

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOPRO, INC.  
Petitioner

v.

CONTOUR IP HOLDING LLC,  
Patent Owner.

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Case No. IPR2015-01078

United States Patent No. 8,896,694 B2

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Before JUSTIN T. ARBES, NEIL T. POWELL, and  
KIMBERLY McGRAW, *Administrative Patent Judges*.

**PETITIONER'S SUPPLEMENTAL PAPER ON RELEVANCE OF  
DISTRICT COURT CLAIM CONSTRUCTION DECISION**

During the February 4, 2019 teleconference with the Board, counsel for Patent Owner asserted that the district court's claim construction order is relevant in this proceeding for a limited purpose. (Ex. 1040, 10:3-20). Patent Owner's counsel asserted that GoPro argued to the Board that there is no word "parallel" in the challenged claims, but the district court construed certain claims to require this limitation. *Id.*

Patent Owner seeks to manufacture inconsistency where there is none. GoPro has consistently argued that Boland teaches generation of high-resolution and low-resolution video data from the video image data in parallel. (Paper 1, 35-36 (explaining that Boland discloses "multiple, parallel video streams"); IPR2015-01080, Paper 38, 14 (explaining that Boland teaches generating "different qualities/resolutions from the video image data at the same time in parallel, not in serial as Patent Owner asserts")). At oral argument in these proceedings, counsel for GoPro clarified that the claims do not require parallel *processors*, nor do the claims require parallel processing *solely or directly from the image sensor* as Patent Owner maintained. (Paper 53, 23:4-24:6, 26:23-27:25, 78:11-80:18).

The district court's construction of the "generate" and "generating" terms that appear in claims 1, 3, and 11 in the '694 patent (Ex. 2016, 9:15-13:28) in no way undermines GoPro's arguments in front of the Board or the disclosure of Boland. While the district court construed the claims to require generation of two

video streams in parallel, consistent with GoPro's arguments to the Board, no requirement for the high resolution and low resolution video streams to be generated solely or directly from the image sensor using parallel processors was added. (*Id.*, 9:23-11:21).

Thus, even if the district court's claim construction applied in this proceeding, Boland teaches the "generating" element, because it discloses high resolution and low resolution video data generated in parallel. (Paper 1, 35-36; IPR2015-01080, Paper 38, 14). Thus, the district court's claim construction order is irrelevant to the obviousness issues before the Board on remand, and Patent Owner's argument to the contrary should be rejected.

Dated: February 22, 2019

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that on February 22, 2019, a copy of **PETITIONER'S SUPPLEMENTAL PAPER ON RELEVANCE OF DISTRICT COURT CLAIM CONSTRUCTION DECISION PURSUANT TO 37 C.F.R. § 42.8(a)(3)** was served by filing this document through the PTAB's E2E Filing System as well as delivering a copy via electronic mail upon the following:

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