

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, MICHAEL J. FITZPATRICK, and
NEIL T. POWELL, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

Introduction

Petitioner filed a Request for Rehearing (Paper 55, “Req. Reh’g”) of our Final Decision (Paper 54, “Dec.”) determining that Petitioner had not shown, by a preponderance of the evidence, that claims 1–20 of U.S. Patent No. 8,896,694 B2 (Ex. 1001, “the ’694 patent”) are unpatentable. Patent Owner filed an Opposition (Paper 56, “Opp.”), pursuant to our authorization provided to the parties by email on November 28, 2016. For the reasons stated below, Petitioner’s Request for Rehearing is *denied*.

Analysis

The party requesting rehearing bears the burden of showing that a decision should be modified. 37 C.F.R. § 42.71(d). “The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

In the Final Decision, we determined that the evidence provided by Petitioner was not sufficient to show that a reference relied upon in each of Petitioner’s obviousness grounds, the GoPro Catalog (Ex. 1011), is a prior art printed publication under 35 U.S.C. § 102(b). Dec. 19–28. The entirety of Petitioner’s argument in the Petition is as follows:

The GoPro Catalog was distributed publicly at least as early as July 2009, when GoPro attended the 2009 Tucker Rocky Dealer Show and handed the GoPro Catalog to potential customers. Thus, it is a printed publication at least as early as July 2009, and is therefore available as prior art under 35 U.S.C. § 102(b).

Paper 1, 24 (“Pet.”) (citing Ex. 1012 ¶¶ 4–11). Petitioner did not include any further explanation in its Petition, relying solely on the cited declaration

from Damon Jones, a Senior Product Manager employed by Petitioner. *Id.* Petitioner later submitted a supplemental declaration from Mr. Jones (Ex. 1022), and argued in its Reply that the GoPro Catalog qualifies as prior art. Paper 38, 2–4 (“Reply”). We evaluated all of Petitioner’s arguments and evidence in the Final Decision. *See* Dec. 19–28. Based on the record presented, we were not persuaded that Petitioner had submitted sufficient proof that the GoPro Catalog is a prior art printed publication, for two main reasons: (1) Petitioner provided no evidence that the 2009 Tucker Rocky Dealer Show was advertised or announced to the public, such that members of the public, including persons interested and ordinarily skilled in the art,¹ would have known about it and could have obtained a copy of the GoPro Catalog there, and (2) Petitioner provided no evidence that the GoPro Catalog was disseminated or otherwise made available at the 2009 Tucker Rocky Dealer Show to persons ordinarily skilled in the art. *Id.* at 23–28.

Petitioner does not appear to dispute the first reason above, but as to the second, argues that we misapprehended the case law regarding prior art printed publications. Req. Reh’g 3–15. First, Petitioner continues to argue that the appropriate standard to be applied to determine whether a reference is a prior art printed publication is accessibility only to the “interested public.” *Id.* at 2–7. Petitioner’s arguments largely repeat what it argued in the Reply and at the oral hearing. Mere disagreement with a decision is not a proper basis for rehearing when a party’s arguments were considered and

¹ We determined that, with respect to the ’694 patent, 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] action sports video cameras.” Dec. 18–19.

addressed in the decision. As we stated in the Final Decision, although some cases, such as *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989), refer simply to “the public interested in the art,” the majority of cases define the standard as accessibility to persons interested and ordinarily skilled in the art. Dec. 19–21. We remain persuaded that the appropriate standard is that set forth in *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016): “A reference will be considered publicly accessible if it was ‘disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it’” (citation omitted).²

Second, Petitioner argues that “[i]n effect, the Board held that to satisfy the standard [for a document to be a prior art printed publication], Petitioner had to show that a person ordinarily skilled in the art was among

