

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 IPR2025-00557

U.S. Patent 12,051,444

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF
PURSUANT TO 37 C.F.R. § 42.107(a) AND THE MARCH 26, 2025 INTERIM
PROCESSES FOR PTAB WORKLOAD MANAGEMENT MEMORANDUM

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<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	'207 Patent Information Disclosure Statement
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	'605 Patent Information Disclosure Statement
2015	Stipulation to Amend the Scheduling Order (ECF No. 136)

2016	DocketNavigator Statistics
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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 Zaxcom, Inc. v. RODE Microphones, LLC, et al., 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 Samadani
“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”	Inter Partes Review
“Samadani”	United States Publication No. 2004/0267387
“Lectrosonics IPRs”	The “Prior ’902 IPR”), the “Prior ’814 IPR, and the Prior ’307 IPR, collectively

“Lectrosonics Litigation”	Zaxcom, Inc. v. Lectrosonics, Inc., No. 1:19-cv-00109-LF-KBM (D.N.M), Zaxcom, Inc. v. Lectrosonics, Inc., No. 20-1350, -1450 (CAFC), Zaxcom, Inc. v. Lectrosonics, Inc., No. 2020-1921,-1922,-1943,-1944 (CAFC), Zaxcom, Inc. v. Lectrosonics, Inc., No. 1:17-cv-3408 (E.D.N.Y
“Litigation”	Zaxcom, Inc. v. RODE Microphones, LLC, et al., No. 1:23cv-01245-JFM (D. Del.)
“MPEP”	Manual of Patent Examining and Procedure
“Nagai”	United States Publication No. 2002/0159179
“Office”	United States Patent and Trademark Office
“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 IPR2025-00557
“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”	RODE Microphones, LLC
“Strub”	United States Patent No. 6,825,875
“SJ”	Summary Judgement
“USPTO”	United States Patent and Trademark Office
“Woo”	United States Patent No. 5,479,351

I. INTRODUCTION

In accordance with the Fintiv Factors (defined *infra* § III.A) and the Board's discretionary authority under 35 U.S.C. §314(a), institution should be denied because the Parties have spent considerable time and resources litigating the validity of the '444 Patent and six other patents in a parallel Litigation (*infra* § II). Petitioners' reliance on the now-withdrawn USPTO Memorandum entitled *Interim Procedure for Discretionary Denials* (June 21, 2022) (the "Memorandum") and corresponding case law carries no weight, as the USPTO formally rescinded the Memorandum, its supporting guidance, and the propriety of relying on case law related to same on February 28, 2025 (*infra* § III.A.6).

Institution is also improper under 35 U.S.C. §325(d) due to Petitioners' reliance on prior art that was before the Examiner during prosecution of the '444 Patent as Petitioners have failed, in its Petition, to demonstrate material error by the Examiner in accordance with *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential)("Advanced Bionics") and *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 3-4 (May 19, 2025) (precedential) (clarifying and reaffirming the *Advanced Bionics* two-part framework)("Ecto World").

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 '902, '443 and '207 Patents were filed by Petitioners on December 4, 2024, and are currently pending. The Petition for this IPR for the '444 Patent was filed on February 7, 2025.

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

III. DISCRETIONARY DENIAL OF THE PETITION PURSUANT TO 35 U.S.C. § 314(a) IS WARRANTED

A. Institution Should Be Denied Pursuant to 35 U.S.C. § 314(a) Because the Same Patent, Claims, Invalidity References and Arguments Are Being Advanced by the Same Parties 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 evaluating 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. The Board's resources are better preserved for cases that present novel issues or where district court resolution is unlikely - neither is true here. 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 four (4) of the seven (7) patents asserted in the Litigation, and sixty-five (65) of the one hundred thirty-one (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 three (3) patents

and sixty-six (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, Petitioners also exchanged their reply claim construction briefing on May 23, 2025, a sur-reply will be due by June 13, 2025, the Joint Claim Construction Brief is set to be completed on June 20, 2025, and the Markman hearing is scheduled for July 9, 2025. Ex-2015, ECF136. 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 IPRs, which will occur at earliest, September 2026, and at latest March 2028 (depending on extensions and/or appeals) (infra § III.A.2.), factor (2) weighs against granting of a stay.

For Factor (3), 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 more than fifteen (15) months after the Original Complaint (Ex-2001, ECF1) was filed. 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 now 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-cv01902-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, this Petition is the last to be filed of the Freedman/Rode IPR Petitions. Since it was filed on February 7, 2025, it will not likely resolve until sometime between September 1, 2026 through July 1, 2028, depending upon extensions and/or appeals (infra § III.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 (i.e., only sixty five of one hundred thirty one Asserted Claims and four out of seven 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, as discussed above. 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* § III.A.1), but briefing is scheduled to conclude by June 20, 2025 (Ex-2015, ECF136), and, as such, it is reasonable that the trial will occur during 2026 (*supra* § III.A.1).

