

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOPRO, INC.,
Petitioner,

v.

CONTOUR IP HOLDING LLC,
Patent Owner.

Case IPR2015-01080
Patent 8,890,954 B2

Before JUSTIN T. ARBES, MICHAEL J. FITZPATRICK, and
NEIL T. POWELL, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a)

I. BACKGROUND

Petitioner GoPro, Inc. filed a Petition (Paper 1, “Pet.”) seeking *inter partes* review of claims 1–30 of U.S. Patent No. 8,890,954 B2 (Ex. 1001, “the ’954 patent”) pursuant to 35 U.S.C. §§ 311–319. On October 28, 2015, we instituted an *inter partes* review of claims 1, 2, and 11–30 on two grounds of unpatentability (Paper 8, “Dec. on Inst.”). Patent Owner Contour IP Holding LLC¹ filed a Patent Owner Response (Paper 30, “PO Resp.”), and Petitioner filed a Reply (Paper 39, “Reply”). Petitioner filed a Motion to Exclude (Paper 43, “Pet. Mot.”) certain evidence submitted by Patent Owner. Patent Owner filed an Opposition (Paper 48, “PO Mot. Opp.”) and Petitioner filed a Reply (Paper 51, “Pet. Mot. Reply”). Patent Owner filed a Motion to Exclude (Paper 45, “PO Mot.”) certain evidence submitted by Petitioner. Petitioner filed an Opposition (Paper 49, “Pet. Mot. Opp.”) and Patent Owner filed a Reply (Paper 50, “PO Mot. Reply”). A combined oral hearing with Case IPR2015-01078² was held on June 22, 2016, and a transcript of the hearing is included in the record (Paper 54, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This final written decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we determine that Petitioner has not shown by a preponderance of the evidence that claims 1, 2, and 11–30 are unpatentable.

¹ The original Patent Owner was Contour, LLC. Paper 5. During trial, Patent Owner filed a notice indicating that ownership of the challenged patent was transferred from Contour, LLC to Contour IP Holding LLC. *See* Papers 19, 28.

² U.S. Patent No. 8,896,694 B2 (Ex. 1002), which is being challenged in Case IPR2015-01078, is a continuation of the ’954 patent.

ll. 38–61, col. 8, l. 64–col. 9, l. 50. “When recording video or taking photographs in a sports application, digital video camera 10 is often mounted in a location that does not permit the user to easily see the camera.” *Id.* at col. 19, ll. 35–37. Digital video camera 10, therefore, includes wireless communication capability to allow another device, such as a smartphone or tablet computer executing application software, to control camera settings in real time, access video stored on the camera, and act as a “viewfinder” to “preview what digital video camera 10 sees” and allow the user to check alignment, light level, etc. *Id.* at col. 19, l. 38–col. 20, l. 47.

B. Illustrative Claim

Claim 1 of the '954 patent recites:

1. An integrated, hands-free, portable, viewfinderless point of view digital video camera, comprising:

a lens and an image sensor, the image sensor capturing light propagating through the lens and representing a scene to be recorded, and the image sensor producing real time video image data of the scene;

a wireless connection protocol device configured to send real time image content by wireless transmission directly to and receive control signals or data signals by wireless transmission directly from a wireless connection-enabled controller; and

a camera processor configured to:

receive the video image data directly or indirectly from the image sensor,

generate, from the video image data, first video image content at a first resolution and second video image content at a second resolution, wherein the first resolution is lower than the second resolution,

communicate the first video image content using the wireless connection protocol device to the wireless

connection-enabled controller without displaying the first video image content, the second video image content, or the video image data at the video camera,

receive the control signals from the wireless connection-enabled controller,

adjust image capture settings of the video camera prior to recording the scene based at least in part on at least a portion of the control signals, and

in response to a record command, cause the second video image content to be stored at the video camera, wherein

the wireless connection-enabled controller comprises executable instructions for execution on a handheld personal portable computing device, wherein when executed, the executable instructions cause the handheld personal portable computing device to:

receive the first video image content from the wireless connection protocol device,

display the first video image content on a display of the handheld personal portable computing device, the first video image content comprising a preview image of the scene, the preview image allowing a user of the video camera to manually adjust a position or orientation of the video camera to record the scene,

generate the control signals based at least on input received at the handheld personal portable computing device, wherein the control signals comprise at least one of a frame alignment, a multi-camera synchronization, remote file access, and a resolution setting and at least one of a lighting setting, an audio setting, and a color setting, and

communicate the control signals to the wireless connection protocol device.

C. Prior Art

The pending grounds of unpatentability in the instant *inter partes* review are based on the following prior art:

U.S. Patent No. 7,362,352 B2, issued Apr. 22, 2008 (Ex. 1013, “Ueyama”);

U.S. Patent Application Publication No. 2010/0118158 A1, published May 13, 2010 (Ex. 1010, “Boland”); and

GoPro Sales Catalog (Ex. 1011, “GoPro Catalog”).³

D. Pending Grounds of Unpatentability

The instant *inter partes* review involves the following grounds of unpatentability:

References	Basis	Claims
Boland and GoPro Catalog	35 U.S.C. § 103(a) ⁴	1, 2, 11–20, 22–25, and 27–30
Boland, GoPro Catalog, and Ueyama	35 U.S.C. § 103(a)	21 and 26

II. ANALYSIS

A. Motions to Exclude

Before turning to the merits of Petitioner’s asserted grounds of unpatentability, we resolve certain aspects of the parties’ motions to exclude.

