

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.

IPR2025-00557

Patent 12,051,444

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
DISCRETIONARY DENIAL BRIEF**

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
A. The Early Challenge to the '444 Patent Strongly Supports Institution	1
B. Petitioners Filed Their Petition Less than Three Months After the '444 Patent Was Introduced into the Delaware Litigation	2
C. Three Co-Pending Petitions Challenging Related Patents With Substantially Overlapping Claims Have Been Instituted	3
II. THE <i>FINTIV</i> FACTORS DO NOT SUPPORT DISCRETIONARY DENIAL OF THE PETITION BASED ON THE PARALLEL DISTRICT COURT PROCEEDING	4
A. Petitioners Moved to Stay the Delaware Litigation Following Institution of the Co-Pending IPRs	5
B. The Trial Date Has Not Yet Been Set in the Delaware Litigation	10
C. The Litigation Is Still at an Intermediate Stage and Petitioners Were Diligent in Filing this IPR	11
D. Patent Owner Mischaracterizes the Issue Overlap	13
E. Litigation Parties	14
F. Evidence of Strong Merits Support Institution	14
III. THE PETITION RAISES ART AND ARGUMENTS NOT CONSIDERED BY THE EXAMINER	15
A. Section 325 (d)	15
1. Advanced Bionics—Part One	16
a. Samadani's Absence from the Prosecution History Ends the § 325(d) Analysis	16
b. The Art and Arguments in the Lectrosonics IPRs Also Have No Similarity To or Overlap With Samadani	19
2. Advanced Bionics—Part Two: Material Errors in Overlooking the Petition's Unpatentability Grounds	20
a. The Record Provides No Indication that the References Filed with the Parent Application Were Meaningfully Considered	20

TABLE OF CONTENTS (continued)

	<u>Page</u>
b. The Examiner Erred in Ignoring the Board's Findings in the Lectrosonics IPRs	23
IV. CONCLUSION.....	30

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020)	15, 16, 22, 23
<i>AGIS Software Dev. LLC v. Google LLC</i> , No. 19-cv-361-JRG, 2021 WL 465424 (E.D. Tex. Feb. 9, 2021)	8
<i>Amazon.com, Inc. v. M2M Sols. LLC</i> , IPR2019-01205, Paper 14 (PTAB Jan. 27, 2020)	22, 23
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)	4, 11, 12, 13
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 15 (PTAB May 13, 2020)	9
<i>Apple Inc. v. Seven Networks, LLC</i> , IPR2020-00156, Paper 10 (PTAB June 15, 2020)	13, 15
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG</i> , IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017)	15, 17, 18
<i>Bio-Rad Labs. Inc. v. 10X Genomics, Inc.</i> , No. 18-cv-1679-RGA, 2020 WL 2849989 (D. Del. June 2, 2020)	11
<i>British Telecomms. PLC v. IAC/InterActiveCorp</i> , No. 18-cv-366-WCB, 2019 WL 4740156 (D. Del. Sept. 27, 2019)	5, 6, 7
<i>British Telecomms. PLC v. IAC/InterActiveCorp</i> , No. 18-cv-366-WCB, 2020 WL 5517283 (D. Del. Sept. 11, 2020)	8
<i>Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.</i> , IPR2025-00434, 436, 437, Paper 11 (PTAB June 26, 2025)	2
<i>Consumeron, LLC v. MapleBear Inc.</i> , No. 21-cv-1147-GBW-MPT, 2023 WL 3434002 (D. Del. May 12, 2023)	7, 8

<i>CyWee Grp. Ltd. v. Samsung Elecs. Co. Ltd.</i> , No. 17-cv-140-WCB-RSP, 2019 WL 11023976 (E.D. Tex. Feb. 14, 2019)	8
<i>Dental Monitoring v. Get-Grin Inc.</i> , No. 22-cv-647-WCB, 2024 WL 1603403 (D. Del. Apr. 9, 2024).....	7
<i>DISH Network LLC v. Broadband iTV, Inc.</i> , IPR2020-01359, Paper 15 (PTAB Feb. 12, 2021).....	12, 13
<i>Ecto World, LLC v. RAI Strategic Holdings, Inc.</i> , IPR2024-01280, Paper 13 (PTAB May 19, 2025)	20, 21
<i>Embodly, Inc. v. LifeNet Health</i> , IPR2025-00248, 249, Paper 13 (PTAB June 26, 2025)	2
<i>Ericsson Inc. v. TCL Commc’n Tech. Holdings, Ltd.</i> , No. 15-cv-11-RSP, 2016 WL 1162162 (E.D. Tex. Mar. 23, 2016)	8
<i>Ethicon LLC v. Intuitive Surgical, Inc.</i> , No. 17-871-LPS, 2019 WL 1276029 (D. Del. Mar. 20, 2019)	8, 9, 11
<i>Google LLC v. Parus Holdings, Inc.</i> , IPR2020-00846, Paper 9 (PTAB Oct. 21, 2020).....	14
<i>Helios Streaming, LLC v. Vudu, Inc.</i> , No. 19-cv-1792-CFC-SRF, 2021 WL 8155604 (D. Del. Aug. 5, 2021)	7
<i>Imperative Care, Inc. v. Inari Med., Inc.</i> , IPR2025-00289, Paper 9 (PTAB June 12, 2025)	1
<i>Int’l Bus. Mach. Corp. v. Rakuten, Inc.</i> , No. 21-cv-461-GBW, 2022 WL 17848779 (D. Del. Dec. 22, 2022)	6
<i>IOENGINE, LLC v. PayPal Holdings, Inc.</i> , No. 18-cv-452-WCB, 2019 WL 3943058 (D. Del. Aug. 21, 2019).....	6
<i>Lectrosonics, Inc. v. Zaxcom, Inc.</i> , IPR2018-00972 (PTAB).....	24
<i>Lectrosonics, Inc. v. Zaxcom, Inc.</i> , IPR2018-01129 (PTAB).....	23