DocketNavigator states an average time to jury trial in the federal courts of Delaware as 1,103 days as of 2021, which would put trial to occur on or about November 8, 2026. Ex-2016. In comparison, the statutory deadline for the last FWD of the Freedman/Rode IPR Petitions is approximately October 7, 2026, which is one year from the date of potential institution of this Petition, or October 7, 2025 (i.e., three months after the filing of Zaxcom’s Preliminary Response, which is due on July 7, 2025). If an extension is taken, the date of the FWD for the ‘444 Patent will be April 7, 2027. If appealed, another 412.1 days is added, on

average, which pushes resolution of the Freedman/Rode IPR Petitions to sometime between November 2027 to May 2028 (if an extension is taken), well after the Litigation should be resolved. Ex-2011. Thus, 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 § III.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. Petitioners state, without support, “it is highly likely that many of the Challenged Claims will not be asserted in the Delaware Litigation.” Petition, pp. 88. 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 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 12; 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 11 at 13.

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 *infra* § IV, A., the merits of the grounds in the Petition are not a close call as all of the pertinent art asserted by the Petitioners in the Petition (i.e., Strub, Woo, Nagai, and Gleissner), as well as arguments similar to those made by Petitioner, were available to the Examiner during prosecution of the ‘444 Patent. The Examiner acknowledged consideration of the asserted art and documents including these arguments in the ‘605 Patent IDS (Ex-2014) and found the ‘444 Patent allowable over the asserted art and related arguments.

Petitioners argue that, under the Memorandum, “the PTAB will not deny institution based on *Fintiv* if there is compelling evidence of unpatentability...” Petition p. 86. 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. 9-13) 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 June 3, 2025).

Accordingly, the USPTO has reinstated the Board's full discretion under Fintiv, and Petitioners cannot rely on the now-eliminated exception to avoid discretionary denial under § 314(a).

For all of the above reasons, discretionary denial of the Petition pursuant to 35 U.S.C. § 314(a) is warranted.

IV. DISCRETIONARY DENIAL OF THE PETITION UNDER 35 U.S.C. § 325(D) IS WARRANTED

Institution should also be denied under 35 U.S.C. § 325(d) because Petitioners extensively rely on prior art and arguments that were previously before the Examiner and have failed to meet its burden of proof under the two-part *Advanced Bionics* framework for a § 325(d) analysis. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential). *See also Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 3-4 (May 19, 2025) (precedential) (clarifying and reaffirming the *Advanced Bionics* two-part framework).

Section 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the patent is based on matters previously presented to the Office. 35 U.S.C. § 325(d) states, in pertinent part, “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter

31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”

Under *Advanced Bionics*, Paper 6 at 8, the Board uses the following two-part framework: (1) “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office” (“Prong 1”); and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims” (“Prong 2”). And, “the question of whether proffered art or arguments are ‘the same or substantially the same’ as art or arguments previously presented to the Office is a highly factual inquiry, which may be resolved by reference to the factors set forth in *Becton, Dickinson*.” *Advanced Bionics*, Paper 6 at 7. The Board has decided that these “common *non-exclusive* factors” should be weighed including:

“(a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its

evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or argument.”

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17-18 (Dec. 15, 2017) (precedential as to § III.C.5) (“*Becton Dickinson*”).

A. THE SAME OR SUBSTANTIALLY THE SAME PRIOR ART WAS PRESENTED TO THE OFFICE.

In the Petition, Petitioners state Grounds 1-3 for cancellation of the challenged claims:

Ground 1: Claims 1-7, 9-10, 13-15, 17-20, 22-23, and 27 are Rendered Obvious Under § 103 By the Combination of Strub and Woo;

Ground 2: Claims 12 and 26 are Rendered Obvious Under § 103 By the Combination of Strub, Woo, Nagai, and Gleissner; and

Ground 3: Claims 16 and 24 are Rendered Obvious Under § 103 By the Combination of Strub, Woo, and Samadani.

