

Docket Nos. 17-1894, 17-1936

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

GOPRO, INC.,

Appellant,

v.

CONTOUR IP HOLDING LLC,

Appellee.

*Appeals from the United States Patent and Trademark Office, Patent Trial and
Appeal Board in Nos. IPR2015-01078 and IPR2015-01080*

REPLY BRIEF OF APPELLANT GOPRO, INC.

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INTRODUCTION

For a brief whose primary thrust is that the Board's determination is all about the evidence, not law, Contour IP Holding, LLC's ("Contour's") brief is surprisingly light on discussion of that evidence. Contour makes no mention at all of the documentary corroboration GoPro provided showing that hundreds of copies of the GoPro Catalog (the "Catalog") were sent to and distributed at the Tucker Rocky Dealer Show ("Tucker Rocky"). Contour still has not explained why it chose not to depose Mr. Jones on the substance of his declarations or present any evidence or witnesses of its own. The lack of any rebuttal evidence is fatal to Contour's opposition, because the facts set forth in Mr. Jones's declarations and the corroborating evidence now stand unrebutted. Based on these facts, the Catalog was sufficiently accessible to members of the interested public, both at Tucker Rocky and for roughly six weeks thereafter, before the one-year time-bar date of September 13, 2009.

The Board's conclusion that the Catalog is not a printed publication should be therefore be reversed and remanded for further consideration of the obviousness grounds raised by GoPro in the proceedings below, with the Catalog correctly considered as prior art.

ARGUMENT

I. THE ONLY ISSUE ON APPEAL IS WHETHER, AS A MATTER OF LAW, THE CATALOG IS A PRINTED PUBLICATION

Whether a document is a printed publication is a legal conclusion based on the underlying facts. *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014). “Where no facts are in dispute, the question of whether a reference represents a ‘printed publication’ is a question of law.” *In re Klopfenstein*, 380 F.3d 1345, 1347 (Fed. Cir. 2004). Contour repeatedly derides as “false” GoPro’s observation that there are no facts in dispute. *See, e.g.*, Contour Br. at 2-3, 19. A party creates a genuine issue of material fact by presenting evidence to contradict the other side’s evidence, or by deposing the other side’s witnesses to introduce contradictions or cast doubt on that testimony. Attorney argument saying “I don’t believe” the only evidence in the record is not enough. *See, e.g., Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005) (recognizing that “[a]ttorney argument is no substitute for evidence” and affirming summary judgment of an on-sale bar where no rebuttal evidence was introduced). If it were, no question would ever be resolved as a matter of law.

Contour introduced no evidence to rebut the sworn statements in Mr. Jones’s declarations about how and when he distributed the Catalog. Contour never sought to depose him and Contour offered no reason to doubt the veracity of his testimony. Appx23 n.9. Nor has Contour introduced any evidence rebutting a

corroborating email from GoPro's CEO to Mr. Jones demonstrating that hundreds of copies of the Catalog were shipped to Mr. Jones's hotel at Tucker Rocky. Appx5004 ¶ 5; Appx5011-5012. Contour never mentions this documentary corroboration at all. Thus, the facts relevant to this appeal *are* undisputed. The remaining question is legal, not factual—whether those facts suffice to show that the Catalog was a printed publication.

In an effort to position itself under a more deferential substantial evidence review standard, Contour suggests that factual disputes remain between the parties. Contour Br. at 18. But the two “disputes” Contour identifies have either already been resolved below or are irrelevant to the merits of GoPro's appeal.

Contour first suggests that a factual dispute remains regarding the authenticity and admissibility of the Catalog. *See* Contour Br. at 19. In the proceedings below, Contour disputed the authenticity of the Catalog on the same grounds it raises here. Appx11; Appx577-578. It served objections and ultimately filed a motion to exclude the Catalog from evidence. *Compare* Appx1062-1067 *with* Contour Br. at 19-20. But Contour fails to mention that the Board *denied* this motion and held that the additional specificity sought by Contour was not required. The Catalog was deemed authentic and admitted as evidence. Appx10-13. Contour's motion to exclude was denied in part because Contour *withdrew* its earlier objections to the admissibility of the Catalog. *Id.*

Even if Contour had not withdrawn its challenge to the admissibility of the Catalog, the Board found that Contour’s “arguments regarding admissibility still would not be persuasive.” Appx11. If Contour wished to challenge the Board’s authenticity and admissibility determination, it could and should have filed a cross-appeal on this point. Because this is an appeal from a PTAB proceeding, the Administrative Procedures Act governs, rather than the normal district court rule that would permit affirmance on any ground supported in the record. Under the *Chenery* doctrine, a reviewing court may affirm “on a *legal* ground not relied on by the agency if there is no issue of fact, policy, or agency expertise.” *In re Comiskey*, 554 F. 3d 967, 974 (Fed. Cir. 2009) (emphasis added). This Court can affirm on any purely legal ground, but cannot substitute its own fact-finding for that done by the agency without an appeal challenging that fact-finding. *See SEC v. Chenery Corp.*, 318 U.S. 80, 88 (1943). Contour did not appeal the Board’s finding that the Catalog was properly authenticated and admissible, and thus, it waived the argument.¹

Next, Contour states that it submitted “to the Board rebuttal evidence regarding Tucker Rocky and the 2009 Tucker Rocky Dealer Show.” Contour Br.

