

Nos. 20-1921, -1922, -1943, -1944

In the
United States Court of Appeals
for the **Federal Circuit**

ZAXCOM, INC.,

Appellant,

v.

LECTROSONICS, INC.,

Cross-Appellant,

ANDREW HIRSHFELD, Performing the Functions and Duties of the Under
Secretary of Commerce for Intellectual Property and Director of the United States
Patent and Trademark Office,

Intervenor.

Appeal from the United Patent and Trademark Office,
Case Nos. IPR2018-01129 and IPR2018-01130.
The Honorable **Scott Russell Boalick**, **Kalyan K. Deshpande** and **Lynne Pettigrew**,
Administrative Patent Judges Presiding.

RESPONSE AND REPLY BRIEF OF APPELLANT
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INTRODUCTORY STATEMENT

Zaxcom in its principal brief presented substantial and meaningful claim construction arguments that, if successful, undisputedly should lead to reversal. Lectrosonics and the Director (as Intervenor) fail to offer meaningful rebuttals. Nor can they refute that the Board deviated from this Court's panel and *en banc* authority when refusing to give any weight to Zaxcom's objective indicia of nonobviousness (including an EMMY and an OSCAR), whichever way this Court decides the claim construction. The Court should grant the main appeal, by reversing in Zaxcom's favor. Zaxcom's arguments in reply carefully take apart each argument raised by Lectrosonics and Intervenor, demonstrating their emptiness in view of this Court's authorities.

No one disputes that the cross-appeal will be mooted by success in the main appeal. However, if Zaxcom's appeal does not succeed, Lectrosonics' cross-appeal should also fail, so that the contingent amendment of the claims would stand. The Board did not err in holding the substitute claims patentable over Lectrosonics' "weak" obviousness case—one that munges recreational hikers in Strub lugging backpacks of gear who paid no heed to dropouts as a problem, with a television broadcast distribution system in Wood that fixes dropouts in the unrelated field of *delivery* of audiovisual content in a user's home via use of the home's *hardwired* backchannel. Lectrosonics' arguments as to the lack of nexus

between the objective indicia and the substitute claims also lack merit, as do its attempts to ignore and downplay the prestige and depth of the industry praise and long felt need that fills this record.

REPLY ARGUMENT

I. REVERSAL ON ANTICIPATION OF CLAIMS 12, 14, AND 15 OF THE '902 PATENT REMAINS WARRANTED, SINCE APPELLEE AND INTERVENOR CANNOT REFUTE THAT THE BOARD ERRED IN CONSTRUING WHAT GETS “COMBINED”

In its opening brief, Zaxcom pointed out the Board’s erroneous claim construction for claim 12 (and dependent claims) of the ’902 Patent (Blue Br. 15-20, 30-39, 46-49). Zaxcom primarily relied on plain grammar and English usage. Claim 12 requires that “local audio data” must get “combined with remote audio data” (Appx195). Tracking the respective “local” and “remote” terms backwards in the claim, it is beyond dispute that each must source from the same audio (*i.e.*, original soundwaves) (Blue Br. 19-20, 37-39). This one irrefutable fact means that claim 12 (and dependent claims) cannot embrace multitrack recording, such as that disclosed in Strub. It can only embrace the Patents’ Dropout Embodiment—*i.e.*, situations where a better (local) recording of particular soundwaves combines with a possibly-degraded (remote) recording of the same soundwaves to repair the remote recording.

As additional (albeit, optional) support for its contended claim scope, Zaxcom dissected each of the Board’s individual record citations (Blue Br. 30-39). In its Final Written Decisions, the Board contended that these citations supported a broader

claim scope for Claim 12 and its dependent claims, that included both the Dropout Embodiment and the Multitrack Embodiment. But Zaxcom showed that the specification discussion of the Multitrack Embodiment involved two subtypes: a first that has nothing to do with wireless transmission (thus cannot support or relate to claim 12), and a second that is not a separate embodiment from the Dropout Embodiment but rather an inevitable precursor to it (Blue Br. 31-33, coining terms “Local/Local Multitrack Embodiment” and “Remote Multitrack Creation Embodiment” to aid this discussion). Zaxcom also showed the Board’s fundamental misunderstanding about extrinsic evidence (testimony from Mr. DeFilippis), attributing statements to him that he did not make, thus misunderstanding Zaxcom’s previously-submitted invention date proof (Blue Br. 33-35). All told, walking through the Board’s extrinsic and intrinsic evidence citations revealed no support for the broader claim construction, and certainly no evidence to counteract plain meaning derived ineluctably from grammar and English usage.

This claim construction error should lead to reversal. The Board’s ruling on the substitute claims demonstrates that, when construed as Zaxcom contends in this appeal, claim 12 is patentable over the asserted prior art because the claims are limited to a Dropout Embodiment (Blue Br. 47-49). The USPTO rightly confesses error if the Court agrees with Zaxcom’s construction. “The “USPTO agrees that

Strub does not anticipate original claim 12 if the Court accepts Zaxcom’s argument to limit ‘combining’ to a dropout repair embodiment” (Intervenor Br. 29 n.9).

Otherwise, the USPTO does not expressly respond on this issue (Intervenor Br. 28-29, incorporating and relying on pages 18-23 of its briefing for Appeal No. 20-1350 by reference). In the 20-1350 proceeding, the USPTO mostly restated the Board’s overbroad view of the specification without meaningfully addressing Zaxcom’s arguments (Intervenor Br. in Appeal No. 20-1350, at 18-21). In the one respect where the USPTO annotated the Board’s analysis, it made further errors. For example, the USPTO misinterpreted in isolation one sentence from the specification to conclude that “the multitrack recording can come from a combination of the centralized remote audio and the local recordings” (Intervenor Br. in 20-1350, at 21). But the specification never says this. The USPTO’s cited specification sentence merely explains: “audio from multiple local audio devices may be transmitted to a multi-track recorder for recording of the audio event while each local audio device locally records its performer’s audio” (Appx88, 14:33-36). This refers to pure multitrack creation at a remote recorder of the individual audio files received from each local audio device—*i.e.*, a receipt and blending of multiple individual “local” transmissions at one time to create a new multitrack file. Despite the USPTO’s best effort, it did not find a single specification sentence or example in which the *claimed*

things being combined according to claim 12 (“local” and “remote” audio data) map onto language used in the specification to disclose multitrack creation.¹

Nor does the USPTO try to refute the grammar and English usage argument that forms the core of Zaxcom’s analysis. While the USPTO purports to devote slightly more than one page of briefing to Zaxcom’s argument that the “local” and “remote” data in claim 12 must originate with the “same source,” the USPTO never actually addresses the grammatical ligatures and connections (namely, the ultra-precise “patentesque” uses of the term “said”) that prove Zaxcom’s point (Intervenor Br. in 20-1350, at 22-23). The USPTO instead posits that the claim uses the wording “at least one local audio device,” but this appears in a limitation involving local audio being stored as local audio data potentially in memory of multiple respective “local audio device” units. Just because redundant “local” units might facilitate dropout repair does not alter the grammatical analysis advanced by Zaxcom, *i.e.*, requiring that both sides of what gets “combined” originate from the same soundwaves.

¹ The Board, Appellee and Intervenor all lose sight of the fact that a “broadest reasonable construction” must still be “*reasonable*.” Here, the Patents discuss wireless multitrack creation by itself (without dropout repair) as the prior state of the art in the background of the invention (Appx183, Appx212). No party in this appeal has even tried to explain how it is reasonable to construe claim 12 so broadly that it covers technology the inventor admitted in the first columns of a patent to be prior art, nor how the USPTO’s examiners might allow a claim of such scope. The broader construction covering multitrack creation is manifestly *unreasonable*.

Like the USPTO, Appellee sidesteps and ignores Zaxcom's primary grammar and English usage argument (Red Br. 28-34). Zaxcom's argument points to express limiting language in the claims themselves. Appellee adopts the ineffectual strategy similar to the USPTO's of simply repeating the Board's holding and denying that there is anything wrong with it (*e.g.*, Red Br. 28-29, repeating mistaken finding Mr. De Filippis made an "admission" about claim scope, without noting Zaxcom's rebuttal at Blue Brief 34-35). Appellee wrongly suggests that Zaxcom seeks to read a particular embodiment into the claim when the language is broader (Red Br. 28-32, attempting to invoke specification-disavowal standards). But again, this is mistaken because Zaxcom's argument is based on express limiting claim language.

Appellee also misunderstands Zaxcom's discussion of the specification as a "strategy" to "recast[] each specification use of the word 'combine' as somehow depicting dropout repair by another name" (Red Br. 30). But this too is not correct. As explained already, Zaxcom discusses the specification primarily to expose Board misunderstandings, and to show that no specification language about creating a "multitrack" embodiment actually reads on or supports the local-data-combined-with-remote-data language of claim 12. In other words, focusing on "combine" alone without looking at what is being combined, improperly reads the express language of "local data" and "remote data" out of the claims.