³ When citing the GoPro Catalog, we refer to the page numbers at the bottom-right corner of each page. See 37 C.F.R. § 42.63(d)(2).

⁴ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102 and 103. Because the ’954 patent has an effective filing date before the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of 35 U.S.C. §§ 102 and 103.

The party moving to exclude evidence bears the burden of proof to establish that it is entitled to the relief requested—namely, that the material sought to be excluded is inadmissible under the Federal Rules of Evidence. *See* 37 C.F.R. §§ 42.20(c), 42.62(a).

1. Petitioner’s Motion to Exclude

a. Exhibits 2001 and 2002

Petitioner moves to exclude printouts of two web pages: a March 3, 2009 archived copy of the Tucker Rocky Distributing (“Tucker Rocky”) website from the Internet Archive Wayback Machine (Exhibit 2001) and a Facebook web page for the 2013 Tucker Rocky Dealer Show (Exhibit 2002). Pet. Mot. 2–4. Petitioner argues that the printouts are inadmissible as unauthenticated under Federal Rule of Evidence 901 and as hearsay under Federal Rule of Evidence 802. *Id.* Patent Owner argues that Petitioner waived its objection to these exhibits by failing to object timely. PO Mot. Opp. 1–2. We agree with Patent Owner.

A party challenging the admissibility of evidence “must object timely to the evidence.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012). A preliminary proceeding “begins with the filing of a petition for instituting a trial and ends with a written decision as to whether a trial will be instituted.” 37 C.F.R. § 42.2. “Any objection to evidence submitted during a preliminary proceeding must be filed within ten business days of the institution of the trial.” 37 C.F.R. § 42.64(b)(1). Doing so allows the party that originally submitted the evidence to attempt to cure the objection by serving supplemental evidence. 37 C.F.R. § 42.64(b)(2). If the submitting party does not serve supplemental evidence, or if the

supplemental evidence does not cure the objection, “[a] motion to exclude evidence must be filed to preserve [the] objection. The motion must identify the objections in the record in order and must explain the objections.”

37 C.F.R. § 42.64(c).

Patent Owner submitted Exhibits 2001 and 2002 with its Preliminary Response on July 30, 2015, prior to our Decision on Institution on October 28, 2015. Therefore, Petitioner was required to object to the evidence within ten business days of institution. Petitioner, however, did not object until January 26, 2016, and thus waived any objection to Exhibits 2001 and 2002. *See* Pet. Mot. 1; Paper 31 (“Petitioner GoPro Inc.’s *First Set of Objections to Patent Owner’s Exhibits*” (emphasis added)). Petitioner argues that its objections were timely because Petitioner filed them within five business days of Patent Owner filing its Response and a declaration from Michael P. Duffey (Exhibit 2012) purportedly authenticating the two web page printouts. Pet. Mot. Reply 2. Petitioner, however, is not moving to exclude Exhibit 2012, in which case an objection to the exhibit filed within five business days of its service would have been timely.⁵ Rather, Petitioner is moving to exclude Exhibits 2001 and 2002, which were submitted during the “preliminary proceeding.” Pursuant to 37 C.F.R. § 42.64(b)(1), any objection was due within ten business days of institution, and Petitioner failed to meet that requirement. Petitioner’s Motion to Exclude is denied as to Exhibits 2001 and 2002.

⁵ For evidence served after institution, “any objection must be filed within five business days of service of [the] evidence.” 37 C.F.R. § 42.64(b)(1).

b. Exhibits 1036 and 2004–2011

Petitioner also moves to exclude certain materials (Exhibits 2005–2011) pertaining to Patent Owner’s arguments regarding secondary considerations of non-obviousness, as well as the testimony (Exhibits 1036 and 2004) of Patent Owner’s declarant, Brent E. Nelson, Ph.D., regarding whether the asserted references render obvious the challenged claims. Pet. Mot. 2–15. As explained below, we need not reach these issues because Petitioner has not proven that the GoPro Catalog is a prior art printed publication. *See infra* Section II.B. Therefore, Petitioner’s Motion to Exclude is dismissed as moot as to Exhibits 1036 and 2004–2011.

2. Patent Owner’s Motion to Exclude

a. Exhibit 1011

Patent Owner moves to exclude the GoPro Catalog (Exhibit 1011) as unauthenticated under Federal Rule of Evidence 901. PO Mot. 3–8. The GoPro Catalog is a product catalog for Petitioner’s HD Motorsports HERO camera. Ex. 1011, 2. As we discuss in greater detail below, Petitioner provides testimony from Damon Jones, a Senior Product Manager employed by Petitioner, to support its arguments regarding the GoPro Catalog. *See infra* Section II.B; Ex. 1012 ¶ 1. Mr. Jones states, among other things, that he attended and distributed copies of the GoPro Catalog at the Tucker Rocky Dealer Show on July 23–27, 2009 in Fort Worth, Texas. Ex. 1012 ¶¶ 5, 8.

Patent Owner argues that Petitioner has not proven that the version of the GoPro Catalog provided as Exhibit 1011 is “*the same* catalog that was purportedly distributed at the Dealer Show in July 2009, or even that the GoPro Catalog had been printed at that time.” PO Mot. 4. According to

Patent Owner, Mr. Jones's testimony is conclusory and does not explain how or why Mr. Jones knows the GoPro Catalog is what he claims it to be, i.e., a copy of the catalog that he distributed at the Tucker Rocky Dealer Show. *Id.* at 4–7. Patent Owner contends that “Mr. Jones does not identify any markings or indicators on the GoPro Catalog that inform him that it is the same catalog he claims to have distributed,” and “does not say how he is capable of determining with any certainty that the GoPro Catalog is the same version, printing, or content as the catalog he claims to have distributed.” *Id.* at 5–6.