² Petitioner cites a number of cases in its Request for Rehearing that, contrary to Petitioner’s assertions, applied that standard. *See, e.g.*, Req. Reh’g 5–11; *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364–65 (Fed. Cir. 2014); *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1379 (Fed. Cir. 2006) (clarifying that in *Cronyn*, the Court determined that three student theses were not publicly accessible and “[t]he significance of whether these theses were meaningfully catalogued or indexed was whether *one skilled in the art* could locate them” (emphasis added)); *In re Klopfenstein*, 380 F.3d 1345, 1350–52 (Fed. Cir. 2004); *Massachusetts Inst. of Tech. v. AB Fortia*, 774 F.2d 1104, 1108–1109 (Fed. Cir. 1985); *Hilsinger Co. v. Eyeego, LLC*, No. 13-cv-10594-IT, 2016 WL 5388944, at *6 (D. Mass. Sept. 26, 2016) (citing the above standard from *Blue Calypso* and finding that a catalog was accessible to “optical professionals” in “optical trade publications”); *Eastman Kodak Co. v. CTP Innovations, LLC*, Case IPR2014-00789, 20–22 (PTAB Nov. 25, 2015) (Paper 34) (finding that testimonial evidence demonstrated that “a person of ordinary skill, using reasonable diligence, could have gained access to the earlier version [of the cited reference], which reasonably would have led that person to the updated version”).

the attendees of the Tucker Rocky Show to whom the GoPro Catalog was distributed.” Req. Reh’g 3–4, 15. According to Petitioner, decisions of the U.S. Court of Appeals for the Federal Circuit require “a flexible standard that has been applied in diverse contexts,” and “[t]he standard has not been applied to require that the proponent show actual distribution to a person ordinarily skilled in the art.” *Id.* at 4–5.

Petitioner misunderstands the Final Decision. We did not require proof that Petitioner physically provided a copy of the GoPro Catalog to someone at the 2009 Tucker Rocky Dealer Show that was of ordinary skill in the art. Rather, as Patent Owner correctly points out, we found no evidence that persons of ordinary skill in the art would have been in attendance at—or even aware of—the 2009 Tucker Rocky Dealer Show, such that they could have obtained a copy there. *See* Dec. 25–28; Opp. 2, 8–13. This is a factor supporting Patent Owner’s position that the GoPro Catalog was not sufficiently accessible to persons interested and of ordinary skill in the art. *See* Dec. 25–28; Paper 30, 10–13. Again, Petitioner provided no evidence during trial that the 2009 Tucker Rocky Dealer Show was advertised to or open to the general public, such that the public would have known about the show and could have obtained a copy of the GoPro Catalog there, and Patent Owner presented some evidence to the contrary. Dec. 23–25 (citing Exs. 2001, 2002, 1012 ¶ 5). Further, as explained in the Final Decision, the 2009 Tucker Rocky Dealer Show primarily pertained to motorcycles and other action sports vehicles and was directed to sales and marketing personnel, but a person of ordinary skill in the art for purposes of the ’694 patent is someone with a technical background with digital video cameras. *Id.* at 18–19, 22–28 (citing Exs. 1012, 2001).

Third, Petitioner argues that our conclusion in the Final Decision is “inconsistent” with our Decision on Institution (Paper 8, “Dec. on Inst.”). Req. Reh’g 4, 7, 12–14. Petitioner is incorrect. At the institution stage, the standard for institution is “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition,” and we look for only a threshold showing that an asserted reference is prior art. *See* 35 U.S.C. § 314(a); Dec. on Inst. 13. At the final decision stage, however, a petitioner has the burden of providing unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). There is no inconsistency between finding a reasonable likelihood of prevailing at the time of institution and less than a preponderance of the evidence in a final decision. Indeed, at institution, “the Board is considering the matter preliminarily without the benefit of a full record.” *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016). “The Board is free to change its view of the merits after further development of the record, and *should do so* if convinced its initial inclinations were wrong. To conclude otherwise would collapse these two very different analyses into one” *Id.* We stated in the Decision on Institution that our finding of a threshold showing by Petitioner was “[b]ased on the current record.” Dec. on Inst. 17 (“The fact that we institute an *inter partes* review on a not fully developed record is not dispositive of the ultimate legal conclusion as to whether the GoPro Catalog qualifies as prior art. That conclusion will be based on a preponderance of the fully developed record evidence.”).

Further, to the extent Petitioner asserts an inconsistency by virtue of the fact that we cited the “public interested in the art” language from *Cronyn*, 890 F.2d at 1160, in the Decision on Institution, but cited the

“persons interested and ordinarily skilled in the subject matter or art” language from *Blue Calypso*, 815 F.3d at 1348, in the Final Decision, we are not persuaded. *See* Req. Reh’g 7, 12–14. Petitioner overlooks the fact that in the Decision on Institution, we also stated the following:

“A reference is publicly accessible ‘upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.’” *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1350–51 (Fed. Cir. 2008) (citation omitted).