¹ Contour’s argument is also entirely speculative. Contour offered no evidence to suggest that the Catalog was *not* the one actually shipped to Mr. Jones’s hotel room in July 2009, distributed at Tucker Rocky and after the show, but before the critical date of September 13, 2009.

at 20. But as GoPro explained in its opening brief, whether Tucker Rocky was open to the general public is not relevant to the legal issues implicated by GoPro's appeal. GoPro Br. at 34-40. Contour disputes GoPro's view based on Contour's reading of this Court's precedent (Contour Br. at 22), but that is a legal, not factual, dispute.

The facts that GoPro relies on, set forth in the Jones declarations and corroborated by contemporaneous emails, cannot be disputed at this stage. These facts are either sufficient to demonstrate the public accessibility of the Catalog or not. That is a question of law, and therefore the Board's answer to the question should be reviewed *de novo*. See *In re Klopfenstein*, 380 F.3d at 1347.

In re Hall, cited by Contour, does not hold otherwise. The *In re Hall* panel recognized that the legal determination of whether a reference is a printed publication "rests of the facts of each case" 781 F.2d 897, 899-900 (Fed. Cir. 1986). And the facts in *In re Hall* were set forth in an ***unrebutted*** affidavit regarding a university library's general practice for indexing and making available theses. *Id.* at 900 ("[T]he evidence of record consisting of Dr. Will's affidavits establishes a prima facie case for unpatentability of the claims under the § 102(b) publication bar. It is a case which stands unrebutted."). Based on these unrebutted facts, the Court concluded the thesis in question was sufficiently accessible to the

interested public, *as a matter of law*, to make it a prior art printed publication. *Id.* at 899-900.

Here, Mr. Jones's testimony is similarly unrebutted. The purported factual disputes raised by Contour in its Appellee's Brief are either untimely or irrelevant to the legal question this Court has been asked to resolve. As such, no deference should be given to the Board's erroneous legal determination that the Catalog is not a printed publication.

II. THE CATALOG IS A PRINTED PUBLICATION BASED ON DISTRIBUTION AT TUCKER ROCKY

Mr. Jones's declarations and corroborating contemporaneous emails confirm that from July 23-27, 2009, hundreds of copies of the Catalog were distributed at Tucker Rocky without any restrictions on future use. Appx4330-4331 ¶¶ 8-10; Appx5004-5005 ¶¶ 4-8; Appx5011-5012. These facts are not in dispute because Contour elected not to depose Mr. Jones and did not introduce any rebuttal evidence of its own. The question for this Court to resolve is whether this actual distribution of hundreds of copies of a sales catalog at a trade show without any confidentiality restriction is sufficient for the Catalog to be a printed publication.

The Board made two legal errors when it determined that the facts showing distribution of the Catalog at Tucker Rocky were insufficient to make the Catalog a printed publication. First, it placed undue emphasis on whether Tucker Rocky was

open to the general public in addition to Tucker Rocky members. Appx23-25. Second, it imposed a requirement on GoPro to show that at least some of the Tucker Rocky attendees were persons of ordinary skill in the art.² Appx25-28. Neither requirement, however, is imposed by the law.

A. There Is No Legal Requirement that Tucker Rocky Was Open to the General Public

Contour appears to agree with GoPro that there is no legal requirement for Tucker Rocky to have been open to the public in order for the Catalog to be considered a printed publication. Contour Br. at 24 (“GoPro also argues that, even if public availability is required (again, nobody ever said it was)”). The problem is that the Board treated openness to the general public as an important factor when it concluded that GoPro’s lack of proof on that question was “significant” to its determination that the Catalog was not a printed publication. Appx24-25. But the Board’s analysis of this issue does not cite any case supporting this legal conclusion, let alone a case involving facts like those here, where *hundreds* of copies of a reference were *actually distributed* (not just displayed) at an event without any confidentiality restriction. Appx4330 ¶ 8.

² Contour does not argue in its brief that interested members of the public were not in attendance at Tucker Rocky (provided they were members of Tucker Rocky). Thus, any argument that the Catalog was not distributed at least to interested members of the public is waived.