We are not persuaded that Exhibit 1011 should be excluded for two reasons. First, Patent Owner withdrew its objection, as Petitioner argues. *See* Pet. Mot. Opp. 4–5. Patent Owner timely objected to Exhibit 1011 within ten business days of institution. *See* Paper 14, 2–3. Petitioner later filed, pursuant to our authorization, a motion to submit a supplemental declaration from Mr. Jones as supplemental information under 37 C.F.R. § 42.123(a). Paper 20. Patent Owner then filed objections to the supplemental declaration, stating that

the Jones Supplemental Declaration cannot resolve Patent Owner's objections stated in Patent Owner Contour LLC's First Set of Objections to Petitioner's Exhibits. However, *to the extent the Board overlooks the untimeliness of Petitioner's evidence and allows Petitioner's evidence to be part of the record, the Jones Supplemental Declaration resolves the objections presented in Patent Owner Contour LLC's First Set of Objections to Petitioner's Exhibits.*

Paper 22, 3 (emphasis added). We allowed Mr. Jones's supplemental declaration “to be part of the record” when we granted Petitioner's motion to submit it as supplemental information. *See* Paper 28. We also now deny Patent Owner's Motion to Exclude the supplemental declaration, for the

reasons explained below. *See infra* Section II.A.2.b. Thus, by Patent Owner's own statement (reproduced above), Mr. Jones's supplemental declaration "resolves" Patent Owner's objection to the admissibility of Exhibit 1011.

Second, even if Patent Owner had not withdrawn its objection, Patent Owner's arguments regarding admissibility still would not be persuasive. "To satisfy the requirement of authenticating or identifying an item of evidence, the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is." Fed. R. Evid. 901(a). "Testimony that an item is what it is claimed to be" may be used to satisfy the authentication requirement. Fed. R. Evid. 901(b)(1).

Mr. Jones's testimony is sufficient to establish that Exhibit 1011 is what he claims it to be, i.e., a copy of the catalog that he distributed at the Tucker Rocky Dealer Show. Mr. Jones testifies in his original declaration that Petitioner "distributed hundreds of copies" of the GoPro Catalog at the Tucker Rocky Dealer Show, and that Exhibit 1011 "is a true and correct copy of the GoPro Catalog that was distributed" there. Ex. 1012 ¶¶ 8, 10. In his supplemental declaration, Mr. Jones testifies that Nicholas Woodman, Petitioner's founder and Chief Executive Officer, sent him an email (Exhibit 1023) on July 20, 2009, with the subject "Shipping for DAMON" and stating that "KINKOS is FEDEXING your HD Moto HERO Catalogs to you on TUES for arrival on WED." Ex. 1022 ¶ 5. Mr. Jones states that he received catalogs at his hotel in Fort Worth, Texas and brought them to the Tucker Rocky Dealer Show. *Id.* ¶ 6. Importantly, Mr. Jones also testifies that (1) he is familiar with Petitioner's marketing materials as a result of his employment with Petitioner since 2008; (2) he recognizes the catalog, which

states that “[t]he HD Motorsports HERO is available Fall ’09,” as pertaining to Petitioner’s HD Motorsports HERO camera launched in the fall of 2009; (3) he “recognize[s]” Exhibit 1011 as a copy of the catalog that he brought to the Tucker Rocky Dealer Show; and (4) the copy of the catalog provided as Exhibit 1011 “was taken from the inventory of these catalogs that [Petitioner] maintained and distributed in the ordinary course of business.” *See id.* ¶¶ 7–10; Ex. 1012 ¶¶ 1–2 (listing Mr. Jones’s employment positions with Petitioner); Ex. 1011, 7.

Thus, Mr. Jones has personal knowledge of what catalog he brought to the Tucker Rocky Dealer Show, and a basis on which to recognize Exhibit 1011 as that catalog due to his employment with Petitioner and familiarity with Petitioner’s products and marketing practices. His testimony also is consistent with the content of Exhibit 1011 itself, which describes the “HD Motorsports HERO” product. Given Mr. Jones’s personal involvement in receiving and using the GoPro Catalog, we are not persuaded that he was required to provide additional detail as to precisely how he recognizes Exhibit 1011 as the particular catalog from the Tucker Rocky Dealer Show, as Patent Owner contends. *See PO Mot.* 4–7. Nor are we persuaded that he needed to identify particular “markings or indicators” on the document as the basis for that recognition. *See id.* at 6. “[D]istinctive characteristics” of an item may provide a basis for admissibility under Rule 901(b)(4), but we are persuaded that Exhibit 1011 is admissible under at least Rule 901(b)(1) based on Mr. Jones’s testimony that Exhibit 1011 is what he claims it to be. Finally, the cases relied on by Patent Owner are distinguishable from the present facts, for all of the reasons stated by Petitioner. *See id.* at 3–4, 7;

Pet. Mot. Opp. 8–9. Patent Owner’s Motion to Exclude is denied as to Exhibit 1011.⁶

b. Exhibits 1022 and 1023

Patent Owner moves to exclude Mr. Jones’s supplemental declaration (Exhibit 1022) and the email from Mr. Woodman (Exhibit 1023) as containing inadmissible hearsay under Federal Rule of Evidence 802 and as untimely. PO Mot. 8–11. First, Patent Owner argues that Mr. Woodman’s email and paragraph 5 of the supplemental declaration quoting it contain out-of-court statements offered for the truth of the matter asserted—namely, “that, on or around July 20, 2009, Mr. Woodman intended to and, in fact, sent Mr. Jones copies of the GoPro Catalog for distribution at the Dealer Show.” *Id.* at 8–10. We are not persuaded. As Petitioner points out, the disputed statements are not offered to prove the truth of whether Mr. Woodman in fact sent catalogs by FedEx to Mr. Jones, but rather that “Mr. Jones was informed that catalogs were being sent to him,” which supports Mr. Jones’s testimony authenticating Exhibit 1011. Pet. Mot. Opp. 10–11; *see* Fed. R. Evid. 801 Advisory Comm. Notes (“If the significance of an offered statement lies solely in the fact that it was made, no issue is raised as to the truth of anything asserted, and the statement is not hearsay.”).