Finally, also similar to the USPTO, Appellee purports to attempt a rebuttal to Zaxcom's "same source" argument on its own terms, but fails. Appellee contends that the "claims do not recite what device transmits the audio from what source" (Red Br. 32). That is beside the point, since the grammar question before the Court has to do with the nouns on opposite sides of the "combine" terminology ("local audio data" and "remote audio data"), and whether they derive from the same original soundwave source (what the claim labels "local audio generated by at least one performer"). They clearly do.

As part of its argument against Zaxcom's position, Appellee attacks a proverbial "straw man." Appellee criticizes Zaxcom for "failing to distinguish between 'local audio' and 'local audio data,'" while quoting from Zaxcom's Patent Owner Response in which Zaxcom indicated that the "same audio data" had to be both received locally and transmitted and stored remotely (Red Br. 32, citing Appx502). True, imprecise wording appeared on the cited page of the Patent Owner Response, but the rest of that document stated with better precision the current claim construction on appeal ("same source," not "same data") (*e.g.*, Appx483, Appx491, Appx504, Appx505, Appx508, Appx509). The Board also correctly understood Zaxcom to be presenting a "same source" argument, not a "same data" argument, and the latter is clearly contradicted by the express wording of the claims (Appx9-10). Most importantly, in this appeal, contrary to what Appellee states, Zaxcom

never contended “that the claims require ‘the same audio data’ to be received and stored locally and transmitted and stored locally” (Red Br. 33, purporting to quote Blue Br. 6, 37-39). The citations do not match the argument. It disserves the Court when an appellee quotes the appellant as having made an argument that the appellant did not actually make.

Appellee’s “straw man” strategy alone shows that Appellee lacks a meritorious argument to counter Zaxcom’s compelling grammar and English usage argument. The same source of audio must be involved in the “combining” limitation of claim 12. The various “said” connections and ligatures in claim 12 require this. This means claim 12 cannot cover multitrack creation but does cover the Dropout Embodiment. As the USPTO concedes, the Court should reverse since Strub does not anticipate the Dropout Embodiment.

II. REVERSAL ON OBVIOUSNESS OF CLAIM 7 OF THE ’902 PATENT AND CLAIM 1 OF THE ’814 PATENT REMAINS WARRANTED

A. Appellee and Intervenor Cannot Refute that the Board Erred in Applying the “Master Timecode Generator” Limitation

In its opening brief, Zaxcom pointed out errors in the Board’s analysis of Strub in view of Woo, and the requirement of claim 7 of the ’902 Patent and claim 1 of the ’814 Patent (and their dependent claims) for there to be a “master timecode generator” in a particular architecture (Blue Br. 42-45). In fact, nowhere did the prior art disclose a local timecode generator within an audio device controlled by another

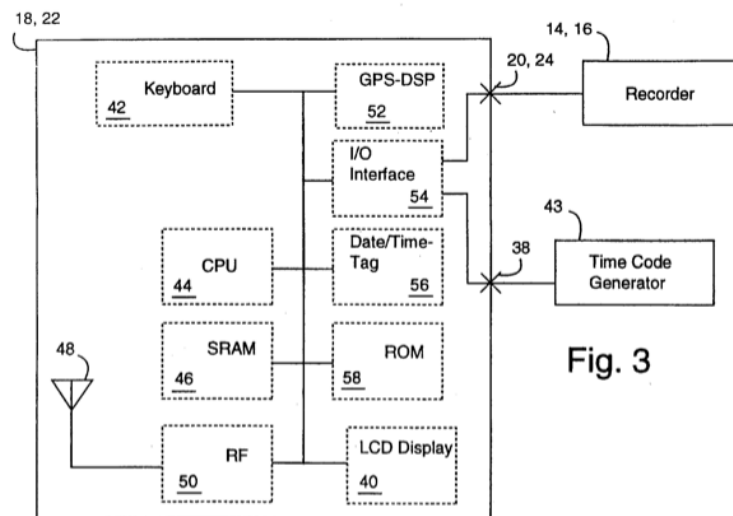
timecode generator. Zaxcom also pointed out that there is usually no obviousness under this Court's precedents when the asserted combination of prior art, even after being combined, lacks a claim limitation (Blue Br. 45). Here, the Board never found (nor attempted to find) the presence in the Strub/Woo combination of a master time code generator that controls another (local) time code generator within a "local audio device." No party on appeal reasonably contends otherwise.

The Board expressly looked to Woo for this claim limitation and architecture. Indeed, in response to Zaxcom pointing out explicitly that Strub lacked the relevant "local timecode generator" that gets controlled by a master, the Board disregarded Zaxcom's argument by stating, "as discussed above, Petitioner relies on Woo as disclosing this limitation" (Appx27 n.8). All eyes turned to Woo at the Board, which makes Woo the appropriate sole focus of analysis at this Court.

This is why the USPTO errs in stating that "Zaxcom improperly ignores that the Board, relying on Letrosonics' arguments, found that Strub already teaches the recited 'local timecode generator' located inside the local audio device" (Intervenor Br. 26, citing Appx22). But that did not happen. In fact, it is the USPTO who improperly ignores the Board. The Board both emphasized it was looking to Woo (not Strub) for these limitations (Appx27 n.8), and (contrary to the USPTO statement) did not "find" anything relevant about Strub (*see* Appx22, merely stating "Petitioner

asserts . . .;” “Petitioner further asserts . . .;” and “Petitioner further asserts . . .” without making findings on the assertions).

Consequently, under the Board’s actual findings, the asserted combination of Strub with Woo would have at most amounted to a modification of Strub into something like Woo’s Figure 3, to add a timecode input port. This would have included a GPS receiver (18, 22) that generates SMPTE timecodes that it sends over ports (20, 24) to clock-less audio recorders (14, 16), while “jamming” the same timecodes in parallel over a connection (38) into a standalone timecode generator (43), that in turn delivers them onward under direct connection to a film camera (Appx1551, Appx1556 7:26-48).



The crucial point here is that none of this “combination” architecture contains the *claimed* requirement of a master timecode generator controlling a local timecode generator inside an audio device. Strub would stand in the role of audio recorders

(14, 16), and (as modified with its timecode input port) not use any internal clock at all.

Just as with the USPTO, Appellee fails to undermine Zaxcom's strong case for reversal. Tellingly, Appellee begins this section with the heading, "As the Board Held, Strub Alone and in Combination with Woo Discloses the '*Master Timecode Generator*'" (Red Br. 36). But "Strub Alone" played no role in this analysis at the Board, and Appellee's brief contains no corresponding argument in the body of this section.

The rest of Appellee's argument asserts that the Board made "findings" it simply never did. For example, Appellee states (citing Appx105 and Appx22) that in the relevant combination, "Strub discloses 'at least one local timecode generator for generating a plurality of local timecodes' as recited in [the claims]. Zaxcom has not appealed that finding" (Red Br. 37). The problem for Appellee is that there were no such findings, and (again) Appx105 and Appx22 reported mere *contentions*—not Board findings. And like the USPTO, Appellee fails to acknowledge that the Board expressly refused to look to Strub for a controlled-local timecode generator, instead exclusively focusing on Woo for that limitation (Appx27 n.8). Appellee does not (and cannot) deny that within Woo, there is no local timecode generator whatsoever within any local audio device.

Finally, Appellee contends that “the Board discussed a combination where Woo’s ‘master clock’ provides timecodes to control the local timecode generator of Strub. Appx18-19; Appx29-30” (Red Br. 37). Again, not so. At Appx18-19, the Board discussed Appellee contentions (again, not findings) that never mentioned any “local timecode generator” in Strub but instead mentioned hypothetical addition of timecode input ports—an architecture agnostic as to whether a local timecode generator is involved (Appx18-19). Discussion at Appx29-30 went no further than to acknowledge a “sufficient rationale to combine the teachings,” but only in regard to adding to Strub a “timecode input port” for receiving time codes from Woo’s master clock, but without mention whatsoever about involvement of Strub’s local timecode generator.

Zaxcom’s argument remains unrebutted and irrefutable. The asserted combination lacks all claim limitations. For that reason alone, the Court should reverse the Board’s decision in this respect as well.

B. Appellee and Intervenor Cannot Refute that the Board Erred in Construing the “Wearable” Limitation

Separately from the master timecode issue, in its opening brief, Zaxcom pointed out errors in the Board’s analysis of Strub and the requirement of claim 7 of the ’902 Patent and claim 1 of the ’814 Patent that the system must be “wearable” (Blue Br. 10-14, 28-30, 39-42). This should have precluded any obviousness conclusion. No combination of prior art involved a system “wearable” in the sense

intended by the patents and all the evidence. Recall that the context of the claimed invention is audio capture from a performer during a performance—not hiking in the woods with buddies. Relevant and conclusive evidence included prosecution history showing a device much smaller than Strub was understood not to be “wearable” in this context because it was too big, and Appellee’s expert admission that a “hiking backpack” (like in Strub) was not “wearable” in this sense (Blue Br. 11, 13-14).

In response, the USPTO asserts collateral estoppel while Appellee asserts statutory estoppel (each discussed and refuted in the next section). On the merits, the other parties have little to say. The USPTO advances no independent points of its own, but relies entirely on Appellee’s argument (Intervenor Br. 25).