Contour maintains that if availability to the general public is shown no further analysis is necessary, because “the set of persons interested and ordinarily skilled is presumably a subset of the general public.” Contour Br. at 23. On Contour’s reading, the standard of proof is heightened if the conference at which a reference is distributed is not open to the public.

The cases, however, draw a different distinction. The concern in cases like *In re Klopfenstein* is that if a reference is *only* disseminated orally or visually, via a presentation or poster that cannot be kept by audience members, the skill level of the audience is a necessary factor to consider, since if no one retains and understands the content of the presentation, the public does not benefit from its disclosure. *See* 380 F.3d 1345, 1350-51 (Fed. Cir. 2004).

By contrast, in *MIT v. AB Fortia*, a paper was deemed a printed publication after being delivered orally to persons of ordinary skill in the art and distributed in hard copy at least six times. 774 F.2d 1104, 1109 (Fed. Cir. 1985). Notably, “[t]he key to the [MIT] court’s finding was that actual copies of the presentation were distributed.” *In re Klopfenstein*, 380 F.3d at 1349. The Court did not focus on *who* specifically received these copies. *MIT*, 774 F.2d at 1109.

Other cases further undermine Contour’s assertion that the lack of availability to the general public means that a party relying on a printed publication bar “needs to work a little harder.” Contour Br. at 24. *See, e.g., Garrett Corp. v.*

United States, 422 F.2d 874, 878 (Ct. Cl. 1970) (holding that distribution of a reference to six commercial companies “without restriction on use clearly” constitutes publication without analyzing who actually received the reference); *Orion IP, LLC v. Hyundai Motor Am.*, 605 F.3d 967, 974-75 (Fed. Cir. 2010) (holding that sales catalogs shown to car dealers were printed publications, without analyzing whether the car dealers possessed ordinary skill in the art).

Rather than adopting the presumption that availability to the general public presumptively establishes availability to persons of ordinary skill in the art as Contour proposes, this Court’s precedent has consistently held that “[t]he determination of whether a reference is a ‘printed publication’ under 35 U.S.C. § 102(b) 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 at 1350. And “[t]he statutory phrase ‘printed publication’ has been interpreted to mean that before the critical date the reference must have been sufficiently accessible to the *public interested in the art . . .*” *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989) (quoting *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568 (Fed. Cir. 1988)) (emphasis added). Accessibility by the general public is not required. The Board’s heavy emphasis on the fact that GoPro did not prove Tucker Rocky was open to the general public therefore constitutes legal error.

B. Additional Proof that the Catalog Was Also Available to Persons of Ordinary Skill in the Art Is Not Required

The Board also erred by requiring GoPro to prove that attendees of Tucker Rocky were interested in the Catalog *and* possessed ordinary skill in the art. Where, as here, enablement of the printed publication is not at issue,³ the legal rationale underlying the printed publication bar is served when a reference is accessible to members of the interested public, even if they do not possess sufficient skill to design the product themselves. *See* GoPro Br. at 41-44, 48-49. As this Court recognized in *In re Klopfenstein*, 380 F.3d at 1351, “the entire purpose of the ‘printed publication’ bar was to ‘prevent withdrawal’ of disclosures ‘already in the possession of the public’ by the issuance of a patent.” This rationale is “grounded on the principle that once an invention is in the public domain, it is no longer patentable by anyone.” *In re Hall*, 781 F.2d 897, 898 (Fed. Cir. 1986). As a result, once a reference becomes “sufficiently accessible to the public interested in the art[,]” it is deemed “published” for prior art purposes. *In re Cronyn*, 890 F.2d at 1160.

Contour points to some of this Court’s decisions addressing the printed publication bar that refer to the relevant public as “persons interested and

³ Contour has never argued, below or on appeal, that the relevant excerpts from the Catalog are not enabled.

ordinarily skilled” in the art. Contour Br. at 26-27. Contour admits that “panels of this Court have chosen at times to recite only portions of the standard,” but it is equally plausible that other decisions have included unnecessary language. Contour Br. at 28. Contour makes no attempt to reconcile the differing language and fails to address GoPro’s argument that the reference to ordinary skill is due in part to the legal requirement that a reference must be published *and* enabled for it to be prior art.⁴

Contour’s argument that disclosure of a reference to persons of ordinary skill is necessarily required for it to be considered “published” elevates the language in the cases over the underlying logic. Few cases actually examine whether persons satisfying the definition of a person of ordinary skill in the art had access to the reference at issue. For example, in *Orion*, sales catalogs shown to car dealers (not the general public) were deemed printed publications. 605 F.3d at 974-75. While they were clearly interested persons, the Court did not analyze whether any of them were also persons of ordinary skill. *Id.* As GoPro explained in its Opening Brief, the skill of the target audience of a reference matters only in unique circumstances not present here. GoPro Br. at 49-50; *In re Klopfenstein*, 380 F.3d

⁴ The person of ordinary skill is of course relevant to the question of whether a reference, in addition to being “published,” is enabled for what it teaches. GoPro Br. at 48-49.

at 1350-51 (considering the “expertise of the target audience” for a slide presentation that was displayed but not distributed, because it could help “determine how easily those who viewed [the slide presentation] could retain the displayed material”).