⁶ Although we deem the GoPro Catalog admissible based on Mr. Jones’s testimony, the question of whether his testimony is sufficient to prove that the GoPro Catalog is a prior art printed publication is a separate issue, which we address below. *See infra* Section II.B.5.

Thus, we are not persuaded that the statements constitute inadmissible hearsay under Rule 802.⁷

Second, Patent Owner argues that the supplemental declaration and email are untimely under 37 C.F.R. § 42.23(b), which provides that “[a] reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, or patent owner response.” PO Mot. 10–11. Patent Owner contends that Petitioner should have submitted the testimony in the supplemental declaration with its Petition. *Id.* We are not persuaded. A motion to exclude ordinarily is not the proper mechanism for raising the issue of whether a reply or reply evidence is beyond the proper scope permitted under the rules, as a motion to exclude is for challenging the “admissibility of evidence” under the Federal Rules of Evidence. *See* 37 C.F.R. §§ 42.62, 42.64; Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,758, 48,767. Regardless, though, the supplemental declaration and email were filed timely. Petitioner submitted the supplemental declaration and email as supplemental information pursuant to our Decision granting Petitioner’s corresponding motion, which was prior to Patent Owner filing its Response. *See* Paper 28. They were not submitted with Petitioner’s Reply. Patent Owner had the opportunity to cross-examine Mr. Jones regarding his declarations and the email and respond substantively in its Response, and Petitioner had the opportunity to respond to Patent Owner’s arguments in its Reply. Patent Owner’s Motion to Exclude is denied as to Exhibits 1022 and 1023.

⁷ Even if the disputed statements were inadmissible, our conclusions herein, including the determination that Exhibit 1011 is authentic, would be the same. *See supra* Section II.A.2.a.

c. Exhibit 1037

Patent Owner also moves to exclude the cross-examination testimony (Exhibit 1037) of its declarant, Richard Mander, Ph.D., regarding secondary considerations of non-obviousness. PO Mot. 11–15. We need not reach the issue of secondary considerations of non-obviousness, *see infra* Section II.B, and dismiss Patent Owner’s Motion to Exclude as moot as to Exhibit 1037.

B. Petitioner’s Asserted Grounds of Unpatentability

Petitioner argues that claims 1, 2, 11–20, 22–25, and 27–30 are unpatentable over Boland and the GoPro Catalog under 35 U.S.C. § 103(a), and that claims 21 and 26 are unpatentable over Boland, the GoPro Catalog, and Ueyama under 35 U.S.C. § 103(a), relying on the supporting testimony of Kendyl A. Román. Pet. 27–59 (citing Ex. 1007). We have reviewed the Petition, Patent Owner Response, and Reply, as well as the evidence discussed in each of those papers, and are not persuaded, by a preponderance of the evidence, that the challenged claims are unpatentable based on the asserted grounds.

1. Boland

Boland describes a “video recording camera system configured to record video from a user’s perspective,” comprising a headset positioned on the wearer’s ear and a wireless handset. Ex. 1010 ¶¶ 6, 30, Fig. 1.

Figure 2A of Boland is reproduced below.

