

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RØDE MICROPHONES, LLC and
FREEDMAN ELECTRONICS PTY LTD,
Petitioner,

v.

ZAXCOM, INC.,
Patent Owner.

IPR2025-00557
Patent 12,051,444 B2

Before JUSTIN T. ARBES, MIRIAM L. QUINN, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

McNEILL, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding
Granting in Part and Denying in Part Petitioner's
Request for Additional Preliminary Briefing
37 C.F.R. §§ 42.5, 42.108(c)

I. BACKGROUND

In the Petition (Paper 1, “Pet.”), Petitioners RØDE Microphones, LLC and Freedman Electronics Pty Ltd (collectively “Petitioner”) identify three co-pending IPRs involving patents related to the patent-in-suit, U.S. Patent No. 12,051,444 B2 (“the ’444 patent”): IPR2025-00230, which involves U.S. Patent No. 7,711,443 B1 (“the ’443 patent”), IPR2025-00231, which involves U.S. Patent No. 7,929,902 B1 (“the ’902 patent”), and IPR2025-00232, which involves U.S. Patent No. 10,276,207 B1 (“the ’276 patent”). Pet. xii. Petitioner also identifies district court litigation and three prior *inter partes* reviews that involved the same patents or related patents in the same patent family. *Id.* In particular, the Petition identifies *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-00972 (U.S. Patent No. 9,336,307 B2), IPR2018-01129 (the ’902 patent), and IPR2018-01130 (U.S. Patent No. 8,385,814 B2) (collectively “the Lectrosonics IPRs”). *Id.*

In an email to the Board dated July 17, 2025, Petitioner requests leave to file a preliminary reply to Patent Owner’s Preliminary Response in this proceeding. Ex. 3001. In the email, Petitioner requests leave to file a six page preliminary reply in order to address the following issues:

- (1) “[c]onstruction of ‘locally generated audio,’ and/or the presence of such features in the prior art in view of Zaxcom’s proposed construction;”
- (2) “[c]onstruction of ‘local audio device wearable by a creator of said locally generated audio,’ and/or the presence of such features in the prior art in view of Zaxcom’s proposed construction;” (3) “[c]onstruction of ‘master timecode’ and ‘master timecode generator,’ and/or the presence of such features in the prior art in view of Zaxcom’s proposed construction;” and
- (4) “[c]onstruction of ‘multi-track recorder,’ and/or the presence of such features in the prior art in view of Zaxcom’s proposed construction.” *Id.*

Petitioner’s email indicates that Patent Owner opposes additional preliminary briefing.

II. ANALYSIS

A petitioner “seek[ing] leave to file a reply to the preliminary response . . . must make a showing of good cause.” 37 C.F.R. § 42.108(c) (2024). “However, the Board does not expect that such a reply will be granted in many cases due to the short time period the Board has to reach a decision on institution.” Consolidated Trial Practice Guide at 52.¹

When determining whether a petitioner has shown good cause for a reply to a preliminary response, the Board may assess whether the argument at issue in the preliminary response was reasonably foreseeable. *See, e.g., Illumina, Inc. v. The Trs. of Columbia Univ. in the City of New York*, IPR2018-00797, Paper 17, 3 (PTAB Aug. 7, 2018) (Order) (stating that “the Board may authorize a reply to afford a petitioner the opportunity to address evidence or arguments that it could not have reasonably foreseen”); *Sandoz Inc. v. Abbvie Biotechnology Ltd.*, IPR2017-01824, Paper 13, 3 (PTAB Dec. 15, 2017) (Order) (same).

In IPR2025-00230, IPR2025-00231, and IPR2025-00232, Petitioner requested additional briefing to address the construction of “master timecode,” “master timecode generator,” and “locally generated audio,” and “the presence of such features in the prior art in view of” Patent Owner’s proposed constructions. *RØDE Microphones, LLC v. Zaxcom, Inc.*,

¹ Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019) (“Consolidated Trial Practice Guide” or “CTPG”), available at <http://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>.