Appellee, in turn, argues that only a clear definition in the specification might justify Zaxcom’s proposed construction (Red Br. 23). This is not the law. Understandings of claim meaning should be derived from the intrinsic evidence first and foremost including, not just from the specification, but also the prosecution history. Extrinsic evidence may be relied on but it is less reliable than the patent and its prosecution history. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318-1319 (Fed. Cir. 2005) (“We have viewed extrinsic evidence in general as less reliable than the patent and its prosecution history in determining how to read claim terms, for several reasons... In sum, extrinsic evidence may be useful to the court, but it is unlikely to

result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence.”)

Appellee also asserts that the Board’s ultimate construction (“suitable and in a condition to be worn”) was first raised by Zaxcom, suggesting that Zaxcom presents a moving target position (Red Br. 23). But this is not so. Zaxcom’s original position took *two* pages of its Patent Owner Response (Appx493-494), not just the *one* page cited by the Board and Appellee (Appx493), and the full remarks set forth from day one Zaxcom’s complete construction as presented on appeal today (*see* Appx494, “small, lightweight, unobtrusive, easily hidden, not visible, and designed to be work on the body of a creator of audio (*i.e.*, performer)”).

From there, the bulk of Appellee’s argument consists of restating Board findings challenged on appeal without attention to Zaxcom’s analysis refuting them (Red Br. 24, noting Board disagreement with how Zaxcom characterized opposing expert testimony but ignoring Blue Br. 11-12), or otherwise advancing a narrative that Zaxcom should have stuck with its “first” construction of the term (Red Br. 23, “attempted to confound the clear . . . articulation it initially proposed;” Red Br. 24, “the broader dictionary definition agreed on by all at first . . .”). But as noted, Zaxcom has been consistent, and the present position is its “first” position. And Appellee remains completely silent about its expert admission that a hiking

backpack (*i.e.*, one like in Strub) is not “wearable” in the industry-understood context.

Appellee concludes by presenting three arguments for ignoring prosecution history evidence showing that Zaxcom and the examiner each believed that the Nagra V device (which was *smaller* than Strub) was still not “wearable” in the patented context. Crucially, these arguments avoid comparing relative sizes of Nagra V versus Strub in view of the term “wearable,” and thus sidestep the merits completely.

First, Appellee states that silence about Nagra V and the prosecution history in the Board decisions “indicates it was likely considered, just deemed unpersuasive” (Red Br. 24). This is rank speculation. But even if true, Appellee’s statement comes nowhere close to suggesting that the Board correctly understood the prosecution history and its significance.

Second, Appellee states that appearance of the issue in a surreply meant it was “untimely presented in a paper to which there could be no response” (Red Br. 24). This is doubly misleading. For one thing, if Appellee believed evidence or argument was improper, it should have used available Board procedures to move to strike or move in limine. It never did, likely because prosecution history is subject to judicial notice and is central to claim interpretation. *Whatsapp, Inc. v. Triplay, Inc.*, 752 Fed. Appx. 1011, 1016 (Fed. Cir. 2018) (nonprecedential) (“[I]t is

incumbent upon the party complaining of some procedural violation—such as the inclusion of improper rebuttal in a [PTAB] reply brief—to first raise the issue [at the Board] below”) (citation omitted). More fundamentally, Nagra V and the prosecution history issue was discussed extensively at the oral hearing by both sides (Appx781-783; Appx791-792; Appx797-798), showing there was no deprivation of any due process rights.

Finally, Appellee argues that the disavowal in the prosecution history was “ambiguous,” characterizing the record as merely an “off-hand comment by an Examiner” (Red Br. 25). This is also incorrect. Appellee relies on the fact that page 29 of the Blue Brief described Nagra V as “arguably ‘suitable and in a condition to be worn . . .’” (Red Br. 25), but this disregards page 13 of the Blue Brief which stated its “size was *certainly* ‘suitable and in a condition to be worn . . .’” (Blue Br. 13). And anyway, the prosecution history (reported at Blue Br. 29-30) speaks for itself and was anything but ambiguous. Nor was the exchange merely an isolated, unendorsed examiner comment. It included an express applicant claim amendment adding the term “wearable,” spurred by a prior Nagra V rejection, leading to examiner-commentary agreeing with the affirmative position on claim meaning effectively taken by the applicant by submitting the amendment. Specifically, the “[E]xaminer stated as his reasons for allowance that the closest prior art, Nagra V, did not teach the ‘wearable’ limitation even though it was a ‘portable audio recorder.’

Id. at 29. That is, portable devices that can be carried in a backpack like Nagra V and Strub were considered by the Examiner to be outside the scope of the ‘wearable’ claim limitation. *Id.*; EX2117” (Appx649).

In short, the other parties raise no merits-based reason to defend the Board’s overbroad construction of “wearable.” This stands as a second, independent reason to overturn the Board’s obviousness conclusions based on their lack of technical merit.

C. Zaxcom’s Sequencing of the “Wearable” Issue Among its Principal Briefs in This Combined Set of Companion Appeals Did Not Trigger Any Estoppel

Perhaps because it is so persuasive, both Appellee and the USPTO invite this Court to disregard Zaxcom’s “wearable” claim construction on mere procedural grounds. Appellee asserts that this is mandated under 35 U.S.C. § 315(e), in view of Zaxcom’s sequencing of the “wearable” issue so that it did not first appear in companion appeal 20-1350 but first appeared in appeal 20-1921 (the instant appeal).² Appellee’s argument lacks merit. Section 315(e) by its plain language does not apply to patent owners. It only operates to bind “[t]he petitioner . . . or the real party in interest or privy of the petitioner.” 35 U.S.C. § 315(e)(1). Likewise, as the USPTO

² Zaxcom sequenced the issue this way because the 20-1921 case has a more fully developed record, including full vetting by both sides of the Nagra V prior art and the prosecution history evidence surrounding it, and the “wearable” term. The Nagra V prior art did not explicitly appear in the parties’ briefing or arguments in 20-1350 (though it was available to the Board by administrative notice).

aptly points out, this statute “applies only to the same claim of the same patent, not separate related patents” (Intervenor Br. 24 n.6). Crucially, Appellee does not raise (or suggest) collateral estoppel / issue preclusion. Appellee has formally and completely waived such an affirmative defense. *Caldera v. Northrop Worldwide Aircraft Servs.*, 192 F.3d 962, 970 (Fed. Cir. 1999) (“collateral estoppel is an affirmative defense, which must be timely pled or generally it is deemed waived”).

The USPTO argues differently. While agreeing that Appellee’s preclusion theory is wrong (Intervenor Br. 24 n.6), the USPTO argues a different one: collateral estoppel. However, the USPTO cites no authority holding that collateral estoppel triggers during appeal just because an appellant has sequenced a particular issue for briefing in one of a set of companion appeals and not another, where all appeals otherwise remain pending. For example, in the case the USPTO cites, *Pabst Licensing GMBH v. Samsung Electronics America, Inc.*, 924 F.3d 1243, 1250-51 (Fed. Cir. 2019), the appellant voluntarily dismissed a companion appeal in which it raised a particular issue, causing a ripple effect of collateral estoppel barring the same issue in an appeal that the appellant had intended to remain pending. *Id.* No such dismissal has occurred here, either in 20-1350 or 20-1921.³

³ Highlighting that 20-1350 and 20-1921 are really, in effect and as a practical matter, one single overall appeal, the USPTO in its briefing consistently incorporates by reference its own brief previously filed in 20-1350 when it suits it (Intervenor Br. 8, 11, 28-29, 35). Collateral estoppel does not operate within a single matter on appeal. *See Rezzonico v. H&R Block, Inc.*, 182 F.3d 144, 148 (2d Cir. 1999).

In addition to a lack of case law support, several additional reasons foreclose the USPTO's collateral estoppel defense, especially in the context of still-pending companion appeals. First,

a bedrock principle of preclusion law has been that a reversed judgment cannot support preclusion; indeed, “a second judgment based upon the preclusive effects of the first judgment should not stand if the first judgment is reversed.” 18A Charles A. Wright, *et al.*, Federal Practice and Procedure § 4433 (2d ed. 2002) (footnote omitted); *see id.* § 4427 at 5 (“Should the judgment be . . . reversed on appeal, however, *res judicata* [in the sense covering both preclusion doctrines] falls with the judgment.”).

Levi Strauss & Co. v. Abercrombie & Fitch Trading Co., 719 F.3d 1367, 1372 (Fed. Cir. 2013). Here, it remains a strong possibility that appeal 20-1350 will result in reversal. Thus, even though Zaxcom sequenced the “wearable” issue to appear in the present 20-1921 appeal and not directly in the 20-1350 appeal, potential reversal on other issues makes appellate recognition of collateral estoppel at best contingent. This is implicit in the *Pabst* holding, which awaited final conclusion of the companion appeals before this Court would entertain collateral estoppel. The proverbial Schrödinger's cat is, at most, in an indeterminate state until this Court decides 20-1350. In any event, such sequencing should never lead to preclusion where the more robust Nagra V evidentiary record in this 20-1921 appeal justified placing the “wearable” appeal in this proceeding. *See* Restatement (Second) of Judgments § 29(8) and comment j (nonmutual offensive collateral estoppel should not be applied when “new evidence has become available that could likely lead to a

different result,” and “[i]t is unnecessary that the party seeking to avoid preclusion show . . . that the evidence could not have been discovered with due diligence”); *see also Rye v. United States Steel Mining Co.*, 856 F. Supp. 294, 278-79 (E.D. Va. 1994) (applying § 29(8) and comment j to refuse collateral estoppel because of new evidence, notwithstanding issues of diligence).