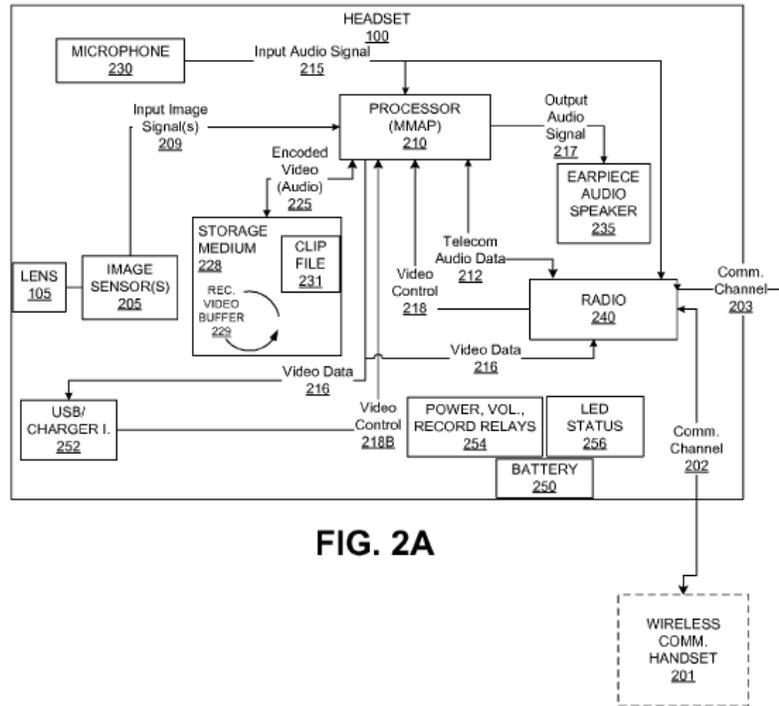


Figure 2A depicts headset 100 comprising lens 105, image sensor(s) 205, multimedia processor 210, storage medium 228, and radio 240, which communicates with wireless communication handset 201 over communication channel 202 (e.g., Bluetooth). *Id.* ¶¶ 32–35. Handset 201 includes “view screen 303 . . . to serve as a viewfinder for the headset 100 and . . . further provide for previewing of video recorded by the headset 100,” and video control soft keys 307 to allow the user to control the operation of headset 100. *Id.* ¶¶ 46, 58, 61, 63, Fig. 3A. Video data is stored and overwritten, in a first in-first out manner, in non-volatile recorded video data buffer 229 of storage medium 228 for “continuous video recording,” and the user may save particular video portions as clip files 231. *Id.* ¶¶ 35, 40–42, 48.

2. GoPro Catalog

The GoPro Catalog is a product catalog for Petitioner’s “HD Motorsports HERO” product. Ex. 1011, 2–3. It describes a “1080p [high-definition (HD)] wearable camera” and “optional wireless remote with an omni-directional range of 30 feet.” *Id.* at 3, 6. The images shown on pages 2 and 15 of the catalog are reproduced below.



The images above depict the camera attached to a user’s helmet, and the wireless remote control, which the GoPro Catalog describes as follows: “With a 30’ / 10m range and the ability to wirelessly transmit a preview image of your photo or video before you start recording, the wireless remote opens up a world of filming opportunities and convenience.” *Id.* at 15.

3. Ueyama

Ueyama describes an “image capturing apparatus which can be remotely operated and is able to transmit captured image data to [an] operation terminal.” Ex. 1013, col. 3, l. 67–col. 4, l. 4. The operation terminal receives streamed image data over a wireless connection, such as Bluetooth, at a particular frame rate and can act as a “view finder” by displaying the images on a monitor. *Id.* at col. 4, ll. 13–18, 24–30. The

image capturing apparatus “judges” the speed of the connection and “decreas[es] the resolution” of images when the speed is low. *Id.* at Abstract, col. 10, ll. 4–14.

4. Level of Ordinary Skill in the Art

Section 103(a) forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. § 103(a)). In the Decision on Institution, we preliminarily determined that a person of ordinary skill in the art would have had at least a bachelor’s degree in computer science, electrical engineering, or a similar discipline, and some experience creating, programming, or working with digital video cameras, such as POV action sports video cameras. Dec. on Inst. 11–12. The parties agree with this assessment. *See* PO Resp. 11; Tr. 30:8–11. Based on our review of the ’954 patent, the types of problems and solutions described in the ’954 patent and cited prior art, and the testimony of the parties’ declarants, we maintain our preliminary determination and apply that level of ordinary skill in the art for purposes of this Decision.

5. Whether Petitioner Has Proven That The GoPro Catalog Is Prior Art

Before reaching the merits of Petitioner’s obviousness grounds, both of which are based on combinations of the GoPro Catalog with other asserted prior art, we must determine whether the GoPro Catalog is a prior art printed publication under 35 U.S.C. § 102(b). *See* Pet. 26. It is

Petitioner’s burden to prove that it is, as Petitioner bears the burden of proving unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”); *In re Wyer*, 655 F.2d 221, 227 (CCPA 1981) (a party asserting a reference as a prior art printed publication “should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates”).

We first resolve the legal standard to be applied, which the parties dispute. The determination of whether a document is a “printed publication” under 35 U.S.C. § 102 “involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.” *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004).

“Because there are many ways in which a reference may be disseminated to the interested public, ‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’ bar under 35 U.S.C. § 102(b).” *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016) (citing *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)). Petitioner argues that the standard to be applied to the GoPro Catalog is whether it was “sufficiently accessible to the public interested in the art.” Reply 2 (citing *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989)). According to Petitioner, there are two different standards depending on the factual circumstances of the case: for “catalog” cases, like a thesis stored at a university, the standard is accessibility to persons interested and

ordinarily skilled in the art, but for “dissemination [cases], like at a trade show,” the standard is only accessibility to the interested public. Tr. 28:13–29:17, 31:16–33:11. Patent Owner disagrees, arguing that a “reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested *and* ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” PO Resp. 6 (citing *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014)). Patent Owner asserts that the standard is the same regardless of whether accessibility is being shown via cataloguing or dissemination. Tr. 40:14–42:13.

We agree with Patent Owner. Although some cases, such as *Cronyn*, refer simply to “the public interested in the art,” the majority of cases define the standard as accessibility to persons interested and ordinarily skilled in the art. Numerous cases pertaining to dissemination of a reference have applied that standard. For example, in *Massachusetts Inst. of Tech. v. AB Fortia*, 774 F.2d 1104, 1108–1109 (Fed. Cir. 1985), the Court found that a paper delivered orally at a cell culture conference was a prior art printed publication because “between 50 and 500 persons interested and of ordinary skill in the subject matter were actually told of the existence of the paper and informed of its contents by the oral presentation, and the document itself was actually disseminated without restriction to at least six persons.” Likewise, in *Klopfenstein*, 380 F.3d at 1350–52, the Court found that a reference displayed at two industry association meetings was a prior art printed publication because it “was shown to a wide variety of viewers, a large subsection of whom possessed ordinary skill in the art of cereal chemistry and agriculture,” specifically noting that “the intended target audience at the

[first] meeting was comprised of cereal chemists and others having ordinary skill in the art,” and “[t]he intended viewers at the [second meeting] most likely also possessed ordinary skill in the art.” In *Suffolk*, 752 F.3d at 1364–65, the Court found that a newsgroup post “was sufficiently disseminated to those of ordinary skill in the art to be considered publically accessible” because, among other reasons, “those of ordinary skill in the art actually were using [the] newsgroups.” See also *Medtronic, Inc. v. Barry*, Case IPR2015-00780, at 9–13 (PTAB Sept. 7, 2016) (Paper 51) (determining that a video and set of slides were not prior art printed publications by virtue of their availability at certain programs because the attendees were invited experts voted into membership, not persons of “ordinary” skill in the art).