IPR2025-00230, Ex. 3002². Petitioner argued that good cause existed because it was not reasonably foreseeable that Patent Owner would propose different constructions in those cases than were addressed in the Lectrosonics IPRs. *Røde Microphones, LLC v. Zaxcom, Inc.*, IPR2025-00230, Paper 9, 4. Petitioner also argued that it was not reasonably foreseeable that Patent Owner would propose new constructions for the claim terms “master timecode” and “master timecode generator” that are substantially different from the constructions adopted in the Lectrosonics IPRs. *Id.*

Patent Owner argued that it was reasonably foreseeable that the parties would disagree regarding claim construction. *Id.* Patent Owner also argued that Petitioner could have addressed claim construction in the petitions and it was Petitioner’s choice whether or not to address these issues. *Id.*

We found that Petitioner had shown good cause for additional briefing regarding Patent Owner’s proposed construction of the claim phrases “master timecode,” “master timecode generator,” and “locally generated audio,” as well as the alleged presence of such features in the prior art in view of Patent Owner’s proposed constructions. Specifically, we found that Petitioner had shown that it was not reasonably foreseeable that Patent Owner would propose a construction different from, and potentially broader than, the construction adopted in the Lectrosonics IPRs. *Id.* at 5.

The Petition in this case was filed on February 7, 2025, more than one month prior to the filing of Patent Owner’s preliminary responses in the

² For expediency, we refer to Paper and Exhibit numbers filed in IPR2025-00230. Similar Papers and Exhibits were filed in IPR2025-00231 and IPR2025-00232.

related IPRs on March 18, 2025. Thus, despite this Petition being filed after the petitions in the related IPRs, Petitioner was not made aware of Patent Owner's claim construction positions from the preliminary responses in advance of the filing of this Petition. Accordingly, for the same reasons we discussed in the related IPRs, we find that good cause exists for additional briefing regarding the claim phrases "master timecode," "master timecode generator," and "locally generated audio."

The same rationale also applies to the claim phrase "local audio device wearable by a creator of said locally generated audio." In particular, Patent Owner proposes a construction of this phrase different from the construction of "wearable" adopted in the Lectrosonics IPRs. Accordingly, good cause exists for additional briefing regarding the claim phrase "local audio device wearable by a creator of said locally generated audio."

However, we find that good cause for additional briefing does not exist for the claim phrase "multi-track recorder." Claim 6 of the '444 patent recites "[a] system according to claim 5, wherein the recording device is a multi-track recorder, a personal computer, a cellular phone, or a camera." Ex. 1001, col. 44, ll. 1–3. Claim 19 depends from claim 18, but otherwise recites similar limitations. *Id.* at col. 45, ll. 12–14. These are the only claims of the '444 patent that recite the claim phrase "multi-track recorder."

In the Petition, Petitioner does not rely on the prior art teaching the "multi-track recorder" limitation of claims 6 and 19, instead relying on the prior art teaching the alternative "camera" limitation. Pet. 63, 71. In the Preliminary Response, Patent Owner does not argue that the prior art fails to teach the "multi-track recorder" limitation. *See* Paper 7. Thus, based on the current record, despite Patent Owner proposing a construction of "multi-track recorder" (*id.* at 23–24), construing "multi-track recorder" does not

appear to be necessary to resolve the controversy between the parties. Accordingly, additional briefing on the issue is unnecessary. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“Because we need only construe terms ‘that are in controversy, and *only to the extent necessary* to resolve the controversy,’ we need not construe [a particular claim limitation] where the construction is not ‘material to the . . . dispute.’” (citation omitted) (emphasis added)).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s request for leave to file a preliminary reply addressing (1) Patent Owner’s proposed constructions of the claim terms “locally generated audio,” “local audio device wearable by a creator of said locally generated audio,” “master timecode,” and “master timecode generator,” and (2) “the presence of such features in the prior art in view of” Patent Owner’s proposed constructions, is *granted*;

FURTHER ORDERED that Petitioner’s request for leave to file a preliminary reply addressing (1) Patent Owner’s proposed constructions of the claim term “multi-track recorder” and (2) “the presence of such features in the prior art in view of” Patent Owner’s proposed construction, is *denied*;

FURTHER ORDERED that within ten (10) business days of the entry of this Order, Petitioner may submit its Preliminary Reply, limited to five (5) pages, addressing only the above-authorized issues;

FURTHER ORDERED that, within ten (10) business days of the entry of Petitioner’s Preliminary Reply, Patent Owner may submit a Preliminary Sur-reply, limited to five (5) pages and in response to the Preliminary Reply.

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