The Catalog was a sales catalog. Appx5005-5006 ¶¶ 7-10. Its intended audience was GoPro retailers, dealers, and their customers. Appx4330 ¶¶ 7-8. Contour has never disputed that the Catalog sufficiently informed this intended audience about GoPro cameras and accessories. Contour has offered no rationale for requiring GoPro to prove that attendees of Tucker Rocky were interested in the Catalog *and* possessed ordinary skill. Their interest in the subject matter of the Catalog is enough. *See, e.g., Orion*, 605 F.3d at 975 (holding that a sales catalog was prior art “because it was accessible to those *interested in the business of auto parts*” before the critical date) (emphasis added); *Iovate Health Scis., Inc. v. Bio-Engineered Supplements & Nutrition, Inc.*, 586 F.3d 1376, 1380 (Fed. Cir. 2009) (finding that an advertisement was a printed publication where it was “published in *Flex* magazine and that the magazine was accessible to those *interested in the art of nutritional supplements*” prior to the critical date) (emphasis added); *see also* GoPro Br. at 42-43 (citing additional cases).

This is particularly true given the facts of this case, which show that the Catalog was distributed to attendees of Tucker Rocky without any confidentiality

restrictions. Thus, it is very likely that attendees of Tucker Rocky who received copies of the Catalog subsequently made it available to their customers.⁵

Distribution of the Catalog at Tucker Rocky put hundreds of copies of the Catalog in the hands of hundreds of interested persons, who were free to use the Catalog however they desired. Contour has not identified a single case where disclosure to this number of interested persons was found insufficient to show “publication” for any reason, let alone because of a lack of explicit proof that persons of ordinary skill were also present. Contour’s counsel confirmed this fact to the Board when he was asked whether he was “aware of any cases where a reference was available to interested persons but not necessarily persons of ordinary skill in the art?” Appx1438 ll. 23-25. He answered, “I’m not, no.”⁶ Appx1439 l. 1 (emphasis added).

⁵ Contour suggests that this is a new argument that GoPro waived. *See* Contour Br. at 25-26 n.6. But GoPro’s argument that distribution of the Catalog is sufficient to make the Catalog “published” was made below and is unchanged. The common sense notion that retailers who took copies of the Catalog with them did so to show them to their potential customers is additional support for the same argument, not a new theory of the case. *Jockmus v. Leviton*, 28 F.2d 812, 814 (2d Cir. 1928) (“[N]o one can seriously suppose that such a document, printed in quantity, was intended to be kept secret; its whole purpose was to be spread broadcast as far as possible.”).

⁶ GoPro never argued that Contour failed to identify any decision that “turned on lack of disclosure to persons ordinarily skilled.” Contour Br. at 29. Rather, GoPro correctly stated that Contour has not identified any case in which “disclosure of a reference to the interested public had been shown, but was found not to be a

Contour cites *Preemption Devices, Inc. v. Minnesota Mining & Manufacturing Co.*, 559 F. Supp. 1250 (E.D. Pa. 1983), *aff'd*, 732 F.2d 903, 906 (Fed. Cir. 1984), but it is not such a case. See Contour Br. at 29. In *Preemption Devices*, the only evidence of dissemination prior to the critical date was the mailing of several sales brochures relating to traffic control devices to a woman named Leigh Robertson. 559 F. Supp. at 1260. As the court explained, “Ms. Robertson was a friend of Long’s [the inventor] who had access to persons with considerable financial resources but who lacked technical expertise in electronic devices.” *Id.* The inventor’s company was having financial difficulties and the “forwarding of the brochures . . . was a desperate attempt to gain some financial backing.” *Id.* While the court concluded that Ms. Robertson was “not skilled in the art,” it also found that “[n]o evidence was introduced to show that [she] was *involved in or concerned with traffic control devices* or that she disseminated the brochures to anyone who was so involved.”⁷ *Id.* (emphasis added). Thus, the only person that the brochures were sent to was neither interested in the art nor ordinarily skilled. Such a limited disclosure is clearly insufficient, because “[t]he printed publication based on lack of proof that persons of ordinary skill in the art also had access.” GoPro Br. at 47.