Accordingly, we apply the following standard, recently enunciated by the Federal Circuit, for determining whether the GoPro Catalog is a prior art printed publication: “A reference will be considered publicly accessible if it was ‘disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.’” *Blue Calypso*, 815 F.3d at 1348 (citing *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1350 (Fed. Cir. 2008)).

Turning to the sufficiency of Petitioner’s showing of public accessibility, we now consider Petitioner’s argument that the GoPro Catalog is a prior art printed publication because it was “distributed publicly at least as early as July 2009, when [Petitioner] attended the 2009 Tucker Rocky Dealer Show and handed the GoPro Catalog to potential customers,” citing Mr. Jones’s original declaration as support.⁸ Pet. 26 (citing Ex. 1012

⁸ Although not argued in the Petition, Mr. Jones states that “[a]fter the 2009 Tucker Rocky Dealer Show and prior to September 13, 2009, [Petitioner]

¶¶ 4–11). Mr. Jones testifies that as part of his employment with Petitioner, he “participate[s] in and [is] otherwise familiar with various trade organizations relevant to [Petitioner’s] business,” including Tucker Rocky. Ex. 1012 ¶ 4. According to Mr. Jones, “Tucker Rocky is a trade organization directed to motorcycles and other action sports vehicles, such as motorbikes, all-terrain vehicles (ATVs), snowmobiles and watercraft, as well as apparel, parts and accessories related thereto,” and is “for vendors, dealers, retailers, customers and enthusiasts of such motorcycles and outdoor vehicles, and associated accessories,” including “video cameras that are mountable, for example, to a rider’s helmet or vehicle.” *Id.*

Mr. Jones states that Tucker Rocky “holds an annual trade show with attendees numbering in the thousands and typically featuring its dealer and vendor members.” *Id.* ¶ 5. Mr. Jones attended the 2009 Tucker Rocky Dealer Show on July 23–27, 2009 in Fort Worth, Texas, which, according to Mr. Jones, had “approximately 150 vendors,” including Petitioner, and “over 1000 attendees,” including “actual and potential dealers, retailers, and

continued to distribute and otherwise make available the GoPro Catalog to [Petitioner’s] actual and potential customers, dealers and retailers through its website, direct mail, and other means of distribution.” Ex. 1012 ¶ 11; *see also* Ex. 1022 ¶ 10 (similar statement). Petitioner provides no support for this assertion, as Patent Owner points out. *See* PO Resp. 14–15. Petitioner does not cite or provide a copy of the specific web page from which the GoPro Catalog allegedly could be downloaded, does not explain how someone could locate and access the web page, and does not explain any circumstances under which the GoPro Catalog was mailed or emailed to others (e.g., to whom, how many times, on what dates). Thus, we are unable to assess whether the GoPro Catalog was disseminated in any way other than at the 2009 Tucker Rocky Dealer Show, which is the only basis for the GoPro Catalog being prior art argued by Petitioner in its Petition. *See* Pet. 26.

customers of portable, point of view video cameras.” *Id.* ¶¶ 5–7 (citing a vendor booth list attached as Ex. A). Mr. Jones further states that he manned Petitioner’s booth at the show, where Petitioner demonstrated its new HD Motorsports HERO camera, displayed the GoPro Catalog, “made [it] available, without restriction, to attendees,” and “distributed hundreds of copies . . . without restriction to attendees.” *See id.* ¶¶ 7–9 (citing a booth layout diagram attached as Ex. B); Ex. 1022 ¶ 8. Mr. Jones testifies that he brought copies of the GoPro Catalog to the show, “personally distributed” them, and “witnessed another [Petitioner] employee distribute the GoPro Catalog to attendees.” Ex. 1022 ¶ 6.⁹

Patent Owner argues that the evidence provided by Petitioner is insufficient to demonstrate that the GoPro Catalog is a prior art printed publication. PO Resp. 5–15, 17. We agree. First, Petitioner provides no evidence that the 2009 Tucker Rocky Dealer Show was advertised or announced to the public, such that a person interested and ordinarily skilled in the art from the public would have known about it and could have obtained a copy of the GoPro Catalog there. *See id.* at 9–11. According to Mr. Jones, the show was “attended by over 1000 attendees,” and “[b]esides vendors, attendees . . . included actual and potential dealers, retailers, and customers of portable, point of view video cameras.” Ex. 1012 ¶¶ 5, 7 (emphases added). Mr. Jones, however, does not explain how any member of the general public (as opposed to just Tucker Rocky’s members) would have known about the show. Indeed, Tucker Rocky is a membership

⁹ Patent Owner did not cross-examine Mr. Jones, and does not point to any reason to doubt the veracity of his testimony. The only issue, therefore, is whether his testimony and cited exhibits are sufficient for Petitioner to meet its burden to prove that the GoPro Catalog is a prior art printed publication.

organization, and the show features “its dealer and vendor members.” *See id.* ¶ 5.