<i>Lectrosonics, Inc. v. Zaxcom, Inc.</i> , IPR2018-01130 (PTAB).....	23
<i>Merck Sharp & Dohme LLC v. Halozyme, Inc.</i> , PGR2025-0006, 0009, Paper 25 (PTAB June 12, 2025).....	1
<i>Microsoft Corp. v. SurfCast, Inc.</i> , IPR2022-00590, Paper 9 (PTAB Oct. 7, 2022).....	22
<i>NEC Corp. v. Peloton Interactive, Inc.</i> , No. 22-cv-987-CJB, 2024 WL 1533952 (D. Del. Apr. 9, 2024).....	11
<i>NFC Tech. LLC v. HTC Am., Inc.</i> , No. 13-cv-1058-WCB, 2015 WL 1069111 (E.D. Tex. Mar. 11, 2015).....	6
<i>Princeton Digit. Image Corp. v. Konami Digit. Ent. Inc.</i> , No. 12-cv-1461-LPS-CJB, 2014 WL 3819458 (D. Del. Jan. 15, 2014).....	6
<i>Prolitec Inc. v. Scentair Techs., LLC</i> , No. 20-cv-984-WCB, 2023 WL 5037173 (D. Del. Aug. 8, 2023).....	6, 8
<i>Ramot at Tel Aviv Univ. Ltd. v. Cisco Sys., Inc.</i> , No. 19-cv-225-JRG, 2021 WL 121154 (E.D. Tex. Jan. 13, 2021)	8
<i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , IPR2025-00246, 247, Paper 10 (PTAB June 12, 2025)	1, 2
<i>RØDE Microphones, LLC v. Zaxcom, Inc.</i> , IPR2025-00230, Paper 14 (PTAB June 16, 2025)	3, 4, 9, 10, 12
<i>RØDE Microphones, LLC v. Zaxcom, Inc.</i> , IPR2025-00231, Paper 23 (PTAB June 16, 2025)	3
<i>RØDE Microphones, LLC v. Zaxcom, Inc.</i> , IPR2025-00232, Paper 14 (PTAB June 16, 2025)	3, 14, 29
<i>Samsung Elecs. Co., Ltd. v. G+ Commc'ns, LLC</i> , IPR2023-00441, Paper 10 (PTAB Aug. 3, 2023).....	18, 19
<i>Sand Revolution II, LLC v. Cont'l Intermodal Grp.–Trucking LLC</i> , IPR2019-01393, Paper 24 (PTAB June 16, 2020)	9, 10

<i>St. Jude Med., LLC v. Snyders Heart Valve LLC</i> , IPR2018-00105, Paper 15 (PTAB May 3, 2018)	20
<i>TC Tech. LLC v. Sprint Corp.</i> , No. 16-cv-153-WCB, 2021 WL 4521045 (D. Del. Oct. 4, 2021)	8
<i>Tesla, Inc. v. Charge Fusion Techs.</i> , LLC, IPR2025-00152, 153 Paper 11 (PTAB June 11, 2025)	2
<i>Tesla, Inc. v. Intellectual Ventures II, LLC</i> , IPR2025-00339, Paper 10 (PTAB June 13, 2025)	14
<i>Verizon Bus. Network Servs. Inc. v. Huawei Techs. Co. Ltd.</i> , IPR2020-01141, Paper 12 (PTAB Jan. 14, 2021)	12
<i>Zaxcom, Inc. v. Lectrosonics, Inc.</i> , Nos. 2020-1350, 2020-1405, 2022 WL 499843 (Fed. Cir. Feb. 18, 2022)	27, 28
<i>Zaxcom, Inc. v. Lectrosonics, Inc.</i> , Nos. 2020-1921, 2020-1922, 2020-1943, 2020-1944, 2022 WL 499848 (Fed. Cir. Feb. 18, 2022)	28
Statutes	
35 U.S.C. § 314(a)	4
35 U.S.C. § 325(d)	14, 16, 19, 21, 23, 30
Other Authorities	
37 C.F.R. § 42.4	4
D. Del. LR 7.1.2(b)	5

I. Introduction

Contrary to the request by Patent Owner Zaxcom (Paper 6, “DD Brief”) the *inter partes* review (“IPR”) challenge of U.S. Patent No. 12,051,444 (the “’444 Patent”) by Petitioners RØDE Microphones, LLC and Freedman Electronics Pty Ltd. (“Petitioners” or individually, “RØDE” or “Freedman”) does not warrant discretionary denial.

A. The Early Challenge to the ’444 Patent Strongly Supports Institution

Petitioners filed their Petition on February 7, 2025, just over seven months after the ’444 patent issued on July 31, 2024 and less than three months after Patent Owner filed its amended complaint in the parallel district court litigation, *Zaxcom, Inc. v. RODE Microphones, LLC, et al.*, No. 1:23-cv-01245-JFM (D. Del.) (the “Delaware Litigation”), adding the ’444 patent to the case. Ex. 1051 at ¶ 8. In numerous decisions, the Director has declined to exercise discretionary denial against IPR challenges of patents issued recently, holding that “[e]arly challenges favor robust, predictable patent rights and weigh against discretionary denial.” *ResMed Corp. v. Cleveland Med. Devices, Inc.*, IPR2025-00246, 247, Paper 10 at 2 (PTAB June 12, 2025); *Imperative Care, Inc. v. Inari Med., Inc.*, IPR2025-00289, Paper 9 at 2 (PTAB June 12, 2025); *Merck Sharp & Dohme LLC v. Halozyme, Inc.*, PGR2025-0006, 0009, Paper 25 at 2 (PTAB June 12, 2025);

Tesla, Inc. v. Charge Fusion Techs., LLC, IPR2025-00152, 153, Paper 11 at 3 (PTAB June 11, 2025); *see also Embody, Inc. v. LifeNet Health*, IPR2025-00248, 249, Paper 13 at 2-3 (PTAB June 26, 2025); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, 436, 437, Paper 11 at 2-3 (PTAB June 26, 2025) (declining to deny institution based on “settled expectations” for patents issued in 2019 and 2020).

Patent Owner’s Discretionary Denial Brief (“DD Brief”) rests heavily on the status of the parallel Delaware Litigation. DD Brief, 10-12. But consistent with recent decisions, the Director should find that “[a]lthough the parties ... have invested some resources into the district court proceeding ... that consideration is outweighed by the early challenge[]” to the ’444 patent. *See, e.g., ResMed*, IPR2025-00246, 247, Paper 10 at 2.

B. Petitioners Filed Their Petition Less than Three Months After the ’444 Patent Was Introduced into the Delaware Litigation

Patent Owner’s numerous allusions to alleged “delay” caused by Petitioners (DD Brief, 16-18, 20) are misleading and, ultimately, irrelevant, to the IPR of the ’444 patent. The ’444 patent issued more than nineteen years after its priority date and less than a year before its expiration date. The ’444 patent issued several months after Patent Owner filed its Complaint in the Delaware Litigation. Patent Owner nonetheless waited three months to add the ’444 patent to the Delaware

Litigation. Ex. 1051 at ¶ 8. Petitioners, in contrast, filed their Petition on February 7, 2025, less than three months after Patent Owner asserted the '444 patent in the Delaware Litigation. The prompt Petition filing supports institution. *Infra* § II.C.