Second, the USPTO as Intervenor is not permitted to raise collateral estoppel since no party raises it. “Intervenors may only argue issues that have been raised by the principal parties; they simply lack standing to expand the scope of the case to matters not addressed by the petitioners in their request for review.” *Nat’l Assn. of Regulatory Util. Commrs. v. Interstate Commerce Commn.*, 41 F.3d 721, 729-30 (D.C. Cir. 1994); *see also Ga. Power Co. v. Teleport Communs. Atlanta, Inc.*, 346 F.3d 1047, 1049 (11th Cir. 2003) (“Except for extraordinary cases, an intervenor is precluded from raising issues not raised by the principal parties.”); *NSK Corp. v. United States*, 547 F. Supp. 2d 1312, 1317-19 (Ct. Int’l Trade 2008) (discussing caselaw in which “the respondent [intervenor] impermissibly enlarged the substantive issues by asserting an affirmative defense that had not been raised between the original parties”). Precedent allows the USPTO to “defend a PTAB decision when a petitioner withdraws on appeal,” *Knowles Elecs. LLC v. Iancu*, 886 F.3d 1369, 1372 n.2 (Fed. Cir. 2018), not to enlarge issues by asserting waived affirmative defenses untethered to the merits of such decision.

Third, even if a court concludes that all prongs of nonmutual offensive collateral estoppel have been established, it must still assure itself that it is fair to apply the doctrine. *Bifolck v. Philip Morris USA Inc.*, 936 F.3d 74, 84 (2d Cir. 2019) (courts retain full discretion to reject nonmutual offensive collateral estoppel based on “fairness” analysis, even if elements are present; remanding for such analysis) (citing *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 331 (1979)). This Court frequently receives companion appeals from the Board, sometimes involving large numbers of Board case numbers implicating numerous patents owned by the same party. Under the expansion of collateral estoppel that the USPTO proposes, an appellant would be forced to include in every appeal’s principal brief every possible relevant appealable issue across all appeals of all companion cases. This will bloat appellate practice. In contrast, sequencing of issues where appropriate (such as here, where one proceeding shines as having a more clearly-developed record, see n.2, above) lightens the Court’s burden in addressing its work, because it obviates undue repetition across principal briefs.⁴

⁴ Relatedly, preclusion would not create judicial efficiencies since both 20-1350 and 20-1921 involved already-tried Board proceedings on the “wearable” issue. *Gough v. Natural Gas Pipeline Co. of America*, 996 F.2d 763, 768-79 (5th Cir. 1993) (rejecting nonmutual offensive collateral estoppel when second trial proceeding was already complete, noting that “efficiency is [offensive] collateral estoppel’s only true justification,” thus “[i]t is too late to invoke the virtue of efficiency when the case has already been tried.”).

Finally, the USPTO's position invites administrative mischief. Taken to its extreme, a Board panel could address a first of multiple related Board proceedings having overlapping issues using a full final written decision on the merits against a patentee, but then proceed to shortchange every party in related proceedings by issuing mere "collateral estoppel" rulings in subsequent decisions as soon as the ink is dry on the first. Relatedly, the USPTO's position would force a losing patentee of multiple issue-overlapping decisions to appeal all of them on all issues, or else risk a collateral estoppel ruling, even if particular ones no longer make sense to pursue (*e.g.*, because a controversy against one of several opponents has extinguished). Fomenting inefficiencies this way makes no sense.

For all of these reasons, the USPTO's position on collateral estoppel is not the law, nor should this Court expand the law to embrace it, nor does the USPTO even have standing to raise a novel affirmative defense on behalf of Lectrosonics. For all of these reasons, no preclusion theory bars Zaxcom from presenting its compelling and correct "wearable" claim construction, or precludes sequencing of issues across still-pending companion appeals where they fit best.

D. Regardless of Claim Interpretation Errors, Appellee and Intervenor Cannot Refute the Board's Erroneous Treatment of Objective Indicia of Nonobviousness

Zaxcom in its opening brief confronted and refuted head-on the Board's errors in its handling of objective indicia in this case (Blue Br. 49-60). The Board ruled in

two parts. First, it ruled under this Court’s newly-emerged *Fox Factory* decision that praised products were somehow not “coextensive” with the claimed invention (Appx33, Appx61, Appx82-83, Appx115). This, to the Board, justified its refusal to recognize a presumption that the exceptional EMMY and OSCAR awards (and related documentation and testimony embodying praise and long felt need) had a “nexus” to the claimed invention. Then acknowledging that a presumption is only one of two alternate ways a patentee can show nexus, the Board then addressed whether it would weigh the awards and related evidence anyway, on Zaxcom’s direct evidentiary showing of nexus. The Board again refused, giving Zaxcom’s evidence (including an EMMY and OSCAR) zero weight, under the misimpression that praise and related evidence went to unclaimed features of the products in question— dropout repair (Appx32-35).

Zaxcom’s opening brief made two simple irrefutable points, exposing error in both prongs of the Board’s analysis. First, the products were legally “coextensive” because they were embodiments of the claimed invention (Blue Br. 50, n.1). This Court’s decision in *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317 (Fed. Cir. 2016) (supported by legal standards announced in the *Apple en banc* decision) held that if products embody the patent claims, that alone is “sufficient” for the presumption to attach in industry praise cases. The Board failed to apply this principle, even though it had cited *WBIP*. Second, even if no presumption were available, the industry praise

explicitly recited product features that are undeniably part of the novel combination of the claims (*e.g.*, timecode management), in addition to praising the dropout repair product feature (Blue Br. 51-57). Two amici filed briefs to support Zaxcom and to further explain error in the Board’s handling of industry praise law (ECF#25 from Former Chief Judge Paul Michel; ECF#26, from nonprofit US Inventor).

On appeal, both the USPTO and Appellee try to justify and rehabilitate the Board’s decision. Underscoring how important it is for this Court to address forcefully the mishandling of the Board’s treatment of objective indicia, the USPTO Director made the underlying decisions “precedential” under his self-granted authority under SOP 2. Thus, every Board panel must currently (until this Court holds otherwise) follow the misapplication of law established in the underlying Board decisions on appeal today. The public urgently needs this Court to repair the patent law.

Neither of the other parties to this appeal comes close to overcoming Zaxcom’s strong showing of error. The USPTO offers only makeweight defense of the Board. First, the USPTO asserts that *WBIP* and *Fox Factory* state “the same coextensiveness standard” (Intervenor Br. 32). This is plainly untrue. *WBIP* states that it is “sufficient” for a coextensiveness conclusion (thus permits a nexus presumption) in an industry praise context if a product embodies the patent claims, except for a limited exception when the claim covers a mere component of a praised

product and the praise does not reach that component. *WBIP*, 829 F.3d 1329, n.7. By contrast, *Fox Factory* adds additional requirements. These requirements withhold a coextensiveness conclusion (thus do *not* permit a nexus presumption) if a product has additional “critical” unclaimed features claimed by a different patent that materially impact the product’s functionality. *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1375 (Fed. Cir. 2019). The law is in disharmony, a situation that must, of necessity, trigger the rule that an earlier Federal Circuit panel decision controls in case of conflict, in this case *WBIP*.

Concerning how Zaxcom met the presumption standard, the USPTO expresses confusion about where in the administrative record Zaxcom showed coextensiveness, but that contention was in the foreground throughout Zaxcom’s Board briefing (Patent Owner Response, Appx541-548 (claim chart); Surreply, Appx672-673, “Petitioner did not even attempt to show that these devices for which Zaxcom received the [OSCAR] and Emmy awards are merely components.”). The only remaining USPTO argument against a nexus presumption contends that Zaxcom on appeal presents a “forfeited” argument when it maps the administrative record onto the new and more onerous *Fox Factory* standards for coextensiveness (Intervenor Br. 34). That is misdirection for two reasons. First, Zaxcom could not waive this showing since it only became germane after all Board proceedings had ended, based on the late emergence of *Fox Factory*. And second, this Court does not

recognize it as a waiver for a party to support an argument made below (*i.e.*, Zaxcom products “commensurate with the scope of the claims,” Appx672-673) with citation to additional record support. *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323, 1346-47 (Fed. Cir. 2001).

