

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOPRO, INC.,
Petitioner,

v.

CONTOUR IP HOLDING LLC,
Patent Owner.

Case IPR2015-01078
Patent 8,896,694 B2

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

ARBES, *Administrative Patent Judge*.

DECISION ON REMAND
35 U.S.C. § 318(a)

I. BACKGROUND

We address this case on remand after a decision by the United States Court of Appeals for the Federal Circuit in *GoPro, Inc. v. Contour IP Holding LLC*, 908 F.3d 690 (Fed. Cir. 2018).

Petitioner, GoPro, Inc., filed a Petition (Paper 1, “Pet.”) seeking *inter partes* review of claims 1–20 of U.S. Patent No. 8,896,694 B2 (Ex. 1002, “the ’694 patent”) pursuant to 35 U.S.C. §§ 311–319. On October 28, 2015, we instituted an *inter partes* review of claims 1–20 on two grounds of unpatentability (Paper 8, “Dec. on Inst.”). Patent Owner, Contour IP Holding LLC, filed a Patent Owner Response (Paper 30, “PO Resp.”), and Petitioner filed a Reply (Paper 38, “Reply”). Petitioner filed a Motion to Exclude (Paper 42, “Pet. Mot.”) certain evidence submitted by Patent Owner. Patent Owner filed an Opposition (Paper 47, “PO Mot. Opp.”) and Petitioner filed a Reply (Paper 50, “Pet. Mot. Reply”). Patent Owner filed a Motion to Exclude (Paper 44, “PO Mot.”) certain evidence submitted by Petitioner. Petitioner filed an Opposition (Paper 48) and Patent Owner filed a Reply (Paper 49). A combined oral hearing with Case IPR2015-01080¹ was held on June 22, 2016, and a transcript of the hearing is included in the record (Paper 53, “Tr.”).

The panel issued a Final Written Decision on October 26, 2016, concluding that Petitioner had not established that a reference applied in each of the asserted grounds of unpatentability, the GoPro Catalog (Ex. 1011), is a prior art printed publication under 35 U.S.C. § 102(b),

¹ The ’694 patent is a continuation of U.S. Patent No. 8,890,954 B2 (Ex. 1001, “the ’954 patent”), which is being challenged in Case IPR2015-01080.

and thus had not shown by a preponderance of the evidence that any of the challenged claims are unpatentable. *See* Paper 54, 30–31 (“Final Dec.”). The Federal Circuit subsequently vacated the decision and remanded to the Board. *GoPro*, 908 F.3d at 696; *see* Paper 68 (mandate issued on January 17, 2019). The Federal Circuit held that “[Petitioner] met its burden to show that its catalog is a printed publication under § 102(b),” and stated: “Because the Board refused to accept the GoPro Catalog as a printed publication, it did not consider the merits of [Petitioner’s] obviousness claims. On remand, the Board shall consider the GoPro Catalog as prior art and evaluate the merits of [Petitioner’s] unpatentability claims.” *GoPro*, 908 F.3d at 695–96 (citations omitted).

Also, while the instant proceeding was on appeal, the district court in the related litigation between the parties, *Contour IP Holding, LLC v. GoPro, Inc.*, Case No. 17-cv-04738-WHO (N.D. Cal.), rendered a decision on claim construction of the ’694 patent. Ex. 2016. Following the remand, Patent Owner requested authorization for the parties each to file a supplemental paper of no more than 350 words directed to claim interpretation and the district court decision, which we granted. *See* Papers 72, 74 (“PO Supp. Br.”), 75 (“Pet. Supp. Br.”). Patent Owner also filed a motion for additional discovery, which we denied. *See* Papers 76, 83.

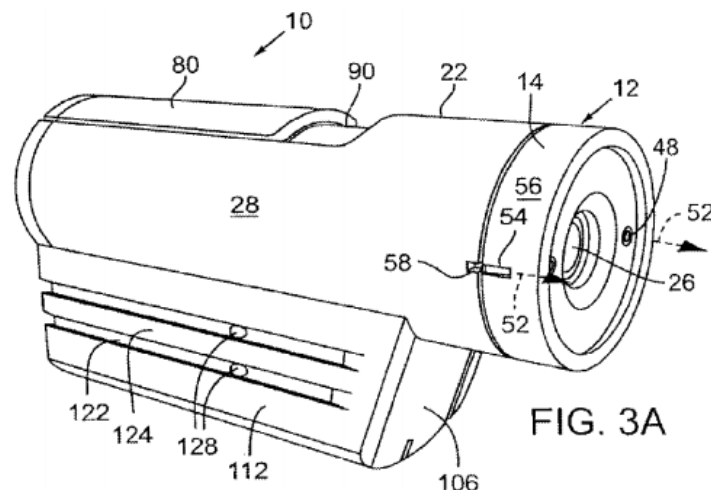
We have reconsidered the record developed during trial anew, as well as the parties’ supplemental briefing on claim interpretation (Papers 74, 75) and the district court decision (Ex. 2016), and evaluated the merits of Petitioner’s asserted grounds of unpatentability, considering the GoPro Catalog to be prior art. For the reasons that follow, we determine that

Petitioner has not demonstrated, by a preponderance of the evidence, that claims 1–20 of the '694 patent are unpatentable.

A. The '694 Patent

The '694 patent describes an “integrated hands-free, [point-of-view (POV)] action sports video camera or camcorder that is configured for remote image acquisition control and viewing.” Ex. 1002, col. 1, ll. 16–19. According to the '694 patent, “integrated hands-free, POV action sports video cameras” available at the time of the invention were “still in their infancy and may be difficult to use.” *Id.* at col. 1, ll. 46–51, Figs. 2A, 2B. The disclosed device uses global positioning system (GPS) technology to track its location during recording and a wireless connection protocol, such as Bluetooth, to “provide control signals or stream data to [the] wearable video camera and to access image content stored on or streaming from [the] wearable video camera.” *Id.* at col. 1, ll. 55–64, col. 16, ll. 52–62.

Figure 3A of the '694 patent is reproduced below.



As shown in Figure 3A, digital video camera 10 comprises camera housing 22, rotatable lens 26, image sensor 18 (not shown), such as a

complementary metal-oxide semiconductor (CMOS) image capture card, microphone 90, and slidable switch activator 80, which can be moved to on and off positions to control recording and the storage of video. *Id.* at col. 5, ll. 41–64, col. 8, l. 66–col. 9, l. 52. “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. 37–39. 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. 40–col. 20, l. 49.

B. Illustrative Claim

Claim 1 of the '694 patent recites:

1. A point of view digital video camera system, comprising:

an integrated hands-free portable viewfinderless video camera, the video camera including 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 without displaying the scene to a user of the video camera, wherein the real time video image data of the scene relates to an activity in which the user of the video camera is about to engage, the video camera comprising:

a camera processor for receiving the video image data directly or indirectly from the image sensor, and

a wireless connection protocol device operatively connected to the camera processor to send real time video

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