C. Three Co-Pending Petitions Challenging Related Patents With Substantially Overlapping Claims Have Been Instituted

Petitioners filed IPR challenges to three other patents from the same family as the '444 patent: U.S. Patent Nos. 7,711,443 (the "'443 Patent") in IPR2025-00230, 7,929,902 (the "'902 Patent") in IPR2025-00231, and 10,276,207 (the "'207 Patent") in IPR2025-00232. All three earlier IPRs were instituted on June 16, 2025. See *RØDE Microphones, LLC v. Zaxcom, Inc.*, IPR2025-00230, Paper 14 (PTAB June 16, 2025); *RØDE Microphones, LLC v. Zaxcom, Inc.*, IPR2025-00231, Paper 23 (PTAB June 16, 2025); *RØDE Microphones, LLC v. Zaxcom, Inc.*, IPR2025-00232, Paper 14 (PTAB June 16, 2025). The claim elements of the challenged claims substantially overlap between the '444 patent and the '443, '902, and '207 patents, so the art and arguments at issue in this IPR substantially overlap too. Because of this overlap, instituting trial on the '444 patent would place far fewer demands on Board resources than a typical IPR.

In contrast, discretionarily denying the IPR of the '444 patent risks an outcome where the Board finds claims of the '443, '902, and '207 patents unpatentable, while similar claims in the '444 patent must be adjudicated in a

duplicative proceeding. Discretionary Denial of this Petition would be inefficient and undermine the Board's efforts to ensure consistency and patent quality across similar patent claims. Patent Owner's Discretionary Denial request should be denied.

II. The *Fintiv* Factors Do Not Support Discretionary Denial of the Petition Based on the Parallel District Court Proceeding

Patent Owner based its allegation that applying the *Fintiv* factors warrants discretionary denial under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4 on now-outdated facts and an incomplete and misleading description of the Delaware Litigation. DD Brief at 12-23 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5 (PTAB Mar. 20, 2020) (“*Fintiv*”) (precedential).) Since Patent Owner filed its brief, the Board instituted trial on the three other IPR Petitions challenging the '443, '902, and '207 patents. In each institution decision, the Board found that “taken as a whole, the [*Fintiv*] factors do not favor exercising discretion to deny institution.” *E.g., RØDE*, IPR2025-00230, Paper 14 at 13.

While the IPRs proceed apace, the Delaware Litigation still does not have a trial date and is unlikely to go to trial before a Final Written Decision in this IPR. Neither party has taken a fact deposition, the Court has not issued a claim construction decision, and Patent Owner has requested that the Court delay the end of fact discovery from August 15, 2025 to September 30, 2025. Ex. 1052 at 2; Ex.

1057 at ¶ 13. Finally, the Court is considering a motion to stay the case pending resolution of Petitioners' four IPRs.

A. Petitioners Moved to Stay the Delaware Litigation Following Institution of the Co-Pending IPRs

On June 26, 2025, ten days after the institution decisions of the IPR challenges of the '443, '902, and '207 patents, Petitioners moved to stay the Delaware Litigation. Ex. 1053; Ex. 1054. The next day the Court ordered Patent Owner to file an accelerated opposition to the motion to stay by July 7, 2025¹ and set a July 9, 2025 oral argument on the stay. Ex. 1055. These actions indicate the Court is seriously entertaining ordering a stay.

Patent Owner's arguments that the Delaware Litigation is unlikely to be stayed paints an incorrect picture of the Delaware Litigation. DD Brief at 14-19. All three factors considered by District of Delaware courts: "(1) whether granting the stay will simplify the issues for trial; (2) the status of the litigation, particularly whether discovery is complete and a trial date has been set; 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" support a stay. *British Telecomms. PLC*

¹ District of Delaware local rules typically allow two weeks for a response to a non-dispositive motion. D. Del. LR 7.1.2(b).

v. IAC/InterActiveCorp, No. 18-cv-366-WCB, 2019 WL 4740156, at *2 (D. Del. Sept. 27, 2019) (“BT”) (quoting *Princeton Digit. Image Corp. v. Konami Digit. Ent. Inc.*, No. 12-cv-1461-LPS-CJB, 2014 WL 3819458, at *2 (D. Del. Jan. 15, 2014)). A fourth factor often considered—“whether a stay, or the denial thereof, will reduce the burden of litigation on the parties and on the court”—also supports a stay. *Int’l Bus. Mach. Corp. v. Rakuten, Inc.*, No. 21-cv-461-GBW, 2022 WL 17848779, at *4 (D. Del. Dec. 22, 2022) (quoting *id.*); *Prolitec Inc. v. Scentair Techs., LLC*, No. 20-cv-984-WCB, 2023 WL 5037173, at *2 (D. Del. Aug. 8, 2023); *see also BT*, 2019 WL 4740156, at *2.

First, a stay will significantly simplify the Delaware Litigation (Ex. 1054 at 6-10), and the “most important factor bearing on whether to grant a stay is whether the stay is likely to simplify the issues at trial.” *IOENGINE, LLC v. PayPal Holdings, Inc.*, No. 18-cv-452-WCB, 2019 WL 3943058, at *8 (D. Del. Aug. 21, 2019). Three of the IPRs in the Delaware Litigation have now been instituted, and District of Delaware courts have held that “after the PTAB has instituted review proceedings, the parallel district court litigation ordinarily should be stayed.” *Id.* at *4 (quoting *NFC Tech. LLC v. HTC Am., Inc.*, No. 13-cv-1058-WCB, 2015 WL 1069111, at *7 (E.D. Tex. Mar. 11, 2015)).

Patent Owner’s arguments (DD Brief at 14-15) ignore that District of Delaware courts have often held that “even when IPRs are instituted on fewer than

all the asserted claims, the policies favoring simplification and the reduction of litigation burdens on the parties and the court are often applicable, particularly when the claims that are before the PTAB in an IPR are similar to those that are not.” *BT*, 2019 WL 4740156, at *7 (stayed when nine of eleven asserted claims of the patent-in-suit were challenged in an instituted IPR). Most of the claims that have not been challenged in the IPRs contain numerous overlapping elements with the challenged claims. Ex. 1054 at 8-9; Ex. 1056. Thus, “any decisions cancelling claims from the first three patents at issue will doubtlessly simplify the case before this court,” which strongly favors a stay. *See Dental Monitoring v. Get-Grin Inc.*, No. 22-cv-647-WCB, 2024 WL 1603403, at *6 (D. Del. Apr. 9, 2024).