On Zaxcom’s direct evidence pointing (*e.g.*) to EMMY materials and testimony highlighting the significance of praise for the products’ timecode management features (undisputedly embodied in the claimed master timecode generator architecture of claim 7 of the ’902 Patent and claim 1 of the ’814 Patent), the USPTO grudgingly acknowledges that the Board’s praise evidence did address other features besides dropout repair (Intervenor Br. 36-38). But the USPTO falls short of excusing the Board’s errors. Indeed, the USPTO virtually confesses error with this admission. Namely, the USPTO seems to misperceive that the Board gave this evidence some weight, made a threshold nexus finding, and conducted a proper weighing of award evidence against the proffered technical obviousness case before reaching its conclusions (Intervenor Br. 37, “Board’s weighing of Zaxcom’s evidence is reviewed for substantial evidence and given ‘broad deference,’” criticizing Zaxcom’s alleged “attempt on appeal to revisit and reweigh the evidence”). To the contrary, the Board found utterly no nexus, and gave objective indicia zero weight (Appx35, “not persuaded there is a nexus” / “evidence does not weigh in favor of nonobviousness”). No “weighing” occurred here at all, which is

precisely the problem. As the Board's disposition of the substitute claims shows, had proper weighing occurred, the Board would have found nonobviousness.

Just as the USPTO falls short, Appellee also cannot justify the Board's errors in handling nexus and objective indicia. Appellee offers a confused jumble of attacks on isolated Zaxcom sentences, without placing its complaints into the framework of (1) nexus presumption standards, or (2) nexus direct evidence standards that receive full play regardless of presumptions. So, for example, Appellee criticizes Zaxcom for explaining that fixing dropouts undisputedly results from the systems of the relevant claims, even if not expressly made claim limitations, hence the present record includes praise for the "merit" of the claimed invention supporting a nexus finding even for claims where dropout repair is not explicitly a claim limitation (Red Br. 39). Deriding this as unauthorized "helper" nexus, Appellee misstates that Zaxcom did not cite a case to support its position, but Appellee overlooks that Zaxcom did for that exact proposition: *WBIP* (Blue Br. 56). In any case, Appellee's out-of-order critique only addresses the "merit" question, which is itself only a proper nexus-*rebuttal* issue, not a probative question about (1) presumptions or (2) direct evidence for triggering at least some weighing by the Board. In fact, throughout its arguments against nexus at Red Brief pp. 38-41, Appellee never refutes or undermines Zaxcom's primary appeal arguments that (1) Zaxcom's praised products are embodiments of the claims and thus entitled to the presumption

under *WBIP*, or (2) that at least Mr. Wexler's testimony and the EMMY documentation calls out timecode management in particular and thus satisfies (as the USPTO concedes) that there was direct evidence of industry praise of express claim limitations within the novel combinations.

Appellee also suggests some kind of waiver foreclosing Zaxcom's ability to argue the "presumption" (although not foreclosing "direct evidence" argument) (Red Br. 42-44). That is incorrect. As mentioned, Zaxcom's showing of coextensiveness was in the foreground throughout Zaxcom's Board briefing (Patent Owner Response, Appx541-548 (claim chart); Surreply, Appx672-673, "Petitioner did not even attempt to show that these devices for which Zaxcom received the [OSCAR] and Emmy awards are merely components."). Again, prior to *Fox Factory*, a challenger could theoretically rebut that a product was "commensurate" or "coextensive" with the scope of the claims when the product is an embodiment of the claims, but only by showing that the product was a mere component. *WBIP* at 1329, n. 7. Zaxcom's Surreply in particular (quoted above) directly addressed this legal standard by refuting that Appellee had met its burden on the question. Zaxcom's Board filings addressed presumption-intrinsic legal standards, and thus adequately preserved the "presumption" issue.

At bottom, Appellee cannot cite a single decision of this Court that, in an industry praise context and outside a commercial success context, withheld a finding

of “nexus” because a product that embodies a claim was not somehow also “coextensive” with that claim. *WBIP*, 829 F.3d 1329, n.7, confirmed the limitation of the “coextensiveness” exclusion in industry praise cases to situations where a claim covered only a component—clearly not the case here—and *Apple en banc* further confirmed that it “weighs against an assertion that the same claimed invention would have been obvious” when there is industry praise of “a claimed invention or a product that embodies the patent claims [full stop].” *Apple, Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1053 (Fed. Cir. 2016) (*en banc*). These are crystal clear expressions of what little a patentee must show to get a nexus presumption. There is no harm to the public to reaffirm these bedrock legal principles. When a nexus presumption exists, a challenger always has the ability to prove that the industry praise was for something other than the merit of the claimed invention—a task Appellee refuses to take on because no evidence of that sort ever existed or was presented in these proceedings. Unfortunately, Appellee persists in confusing the law by front-loading *presumption* standards with the labor and work that the law actually assigns to a challenger to meet its *rebuttal* standards. Reversal is warranted, and the public needs clarification of the law from this Court.

CROSS-APPEAL RESPONSE ARGUMENT⁵

I. LECTROSONICS' CROSS-APPEAL LACKS MERIT

The only possible error by the Board in granting the motion to amend (“MTA”) was in not naming *even more* reasons why the substitute claims were patentable over the prior art combination of Strub and Wood. For example, the Board should have recognized that Zaxcom’s products falling within the substitute claims’ scope received relevant industry praise and satisfied a relevant long-felt need, leading *presumptively* to a nexus finding for reasons discussed above (*i.e.*, not requiring a *weighing* exercise, or scrutiny of the record for “reasons” Zaxcom won key awards). The Board also should have credited the properly-construed “wearable” limitation, and the timecode management limitations, as further distinctions over the art. But this kind of error was not prejudicial error against *Appellee* to justify a cross-appeal. In fact, though it did not go far enough, the Board’s analysis of patentability was sound as far as it went, and substantial evidence review does not permit reweighing of evidence or retrying of the case.

The USPTO agrees with this position, and Zaxcom hereby incorporates by reference Section 2 of Intervenor’s brief entitled “[t]he Board correctly determined that the substitute claims, limited to dropout repair, are patentable” (Intervenor Br.

⁵ This cross-appeal response is not identical to, but is very similar to, the cross-appeal response in the 20-1350 appeal.

38-44). Zaxcom agrees with the USPTO that: (1) “[t]here was no error in the Board’s procedure here, where the Board considered properly presented record arguments and evidence on objective indicia of non-obviousness relevant to proposed substitute claims;” (2) “the Board’s finding that Lectrosonics ‘presents a weak case of obviousness’ is consistent with the record;” and (3) “[t]he Board additionally correctly found that Zaxcom’s evidence of long-felt need favored nonobviousness” (Intervenor Br. 40, 43).

A. The Board Properly Construed Zaxcom’s Nexus Arguments

Lectrosonics’ arguments that Zaxcom “failed in its burden to show *prima facie* nexus” and the “Board abused its discretion in making nexus arguments for Zaxcom” ignore the plethora of evidence and arguments set forth throughout Zaxcom’s pleadings generally and, in particular, those set forth in Zaxcom’s MTA Reply Brief at Appx697-699 (*i.e.*, a brief that gets full credit as part of the record in view of no request by Lectrosonics to have it stricken). Not only does Zaxcom provide numerous examples linking its industry praise and long felt need to the claimed elements, it goes to the extent of, *inter alia*, putting forth Mr. DeFilippis, a *member of the committee* that granted the Emmy award to Zaxcom, as an expert witness to speak about his *first-hand knowledge* of this award and the reasons it was granted to Zaxcom. Mr. DeFilippis specifically testified at length that the committee awarded the Emmy to Zaxcom for the claimed elements. See Appx4370 (the Emmy

award is “[n]ot for a single component but for the system as a whole,” and discussing, first, “provid[ing] backup recording of the original microphone signal.”)

Quite to the contrary of Lectrosonics’ suggestion, the Board did not “make[] nexus arguments for Zaxcom” (Red Br. 46), and this suggestion is in contradiction with the plain text of the Final Written Decisions. Notably Lectrosonics has not specifically *cited* any purported new arguments set forth by the Board because the Board did not make any such “new” arguments.

Further, in citing Appx62-72, Lectrosonics incorrectly asserts that “in the ten pages after the Board assumed the right to *select* the nexus arguments, not a single citation in support is taken from the sequence of briefs associated with the Motion to Amend.” *Emphasis Added*. First, Lectrosonics contradicts itself. Did the Board “make arguments” for Zaxcom or did it “select” Zaxcom’s arguments? Second, Lectrosonics is incorrect because the Board literally begins its discussion of nexus by citing to the MTA and no less than seven exhibits set forth by Zaxcom therein as support for nexus, namely, Exs. 2111 ¶¶ 55–61, 2098, 2099, 2100, 2101, 2102, and 2087 ¶¶ 8–10) (Appx62, Appx138).

Further, after citing the MTA, the Board continues to cite over three pages of additional arguments and evidence found in non-MTA portions of the record including the testimony of various experts and other evidence set forth by Zaxcom. The Board did not “make” these arguments on behalf of Zaxcom. Not only was the

Board well within its rights to rely on the full record (including the Patent Owner Responses and Sur-replies) when deciding issues relating to patentability of the substitute claims, it was required to do so to avoid acting in an arbitrary and capricious manner. “In the context of this case, accordingly, we believe that the Board’s decision to reject Aqua’s proposed amended claims *without consideration of the entirety of the IPR record* was an abuse of discretion which provides an independent basis for our judgment vacating and remanding this matter to the Board ... we believe it is a fairly uncontroversial proposition under the APA.” *Aqua Products, Inc. v. Matal*, 872 F.3d 1290, 1326 (Fed. Cir. 2017) (*en banc*) (emphasis added).