⁷ The court also found that the brochures were not “printed publications” because “they did not include the mechanical information that would allow an expert in the area to create the same or a similar device,” i.e., they were not enabling to one of ordinary skill in the art. *Preemption Devices*, 559 F. Supp. at 1259.

public, for purposes of the statute, constitutes that class of persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.” *See Garrett Corp.*, 422 F.2d at 878 (citing *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928)). Ms. Robertson was not interested in traffic control devices and thus, the holding in *Preemption Devices* is unsurprising.

By contrast, hundreds of copies of the Catalog were made available to attendees of Tucker Rocky interested in GoPro products and accessories. Such persons, including GoPro retailers, are likely to avail themselves of the contents of the Catalog, so that they can explain to their customers what GoPro cameras and accessories are available, their relevant features, and how to use them. Once the attendees of Tucker Rocky received the Catalog, in hardcopy and without any confidentiality restriction, they were free to use it as they saw fit with their customers. As such, the Catalog was “in the possession of the public” and its contents should be available prior art to challenge Contour’s patents, just as the Catalog would preclude GoPro from obtaining a patent of its own on the contents described therein, filed more than a year after the Catalog was distributed. *See In re Wyer*, 655 F.2d 221, 226 (C.C.P.A. 1981).

III. THE CATALOG IS A PRINTED PUBLICATION BASED ON THE UNDISPUTED FACTS SHOWING IT WAS DISTRIBUTED AFTER TUCKER ROCKY

Both of Mr. Jones's declarations include testimony about how the Catalog was distributed after July 27, 2009 (the last day of Tucker Rocky), but before the critical one-year date of September 13, 2009. *See* Appx4331 ¶ 11; Appx5005-5006 ¶ 10. Contour offered no evidence of its own challenging Mr. Jones's statements. Appx23 n.9.

Faced with this unrebutted testimony, Contour argues that GoPro waived the argument that distribution after Tucker Rocky was sufficient to make the Catalog a printed publication and that Mr. Jones's declarations do not contain enough specifics for the Catalog to be deemed a printed publication. Contour Br. at 30-34. In view of the record below and this Court's precedent, both of Contour's arguments should be rejected.

A. GoPro Did Not Waive this Argument

GoPro did not waive the argument that the Catalog is a printed publication based on distribution after Tucker Rocky, but before the one-year time bar. Mr. Jones's declarations contain testimony about his distribution of the Catalog during this timeframe and GoPro expressly cited the relevant paragraph from Mr. Jones's declaration in its Petition. *See* Appx4331 ¶11; Appx306 (citing paragraph 11 of

the Jones declaration in support of the argument that the Catalog was “distributed publicly”); Appx5005-5006 ¶10.

Contour recognized that this was an argument GoPro was making in the proceedings below. In Contour’s Preliminary Patent Owner Response (before institution)⁸, Patent Owner Response (after institution), and demonstrative exhibits presented to the Board at oral argument, Contour dedicated entire sections to explicitly addressing GoPro’s arguments regarding distribution of the Catalog after Tucker Rocky. *See* Appx427-428; Appx804-805; Appx5914. It would not have done so if, as it now claims, GoPro never even made the argument below.

Similarly, the Board addressed the issue in its Final Written Decisions. While the Board incorrectly stated that GoPro did not raise this issue in its Petition,⁹ the Board went on to address the merits of the argument and conclude

⁸ In the Institution Decision, the Board acknowledged Contour’s argument about post-show distribution and concluded that “[b]ecause Petitioner’s assertions regarding the GoPro Catalog’s availability at the Tucker Rocky Dealer Show in 2009 are sufficient for a threshold showing, however, we need not determine at this time any public accessibility that may have occurred subsequent to the show.” Appx513. The Board did not suggest that GoPro never made the argument, as the Board later did in its Final Written Decision. Indeed, had GoPro never made the argument it would be odd that the Board had addressed it.

⁹ Contour incorrectly asserts that “GoPro has not argued here that the Board committed any error in finding that GoPro did not make this argument in its petitions.” Contour Br. at 31. To the contrary, that is exactly what GoPro argued in its Opening Brief: “The Board *incorrectly states* that disclosure at the 2009 Tucker Rocky Dealer Show ‘is the only basis for the GoPro Catalog being prior art

that Mr. Jones’s un rebutted testimony regarding distribution of the Catalog after Tucker Rocky was not specific enough for the Board to “assess whether the GoPro Catalog was disseminated in any way other than at the 2009 Tucker Rocky Dealer Show” Appx22 n.8. The Board did not find waiver or a violation of 35 U.S.C. § 312(a)(3)¹⁰ or 37 C.F.R. § 42.6(a)(3),¹¹ both which Contour relies on to support its waiver argument.

