

# United States Court of Appeals for the Federal Circuit

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GOPRO, INC.,  
*Appellant*

v.

CONTOUR IP HOLDING LLC,  
*Appellee*

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2017-1894, 2017-1936

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

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OPINION ISSUED: July 27, 2018  
OPINION MODIFIED: November 1, 2018\*

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MARK A. LEMLEY, Durie Tangri LLP, San Francisco,  
CA, argued for appellant. Also represented by ADAM R.  
BRAUSA; KARINEH KHACHATOURIAN, Rimon, P.C., Palo  
Alto, CA.

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\* This opinion has been modified and reissued fol-  
lowing a petition for rehearing filed by Appellee.

PAUL MICHAEL SCHOENHARD, McDermott, Will & Emery LLP, Washington, DC, argued for appellee. Also represented by IAN BARNETT BROOKS, NICOLE JANTZI.

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Before REYNA, WALLACH, and HUGHES, *Circuit Judges*.

REYNA, *Circuit Judge*.

GoPro, Inc. appeals from final written decisions of the Patent Trial and Appeal Board in two *inter partes* review proceedings. In the proceedings, the Board found that the petitioner, GoPro, did not demonstrate that the challenged claims are unpatentable as obvious. The Board based this decision on its conclusion that a certain GoPro catalog is not a prior art printed publication. We disagree. We vacate and remand for further proceedings consistent with this opinion.

#### BACKGROUND

##### A. The '954 patent and '694 patent

Contour IP Holding LLC owns U.S. Patent Nos. 8,890,954 (“the '954 patent”) and 8,896,694 (“the '694 patent”). The patents share a common specification that generally relates to and describes action sport video cameras or camcorders that are configured for remote image acquisition control and viewing.<sup>1</sup> '954 patent, col. 1 ll. 16–17. According to the patents, the claimed 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. 53–62, col. 16 ll. 50–60.

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<sup>1</sup> Neither the claim terms nor the claimed inventions are at issue in this appeal.

The patents further describe that “[w]hen recording video or taking photographs in a sports application, [a] digital video camera . . . is often mounted in a location that does not permit the user to easily see the camera.” *Id.* at col. 19 ll. 35–37. The digital camera includes wireless communication capability to allow another device, such as a smartphone or tablet, to control camera settings in real time, access video stored on the camera, and act as a “viewfinder” to preview what the camera sees. *Id.* at col. 19 l. 38–col. 20 l. 47.

Both the ’954 and ’694 patents claim priority to a provisional application filed on September 13, 2010. Thus, the one-year critical date is September 13, 2009.

#### B. Proceedings Before the Board

GoPro petitioned for *inter partes* review (“IPR”) of the ’954 and ’694 patents on April 20, 2015. GoPro challenged the patentability of claims 1–30 of the ’954 patent and claims 1–20 of the ’694 patent on obviousness grounds, relying on a 2009 GoPro sales catalog (“the GoPro Catalog”) as prior art in each petition. The GoPro Catalog discloses a digital camera linked to a wireless viewfinder/controller that allows for a user preview before recording. The Board instituted both IPRs on October 28, 2015, as IPR2015-01080<sup>2</sup> and IPR2015-01078.

In its decisions to institute, the Board found that GoPro made a threshold showing that the GoPro Catalog is prior art. In reaching this determination, the Board concluded 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 point of view (“POV”) action

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<sup>2</sup> The Board instituted the IPR as to claims 1, 2, and 11–30 of the ’954 patent. J.A. 499.

sports video cameras. Critical to its decision, the Board credited a declaration from GoPro employee, Damon Jones, relating to the distribution of the GoPro Catalog. Mr. Jones worked at GoPro from 2008 to 2016 and participated in various trade organizations relevant to GoPro's business. This included Tucker Rocky Distributing ("Tucker Rocky"), a trade organization focused on action sports vehicles as well as related apparel, parts, and accessories.

In his declaration, Mr. Jones testified that Tucker Rocky holds an annual dealer trade show, which he attended in Fort Worth, Texas, from July 23 through July 27, 2009, on GoPro's behalf. Mr. Jones also testified that at the 2009 show, there were approximately 150 vendors and more than 1,000 attendees, including actual and potential dealers, retailers, and customers of portable POV video cameras. Mr. Jones stated that he manned the GoPro booth at the show, where the GoPro Catalog was displayed, and that he personally distributed the GoPro Catalog to attendees. Attached to Mr. Jones's declaration, GoPro provided the catalog, a vendor list and map of the Tucker Rocky 2009 show, and email records supporting Mr. Jones's statements. The declaration from Mr. Jones also included testimony that GoPro continued to make the GoPro Catalog available to GoPro's actual and potential customers, dealers, and retailers through its website, direct mail, and other means of distribution. During the proceedings, GoPro submitted a supplemental declaration from Mr. Jones to support statements from his first declaration.

In its Patent Owner Responses, Contour argued that GoPro had not demonstrated that the GoPro Catalog was a prior art printed publication. To support its argument, Contour submitted two pieces of evidence—a screenshot from Tucker Rocky's website from 2009 and a Facebook webpage for the 2013 Tucker Rocky Dealer Show. The 2009 website screenshot explained that Tucker Rocky is a

wholesale distributor that does not sell to the public. The 2013 Facebook page stated that the 2013 Tucker Rocky Dealer Show was open to dealers but not the public. Contour did not depose Mr. Jones.

In its final written decisions, the Board concluded that the GoPro Catalog did not qualify as a prior art printed publication under 35 U.S.C. § 102(b). *GoPro, Inc. v. Contour IP Holding LLC*, IPR2015–01078, Paper No. 54, at 28 (PTAB Oct. 26, 2016) (“’694 FWD”); *GoPro, Inc. v. Contour IP Holding LLC*, IPR2015–01080, Paper No. 55, at 28 (PTAB Oct. 26, 2016) (“’954 FWD”). Specifically, the Board concluded that GoPro had not met its burden 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 and exercising reasonable diligence could have located it. *See* ’694 FWD, at 28; ’954 FWD, at 27–28. Because all the instituted grounds were based on the GoPro Catalog, the Board found that GoPro had not demonstrated that the challenged claims of the ’954 and ’694 patents were unpatentable under 35 U.S.C. § 103.

GoPro timely appealed from these final written decisions to this court. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(A).

#### DISCUSSION

Whether a reference constitutes a printed publication under 35 U.S.C. § 102(b)<sup>3</sup> is a legal conclusion based on underlying factual determinations. *See In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009). The issue of whether a

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<sup>3</sup> Because the ’954 and ’694 patents each have an effective filing date before the effective date of the Leahy-Smith America Invents Act (“AIA”), references are to the pre-AIA version of 35 U.S.C. § 102. *See* Pub L. No. 112-29, 125 Stat. 284 (2011); 35 U.S.C. § 102 (2006).

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