Although Lectrosonics sets forth the position that the *Aqua Products* opinion should be limited to “the unique context of vetting and challenging amendments as unpatentable,” (Red Br. 58), the *Aqua Products* opinion makes no such distinction. Lectrosonics attempts to apply legal standards bestowing full-record consideration when a challenger opposes a motion to amend, but myopic moving-papers-only consideration when a patent owner supports a motion to amend. The law does not permit such asymmetry, nor unequal protection, based solely on which side the Board favored. To the contrary, *Aqua Products* clearly states “Section 318(a) provides that, where it proceeds to a final written decision, the Board is to issue a decision on the patentability of both originally issued, challenged claims and

any amended claims. That final substantive decision must be based on *the entirety* of the record. Basic principles of administrative law compel this conclusion.” *Id.* at 1325 (emphasis added).

Lectrosonics also analyzes *Nike Inc. v. Adidas AG* to bolster its position, but again misses the mark (Red Br. 58-59). *Nike* confirms that the Board may raise a patentability issue for a substitute claim *sua sponte* provided proper notice is given, however this is irrelevant in the instant case because the Board did not raise any issues *sua sponte* and there were no surprises here. Rather, as discussed above, it relied upon Zaxcom’s proffered arguments and evidence with great specificity in its analysis of nexus (Appx62-72).

B. Substantial Evidence Supports the Board’s Determination that Lectrosonics’ Obviousness Arguments are Weak

The Board determined that Lectrosonics’ obviousness arguments for claims limited to the Dropout Embodiment were weak on numerous grounds including: 1) the failure of Strub to specifically contemplate deficiencies resulting from dropouts in transmission of local audio to a remote recorder or receiver (*See* Appx1334 48:18–30, Appx1353 85:28–41); and 2) a lack of motivation of one of ordinary skill in the art to combine Wood with Strub to repair any such purported deficiencies (assuming one were to contemplate such deficiencies)(Appx59-60). These findings are supported by substantial evidence.

Regarding (1), the Board is correct that not only does Strub not contemplate deficiencies resulting from dropouts in transmission, but it specifically states that this is *not* an issue because users will commonly be near each other anyway before they commence Strub's version of media sharing. "[T]hough such a limitation does preclude a recorder from storing recording data obtained by other recording units ... it is anticipated that this limitation will often be of little or no detriment, since it will often be the case that the recorders have a sufficiently close relationship that the recorders can, and will, exchange recording data after the event is over, thus enabling each recorder to obtain, if desired, part or all of a recording obtained by another recording unit" (Appx1329, 37:18-27). That is, Strub does not deny that dropouts could happen, but shrugs his shoulders in not considering it a problem, considering how users will most commonly initiate his media sharing feature.

As far as motivation to combine Strub and Wood, as the Board correctly opined, the evidence that a person with ordinary skill in the art would have looked to combine an allegedly (and *arguendo*) small, wearable device for recording the audio of an event, as taught in Strub, with a method for repairing a TV broadcast signal, as taught in Wood, does not support a strong showing of obviousness (Appx60). Petitioner failed to provide experimental data or other objective evidence indicating that a "skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the

skilled artisan would have had a reasonable expectation of success in doing so.” *OSRAM Sylvania, Inc. v. Am Induction Techs., Inc.*, 701 F.3d 698, 706 (Fed. Cir. 2012).

Lectrosonics attempts to set forth various passages from Wood that purportedly teach the motivation to combine (Red. Br. 48). However, this evidence fails on multiple fronts. Most notably, the recording device of Wood requests retransmission of corrupted portions of a broadcast via a fixed line back channel, thereby ensuring that the request is not corrupted by the same interfering characteristics that plague the (wireless) broadcast channel (Appx1420, ll. 24-30). As testified by Mr. DeFilippis, “[u]sing such a hard-wired solution in Strub would be impractical, as it would require multiple participants recording an event to connect to one another via wires. A POSA would not have been motivated to use a wireless channel instead for the retransmission because using a wireless channel for broadcast and another wireless channel for retransmission in the same environment between the same two endpoints (*i.e.*, two participants recording the same event from different vantage points) would subject both channels to the same interference. This would result in an inoperable system for correcting dropouts” (Appx3137-3138, ¶ 79).

Lectrosonics has failed to explain in any of its papers how a wired connection could be used to fix dropout repair in a “portable video recorder and auxiliary device”

that is allegedly meant to be wearable by the users (Appx1299, Title). It is untenable to think the hikers depicted in Fig. 1 can be connected via a fixed wire connection to a server in order to facilitate some type of backup repair as is required and taught by Wood. A hardwired connection coupled to a server is not compatible with the “low attention recording” described in Strub in which “the act of recording need not, and typically does not, (appreciably) affect interaction of the recorder or others with the environment in which the recording is taking place” (Appx1314, 8:31-36). In short, Lectrosonics cannot show a lack of substantial evidence for Board “no-motivation” findings by ignoring on appeal the full teachings of the prior art, including those teachings that refute any reason to combine. That such teachings against combining exist in the record at all protects the Board’s decision from reversal under the “substantial evidence” standard, because this Court does not reweigh evidence to make findings anew.

As best stated by Mr. DeFilippis, “[t]herefore, applying the Wood solution in post-production in Strub would have been unnecessary. A POSA would not have been motivated to change Strub’s simple system with a complex technical solution requiring multiple transmitters and receivers, delay circuitry, commands and requests, etc., especially because doing so would dramatically increase the size, weight and battery requirements of the bodypacks, making the Strub body pack

unwieldy, cumbersome and impractical for its intended use for ‘low attention recording’” (Appx4562, ¶ 51).

The weakness of Lectrosonics’ obviousness arguments is exacerbated for Claim 1 of the ’814 Patent, Claim 7 of the ’902 Patent, and their dependent claims because (as argued earlier in this brief) the Board lacked substantial evidence for finding that any item or combination of prior art contained the particular “master timecode generator” architecture of the claims. Not only did the prior art (including Strub and Wood) lack any disclosure of a local or other timecode generator within an audio device that can be controlled by a master timecode generator, as mandated by the Board’s construction of “master timecode generator,” but the Board did not even attempt to identify such a thing. Although reference is made to a “jammable” “timecode generator 43” in Woo, this Woo generator does *not* exist inside a local or other audio device, and its purpose is to be a standalone device that merely sends timecodes to an external “camera.”

C. The Argument that the Claims Do Not Require a “Digital Wireless Transmitter with Internal Recording” or “Internal Recording” within a Transmitter

Lectrosonics sets forth various arguments in an attempt to demonstrate that the claims do not require a “digital wireless transmitter” or “internal recording” in an attempt to separate the evidence of secondary considerations, including industry praise, from the claims of the ’814 and ’902 Patents. Again, this simply attempts to

sidestep the Board's finding that the record showed praise related to digital recording to provide "backup" recordings, and hence related to dropout repair (Appx64-65, Appx140-141). But even if its argument were somehow probative, Lectrosonics errs in its analysis.

All substitute claims at issue require the sort of "digital wireless transmitter" named in the industry praise evidence. Although a "transmitter" is known in certain contexts as a specific RF electrical component, when the term transmitter is used by experts and by Zaxcom's industry in the context of Zaxcom's products and the praise thereof, people mean the performer's worn microphone system as a whole, and not an internal transmitter component. After all, a "transmitter" in its strictest sense does not record. The Board understood this. The awarding committees did, too. The EMMY evidence, for example, lavished praise on "a production tool that married wireless transmission with a recording device located within the actor's body pack" (Appx4370). Such praise as worded did not depend on the "body pack" that has internal recording actually performing the RF "wireless transmission."

Zaxcom made this distinction in its opening briefs— "the first digital wireless transmitter with internal recording having model nos. TRX900, TRX901, TRX910, and TRX990 and also referred to in the record as 'transmitters'" (Blue Br. 54). That is, in contemporary times, Zaxcom's industry typically refers to these body pack type systems as a whole as "transmitters," as long as some part of the system

“transmits” the performer’s audio. The substitute claims all cover a system capable of transmitted performer audio. Substitute claim 50 of the ’814 Patent and substitute claim 21 of the ’902 Patent (and their dependent claims) require “a wireless transmitter transmitting said locally generated audio to said at least one remote recorder,” and substitute claim 24 (and its dependent claims) require “wirelessly transmitting said local audio to at least one of the groups consisting of a recorder, a receiver, and combinations thereof” (Appx444, Appx449, Appx7577).

The same conclusion holds with respect to transmitters in the praise and long felt need evidence, and transmitters of the ’902 and ’814 Patent claims, sharing the characteristic of being “digital.” The digital nature of the claimed product is evident in claim language that requires the “at least one control unit . . . for creating stamped local audio data . . . and storing said stamped local audio *data* in said *memory*” or the step of “locally recording said local audio as local audio data *in at least one memory* of at least one wearable local audio device.” *Emphasis Added*. Technologically, one of skill in the art would understand that the claimed system and method could only be digital, since no non-digital system could operate as claimed—*i.e.*, with “data” stored in a “memory.” Accordingly, it was unnecessary, and would have been redundant, to affirmatively include the term “digital” in the express language of the claims.