Second, the Delaware Litigation is not as advanced as Patent Owner represents. DD Brief at 11, 15-16. Trial has not been scheduled, the parties have yet to begin expert discovery, neither party has taken any fact depositions, and Patent Owner has asked to postpone the completion of fact discovery (Ex. 1052 at 2; Ex. 1057 at ¶ 13; Ex. 1058 at 14). *See Helios Streaming, LLC v. Vudu, Inc.*, No. 19-cv-1792-CFC-SRF, 2021 WL 8155604, at *3 (D. Del. Aug. 5, 2021) (staying a case pending IPR resolution where “fact discovery remain[ed] ongoing, no depositions have been taken, expert discovery ha[d] not yet begun . . .”). District of Delaware courts have stayed much more advanced cases. *Conuseron, LLC v. MapleBear Inc.*, No. 21-cv-1147-GBW-MPT, 2023 WL 3434002, at *2 (D. Del.

May 12, 2023). In fact, courts in the district have stayed cases pending IPRs mere months from trial dates. *See, e.g., Prolitec*, 2023 WL 5037173, at *7 (stay granted seven months before scheduled trial wherein some of the pretrial proceedings in the case had been completed); *see also TC Tech. LLC v. Sprint Corp.*, No. 16-cv-153-WCB, 2021 WL 4521045, at *7 (D. Del. Oct. 4, 2021) (stay granted less than two months before trial); *British Telecomms. PLC v. IAC/InterActiveCorp*, No. 18-cv-366-WCB, 2020 WL 5517283, at *5 (D. Del. Sept. 11, 2020) (stay granted less than three months before trial); *see also AGIS Software Dev. LLC v. Google LLC*, No. 19-cv-361-JRG, 2021 WL 465424, at *3 (E.D. Tex. Feb. 9, 2021) (stay granted three months before trial); *see also Ramot at Tel Aviv Univ. Ltd. v. Cisco Sys., Inc.*, No. 19-cv-225-JRG, 2021 WL 121154, at *2 (E.D. Tex. Jan. 13, 2021) (stay granted six weeks before trial); *CyWee Grp. Ltd. v. Samsung Elecs. Co. Ltd.*, No. 17-cv-140-WCB-RSP, 2019 WL 11023976, at *6–7 (E.D. Tex. Feb. 14, 2019) (stay granted three months before trial); *Ericsson Inc. v. TCL Commc’n Tech. Holdings, Ltd.*, No. 15-cv-11-RSP, 2016 WL 1162162, at *2 (E.D. Tex. Mar. 23, 2016) (stay granted within two months of trial).

Third, Patent Owner’s argument regarding alleged prejudice arising from a stay (DD Brief at 17-19) omits several important facts regarding Patent Owner’s conduct in the Delaware Litigation. Ex. 1054 at 12-14. Patent Owner has not moved for a preliminary injunction. *See Ethicon LLC v. Intuitive Surgical, Inc.*,

No. 17-871-LPS, 2019 WL 1276029, at *3 (D. Del. Mar. 20, 2019) (Plaintiff's "decision not to seek a preliminary injunction" weighed against finding prejudice to the plaintiff.). Only the '443 and '902 patents do not imminently expire, and the remaining patents-in-suit, including the '444 patent, expire next week on July 14, 2025. Any potential damages related to these patents will cease accruing long before the litigation is resolved, whether or not the case is stayed. Moreover, Patent Owner is responsible for the late addition of the '444 patent to this litigation. Ex. 1054 at 13.

Fourth, a stay will substantially reduce the burden of the Court and the parties. Many of the resources to be expended with respect to the '443, '902, '207, and '444 patents will be mooted by the IPR proceeding. And many issues relating to most of the unchallenged claims will also be addressed in the IPR proceedings. A substantial amount of work and expense is still needed in this case. Ex. 1054 at 15-16.

At a minimum, the stay factor is neutral while the Court considers Petitioners' motion. *RØDE*, IPR2025-00230, Paper 14 at 8-9 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020)) (informative) (finding this factor neutral); *Sand Revolution II, LLC v. Cont'l Intermodal Grp.—Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative)

(explaining that without “specific evidence” how the court will rule, this factor is neutral).

B. The Trial Date Has Not Yet Been Set in the Delaware Litigation

No trial date has been set in the Delaware Litigation and the most burdensome stages of the litigation lie in the future. Ex. 1031 at 3. Patent Owner engages in the same speculation regarding the trial date (DD Brief at 19-20) that the Board rejected in its institution decision of the related patents. *See, e.g., RØDE*, IPR2025-00230, Paper 14 at 9 (finding that the lack of trial date “weighs against exercising discretion to deny institution.”)

Patent Owner also provides an outdated 2021 time-to-trial estimate that projects a November 6, 2026 trial. DD Brief at 19 (citing Ex. 2016). Patent Owner’s incomplete reading of the article describing the District of Delaware time-to-trial average is misleading. The two prior years to 2021 saw average time to trial in District of Delaware Courts of 1308 days (2019) and 1433 days (2020). Ex. 2016 at 3. According to statistics compiled by the United States Courts, for the twelve-month period ending March 31, 2025, the median time from filing to disposition by trial in Delaware was 41.6 months (1265 days), which would place

trial in April 2027.² Judge Murphy, who is presiding over the Delaware Litigation, oversaw a single patent trial since assuming the bench in 2022, where 44 months elapsed from case filing to trial. Ex. 1059. These statistics indicate that any trial will be many months after a FWD in this proceeding.

Moreover, the District of Delaware has often granted requests to stay pending IPR that were filed after an institution decision. See *Ethicon*, 2019 WL 1276029, at *1-3; *Bio-Rad Labs. Inc. v. 10X Genomics, Inc.*, No. 18-cv-1679-RGA, 2020 WL 2849989, at *1-2 (D. Del. June 2, 2020); *NEC Corp. v. Peloton Interactive, Inc.*, No. 22-cv-987-CJB, 2024 WL 1533952, at *1–3 (D. Del. Apr. 9, 2024). With no trial scheduled, and trial likely occurring well after any FWD, Factor 2 weighs against discretionary denial. *Fintiv*, IPR2020-00019, Paper 11 at 9.

