

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOPRO, INC.,
Petitioner,

v.

CONTOUR IP HOLDING LLC,
Patent Owner.

Case IPR2015-01080
Patent 8,890,954 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 1–30 of U.S. Patent No. 8,890,954 B2 (Ex. 1001, “the ’954 patent”) pursuant to 35 U.S.C. §§ 311–319. On October 28, 2015, we instituted an *inter partes* review of claims 1, 2, and 11–30 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 39, “Reply”). Petitioner filed a Motion to Exclude (Paper 43, “Pet. Mot.”) certain evidence submitted by Patent Owner. Patent Owner filed an Opposition (Paper 48, “PO Mot. Opp.”) and Petitioner filed a Reply (Paper 51, “Pet. Mot. Reply”). Patent Owner filed a Motion to Exclude (Paper 45, “PO Mot.”) certain evidence submitted by Petitioner. Petitioner filed an Opposition (Paper 49) and Patent Owner filed a Reply (Paper 50). A combined oral hearing with Case IPR2015-01078¹ was held on June 22, 2016, and a transcript of the hearing is included in the record (Paper 54, “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), and thus had not shown by a preponderance of the evidence that any of the

¹ U.S. Patent No. 8,896,694 B2 (Ex. 1002), which is being challenged in Case IPR2015-01078, is a continuation of the ’954 patent.

challenged claims are unpatentable. *See* Paper 55, 29–30 (“Final Dec.”). The Federal Circuit subsequently vacated the decision and remanded to the Board. *GoPro*, 908 F.3d at 696; *see* Paper 70 (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).

Subsequent to the Final Written Decision and while the instant proceeding was on appeal, the Supreme Court of the United States held that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). Accordingly, we modified the Decision on Institution to institute on all claims and all grounds asserted in the Petition (including the originally non-instituted challenges to claims 3–10). Paper 74, 3–4, 8. The parties subsequently filed a joint motion to limit the Petition to remove the newly instituted grounds from consideration, which we granted. *See* Paper 77. Thus, the grounds now at issue are the same as those in the original trial.

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 ’954 patent. Ex. 2016. Following the remand, Patent Owner requested authorization for the parties each to file a

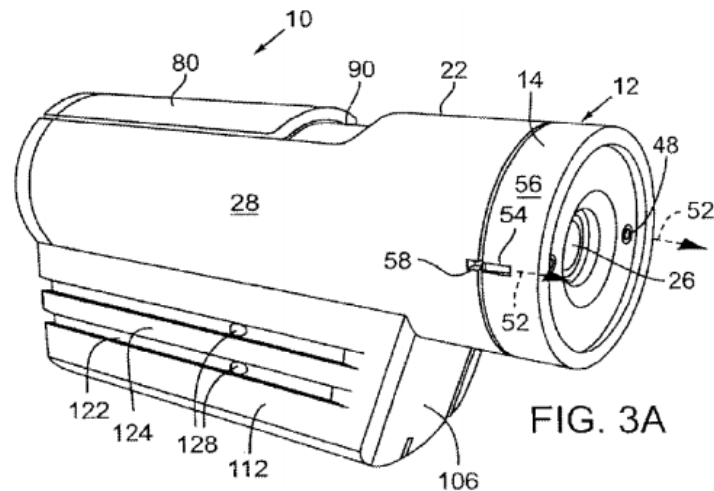
supplemental paper of no more than 350 words directed to claim interpretation and the district court decision, which we granted. *See* Papers 74, 78 (“PO Supp. Br.”), 79 (“Pet. Supp. Br.”). Patent Owner also filed a motion for additional discovery, which we denied. *See* Papers 74, 88.

We have reconsidered the record developed during trial anew, as well as the parties’ supplemental briefing on claim interpretation (Papers 78, 79) 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, 2, and 11–30 of the ’954 patent are unpatentable.

A. The ’954 Patent

The ’954 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. 1001, col. 1, ll. 14–17. According to the ’954 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. 44–49, 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. 53–62, col. 16, ll. 50–60.

Figure 3A of the '954 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. 38–61, col. 8, l. 64–col. 9, l. 50. “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. 35–37. 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. 38–col. 20, l. 47.

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