With the exception of Samadani, all of the previously presented art (i.e., Strub, Woo, Nagai, Gleissner) is exactly the same art that was available to the Examiner during prosecution of the ‘444 Patent. Samadani applies to only two dependent claims (i.e., claims 16 and 24) of the challenged twenty-three claims, and invalidation of these two dependent claims is based upon a combination of

Samadani in combination with two other references that were available to the Examiner (i.e., Strub and Woo). Even in claims 16 and 24, Petitioners do not rely on Samadani for any new or inventive concept, or to assert some new combination of references that invalidate the underlying independent claims. Rather, Samadani is only cited for its purported disclosure of the single, narrow limitation: “wherein the remote control unit is a personal computer.” Ex-1001, pp. 80-82. As such, Samadani adds nothing new to the analysis and pertains only to this one specific aspect of two dependent claims 16 and 24. Therefore, the combination of Samadani with Strub and Woo only adds a routine substitution onto prior art that was already before the Examiner and fully addressed during prosecution.

“Under § 325(d), the art and arguments must have been previously presented to the Office during proceedings pertaining to the challenged patent. Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Advanced Bionics*, Paper 6 at 7-8. Accordingly, “previously presented art” includes Strub, Woo, Nagai, and Gleissner, as each of these references were included in the IDS submitted during the prosecution of the ‘605 Patent (the “’605 Patent IDS”). Ex-2014, Information Disclosure Statement, pp. 1-2. The ‘605 Patent IDS, dated October 13, 2022, was submitted during prosecution of the ‘605 Patent, which is the parent application of

the ‘444 Patent. This filing has the same effect as filing an information disclosure statement during prosecution of the ‘444 Patent, as the Examiner is required to review all references in the parent application in accordance with MPEP § 609.02(II)(A)(2), “[t]he examiner will consider information which has been considered by the Office in a parent application...when examining: (A) a continuation application filed under 37 CFR 1.53(b).” Because the ‘444 Patent issued from an application that is a continuation of the ‘605 Patent, the prior art cited during prosecution of the ‘605 Patent is presumed to have been considered by the Examiner during prosecution of the ‘444 Patent.

Under this first prong, per *Advanced Bionics*, the *Becton Dickinson* factors determine whether the same or substantially the same art or arguments were previously presented to the Office. Here, at least *Becton Dickinson* factor (a) is met (i.e., “the similarities and material differences between the asserted art and the prior art involved during examination”). With the exception of Samadani, which has very limited application as explained above, there is no difference between the prior art asserted in the Petition and the previously presented art which was before the Examiner during prosecution of the ‘444 Patent and as submitted in the ‘605 Patent IDS. Further, the Examiner confirmed consideration of Strub, Woo, Nagai, and Gleissner in the ‘605 Patent IDS as confirmed by the Examiner’s signature on the IDS and the Examiner’s indication that “ALL REFERENCES CONSIDERED

EXCEPT WHERE LINED THROUGH. Ex-2014. Petitioners do not assert different art than considered by the Office. Rather, they rely on the same previously presented art that the Examiner had already considered.

Per *Becton Dickinson* factor (b), there is no cumulative art because of all of the asserted art cited is identical to the prior art. Samadani would not be considered cumulative, because it is only cited in combination with Strub and Woo to cover the very narrow limitation of the remote control unit being a personal computer. Additionally, the Board has stated if “the asserted prior art is identical to that involved during examination, [the Board] need not consider *Becton Dickinson* factor (b).” See *Puma North America, Inc. v. Nike, Inc.*, IPR2019-01042 Paper 10 at 11, (PTAB Oct. 31, 2019) (informative) (citing *NHK Spring Co., Ltd. v. Intriplex Techs., Inc.*, IPR2018-00752, Paper 8 at 13 (PTAB Sep. 12, 2018) (precedential)).

Turning to *Becton Dickinson* factor (d), “the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art,” there is extensive overlap between the Lectrosonics IPR arguments submitted to the Examiner in the ‘605 Patent IDS and the arguments presented by the Petitioners in the Petition. *Inter alia*, the petitions, and the final written decisions of all three Lectrosonics IPRs are cited as non-patent literature in the ‘605 Patent IDS. Ex-2014, ‘605 Patent

IDS. Specifically, the petitions listed in the ‘605 Patent IDS for IPR2018-01129 and IPR2018-01130 both include arguments citing Strub in view of Nagai, Gleissner, and Woo for claim limitations similar to those of the ‘444 Patent. These arguments were not only available to the Examiner during prosecution, but they were also framed in the same combinations and for the same reasons shown in the Petition for the ‘444 Patent. Thus, the Petition merely repackages arguments made by Lectrosonics in the Lectrosonics IPRs, which were presented to the Examiner via the ‘605 Patent IDS. Just as the presentation of prior art in an IDS is sufficient to meet prong 1 of the *Advanced Bionics* framework, presentation of arguments in an IDS should also be sufficient to meet *Becton Dickinson* factor (d). *See Ecto World*, Paper 13 at 4 (“Challenging the claims using the same prior art that was previously presented on an IDS is sufficient to satisfy the first part of the *Advanced Bionics* framework.”). Because the Examiner acknowledged consideration of these documents containing the Lectrosonics’ arguments during prosecution of the ‘444 Patent, factor (d) weighs against institution.