Thus, this is not a situation where Contour was surprised by GoPro’s arguments. At all times, GoPro has argued that the Catalog is a prior art printed publication based on *both* the distribution of hundreds of copies of the Catalog at Tucker Rocky and on its further availability to the public during the roughly six-

argued by Petitioner in its Petition.” GoPro Br. at 28 n.2 (emphasis added).

¹⁰ Section 312 requires that an IPR petition identify “the evidence that supports the grounds for the challenge to each claim,” which includes “affidavits or declarations of supporting evidence.” 35 U.S.C. § 312(a)(3). This requirement serves to ensure that “a patent owner has sufficient notice of the challenge against which it must defend.” *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2154 (2016). Here, there can be no doubt that Contour was on notice of GoPro’s challenge because it specifically addressed the argument in its various papers, discussed above.

¹¹ 37 C.F.R. § 42.6(a)(3) provides that “[a]rguments must not be incorporated by reference from one document into another document.” The PTAB has recognized that this regulation “prohibits incorporation of *arguments*, and an expert declaration . . . generally is considered *evidence*, not argument.” *Silicon Labs., Inc. v. Cresta Tech. Corp.*, No. IPR2015-00626, 2016 WL 8969909, *7 (P.T.A.B. Aug. 11, 2016) (emphasis in original). Mr. Jones’s two declarations are factual evidence about what occurred, not legal argument about what should be decided.

week period following the show. Contour understood and responded to both arguments made by GoPro, and the Board addressed both arguments in its Final Written Decisions. Waiver in these circumstances is not warranted. *See, e.g., Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1251-52 (Fed. Cir. 2005) (recognizing that “[a]n appellate court retains case-by-case discretion over whether to apply waiver” and finding no waiver where the “same concept” was being argued on appeal as had been argued below, even though in a slightly different way); *Gaus v. Conair Corp.*, 363 F.3d 1284, 1288 (Fed. Cir. 2004) (declining to find a waiver, where the Court found “no change of position” by a party on appeal).

B. Mr. Jones’s Unrebutted Testimony Establishes Public Accessibility after Tucker Rocky

Contour argues that “GoPro’s evidence is insufficient to show distribution after the dealer trade show.” Contour Br. at 31. Contour is incorrect. The Jones declarations establish the following facts:

- i. From July 27, 2009 to September 13, 2009, Mr. Jones was personally familiar with the “marketing material available on GoPro’s website and distributed through direct mail”;
- ii. Mr. Jones was personally aware that the Catalog was distributed and made available to “GoPro’s actual and potential customers, dealers

and retailers” after July 27, 2009, but before September 13, 2009 through its website or by hardcopy; and

- iii. Mr. Jones was also personally aware that electronic copies of the Catalog were emailed to GoPro distributors after July 27, 2009, but before September 13, 2009.

Appx5005-5006 ¶ 10; Appx4331 ¶ 11.

Contour characterizes Mr. Jones’s sworn testimony as a “catch-all conclusion” (Contour Br. at 31), but again, Contour never challenged Mr. Jones’s statements in a deposition or introduced any rebuttal evidence. Thus, the question for the Court is whether Mr. Jones’s statements, taken as true, sufficiently demonstrate that the Catalog was publicly accessible.

Contour argues that Mr. Jones’s statements are not enough because Mr. Jones did not provide enough detail about how the Catalog was available on GoPro’s website. Contour Br. at 32-33. According to Contour, GoPro was required to describe how the Catalog could be accessed, whether access was freely available, and whether anyone actually viewed or downloaded the Catalog.¹² *Id.*

¹² Contour implies that the Catalog may not have been available on the website at all, noting that the Catalog refers to www.gopro.com while archival copies of the Catalog were accessed on www.goprocamera.com. Contour Br. at 33 n.8. But it is not surprising that a company’s website might be accessible from two different domain names. If Contour thought there was some uncertainty about GoPro’s

But the cases on which Contour relies involve very different facts. *Blue Calypso*, for example, considered the public accessibility of a reference hyperlinked on a graduate student's personal webpage, where there was no evidence that anyone viewed or downloaded the reference, nor was there any evidence that the webpage could be found using a search engine. 815 F.3d 1331, 1349 (Fed. Cir. 2016). On those facts, the Court found that the posting of a reference on a website did not make the reference sufficiently accessible to an "interested party exercising reasonable diligence." *Id.* By contrast, where a publication was in fact distributed, the fact that it was not searchable later did not prevent it from being a printed publication. *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1385 (Fed. Cir. 2014).

SRI International, Inc. v. Internet Security Systems, Inc., 511 F.3d 1186 (Fed. Cir. 2008), also cited by Contour, considered an electronic reference that was even more difficult to access. In that case, a draft thesis was posted on an FTP server that "might have been available to anyone with FTP know-how and knowledge" of a specific subdirectory. *Id.* at 1197. The reference was only posted to the FTP server to "facilitate peer review in preparation for later publication." *Id.*

websites at the relevant time that called into question the veracity of Mr. Jones's statements or the authenticity of the Catalog, it could have deposed Mr. Jones or presented rebuttal evidence to the Board. It did neither.

