

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)
Case IPR2015-01080 (Patent 8,890,954 B2)¹

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

ARBES, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)(i)

¹ This Decision addresses an issue pertaining to both cases. Therefore, we exercise our discretion to issue a single Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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IPR2015-01080 (Patent 8,890,954 B2)

Patent Owner Contour IP Holding LLC (“Patent Owner”) filed a Motion for Additional Discovery in the instant proceedings, and Petitioner GoPro, Inc. (“Petitioner” or “GoPro”) filed an Opposition.² For the reasons stated below, Patent Owner’s Motion is *denied*.

Background

The instant proceedings are on remand from the United States Court of Appeals for the Federal Circuit. During the original trials, Petitioner submitted two declarations from Damon Jones in support of its position that the GoPro Catalog (Ex. 1011) is a prior art printed publication under 35 U.S.C. § 102(b). *See* Exs. 1012, 1022. Specifically, Mr. Jones testified that he attended and distributed copies of the GoPro Catalog at the Tucker Rocky Dealer Show in 2009. Ex. 1012 ¶¶ 5, 8. The panel determined in each proceeding that Petitioner had not established that the GoPro Catalog is a prior art printed publication. Paper 54, 30 (“Final Dec.”).

The Federal Circuit subsequently vacated the Final Written Decisions and remanded to the Board. *GoPro, Inc. v. Contour IP Holding LLC*, 908 F.3d 690 (Fed. Cir. 2018). The Federal Circuit found that because the GoPro Catalog was distributed sufficiently at the Tucker Rocky Dealer Show, “[Petitioner] met its burden to show that its catalog is a printed publication under § 102(b).” *Id.* at 695 & n.5. The Federal Circuit further stated: “Because the Board refused to accept the GoPro Catalog as a printed publication, it did not consider the merits of [Petitioner’s] obviousness

² *See* IPR2015-01078, Papers 72 (authorizing filing of the Motion), 76 (“Mot.”), 78 (“Opp.”); IPR2015-01080, Papers 74, 80, 83. Although the analysis herein applies to both proceedings, we refer to the papers and exhibits filed in Case IPR2015-01078 for convenience.

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claims. On remand, the Board shall consider the GoPro Catalog as prior art and evaluate the merits of [Petitioner’s] unpatentability claims.” *Id.* at 695–96 (citations omitted).

Analysis

In an *inter partes* review, a party seeking discovery beyond what is expressly permitted by rule must do so by motion, and must show that such additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); *see* 37 C.F.R. § 42.51(b)(2)(i). Patent Owner, as the movant, bears the burden of demonstrating that it is entitled to the additional discovery sought. 37 C.F.R. § 42.20(c). We consider the five factors set forth in *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001 (PTAB Mar. 5, 2013) (Paper 26) (precedential) (“*Garmin*”), in determining whether additional discovery is necessary in the interest of justice.

Patent Owner in its Motion seeks the following discovery:

- (1) “an unredacted copy of the email provided as Exhibit A to Mr. Jones’s supplemental declaration” (Ex. 1023);
- (2) “native versions with all metadata of two versions of the HD Hero catalog (*i.e.*, (a) the version offered to the Board, [Ex. 1011]; and (b) the version located on an archived version of GoPro’s website identified as ‘v01,’ *see* Ex. 2017)”; and
- (3) “copies of records showing payments for the copies of the brochures, receipts associated with the brochure, [and] shipping statements to corroborate or disprove that the catalog proffered to the Board was created and delivered before the Tucker Rocky dealer show in 2009.”

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Mot. 1. Patent Owner argues that “information discovered by Patent Owner during the parties’ district court litigation . . . raises substantial questions about the veracity of Mr. Jones’[s] declarations and the catalog.” *Id.* at 2. Patent Owner acknowledges the Federal Circuit’s instruction that we must consider the GoPro Catalog as prior art on remand, but argues that authorizing additional discovery is permissible “notwithstanding the mandate” because “[t]he question of whether a fraud has been perpetrated upon the Board” is a different issue from whether the GoPro Catalog is prior art. *Id.* at 5. According to Patent Owner, the requested discovery “will permit the Board to determine whether the proffered GoPro Catalog is what Petitioner purports it to be, and whether Mr. Jones was truthful” in his original declarations. *Id.* Petitioner opposes the Motion, arguing that re-litigating the authenticity of the GoPro Catalog is inappropriate at this late stage, Patent Owner was not diligent in seeking the requested discovery, Patent Owner’s requests are based only on speculation, and the requests are unduly burdensome. Opp. 1.

The first *Garmin* factor asks whether the party seeking additional discovery demonstrates more than “[t]he mere possibility of finding something useful, and mere allegation that something useful will be found.” *Garmin* at 6. “The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.” *Id.* “Useful” in this context means “favorable in substantive value to a contention of the party moving for discovery,” not just “relevant” or “admissible.” *Id.* at 7.

Patent Owner makes three arguments in support of this factor. First, Patent Owner states that it located two other “versions of the GoPro

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Catalog” (referred to as “v01” and “v04”) on “archived versions of GoPro’s website” that postdate the Tucker Rocky Dealer Show and do not include the specific portion Petitioner relies on for its unpatentability arguments.

Mot. 2–3 (citing Exs. 2017, 2019, 2027, 2029). Patent Owner also argues that the part number referenced in the relied upon portion of the GoPro Catalog does not appear anywhere else online. *Id.* at 3 (citing Ex. 2028). According to Patent Owner, these facts raise uncertainty as to exactly what document Petitioner submitted to the Board. *Id.* Petitioner responds that Patent Owner’s arguments are speculative because the cited files are not actually “versions” of the GoPro Catalog, but “different catalogs” altogether. Opp. 5. According to Petitioner, the GoPro Catalog (Ex. 1011) is for “the HD Motorsports HERO product,” whereas the “v01” catalog (Ex. 2017) is for “the entire HD HERO product line.” Opp. 5 (emphases omitted).

We agree with Petitioner that the GoPro Catalog (Ex. 1011) is a different catalog from the “v01” and “v04” catalogs (Exs. 2017, 2019). Although certain portions of the catalogs are the same, there are numerous differences indicating that the GoPro Catalog (Ex. 1011) is not simply a different version of the archived versions submitted by Patent Owner, but rather is a different catalog directed to the HD Motorsports HERO product line.³ Most importantly, the introductory text is different. The GoPro Catalog states: “Introduc[ing] the HD MotorsportsHERO.” Ex. 1011, 2. In contrast, the “v01” and “v04” catalogs are not limited to the HD Motorsports HERO, but rather are directed to: “The HD HERO line of

³ The “v01” catalog (Ex. 2017) and “v04” catalog (Ex. 2019) appear to have identical content. For purposes of this discussion, we compare the GoPro Catalog (Ex. 1011) primarily to the “v01” catalog (Ex. 2017).

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