Petitioners’ arguments in section X.A.1. *Advanced Bionics* – Part One of its Petition do not counter Zaxcom’s arguments as presented above. First, Petitioners inexplicably focus on the prosecution of the ‘207 Patent (Ex-1001, p. 84), rather than focusing on the prosecution of the application associated with the ‘605 Patent, which is the parent application of the ‘444 Patent. As discussed above, in

accordance with MPEP § 609.02(II)(A)(2), the Examiner is required to review all references in the parent application, and, as such, it is presumed that the Examiner has reviewed all references submitted in the prosecution of the ‘605 Patent.

Accordingly, the ‘605 Patent is the proper point of reference – not the ‘207 Patent.

Further, Petitioners assert that “[a]lthough the Examiner signed the IDSs and added the footnote ‘ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH,’ *id.*, there is no evidence that Strub, Woo, Nagai, or Gleissner received meaningful consideration.” Ex-1001, p. 84. This assertion is inherently contradictory. Petitioners acknowledge that the references were listed and expressly marked as “considered” by the Examiner, yet they provide no evidence that the Examiner lacked sufficient information or failed to understand the relevance of the prior art, other than attempting to argue that the references did not receive *meaningful consideration* because they weren’t used in a rejection against the patent owner. However, the MPEP is clear that an examiner’s obligation is to consider the documents, not necessarily to apply them in a rejection. As stated in MPEP § 609:

[T]he examiner has an obligation to consider the information. **There is no requirement that the information must be prior art references in order to be considered by the examiner.**

Consideration by the examiner submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files...the following alternative electronic signature method may be used by examiners in information disclosure statements to indicate whether the information has been considered.

(emphasis added) MPEP § 609 (9th ed. Rev. 9, Jan, 2024). Petitioners cite no precedential authority to overcome the presumption that references marked as considered were in fact evaluated by the Office.

Additionally, this presumption applies not only to the Strub, Woo, Nagai, and Gleissner references themselves, but also to arguments applying these references to patents covering the same or similar technology as the ‘444 Patent including, *inter alia*, the petitions and final written decisions of the Lectrosonics IPRs as non-patent literature. Exs-2009, 2014. These petitions included invalidity arguments relying on the same or substantially similar combinations of Strub, Woo, Nagai, and Gleissner as those presented in the Petition. Accordingly, the Examiner had the opportunity to evaluate not only the prior art references themselves, but also arguments applying the asserted combination of references to similar claims.

Biocon Pharma Ltd. v. Novartis Pharms. Corp, IPR2020-01263, Paper 12 at 9 (PTAB Feb. 16, 2021) is similar to the instant case. There, the Board agreed with the Patent Owner that prior art cited only in the IDS, and not used in any rejection, was identical to the asserted art in the Petition. As a result, the Board determined that Petitioners argument would fail on §325(d) grounds. (“the record shows that the Examiner signed an IDS...In light of the Board’s precedential *Advanced Bionics* decision, we reject Petitioner’s content that, even though [a prior art] appears on an IDS, we should decline to exercise discretion under § 325(d) because

[the prior art] was ‘not applied by the Examiner.’ As explained in *Advanced Bionics*, ‘[p]reviously presented art includes art made of record...such as on an Information Disclosure Statement (IDS).’ Thus, [the Board] accept[s] that the Examiner considered [the prior art] because it is listed on the IDS and the Examiner signed the IDS with the statement ‘all references considered except where lined through.’” (citations omitted).) The instant case is indistinguishable and should be resolved the same way. It is presumed that the Examiner considered not only the prior art asserted in the Petition, but also arguments related to same, as these references and arguments were all cited in the ‘605 Patent IDS.

Factors (c), (e), and (f) will be discussed in the following section regarding the second prong of the *Advanced Bionics* framework.

B. THE PETITIONER HAS FAILED TO DEMONSTRATE THAT THE OFFICE ERRED IN A MANNER MATERIAL TO PATENTABILITY OF THE CHALLENGED CLAIMS.