Given these facts, and because the paper was not “catalogued or indexed in a meaningful way *and not intended for dissemination to the public*[,]” the Court concluded that the paper was not a printed publication. *Id.* (emphasis added). “In effect,” posting a draft thesis on an FTP server, without more, was “most closely analogous to placing posters at an unpublicized conference with no attendees.” *Id.*

Thus, both of the cases cited by Contour involve references posted on websites that are different in character from a commercial website like GoPro’s. And unlike the references at issue in those cases, the Catalog is a sales catalog, the entire purpose of which is dissemination to the public. Furthermore, neither of the cases cited by Contour involved un rebutted facts, like those present here, regarding distribution of a reference *in addition* to availability on a website.

Contour also discounts Mr. Jones’s additional testimony about direct mail and email distribution of the Catalog after Tucker Rocky, however, because he does not testify that “anyone actually received any mailings prior to the critical date.” Contour Br. at 33-34. But Contour seeks to impose a rigid proof requirement where there is none. *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 139 (Fed. Cir. 1986), cited by Contour, does not hold that actual receipt of mailed references must be shown to give rise to a printed publication bar. Instead, the *Carella* decision quotes with favor the flexible standard set forth in *In re Wyer*, pursuant to which a party relying on a printed publication as prior art

“should produce sufficient proof of its dissemination or that it has been otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.” *Carella*, 804 F.2d at 139 (quoting *In re Wyer*, 655 F.2d 221, 227 (C.C.P.A. 1981)).

Applying this standard to the facts before it, the *Carella* court found that the reference at issue was not a printed publication because that there was no evidence that the reference was *ever* sent prior to the critical date, let alone any evidence as to the “date of receipt of the mailer by any of the addressees.” *Id.* at 136, 139 (finding no public accessibility until after the mailing of an advertisement on August 17, 1966, where the priority date was August 7, 1967).

In contrast, Mr. Jones’s declarations establish that the Catalog was sent after July 27, 2009, but before the critical date of September 13, 2009 to GoPro’s customers, dealers and distributors. Appx5005-5006 ¶ 10; Appx4331 ¶ 11. While the lack of specifics regarding the dates on which hard copies were actually received by GoPro’s actual and potential customers might weigh against concluding that the Catalog was publicly accessible if it were the *only* evidence of dissemination, Mr. Jones testified that he also emailed copies of the Catalog to GoPro distributors, which would have been received a few minutes after Mr. Jones sent them. Appx5005-5006 ¶ 10.

Together with Mr. Jones's testimony that the Catalog was also available on GoPro's website and distributed at Tucker Rocky, the flexible standard of *In re Wyer* is satisfied. Those persons "concerned with the art" to which the Catalog relates and "most likely to avail themselves of its contents," could have, at a minimum, viewed it on GoPro's website, or requested it via hard copy or email. *See In re Wyer*, 655 F.2d at 227. While more specific "evidence would be desirable, in lending greater certainty to the accessibility determination, the realities of routine business practice counsel against requiring such evidence." *In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986). Approximate dates of public availability set forth in unrebutted affidavits were deemed sufficient by the panel in *In re Hall*, because the approximate dates were several weeks before the critical date and therefore "[r]eliance on an approximation . . . works no injustice . . ." *Id.*

Contour argues that the cases cited by GoPro where unrebutted testimony was deemed sufficient to demonstrate public accessibility are inapplicable because those cases dealt with testimony about routine business practices, whereas Mr. Jones testified about distribution of the Catalog specifically. Contour Br. at 34-36. But if unrebutted testimony about routine business practices is sufficient to demonstrate public accessibility, unrebutted testimony proving distribution of a specific reference should be even more persuasive. Indeed, the only reason routine business practices were at issue in *In re Hall* and *Constant v. Advanced Micro-*

Devices, Inc. was because specific evidence of public availability of the references in question was not available. See *In re Hall*, 781 F.3d at 899 (relying on “[t]he probative value of routine business practice to show performance of a specific act”); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988) (relying on “routine business practice” to show availability to the “interested members of the relevant public”). Mr. Jones, however, provided unrebutted testimony about the distribution of the specific prior art reference itself and eliminated the need for testimony about GoPro’s ordinary business practices regarding distribution.