C. The Litigation Is Still at an Intermediate Stage and Petitioners Were Diligent in Filing this IPR

In the Delaware Litigation, fact discovery is still ongoing. Neither party has taken any fact depositions. Ex. 1057 at ¶ 13. Expert discovery has not even begun

² Ex. 1062, United States Courts, Table C-5—U.S. District Courts—Civil Federal Judicial Caseload Statistics (Mar. 31, 2025), available at <https://www.uscourts.gov/data-news/data-tables/2025/03/31/federal-judicial-caseload-statistics/c-5>.

(Ex. 1031 at 2-3), a trial date has not been set (*id.* at 3), and no substantive orders have been issued related to the patents-in-suit. The most resource intensive stages of this case still lie in the future, which several District of Delaware courts have held warrants a stay. *Fintiv*, IPR2020-00019, Paper 11 at 9-10. Indeed, as the Board pointed out in its institution decisions, “much work remains in the district court case.” *See, e.g., RØDE*, IPR2025-00230, Paper 14 at 10.

Patent Owner’s allegations of Petitioners’ alleged delays are inapplicable to the challenge of the ’444 patent. DD Brief at 20. Petitioners filed their Petition on February 7, 2025, just over seven months after the ’444 patent issued on July 31, 2024 and less than three months after Patent Owner filed its amended complaint in the parallel district court litigation that added the ’444 patent to the case. “If the evidence shows that a petitioner filed its petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against denying institution.” *Verizon Bus. Network Servs. Inc. v. Huawei Techs. Co. Ltd.*, IPR2020-01141, Paper 12, at 12 (PTAB Jan. 14, 2021) (citing *Fintiv*, IPR2020-00019, Paper 11 at 11) (crediting Petitioner’s diligence in filing the Petition less than three months after being served infringement contentions); *see also DISH Network LLC v. Broadband iTV, Inc.*, IPR2020-01359, Paper 15, at 19-20 (PTAB Feb. 12, 2021) (The Petitioner’s filing “approximately three months after first receiving notice of Patent Owner’s infringement positions” and seven months after

the complaint “weigh[ed] strongly against” discretionary denial.) Thus, this factor weighs strongly against discretionary denial.

D. Patent Owner Mischaracterizes the Issue Overlap

Patent Owner wrongly alleges that “there is 100% overlap between the Petition and Litigation issues, which rely on identical prior art references and arguments.” DD Brief at 20. Patent Owner dropped five ’444 patent claims from the Delaware Litigation. Ex. 1060. Four of these, claims 7, 16, 20, and 27, are challenged in this Petition. Patent Owner is still asserting 129 claims among all the patents in suit. Many claims are unlikely to remain in the Delaware Litigation because the Court ordered Patent Owner to “identify narrowed set of claims for the case going forward” after the Court issues its Claim Construction Order. Ex. 1031 at 2. Thus, it is highly likely that many of the Challenged Claims will not be asserted in the Delaware Litigation. “The IPR trial will impact the integrity of the patent system positively by considering material issues not raised in the District Court Action.” *Apple Inc. v. Seven Networks, LLC*, IPR2020-00156, Paper 10 at 17 (PTAB June 15, 2020); *Fintiv*, IPR2020-00019, Paper 11 at 12-13. This Petition is challenging claims that are not at issue in the Delaware Litigation, and additional challenged claims may be withdrawn from the litigation. This factor disfavors discretionary denial.

E. Litigation Parties

This Petition involves the same parties as the Delaware Litigation, so this factor may “depend[] on which tribunal was likely to address the challenged patent first,” which is the Board. *Google LLC v. Parus Holdings, Inc.*, IPR2020-00846, Paper 9 at 20-21 (PTAB Oct. 21, 2020). Nonetheless, the Board will likely address the challenged patent before the trial in the Delaware Litigation, regardless of whether the case is stayed or not. *Supra* § II.B; Ex. 1031 at 2-3

F. Evidence of Strong Merits Support Institution

The institution of the IPRs challenging the ’443, ’902, and ’207 patents obviates Patent Owner’s assertion that “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.” DD Brief at 22. Thus, “the Board previously determined there was a reasonable likelihood that similar claims of an ancestor patent were unpatentable,” which “counsel[s] against discretionary denial.” *Tesla, Inc. v. Intellectual Ventures II, LLC*, IPR2025-00339, Paper 10, at 2 (PTAB June 13, 2025).

The Board expressly rejected Patent Owner’s § 325(d) arguments in the institution decision of the ’207 patent. *RØDE*, IPR2025-00232, Paper 14 at 16-20.

The “strong showing on the merits” presented here weighs against denial. *Seven Networks*, IPR2020-00156, Paper 10 at 20.

III. The Petition Raises Art and Arguments Not Considered by the Examiner

A. Section 325 (d)

Discretionary denial under 35 U.S.C. § 325(d) is analyzed based on the two-part framework of *Advanced Bionics*, which incorporates the factors set out in *Becton, Dickinson. Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, at 8-11 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”) (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017) (precedential as to §III.C.5, first paragraph)). *Advanced Bionics* Part One analyzes whether the same or substantially the same art or arguments previously were presented to the USPTO, based on *Becton, Dickinson* factors (a), (b), and (d): (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; and (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art. *Advanced Bionics*, IPR2019-01469, Paper 6 at 8, 10. If, in *Advanced Bionics* Part One, it is determined that the same or substantially the same

art or arguments were previously presented to the Office, then the analysis moves on to *Advanced Bionics* Part Two, which analyzes whether the Office materially erred, based on *Becton, Dickinson* factors (c), (e), and (f): (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. *Id.* at 8-10.

Here, denial of institution under § 325(d) is unwarranted because (1) the same or substantially the same art or arguments were **not** previously presented to the USPTO—thus, the analysis should stop at *Advanced Bionics* Part One, and (2) even if the Board moves on to *Advanced Bionics* Part Two, the PTO materially erred during prosecution.

1. Advanced Bionics—Part One

a. Samadani’s Absence from the Prosecution History Ends the § 325(d) Analysis

Patent Owner acknowledges that Ground 3 of the Petition relies in part on Samadani (Ex. 1007), which was not before the PTO at any time during prosecution of the ’444 Patent, its parent, U.S. Patent No. 11,610,605 (the “’650 patent”), or any of their ancestors. DD Brief at 25. Furthermore, Zaxcom (1) does

not allege that Samadani bears any similarity to the art before the Examiner, (2) admits that “Samadani would not be considered cumulative,” *id.* at 28, and (3) presents no evidence of any overlap between the arguments made during examination and the manner in which Petitioner now relies on Samadani. *See Becton, Dickinson*, at 17-18 (factors (a), (b), (d)).