Ecto World, Paper 13 at 5, reaffirms that when prior art is listed on an IDS, even if it is not applied by the Examiner, prong 1 of the *Advanced Bionics* framework is met, and the burden shifts to Petitioners to show material error under the second prong of *Advanced Bionic*, Paper 6 at 5 (“This decision resolves that dispute and clarifies that a petitioner must provide an analysis even when the asserted prior art is on an IDS, but the Examiner did not apply the reference”). Further, “[i]n that analysis, a petitioner must explain, with reference to *Becton*

Dickinson factors (c), (e), and (f), how the Examiner erred in overlooking the prior art.” See *Ecto World*, Paper 13 at 5. These factors are:

- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

See *Advanced Bionics*, Paper 6 at 10.

Petitioners’ arguments in section X.A.2. *Advanced Bionics* – Part Two of its Petition are found at pages 84-86. Petitioners’ analysis makes no reference to *Becton Dickinson* at all, nor to its specific factors (c), (e), and (f). As such, the Petitioner has failed to point out how the Examiner erred in its evaluation of the asserted prior art with specific reference to the *Becton Dickinson* factors, or how the Examiner erred in overlooking the prior art.

Additionally, relating to factor (f), the Petition does not introduce any additional facts or evidence to warrant reconsideration of the previously presented art or arguments. In *Ecto World*, Paper 13 at 6-7, the Board clarified that it “should consider a petitioner’s argument based on the volume of the references submitted to the Office during examination and any applicant information,” because, in this

case, the Patent Owner submitted an IDS that “contain[ed] over 1,000 references, which is over 40 times the size of a typical IDS.” Ultimately, the Director decided to remand the case to the Board to determine whether discretionary denial is appropriate in view of the 1000-reference IDS. That is not the case here, as the ‘605 Patent IDS including the asserted references includes nine (9) U.S. patents, six (6) U.S. patent application publications, one (1) foreign patent, and fifty (50) non-patent literature documents, the latter of which included documents relating to the Lectrosonics IPRs and Lectrosonics Litigation. Ex-2014. This is nowhere near the volume that the Board would consider as voluminous, as explained in *Ecto World*.

Instead, Petitioners cite a nonprecedential Board opinion to argue that the prior art wasn’t considered meaningfully. Petition at 83. Further, Petitioners have not explained how the Examiner materially erred in failing to apply the Strub, Woo, Nagai, and Gleissner references. In fact, the Petition wholly lacks a *Becton Dickinson* discussion that would justify re-litigation of the same references. Where a Petitioner fails “to provide a compelling reason why [the Board] should readjudicate substantially the same prior art and arguments as those presented during prosecution and considered by the Examiner,” the Board will deny institution pursuant to §325(d). See *Unified Patents Inc. v. Berman*, IPR2016-01571, Paper 10 at 12 (PTAB Dec. 14, 2016)(informative).

Additionally, Petitioners are not entitled to cure these deficiencies in a reply.

The Board requires Petitioners to proactively address both prongs of the *Advanced Bionics* framework in the initial Petition. As the Board has emphasized, a reply may only rebut new issues raised by the patent owner, it cannot introduce new arguments or evidence to correct omissions in the original filing. Per 37 C.F.R. § 42.24(b), “[a] reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution.” Additionally, per the Trial Practice Guide, a “[p]etitioner may not submit new evidence or argument in reply that it could have presented earlier.” *Patent Trial and Appeal Board Consolidated Trial Practice Guide* at 73 (Nov. 2019). Lastly, the U.S. Court of Appeals for the Federal Circuit has stated that the Board should disregard any inappropriately presented argument and evidence. *See Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369-70 (Fed. Cir. 2016).

Thus, under the *Advanced Bionics* framework, Petitioners failure to meaningfully address §325(d), the *Becton Dickinson* factors, or demonstrate material error by the Office, renders institution improper.

V. CONCLUSION

For all the reasons expressed herein, the Board should deny institution of the Petition under both 35 U.S.C. §314(a) and 35 U.S.C. §325(d).

Date: June 7, 2025

Respectfully Submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I certify that this PATENT OWNER’S DISCRETIONARY DENIAL BRIEF PURSUANT TO 37 C.F.R. § 42.107(a) AND THE MARCH 26, 2025, INTERIM PROCESSES FOR PTAB WORKLOAD MANAGEMENT MEMORANDUM” contains 6,164 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: June 7, 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 June 7, 2025, a complete and entire copy of the foregoing “PATENT OWNER’S DISCRETIONARY DENIAL BRIEF PURSUANT TO 37 C.F.R. § 42.107(a) AND THE MARCH 26, 2025, INTERIM PROCESSES FOR PTAB WORKLOAD MANAGEMENT MEMORANDUM” is being served on the petitioners at the electronic addresses shown below per consent.

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