The fact that the Catalog is a sales catalog further corroborates Mr. Jones’s testimony about its public availability. Contour asserts that GoPro “never presented facts regarding ‘the nature of the publication’ to support its claim” that the Catalog was publicly disseminated (Contour Br. at 37), but that is not true. The Jones declarations explain when and how the Catalog was disseminated, and the contents of the Catalog make it clear that it was intended to serve as promotional material for GoPro cameras and accessories. It would make little sense for GoPro to go to the trouble of creating and printing such a catalog if it did not intend to make it available to the interested public. But the Court need not make any assumptions about whether the Catalog was, in fact, distributed. Mr. Jones’s

declarations confirm that the Catalog went “upon its intended errand” and was made available to the public. *Jockmus v. Leviton*, 28 F.2d 812, 814 (2d Cir. 1928).

Thus, the facts of this case are closely analogous to those in *Orion IP, LLC v. Hyundai Motor America*, where the Court concluded that a sales catalog was a prior art printed publication based on unrebutted testimony.¹³ 605 F.3d at 974-75. The evidence there showed that the sales catalogs were used by salespersons in the field and that the declarant personally demonstrated the products described in the catalog, but no specific evidence was provided regarding who saw the catalog, when they saw it, or under what circumstances. *Id.* Thus, the purported deficiencies in Mr. Jones’s testimony that Contour emphasizes on appeal were also missing from the testimony considered in *Orion*. But as the *Orion* court’s holding confirms, such specifics are not required.¹⁴ *Id.*; see also *In re Hall*, 781 F.2d at 899.

¹³ *Orion* is not a case about routine business practices, as Contour contends. See Contour Br. at 35-36. Instead, the evidence presented related to dissemination of a specific sales catalog. *Id.*

¹⁴ While Contour argues that *Orion* involved “extensive factual evidence—not shown here” (Contour Br. at 35), it fails to acknowledge the additional factual evidence in Mr. Jones’s declarations, not shown in *Orion*, i.e., availability of the Catalog on GoPro’s website and via email, and the internal email corroborating the mass physical production of the catalogs. On balance, the amount of factual evidence in the two cases is similar.

In *Jockmus v. Leviton*, the court also considered the public accessibility of a sales catalog and concluded that, due to the nature of the document, oral testimony is sufficient to corroborate its availability. Contour's attempt to distinguish *Jockmus* on the grounds that printing costs have decreased since it was decided misses Judge Hand's primary point.¹⁵ As Judge Hand recognized, the "whole purpose" of the catalog at issue, "was to be spread broadcast as far as possible" and "unless some accident happened to prevent, it would in due course have gone upon its intended errand." 28 F.2d at 814.

Here, the Catalog is of the same nature as the catalogs at issue in *Jockmus* and *Orion*. It was used to show the interested public GoPro's products and accessories. Mr. Jones provided un rebutted testimony that it was available on GoPro's website, sent via hard copy, and sent via email to GoPro's actual and

¹⁵ Contour also asserts that the "Catalog lacks any indication of when it was printed." Contour Br. at 38. Contour is wrong. Page 007 of the Catalog, for example, states that the "HD Motorsports HERO is available Fall '09." Appx4307. During oral argument, Contour's counsel agreed that "one could infer from that that that is a future timing," but he didn't "believe that that is enough by itself, in fact, to establish priority." Appx1448 ll. 5-6. Furthermore, Mr. Jones testified that he was familiar with GoPro marketing materials at the relevant time, the Catalog is the same catalog that was shipped to his hotel room in July 2009, and it is the same catalog that he distributed via other means prior to September 13, 2009. Appx5004-5006 ¶¶ 5-7, 10. Based on these facts, the Board denied Contour's motion to exclude the reference. Appx10-13.

potential customers, dealers, retailers and distributors. Judge Hand found distribution of a publication corroborated in similar circumstances:

[N]o one can seriously suppose that such a document, printed in quantity, was intended to be kept secret; its whole purpose was to be spread broadcast as far as possible. It had been printed at some expense in French for French customers, and, unless some accident happened to prevent, it would in due course have gone upon its intended errand. To prove that no accident did happen, and that it did reach its destination we have, it is true, only oral, though entirely disinterested, testimony; but it is a mistake to assume that, even under the extraordinarily severe tests applied to the proof of anticipation, every step must be buttressed by documents.

Jockmus, 28 F.2d at 814. For the same reasons, Mr. Jones's unrebutted testimony that the Catalog was publicly distributed after Tucker Rocky but before September 13, 2009 is sufficient to make the Catalog a printed publication under the law.

CONCLUSION

The unrebutted evidence in this case demonstrates that hundreds of copies of the Catalog were distributed to interested members of the public without any confidentiality restrictions and it was available on GoPro's website, all before the one-year time-bar date of September 13, 2009. The Board's conclusion, in the face of this evidence, that the Catalog is not a prior art printed publication constitutes legal error and should be reversed.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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