Indeed, Samadani is materially different from, and not cumulative to, the prior art involved during examination. Patent Owner dismisses Samadani as relied on solely for the limitation “wherein the remote control unit is a personal computer,” and characterizes that limitation—without any evidence—as merely “a routine substitution.” DD Brief at 25-26. Zaxcom further contends that “Samadani adds nothing new to the analysis”—based on the erroneous premise that claims 16 and 24 do not matter because they are “dependent claims.” *Id.* at 26.

But the Examiner issued only one Office Action during examination of the ’444 Patent, and in that Office Action—indeed, in the entire prosecution—the Examiner did not even address the “personal computer” limitation for which Petitioners now cite Samadani, let alone find that limitation in the references that he considered during prosecution, U.S. Patent Pub. No. 2004/0237115 (“Horiuchi”) and U.S. Patent 4,872,195 (“Leonard”). Ex. 1038 at 3-6. Indeed, the Examiner could not have considered the “personal computer” limitation when issuing the Office Action, because that limitation did not even exist in the single

claim that was pending at the time. Ex. 1061 at 187. Instead, the Examiner focused attention on the RF power control limitations of the sole pending claim, which he found in Horiuchi and Leonard. Ex. 1061 at 69-71. Thus, the Examiner never got close to examining the “personal computer” element that Samadani expressly addresses.

Furthermore, when the Applicant later filed an amendment canceling the rejected claim and replacing it with an entirely new set of claims, its only argument in favor of patentability was: “Applicant submits that Claims 2-30 are patentable over the rejections raised by the Examiner in the present Office Action.” Ex. 1061 at 64. Thus, not only is Samadani materially different from and not cumulative to the art before the Examiner, but there is no overlap whatsoever between the arguments made during examination—which related solely to the RF power control teachings of Horiuchi and Leonard—and the manner in which Petitioner relies on Samadani—which relates to the “personal computer” limitation of issued claims 16 and 24. *See Becton, Dickinson*, at 17-18 (factors (a), (b), (d)).

Even though Samadani is relied on in just one of the three grounds in the Petition, its absence from the prosecution history is sufficient for the Board to decline to exercise its discretion to deny institution. *See Samsung Elecs. Co., Ltd. v. G+ Commc’ns, LLC*, IPR2023-00441, Paper 10, at 15-17 (PTAB Aug. 3, 2023). When the Petition asserts grounds relying on a combination of references, and at

least one ground relies on a reference that was not before the Examiner, *Advanced Bionics* Part One is not met:

We are not persuaded to deny institution based on Section 325(d). Although Li was previously presented to the Office under part 1 of *Advanced Bionics*,...Kim was not. Even were we to discount Li because of Section 325(d), the challenge here is not based solely on Li. Some grounds rely on Kim....Kim differs from Li and the Kim and Li combination was not previously considered. These differences provide a separate basis for the challenge presented here. Kim was not presented to the Examiner during prosecution....Because the first prong of the framework of *Advanced Bionics* is not satisfied, we determine that Section 325(d) is not sufficiently implicated to deny institution.

Id. Here, as in *Samsung*, at least one ground relies on a combination with a reference, Samadani, that was never considered. Thus, the absence of Samadani from the prosecution history is dispositive and should end the § 325(d) analysis.

b. The Art and Arguments in the Lectrosonics IPRs Also Have No Similarity To or Overlap With Samadani

Zaxcom cites the Lectrosonics IPRs for alleged overlap between the arguments made in those proceedings and Petitioner's current reliance on Strub, Woo, Nagai, and Gleissner. DD Brief, at 28-29. But that does not change the above analysis of the original examination of the '444 patent, because just as Samadani was never before the Examiner during prosecution, it also was not

before the Board during the Lectrosonics IPRs. Furthermore, Zaxcom cites no art or argument from the Lectrosonics IPRs that has any similarity to or overlap with Samadani or the manner in which Petitioner now relies on Samadani. Thus, as with the original prosecution, the Lectrosonics IPRs provide no basis for moving beyond *Advanced Bionics* Part One.

2. Advanced Bionics—Part Two: Material Errors in Overlooking the Petition’s Unpatentability Grounds

Even if the Board were to consider Part Two of *Advanced Bionics*—which it should not, for the reasons set forth above—*Becton, Dickinson* factors (c), (e), and (f) weigh against discretionary denial.

a. The Record Provides No Indication that the References Filed with the Parent Application Were Meaningfully Considered

With respect to *Becton, Dickinson* factor (c), even if the Board focuses on the grounds based on Strub, Woo, Nagai and Gleissner, there is no evidence that these references were considered meaningfully, let alone in the combinations asserted in this Petition. *St. Jude Med., LLC v. Snyders Heart Valve LLC*, IPR2018-00105, Paper 15 at 12 (PTAB May 3, 2018) (instituting where “evidence of record does not demonstrate that the Examiner considered the references in the combinations relied upon by Petitioner or addressed arguments similar to those Petitioner now presents”). The Director’s decision in *Ecto World, LLC v. RAI*

Strategic Holdings, Inc. explained that a buried reference may not be a basis for a § 325(d) discretionary denial. IPR2024-01280, Paper 13 at 6-7 (PTAB May 19, 2025) (precedential). Although Strub, Woo, Nagai and Gleissner were submitted to the PTO in an IDS during examination of the '650 patent, there is no indication in the prosecution record that the Examiner gave these references any meaningful consideration in the prosecution of either of the '605 and '444 patents. Patent Owner's Ex. 2014. Beyond initialing the Information Disclosure Statement ("IDS") in the '605 file, the Examiner never cited Strub, Woo, Nagai or Gleissner in an Office Action during prosecution of the '605 patent. *Id.* Combinations of Strub, Woo, Nagai and Gleissner never appear in the '444 patent prosecution history in any form, let alone as the basis for a rejection. The cover of the '444 patent does not list Strub, Woo, Nagai and Gleissner. Therefore, there is no indication that the Examiner actually considered these references when examining the application that became the '444 patent. In particular, no arguments of any kind relating to Strub, Woo, Nagai, and Gleissner appear anywhere in the prosecution of the '605 and '444 Patents, let alone "the same or substantially the same...arguments" now presented in the present IPR. 35 U.S.C. § 325(d).