Similarly, the claims also require “internal recording” in precisely the sense used within the industry praise evidence. With regard to all substitute claims at issue, Lectrosonics appears to infer erroneously that the claims do not require “internal recording” because they are broad enough to allow all local functionality to be split between multiple belt pack devices that are electrically coupled on one person’s body. For instance, consistent with the claims, one piece might have the “memory,” another might have RF transmission electronics to achieve “wireless” transmission of audio, and these two pieces might couple together via a cable. As such, the overall “transmitter” of the claims (again, the industry lingo for the whole performer belt pack system of the claims, Appx4370) has “internal memory.”

Nonetheless, Lectrosonics on appeal equates “internal recording” with the need of all features of the claimed local audio device to be included within one box or housing.⁶ “[T]he claims do not require the transmitter and memory be within the same ‘at least one local audio device’” (Red Br. 68). This is an erroneous interpretation of the industry praise evidence that names “internal recording.” Again, the EMMY evidence praises “a production tool that married wireless transmission

⁶ Zaxcom believes that Lectrosonics raises this argument to advance a future noninfringement theory about one box versus two. Even if this were appropriate in this appeal, typical application of the doctrine of equivalents holds that one does not escape infringement liability by separating components of the invention. *Toro Co. v. White Consol. Indus.*, 266 F.3d 1367, 1370 (Fed. Cir. 2001) (“[I]f an accused infringer has simply separated into two components what the patentee has claimed as one component, a fact finder might indeed find such a change ‘insubstantial.’”).

with a recording device located within the actor's body pack" (Appx4370), a statement clearly unconcerned with whether a single box or housing contains *both* RF circuitry *and* data memory. Nothing in the record suggests Lectrosonics' interpretation.

Although Zaxcom's commercial product is a one box solution, the claims and the industry praise evidence are broader than that. This makes sense in terms of real-world benefits. One receives the technological benefits of the praised "internal recording" feature even after, for example, splitting the components of one belt-worn, body pack box between two adjacent belt-worn, body pack boxes coupled to each other with a cable as suggested by Lectrosonics. Praise for "internal recording" speaks to overall integration of the local recording with the other components of the system to achieve benefit in film and video production. Nothing suggests that the praise only pertains to a one-box solution, excluding a two-box solution achieving the same benefits.

Lectrosonics simply has no basis for, and has provided no support for, the proposition that the "internal recording" feature named in the industry praise only covered a one-box solution, or was otherwise for an unclaimed feature. It certainly falls short of its appellate burden to show lack of substantial evidence for Board findings that the industry praise related to the claimed invention of the substitute claims. And again, the issue discussed in this subsection is not actually probative in

this appeal, since praise for digital recording to provide “backup” recordings exists in the record (directed to express limitations of the substitute claims) (Appx61-70), even if the Court accepted every aspect of this particular Lectrosonics argument.

D. The Argument that the Obviousness of a Feature Known in the Art Cannot be Overcome by Secondary Considerations

Lectrosonics argues that “[p]raise of features known in the art cannot overcome obviousness” (Red Br. 65). Zaxcom denies that the industry praise was limited to features known in the art, but, even if this were true, Lectrosonics overlooks an important aspect of the cited principle: “what was not known in the prior art . . . may well be the novel combination or arrangement of known individual elements.” *Novartis AG v. Torrent Pharm. Ltd.*, 853 F.3d 1316, 1331 (Fed. Cir. 2017). “Where the allegedly obvious patent claim is a combination of prior art elements, we have explained that the patent owner can show that it is the claimed combination as a whole that serves as a nexus for the objective evidence; proof of nexus is not limited to only when objective evidence is tied to the supposedly ‘new’ feature(s).” *WBIP*, 829 F.3d at 1330; *see also Chemours Co. FC, LLC v. Daikin Indus., Ltd.*, 4 F.4th 1370, ___, 2021 U.S. App. LEXIS 21690, at *14 (Fed. Cir. 2021) (“Concluding otherwise would mean that nexus could never exist where the claimed invention is a unique combination of known elements from the prior art.”).

Zaxcom showed the Board that the claimed combination as a whole serves as the nexus for the objective evidence. That is, nexus is found for the claimed

combination because the industry praise was directed at a product that embodies the patent claims. Zaxcom presented substantial and undisputed evidence that its second-generation wireless transmitter, and all later generations of this product, embody the patent claims (Blue Br. 54-57).

The Board also acknowledges in its Decisions that the praise is directed to the claimed combination as a whole in stating “[f]or example, the Emmy award specifically praises the digital recording of microphone signals in the wireless transmitter to provide *backup* recording of the original microphone signal ... (citing Ex. 2106). That is, the Emmy award praises the ‘replacing’ feature recited by the proposed substitute claims” (Appx64, Appx140) (emphasis in original). That is, the Board determined that the praise was for the claimed combination as a whole including “digital recording of microphone signals in the wireless transmitters” and the “replacing feature,” a combination of at least two different claim elements.

Lectrosonics’ strategy on appeal thus gets it nowhere. To accept Lectrosonics’ point about praise being only for the oldest of old features would amount to agreeing that Zaxcom bamboozled the EMMY and OSCAR committees into bestowing the highest industry awards by mistake. It is simply not credible that the most prestigious committees of distinguished competitors in the field would do such a thing.

Also, Lectrosonics’ attempt to invoke a prior art exception to nexus fails in another way. Lectrosonics correctly cites the legal standard at page 65 of the Red

Brief. As it admits, “A nexus may not exist where, for example, the merits of the claimed invention were ‘readily available in the prior art.’ *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1580 (Fed. Cir. 1983).” But then Lectrosonics jumps the rails. It goes on to apply a completely different standard—whether “every claim element pertaining to the wireless transmitter” was readily available in the prior art (Red Br. 14-18, 65-66). And even then, in Lectrosonics’ follow-on argument, it merely pays lip service to “ready availability.” In effect, it relies on mere disclosures in the obscure, never-commercialized Strub patent (Red Br. 16-17, 65-66). As such, its argument and proffered evidence do not actually fit the legal standard on which it attempts to rely.

Lectrosonics also leaves unrefuted Zaxcom’s principal brief argument that “the merit” of its invention earned it highest industry praise, and did not exist in the prior art, regardless of who is right about claim construction. As discussed in Zaxcom’s principal brief, “the merit” of Zaxcom’s invention is the result it enables for industry—a cure for the problem of audio dropouts during media production (Blue Br. 56-57). This “merit” did not exist in the prior art. More to the point, to reach this conclusion, it is utterly irrelevant whether, as Lectrosonics suggests, “every claim element pertaining to the wireless transmitter was ‘readily available in the prior art’” (Red Br. 65). Even if that were true, and even if Lectrosonics’ briefing about mere disclosures Strub could qualify as “ready availability” under the legal

standard, Lectrosonics still leaves unaddressed the legal standard that it is “the merit” that must be readily available. That is, a mere disclosure in a patent document of a subset of arbitrarily picked claim limitations does not necessarily mean that the field already had access to “the merit” (*i.e.*, the admirable result) of the praised invention prior to the inventors devising their system.

Further, even if all of the elements of the substitute claims were known in the prior art, this does not undermine the Board’s decision. As stated correctly by the USPTO:

that is the point of objective evidence—it helps determine whether a person of ordinary skill would have combined features that were already known. *InTouch Techs., Inc. v. VGO Communications, Inc.*, 751 F.3d 1327, 1347-48 (Fed. Cir. 2014) (crediting objective evidence because “that which may be made clear and thus ‘obvious’ to a court, with the invention fully diagrammed and aided, may have been a breakthrough of substantial dimension when first unveiled” (marks omitted)). And Lectrosonics does not argue that the dropout repair feature is disclosed in Strub; it argues only that other features, which were, in some places, also praised, are disclosed in Strub. Lectrosonics Br. 30-43 (focusing on the digital aspect and “internal recording” aspect of the praised product).

(Appeal No. 20-1350, ECF No. 39, USPTO Br. 31).

E. Zaxcom’s Industry Praise Evidence is Strong

With respect to industry praise, the Board stated as follows: “Patent Owner’s evidence of praise in the form of the [OSCAR] and the [EMMY] also has probative value in establishing that the asserted objective evidence is tied to the invention disclosed and claimed in the substitute claims. For example, the Emmy award

specifically praises the digital recording of microphone signals in the wireless transmitter to provide *backup* recording of the original microphone signal ... (citing Ex. 2106)” (Appx64, Appx140 emphasis in original). Further, “the testimonial evidence by Mr. Sarokin and Mr. Wexler praising Patent Owner’s dropout correction features . . . weighs in favor of nonobviousness. Furthermore, the awards evidence that praises Patent Owner’s digital recording devices that ‘married wireless transmission with a recording device located within the actor’s body pack’ also strongly weighs in favor of nonobviousness” (Appx70, Appx146).