Further, Patent Owner has submitted some evidence indicating that it is unlikely that the public (including persons interested and ordinarily skilled in the art) would have known about the 2009 Tucker Rocky Dealer Show. *See* PO Resp. 9–11. Tucker Rocky’s website from 2009 states that Tucker Rocky is a wholesale distributor that does not sell to the public:

Tucker Rocky Distributing is a world-wide leader in the wholesale distribution of aftermarket parts, accessories and apparel for the powersports industry. We stock and sell over 75,000 items for street bikes, off-road motorcycles and ATVs, as well as all the accessories and apparel needed by the people that ride them. *We do not sell direct to the public*, but we have a network of thousands of retail dealers located throughout the world. You can use our Dealer Locator on our consumer website . . . to find your nearest dealer. If they don’t have what you are looking for, they can usually order it and have it for you the next day.

Ex. 2001; *see also id.* (describing a related “dealer website” where Tucker Rocky’s “registered dealers” can “check stock, see pricing, [and] place orders” with Tucker Rocky). A Facebook web page for the 2013 Tucker Rocky Dealer Show also states: “Not open to the public. Dealers Only.”

Ex. 2002. The Facebook posting is of limited relevance because it pertains to the 2013 show, not the 2009 show. Notably, however, Petitioner does not provide any supporting evidence showing that the 2009 show was advertised to the public or even open to the public, beyond Mr. Jones’s bare assertion that the GoPro Catalog was “made publicly available” at the show. *See* Ex. 1012 ¶¶ 9–10. Given Tucker Rocky’s function as a wholesale distributor for its members and the fact that it did not sell to the public in 2009, we find that lack of proof from Petitioner significant.

Second, Petitioner provides no evidence that the GoPro Catalog was disseminated or otherwise made available at the 2009 Tucker Rocky Dealer Show to persons ordinarily skilled in the art, as Patent Owner contends. *See* PO Resp. 11–13. As explained above, a person of ordinary skill in the art would have had at least a bachelor’s degree in computer science, electrical engineering, or a similar discipline, and some experience creating, programming, or working with digital video cameras, such as POV action sports video cameras. *See supra* Section II.B.4. Petitioner does not explain why, or provide any evidence demonstrating that, such persons would have been in attendance at the 2009 Tucker Rocky Dealer Show. The evidence shows that Tucker Rocky is a trade organization for action sports vehicles (e.g., motorcycles, motorbikes, ATVs, snowmobiles, watercraft) and related apparel, parts, and accessories, and that the show was directed primarily at sales and marketing personnel. *See* Ex. 2001 (2009 website stating that Tucker Rocky is a wholesale distributor of “aftermarket parts, accessories and apparel for the *powersports industry*,” and stocks “items for *street bikes, off-road motorcycles and ATVs*, as well as . . . accessories and apparel” (emphases added)); Ex. 1012 ¶ 4 (“Tucker Rocky is a trade organization directed to *motorcycles and other action sports vehicles*, such as motorbikes, all-terrain vehicles (ATVs), snowmobiles and watercraft, as well as apparel, parts and accessories related thereto,” and is “for vendors, dealers, retailers, customers and enthusiasts of such motorcycles and outdoor vehicles, and associated accessories.” (emphasis added)), 5 (stating that the annual show “typically featur[es Tucker Rocky’s] dealer and vendor members”), Ex. A (“Tucker Rocky National *Sales Mtg & Dealer Show*”) (emphasis added).

Petitioner does not provide any proof that the 2009 Tucker Rocky Dealer Show would have been attended by, for example, camera engineers, designers, or developers, who would have a technical background with digital video cameras and fall within the above definition of someone ordinarily skilled in the art. Certainly, it is possible that such an individual could have been in attendance, but speculation is insufficient for Petitioner to meet its burden.¹⁰ The mere fact that someone is an action sports vehicle and accessory enthusiast does not demonstrate that he or she is a person ordinarily skilled in the art at the time of the invention of the '954 patent. We do not see how an interest in action sports vehicles and accessories implies in any way having a technical background with digital video cameras. *See* Tr. 30:12–31:2 (Petitioner arguing that a person of ordinary skill in the art would have been interested in something like the show “[b]ecause they also liked extreme sports”). The 2009 Tucker Rocky Dealer Show was not an academic conference or camera industry conference. It was a dealer show for action sports vehicles like motorcycles, motorbikes, ATVs, snowmobiles, and watercraft. To the extent it pertained to digital video cameras at all, it did so only tangentially—as one type of “accessory” for riders of certain action sports vehicles. Further, we agree with Patent Owner that, even assuming that “those interested in *buying* [Petitioner’s]

¹⁰ Indeed, the only confirmed attendee, based on the evidence provided by Petitioner, is Mr. Jones, but we find no evidence in the record indicating that he would have been a person of ordinary skill in the art. *See* Ex. 1012 ¶ 1 (listing his positions with Petitioner as “Senior Product Manager,” “Product Manager, User Generated Content Specialist (Marketing), Marketing Brand Compliance Manager (Marketing), Online Brand Manager (Marketing), QA, and North and South America Sales”); Tr. 84:13–20 (Petitioner acknowledging that “that is not something we put in the declaration”).

devices” were in attendance at the show, that does not establish that any of those individuals were ordinarily skilled in the art. *See* PO Resp. 13. Again, customers “may or may not” have been of ordinary skill in the art, as Petitioner acknowledged. *See* Tr. 86:16–22.