Furthermore, Strub, Woo, Nagai, and Gleissner are not "substantially the same" as the prior art substantively considered by the Examiner. *Advanced Bionics*, IPR2019-01469, Paper 6 at 13-19. As discussed *supra* regarding Part One

of *Advanced Bionics*, the only references that the Examiner considered substantively were Horiuchi and Leonard, which relate to RF power control and have nothing to do with the vast majority of the features in Petitioner's cited references. See Ex. 1061 at 69-72. For example, the Examiner never asserted that Horiuchi or Leonard discloses recording locally generated audio as time-referenced local audio data and substantially simultaneously transmitting audio data to a remote device, creating time-referenced local audio data from locally generated audio and at least one master timecode, synchronizing a local timecode with at least one master timecode, or creating time-referenced local audio data from at least one local timecode, as in Strub and Woo, or a local audio device wearable by a creator of said locally generated audio, as in Strub. *Id.*; see also Petition at Ground 1, Elements 1[Pre], 1[C], 1[I], 13[I], 13[J]. Indeed, none of those limitations is present in Horiuchi or Leonard, and neither reference is relied on in the Petition.

The lack of evidence that the Examiner meaningfully considered Strub, Woo, Nagai, or Gleissner, or was aware of Samadani, is evidence of material error that favors institution. *Microsoft Corp. v. SurfCast, Inc.*, IPR2022-00590, Paper 9 at 15 (PTAB Oct. 7, 2022) (instituting where cited art “was not extensively evaluated during examination and was not the basis for a rejection”); *Amazon.com, Inc. v. M2M Sols. LLC*, IPR2019-01205, Paper 14 at 16 (PTAB Jan. 27, 2020)

(internal quotations omitted) (“a reference that was neither applied against the claims nor discussed by the Examiner does not weigh in favor of exercising the Board’s discretion under § 325(d) to deny a petition”).

For *Becton, Dickinson* factor (c), “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection” (*Advanced Bionics*, IPR2019-01469, Paper 6 at 10; *see also* DD Brief at 33), the Petition explained that “there is no evidence that Strub, Woo, Nagai, or Gleissner received meaningful consideration; none appear in an Office Action or any other substantive discussion in the prosecution file.” Petition at 84-85.

b. The Examiner Erred in Ignoring the Board’s Findings in the Lectrosonics IPRs

Strub, Woo, Nagai, and Gleissner were considered and analyzed by the Board in prior third-party IPRs challenging the ’902 patent and U.S. Patent Nos. 8,385,814 (the “’814 patent”) and 9,336,307 (the “’307 patent”) filed by third-party, Lectrosonics, Inc., listed below (the “Lectrosonics IPRs”). Petition at 9-13.

- ’902 Patent: *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129 (“the ’1129 IPR”);
- ’814 Patent: *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01130 (“the ’1130 IPR”); and

- '307 Patent: *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-00972

("the '972 IPR)

(collectively, "the Lectrosonics IPRs"). In the Lectrosonics IPRs, the Board found claims similar to the present Challenged Claims unpatentable over those references. Yet the Examiner of the '444 Patent failed even to mention the Lectrosonics IPR proceedings, let alone address the PTAB's findings in those IPRs. Representative overlap between the Lectrosonics IPRs and the challenged '444 patent claims are described below.

In the '972 IPR, the Board found claims 12-14 of the '307 Patent anticipated by Strub. Ex. 1014 at 25-26; Petition at 10-11. The Board necessarily found all elements of those claims present in Strub, including locally receiving local audio generated by at least one performer during an audio event. Petition at 10. Similarly, for example, Strub's disclosure of receiving local audio addresses claim element 1[b] of the '444 patent, which recites "a local audio device capable of communicating with the remote receiver and configured to receive locally generated audio." Petition at 35-40.

In the '972 IPR, the Board found that Strub discloses locally recording the local audio as local audio data in at least one memory of at least one local audio device wearable by a creator of said local audio. Petition at 10. Similarly, for example, Strub's disclosure addresses the preamble of claim 1, which recites a

“system for locally recording locally generated audio as time-referenced local audio data and for substantially simultaneously transmitting audio data to a remote device, the system comprising.” Petition at 26-29. Strub’s disclosure of a wearable local device also addresses claim element 1[c], “the at least one local audio device wearable by a creator of the locally generated audio.” Petition at 40-41.

In the ’972 IPR, the Board found that Strub discloses locally receiving or generating master time data including hour, minute, and/or second data. Petition at 11. Similarly, for example, Strub’s disclosure addresses claim element 1[I], which recites “create time-referenced local audio data from the locally generated audio and the at least one master timecode.” Petition at 53-54. Similarly, for example, Strub’s disclosure of locally receiving or generating master time data also addresses claim element 1[J], which recites “stor[ing] the time-referenced local audio data in the at least one local memory.” Petition at 55.

In the ’972 IPR, the Board found that Strub discloses wirelessly transmitting the locally generated audio to a remote recorder. Petition at 11. Similarly, for example, Strub’s disclosure addresses claim element 1[e], which recites “at least one local transmitter.” Petition at 44-48.

In the ’972 IPR, the Board found that Strub disclosed remotely recording the locally generated audio by the remote recorder as remotely recorded audio data.

See Ex. 1015 claims 12-14; *see also* Ex. 1014 at 21 (finding Strub discloses “a local audio device that records local audio and transmits the local audio to other remote devices”), 22 (“Strub’s device is ‘wearable’”). This finding is relevant to claim elements 1[pre] (Petition at 26), 1[B] (Petition at 35), 1[C] (Petition at 40), 1[F] (Petition at 49), and 1[K] (Petition at 56).

In the Lectrosonics IPRs, the Board also found that Strub discloses “at least one control unit electrically coupled to said local audio device receiver, said audio input device, said memory and said local timecode generator for creating stamped local audio data and storing said stamped local audio data in said memory,” that Woo discloses a “master timecode generator for generating a plurality of master timecodes,” and that a POSA would have been motivated to use Woo’s synchronization in Strub’s system. Ex. 1017 at 25-31; Ex. 1018 at 22-28; *see also* Petition at 12. For the same reason, Strub and Woo render claim element 1[A], “a remote receiver, the remote receiver configured to create at least one master timecode and to receive audio data,” obvious. Petition at 32-35. The Lectrosonics IPR Board found that: (1) Strub teaches (a) “a local audio device that...transmits...audio to other remote devices”—*i.e.*, there is necessarily a remote receiver that receives audio data from local audio devices—and (b) generating—*i.e.*, creating—master time data; (2) Woo discloses a “master timecode generator for generating a plurality of master timecodes”; and (3) a

POSA would have been motivated to use Woo's synchronization techniques in Strub's system. Petition at 32.

