

Also, in *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018) (“AIT”), “[d]etermining whether a nonparty is a ‘real party in interest’” involves “determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” Here, [REDACTED]

[REDACTED]. [REDACTED]

[REDACTED] [REDACTED]

[REDACTED]

[REDACTED], [REDACTED], [REDACTED]

[REDACTED] [REDACTED]

[REDACTED]

[REDACTED] *See* Ex-2031. [REDACTED]

[REDACTED]

[REDACTED]. *See* Exs-2032 and 2033. [REDACTED]

[REDACTED]. *See* Ex-

2034. [REDACTED]. *See*

Ex-2035. Finally, on or about May 5, 2025, (the “Acquisition Date”), [REDACTED]

[REDACTED] [REDACTED] Exs-2036, 2037,
and 2038. As per Petitioners’ interrogatory responses, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]. [REDACTED]

[REDACTED], [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED].

Lectrosonics is also a clear beneficiary of the outcome of this IPR.

Lectrosonics and Zaxcom are widely known as two, if not the only two, leading manufacturers in wireless audio equipment for industries including film, television, and live performance. Due to the ‘902 Patent and related patents, Lectrosonics has been unable to sell a wireless transmitter with internal recording. In 2016, Lectrosonics attempted to add internal recording to its transmitters by selling a Portable Digital Audio Recorder (the “Accused Product”) that could be coupled to its transmitter to provide it with internal recording. *See* Ex-2027. Zaxcom

immediately sued Lectrosonics for infringement of the ‘902 Patent, after which Lectrosonics filed three IPRs (i.e., 2018-00972, -01129, and -01130)(“Lectrosonics IPRs”) against multiple Zaxcom patents including the ‘902 Patent. *See* Ex-2029. Once the Board upheld the validity of the ‘902 Patent, Lectrosonics immediately ceased sales of the Accused Products. If the current IPR is successful, Lectrosonics will benefit from the ability to add internal recording to its products and to have the option of resuming sales of the Accused Product. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] *See* Ex-2030.

Additionally, [REDACTED]

[REDACTED].

Both parties have incentive to invalidate the ‘902 Patent, and the [REDACTED]

[REDACTED] As made clear in *AIT* 897 F.3d at 1353, “[t]he point is not to probe RPX’s [Petitioners] interest (it does not need any); rather, it is to probe the extent to which Salesforce [Lectrosonics]—as RPX’s client—has an interest in and will benefit from RPX’s [Petitioners’] actions, and inquire whether RPX [Petitioners] can be said to be representing that interest after examining its relationship with Salesforce [Lectrosonics].”

Additionally, the term “real party in interest” is intended to “sweep[] broadly” and should focus on “*who*, from a ‘practical and equitable’ standpoint *will benefit* from the redress that the chosen tribunal might provide.” (emphasis added) “Congress ... chose language that bars petitions where proxies or privies would benefit from an instituted IPR, even where the petitioning party might separately have its own interest in initiating an IPR.” *Id.* at 1346-49. There is no credible argument that Petitioners are not, at least in part, representing the interests of Lectrosonics, particularly in consideration of [REDACTED]

[REDACTED].

Lectrosonics is also a privy of Petitioners. Privy, “is more expansive, encompassing parties that do not necessarily need to be identified in the petition as a ‘real party-in-interest.’” CTPG at 14. In *Taylor v. Sturgell*, 553 U.S. 880, 893–95 (2008), the Supreme Court provided a non-exhaustive list of six factors for examining privy including: “(2) pre-existing substantive legal relationships between the parties ... (5) where the non-party acts as a proxy for the named party to relitigate the same issues...” *AIT*, 897 F.3d at 1360 (Reyna, J., concurring) (citing *Taylor*, 553 U.S. at 894–95). Analysis under any one of these factors “could suffice to establish privy under §315(b).” *AIT*, 897 F.3d at 1363.

At least factors 2 and 5 are met. The legal relationship between the parties is discussed above in the RPI argument and [REDACTED],

[REDACTED]. *See Id.* at 1363–64 (Reyna, J., concurring) (noting alignment of interests and lack of conflict as “indicators of privity”). [REDACTED], [REDACTED], which is impacted by its ability to add internal recording to its products and to potentially resume sale of the Accused Product if the ‘902 Patent is held invalid.

Futhermore, “courts have repeatedly found privity where ... [REDACTED] [REDACTED] *Power Integrations, Inc. v. Semiconductor Components Industries, LLC*, 926 F.3d 1306, 1316 (Fed. Cir. 2019) citing *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1583 (Fed. Cir. 1986). *See also VMWARE, Inc. v. Good Technology Software, Inc.*, No. IPR2015-00031, Paper No. 11 (Mar. 6, 2015) (Pursuant to the Agreement, Petitioner acquired AirWatch as its wholly owned subsidiary in February 2014 ... thus, Petitioner and AirWatch have been in privity at least since February 2014). Separately, the legislative intent behind § 315(b) is to prevent harassment and duplicative challenges. Allowing an acquiring company to refile an IPR that its predecessor could not file is the type of abuse the statute aims to prevent. *See AIT*, 897 F.3d at 1351. Here, Petitioners’ filing of this IPR amounts to a continuation of a time-barred challenge under a different name. Petitioners are a mere proxy for Lectrosonics to relitigate the same issues and arguments previously litigated in the

Lectrosonics IPRs. Petitioners have literally restated the same arguments as Lectrosonics and are citing the same, primary prior art Lectrosonics cited in its petition (i.e., Strub U.S. Patent No. 6,825,875, Woo U.S. Patent No. 5,479,351, Nagai U.S. Publication No. 2002/0159179, and Gleissner U.S. Publication No. 2004/0028241). *See* IPR2025-00231, Paper 1 vs. Ex-2039, IPR2018-00129 Petition.

Regarding timing, “[p]rivity relationships arising after an IPR is filed but before institution should be considered in the §315(b) time-bar analysis” *Power Integrations*, 926 F.3d at 1316. Lectrosonics became an RPI or privy at least as early as the Acquisition Date, prior to any decision regarding institution.

Finally, “[w]hen a patent owner provides sufficient evidence prior to institution that reasonably brings into question the accuracy of a petitioner’s identification of RPIs, the overall burden remains with the petitioner to establish that it has complied with the statutory requirement.” *AIT*, 897 F.3d at 1343. Petitioners are in the best position to prove or disprove this point as they have the information relevant to this issue. Although Petitioners provided some discovery to Zaxcom, it refused many of Zaxcom’s requests for production and interrogatories.

For all the above reasons, Zaxcom respectfully submits that the Board is required pursuant to § 35 USC 315(b) to grant this Motion to Terminate.

Dated: June 2, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that on June 2, 2025, a complete and entire copy of the foregoing “Motion to Terminate” is being served on the petitioners at the electronic addresses shown below per consent.

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