

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AXON ENTERPRISE, INC.,
Petitioner

v.

DIGITAL ALLY, INC.,
Patent Owner

Case PGR2018-00052
Patent 9,712,730

**PATENT OWNER'S PRELIMINARY RESPONSE
TO PETITION FOR POST-GRANT REVIEW**

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<i>In re Suitco Surface, Inc.</i> , 603 F.3d 1255 (Fed. Cir. 2010)	5
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Microsoft Corp. v. Proxyconn, Inc., 789 F.3d 1292 (Fed. Cir. 2015) 5

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Statutes:

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Regulations:

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