Finally, when asked at the hearing to point to any evidence in the record indicating that a person of ordinary skill in the art would have been present at the 2009 Tucker Rocky Dealer Show, Petitioner cited Mr. Jones’s attendance, his alleged “pass[ing the GoPro Catalog] out to others . . . after the show,” and the vendor list for the show. *Id.* at 84:13–87:20. We addressed the first two arguments above. Regarding the vendor list, the document lists numerous company names, such as “Accel,” “Acerbis,” “AFE Power,” and “Airhawk Seat Cushions,” as well as Petitioner. Ex. 1012, Ex. A. Petitioner does not provide any evidence in the record of what products these companies make, what they displayed or promoted at the show, or who might have been present from these companies at the show. We do not know if the companies made digital video cameras, or, for example, action sports vehicles, parts, apparel, or other types of accessories. We do not agree that such facts are “judicially noticeable” or “verifiable by a quick Internet search,” as Petitioner argued at the hearing. *See* Tr. 85:7–86:11, 88:7–19. It was Petitioner’s obligation to provide the evidence necessary to substantiate its assertion of the GoPro Catalog as prior art.

Ultimately, it is Petitioner’s burden to prove unpatentability by a preponderance of the evidence, which includes proving that the GoPro Catalog qualifies as a prior art printed publication under 35 U.S.C. § 102(b). The evidence of record provided by Petitioner is not sufficient to show that the GoPro Catalog was disseminated or otherwise made available to the

extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence could have located it. Therefore, based on the record presented, the GoPro Catalog is not prior art to the '954 patent.

6. Analysis

Both of Petitioner's asserted grounds rely on the GoPro Catalog as prior art allegedly teaching certain limitations of the challenged claims. *See* Pet. 27–59; Ex. 1007 ¶ 118 (Mr. Román testifying that “I have been informed and understand that the GoPro Catalog is available as prior art under 35 U.S.C. § 102(b)”). For example, with respect to claim 1, Petitioner relies on Boland alone as allegedly teaching an “integrated, hands-free, portable, viewfinderless point of view digital video camera,” “image sensor,” “camera processor,” and “wireless connection protocol device,” and relies on the combined teachings of Boland and the GoPro Catalog as allegedly teaching the following limitations of claim 1:

- (1) the camera processor being configured to “generate, from the video image data, first video image content at a first resolution and second video image content at a second resolution, wherein the first resolution is lower than the second resolution”;
- (2) the camera processor being configured to “adjust image capture settings of the video camera prior to recording the scene based at least in part on at least a portion of the control signals”; and
- (3) executable instructions that cause a handheld personal portable computing device to “display the first video image content on a display of the handheld personal portable computing device, the first video image content comprising a preview image of the scene, the preview image allowing a user of the video camera to manually

adjust a position or orientation of the video camera to record the scene.”

Pet. 27–42 (arguing that “Boland in view of the GoPro Catalog” teaches the limitations above).¹¹

According to Petitioner, it would have been obvious to combine Boland’s teachings with the GoPro Catalog’s teaching of a camera and wireless remote control that perform certain functions. *Id.* at 29, 35–37, 39. For example, with respect to the “adjust[ing] image capture settings” limitation, Petitioner argues that Boland’s camera processor is configured to adjust image capture settings, and “[i]t would have been obvious to do so prior to recording in view of the [preview] teaching in the GoPro Catalog” because a person of ordinary skill in the art “would readily understand that previewing before recording allows for ‘filming opportunity and convenience.’” *Id.* at 36–37 (citing Ex. 1011, 15). Petitioner makes similar assertions for independent claims 11, 22, and 27, and relies on its arguments regarding the combined teachings of Boland and the GoPro Catalog for its asserted ground based on Boland, the GoPro Catalog, and Ueyama for claims 21 and 26. *Id.* at 49–50, 52–59.

As explained above, Petitioner has not established that the GoPro Catalog is a prior art printed publication under 35 U.S.C. § 102(b). Consequently, we determine that Petitioner has not shown, by a preponderance of the evidence, that the challenged claims are unpatentable based on Petitioner’s asserted grounds.

¹¹ Petitioner also argues that “Boland alone, or in view of the GoPro Catalog,” teaches “a lens and an image sensor, the image sensor capturing light propagating through the lens and representing a scene to be recorded.” Pet. 31–33.

III. ORDER

Petitioner has not demonstrated, by a preponderance of the evidence, that claims 1, 2, 11–20, 22–25, and 27–30 are unpatentable over Boland and the GoPro Catalog under 35 U.S.C. § 103(a), or that claims 21 and 26 are unpatentable over Boland, the GoPro Catalog, and Ueyama under 35 U.S.C. § 103(a).

In consideration of the foregoing, it is hereby:

ORDERED that claims 1, 2, and 11–30 of the '954 patent have not been shown to be unpatentable;

FURTHER ORDERED that Petitioner's Motion to Exclude (Paper 43) is *denied-in-part* and *dismissed-in-part*; and

FURTHER ORDERED that Patent Owner's Motion to Exclude (Paper 45) is *denied-in-part* and *dismissed-in-part*.

This is a final decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2015-01080
Patent 8,890,954 B2

PETITIONER:

Patrick D. McPherson
David T. Xue
John M. Baird
Karineh Khachatourian
DUANE MORRIS LLP
pdmcperson@duanemorris.com
DTXue@duanemorris.com
karinehk@duanemorris.com

PATENT OWNER:

Nicole M. Jantzi
Ian B. Brooks
Paul M. Schoenhard
ROPES & GRAY LLP
nicole.jantzi@ropesgray.com
Ian.Brooks@ropesgray.com
paul.schoenhard@ropesgray.com