Lectrosonics argues that “the alleged “industry praise,” coming when and how it did, is far from probative evidence in this analysis” with a footnote, that

[t]he Board’s decision to rely heavily on customer declarations for “industry praise” is a paradigm shift in the law. The theory behind industry praise is that “[i]ndustry participants, especially competitors, are not likely to praise an obvious advance over the known art.” *WBIP*, 829 F.3d at 1334. The same does not hold true for customer declarations, particularly customers that have been acquaintances for about twenty years. Appx1974, 9:18. For similar reasons, when praise is given based on the fact that a party has patents (Appx4384), it should be given no more weight than the examiner’s original determination that the claims were patentable.

(Red Br. 66). But Lectrosonics’ assertion regarding a “paradigm shift in the law” errs in many ways, and Lectrosonics does not cite a single case to support this assertion. Astonishingly, this footnote infers that the Board focused solely on customer praise while completely ignoring the Board’s reliance on the industry praise associated with Zaxcom’s EMMY and OSCAR Awards! This is factually

incorrect. In its Final Written Decisions, the Board clearly cites Zaxcom's awards in its evaluation of industry praise. "[T]he awards evidence that praises Patent Owner's digital recording devices that 'married wireless transmission with a recording device located within the actor's body pack' also strongly weighs in favor of nonobviousness" (Appx70, Appx146).

No paradigm shift in the law has occurred. Although in some instances customer praise may have lesser value than other forms of industry praise, the record is replete with highly probative, non-customer related praise, and customer praise is not to be disregarded, as asserted by Lectrosonics. For example, in *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1329-1330 (Fed. Cir. 2019), this Court stated:

Further, the Board found that evidence of secondary considerations supported nonobviousness. Frymaster submitted evidence that it marketed a product called the "Oil Quality Sensor" ("OQS") that won praise from two industry organizations and one customer. The Board found that there was a presumption of nexus between the objective evidence and the OQS product because HPC conceded at argument that claim 1 was commensurate in scope with the praised product. The Board also determined that each award specifically praised the TPM sensor in the OQS. While the Board recognized that the individual claim elements were in the prior art, it found that the praise was directed to the claimed combination as a whole. *Accordingly, the Board found that the two industry awards weighed in favor of patentability, as did, to a lesser extent, the customer award.*" (Emphasis Added).

Similarly, in *Apple v. Samsung*, this Court found highly probative that "[w]hen Mr. Jobs swiped to unlock the phone, 'the audience burst into cheers'"

Apple Inc. v. Samsung Elecs. Co., Ltd., 839 F.3d 1034, 1054 (Fed. Cir. 2016) (*en banc*). Accordingly, the Board did not err in affording weight to both the industry praise received from two highly regarded industry organizations as well as the praise of multiple customers. Ignoring customer praise would be inconsistent with this Court's precedent.

Further, that people testifying under oath were already familiar with Zaxcom does not diminish the evidentiary weight. Mr. Sanders has had a twenty-year relationship with many people in his industry, and any company in the field would be hard pressed to find a witness with whom Mr. Sanders was not acquainted. To suggest that the length of the acquaintance creates some type of bias underscores the extensive and highly accomplished professional resumes of the witnesses.

As Mr. Wexler states in his declaration, "I have been working in the motion picture and television industry for 48 years, primarily as a Production Sound Mixer. I have been nominated twice for an Academy Award for 'The Last Samurai' and 'Independence Day.' I won the British Academy Award for Cameron Crowe's 'Almost Famous.' I was honored with the Cinema Audio Society's Career Achievement Award, and completed over 80 feature films. I also received an Emmy nomination for '*61 *'" (Appx4356, ¶ 2). "I have owned and used almost every piece of professional sound recording equipment, always striving to find the most useful tools for the job" (Appx4356, ¶ 3).

Similarly, Mr. Sarokin states, “I’ve been a motion picture and television sound mixer since 1978. I’ve been nominated for an Oscar, an Emmy, a CAS award, an Italian Oscar (the Davide de Donatello awards) and numerous others. My credits include American Gangster, Mr Robot, Inside Man, Sex and the City, Salt, Sicario and over 120 other movies and television shows. I’m at the top of the game and I have been for many years” (Appx4348, ¶ 2).

Both Mr. Wexler and Mr. Sarokin are appropriate witnesses due to their exceptional qualifications and intimate and thorough understanding of Zaxcom’s products and its industry. Their testimony supplied substantial evidence for the Board’s decisions.

F. The 1975 Nagra SN Device Does Not Show the Board Erred

In service of an argument that the Board should have invoked the prior art exception to nexus, Lectrosonics invokes the Nagra SN device. Lectrosonics states that “as far back as 1975 it was known to both wirelessly transmit and locally record microphone audio using a mini or pocket recorder hooked up to the microphone and wireless transmitter. Appx1991-1992, 26:9-27:23” (Red Br. 15). In its statement, Lectrosonics relies on a vague, single answer to a single question of a single witness. The support cited by Lectrosonics for this bald, threadbare assertion is as follows:

“Yeah. ‘We’ve all done this sort of thing.’ Yeah. I think probably I misspoke then when I said, ‘We’ve all done’ because as I said, I have not done it myself. But I was aware -- I was referencing the fact that, as I said earlier, that I was aware of the fact that there were people that had

taken the SN recorder and used it in that manner.” Appx1992, 27:16-23.

Lectrosonics did not cite or use this testimony in any of its briefing before the Board. It is waived and forfeited. This is a court of error, not a Court for making factual findings for the first time on appeal, especially on evidence never argued before the tribunal.

Subsequently, the line of questioning abruptly ends with no clarification of what Mr. Wexler intended by “used it in that manner” or of how or when he “misspoke.”

A single answer to a single question by a single witness never argued before the Board should not be sufficient evidence to obtain reversal in a case involving substantial evidence review, especially when: 1) there is no other corroborating evidence or testimony; 2) the testimony is contradicted by other testimony of the same witness; and 3) the testimony is so vague that one is unable to affirmatively ascertain what is to be concluded by the testimony. Even Lectrosonics does not argue that the Nagra SN had anything to do with “data” stored in “memory” in the claimed manner, since it was just a 1970’s vintage reel-to-reel analog tape recorder. *See* <https://www.cryptomuseum.com/covert/rec/nagra/sn/index.htm>.

Despite the preposterous suggestion that Zaxcom’s invention, or significant elements thereof, were known and used since 1975, which, if true, should have been a central issue presented by Lectrosonics in the IPR proceedings, Lectrosonics

waited until appeal to raise this evidence and has not provided one iota of corroborating evidence to prove this point. On offer is solely a vague memory of one witness musing on and trying to remember why he said something in a public blog post. Lectrosonics did not introduce technical information for the Nagra SN into evidence (subject to the rigorous Board procedural rules on such matters). No one was asked or has tried to explain how the Nagra SN, or any other analog reel-to-reel “personal pocket recorder” was purportedly hooked up to a transmitter. What transmitter was it hooked up to? Was remote audio data created? Was local audio data combined with remotely recorded audio data? The same witness admits that, assuming *arguendo* that it was in usage at all, it was “certainly not in general usage” (Appx1989; 24:1-2).

Second, the citation of this one answer by Mr. Wexler is contradicted by his own statements, namely: “[i]t was just a very, very small portable recorder that was used . . . for surveillance work for – for law enforcement agencies” Appx1987; 22:7-10; “[t]o the best of my – my knowledge, I’m sure the SN was used – used in production by someone. I never used it in production myself, but I’m sure it was used by someone at some point, but I wouldn’t know the circumstances. I will say that it certainly was not in general usage by anyone. *Otherwise, I would have been much more aware of it*” (Appx1988-1989; 23:20-24:3). Had Lectrosonics brought

Nagra SN before the Board on such a thin record, Zaxcom would have had meritorious evidentiary objections (*e.g.* hearsay) to bring in response.

Third, even what little is known of the Nagra SN does not contradict the novelty of the praised feature underscored in the Board decision: “*digital recording of microphone signals* in the wireless transmitter to provide *backup* recording of the original microphone signal ... (citing Ex. 2106)” (Appx64, Appx140, first emphasis added). No evidence suggests that the Nagra SN could digitally record.

Lectrosonics’ cherished deposition answer is categorically forfeited for use in this appeal, is at best equivocal evidence, and does not contradict the novelty of the praised claimed features. It deserves no further attention from the Court.

For all of the reasons stated above, Lectrosonics’ complaints and arguments amount to nothing more than an attempt to reweigh evidence while myopically ignoring the multitude of evidence (and reasoning) favoring the Board’s outcome. Lectrosonics has failed to meet its appellate burden to show lack of substantial evidence for Board findings that Lectrosonics obviousness showing is weak and the evidence of secondary considerations is strong.

CONCLUSION

For the reasons discussed above and in Zaxcom’s opening brief, this Court should reverse the decision of the Board relating to original claims 7, 8, 11, 12, 14, 15 of the ’902 Patent and original claims 1–4, 9, 10, 12, 15, 31, 36, 37, and 41–44

of the '814 Patent. Zaxcom's success in the main appeal should moot the cross-appeal. However, if the Court needs to reach the cross-appeal, the Court should affirm the decision of the Board accepting substitute claims 21-26 of the '902 Patent and substitute claims 50-65 of the '814 Patent.

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Respectfully Submitted,

/s/ Rita C. Chipperson

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**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

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