The Board found claim 1 of the '307 patent obvious over Strub with Nagai or Gleissner (Ex. 1014 at 19, 25), thus necessarily finding that Strub, Nagai and/or Gleissner teach "at least one local audio device...including...at least one audio input port for receiving said locally generated audio from an audio input device," and that it would have been obvious to combine Strub with Nagai or Gleissner. *Id.* at 4-5, 16-19; *see also* Petition at 11. In the '1129 and '1130 IPRs, the Board made similar findings regarding (1) the presence of the above-referenced limitations in Strub, Nagai, and Gleissner, and (2) the obviousness of combining those references. *See, e.g.*, Ex. 1017 at 25 (Strub's device "wearable by a creator of said locally generated audio"), 35 (finding '902 patent, claims 7-8 and 11 obvious over Strub, Nagai or Gleissner, and Woo), 40 (Strub teaches a local audio device that records local audio and transmits it to a remote device), 41 ('902 patent, claims 12, 14, and 15 anticipated by Strub); Ex. 1018 at 21-22 (Strub's device "wearable by a creator of said locally generated audio"), 32 (finding numerous '814 claims obvious over Strub, Nagai or Gleissner, and Woo); Petition at 11-12. Similarly, for example, these teachings in Strub, Nagai, and Gleissner render obvious the element of claims 13 and 26 reciting "at least one audio input configured to receive the local audio data." Petition at 74-78.

Patent Owner appealed the Board’s decisions in all three Lectrosonics IPRs. The Federal Circuit affirmed each in its entirety. *Zaxcom, Inc. v. Lectrosonics, Inc.*, Nos. 2020-1350, 2020-1405, 2022 WL 499843, at *1-2 (Fed. Cir. Feb. 18, 2022); *Zaxcom, Inc. v. Lectrosonics, Inc.*, Nos. 2020-1921, 2020-1922, 2020-1943, 2020-1944, 2022 WL 499848, at *1-2 (Fed. Cir. Feb. 18, 2022).

The only claims **not** found unpatentable in the Lectrosonics IPRs were substitute claims that added the limitation “replacing...[remote/remotely recorded] audio data with...local audio data.” Ex. 1014 at 64 (claims 1-14 unpatentable over Strub, Nagai, and Gleissner, replaced by substitute claims 15-28); Ex. 1015 at IPR Certificate, 1:30-31, 2:27-30; Ex. 1017 at 73 (claims 7-8, 11-12, and 14-15 unpatentable over Strub, Nagai, Gleissner, and Woo, replaced by substitute claims 21-26); Ex. 1030 at IPR Certificate, 1:41-43, 2:32-33; Ex. 1018 at 6 n.6, 63 (claims 1-4, 9-10, 12, 15, 31, 36-37, and 41-44 unpatentable over Strub, Nagai, Gleissner, and Woo, claim 45 (reciting storage of timecode-associated data in file header) unpatentable over those references plus U.S. Pat. 6,571,211 (replaced by substitute claims 50-65)); Ex. 1028 at IPR Certificate, 1:41-43. That limitation does not appear in any challenged claim of the ’444 patent in the present IPR. Petition at 85.

Contrary to Patent Owner’s assertion (DD Brief at 33), the Petition did “point out sufficiently how the Examiner erred in its evaluation of the asserted

prior art” (*Becton, Dickinson* factor (e)). The Petition explained in detail how “Strub, Woo, Nagai, and Gleissner were considered by the PTAB in the Lectrosonics IPRs, but” unlike in the prosecution of the ’444 patent, “in those earlier proceedings the Board found claims similar to the present Challenged Claims unpatentable over those references.” Petition at 85, 9-13. The only record of the Office’s substantive consideration of any of the presently presented prior art resulted in unpatentability findings and cancellation of claims similar to those challenged in this proceeding. In the institution decision for the challenge to the ’207 patent, the Board was persuaded that the challenged claims in that IPR found unpatentable “were sufficiently similar” to the *Lectrosonics IPRs* “to warrant reconsideration.” See *RØDE*, IPR2025-00232, Paper 14 at 19 (“Based on these unique facts, we determine that *BD* factors (e) and (f) do not favor denial”). Patent Owner acknowledges that “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.” Patent Owner’s Ex. 2014; DD Brief at 28. Yet, the Examiner overlooked these arguments entirely even though the same limitations appeared in the claims of the ’444 patent. The Examiner’s failure to recognize the PTAB’s findings regarding the teachings of Strub, Woo, Nagai, and Gleissner is a clear indication of material error in the examination of the ’444 patent and is relevant not only to *Becton, Dickinson* factor

(e)—demonstrating Examiner error—but also factor (f)—additional evidence and facts that warrant reconsideration of the prior art and arguments that Lectrosonics successfully presented in its IPRs but that the Examiner of the '444 patent improperly ignored. Discretionary denial under § 325(d) is not warranted.

IV. Conclusion

Patent Owner has not identified any legitimate basis for the Board to deny institution based on any discretionary factors. Moreover, the early challenge of the '444 patent further supports institution of the proceeding. The Board should institute trial.

Dated: July 7, 2025

/ Michael A. Fisher /
Jeffrey B. Plies, reg. no. 46,999
Michael A. Fisher, reg. no. 42,536
DECHERT LLP
Counsel for Petitioner

WORD COUNT CERTIFICATION

I hereby certify that this brief complies with the type-volume limitations of 37 C.F.R. § 42.24, because it contains 6,797 words (as determined by the Microsoft Word word-processing system used to prepare the brief), excluding the parts of the brief exempted by 37 C.F.R. § 42.24.

Dated: July 7, 2025

/ Michael A. Fisher /
Michael A. Fisher, Reg. No. 42,536
DECHERT LLP
Counsel for Petitioner

CERTIFICATE OF SERVICE

I certify that today in:

RØDE Microphones, LLC., et al. v, Zaxcom, Inc., IPR2025-00537 (U.S. Patent 12,051,444)

I caused to be served a copy of:

Petitioner's Opposition to Patent Owner's Discretionary Denial Brief

upon:

ZAXCOM INC., c/o:

Rita Chipperson - rcc@chippersonlaw.com

Janice Kwon - jk@chippersonlaw.com

Morgan Golightly - mdg@chippersonlaw.com

Gerard O'Rourke - gorourke@okorlaw.com

Sean O'Kelly - sokelly@okorlaw.com

Laura Carrig - lcarrig@okorlaw.com

via:

Electronic Mail

Dated: July 7, 2025

By: / Michael A. Fisher /
Michael A. Fisher, Reg. No. 42,536
Dechert LLP
Cira Centre
2929 Arch Street
Philadelphia, PA 19104-2808
Tel: 215-994-2079
Fax: 215-655-2279
michael.fisher@dechert.com