Dec. on Inst. 13. This formulation of the test for public accessibility is the same one set forth in *Blue Calypso*. *See* 815 F.3d at 1348 (citing *Kyocera*, 545 F.3d at 1350); Dec. 19–21. Regardless, the issue to be decided now is whether we misapprehended or overlooked any matters in rendering the Final Decision, and Petitioner’s arguments regarding slight differences in wording between the Decision on Institution and Final Decision do not demonstrate that we did.

Fourth, Petitioner argues that the facts in this proceeding are analogous to or distinguishable from a number of prior cases. Req. Reh’g 8–15. We could not have misapprehended or overlooked arguments not made in a party’s papers. Petitioner had the opportunity to analogize or distinguish the facts of these cases in its Petition and Reply, but did not do so. *See* Pet. 24; Reply 2–4. A request for rehearing is not an opportunity to supplement the record with new substantive argument. Nevertheless, we agree with Patent Owner’s arguments in its Opposition, *see* Opp. 4–13, and respond specifically to the following points made by Petitioner.

Petitioner asserts throughout its Request for Rehearing that the GoPro Catalog was “widely” distributed. *See, e.g.*, Req. Reh’g 3, 6, 9, 10. For the

reasons explained in the Final Decision, we do not see how distribution at a single trade show for sales and marketing personnel, only tangentially related (at best) to the art to which the '694 patent pertains, and with no evidence that the show was advertised to or open to the public, amounts to “wide” distribution that would qualify it as a prior art printed publication. *See* Dec. 22–28.

Petitioner also argues that the 2009 Tucker Rocky Dealer Show was “for ‘vendors, dealers, retailers, customers and enthusiasts’ of action sports vehicles and accessories.” Req. Reh’g 11 (citing Ex. 1012 ¶ 4). According to Petitioner,

[t]here is no reason why this broad group could not include persons of skill in the art and there is no indication that people with technical backgrounds fitting the definition of persons ordinarily skilled in the art were excluded from the show. To the contrary, it is reasonable to infer, as does the majority of the case law that such persons would be found among these groups.

Id. at 11–12. Petitioner’s double-negative argument ignores that it is Petitioner’s burden to establish the GoPro Catalog as a prior art printed publication. Petitioner provided no evidence that an ordinarily skilled artisan with a technical background with digital video cameras would have known about or likely attended the 2009 Tucker Rocky Dealer Show. Dec. 22–28. Given the lack of supporting evidence in the record, speculation that such an individual *could* have done so is insufficient to meet Petitioner’s burden.

Finally, we note that Petitioner argues a number of times in its Request for Rehearing that it made the GoPro Catalog available via “direct mail,” “email,” and on Petitioner’s “website” for “nearly two months” after the 2009 Tucker Rocky Dealer Show. Req. Reh’g 2, 11–12, 14. We pointed

out in the Final Decision, and emphasize again, that Petitioner provided no underlying facts or evidence to substantiate this, other than Mr. Jones’s bare statement that Petitioner “continued to distribute and otherwise make available the GoPro Catalog to [Petitioner’s] actual and potential customers, dealers and retailers through its website, direct mail, and other means of distribution.” *See* Dec. 22 n.8; Ex. 1012 ¶ 11; Ex. 1022 ¶ 10. We are not persuaded that simply stating that a document was available “by mail” or “on a website,” without additional detail, is sufficient to demonstrate public accessibility of a reference. *See Blue Calypso*, 815 F.3d at 1349–50 (analyzing the underlying facts regarding a report posted on a website, including the lack of evidence that anyone “viewed or downloaded” the report or that “a query of a search engine” would have led to it). For example, Petitioner does not tell us the website to which it is referring from 2009, identify or provide a copy of the specific web page from which the GoPro Catalog allegedly could have been downloaded, or explain in any detail how someone could have obtained a hard copy via mail. Without supporting evidence from Petitioner, we are unable to determine how potential availability online or by mail impacts the analysis, and are left only with Petitioner’s evidence regarding the 2009 Tucker Rocky Dealer Show, as explained in the Final Decision. *See* Dec. 22–28 & n.8.

It was Petitioner’s burden to prove unpatentability by a preponderance of the evidence, including proving that the GoPro Catalog qualifies as a prior art printed publication under 35 U.S.C. § 102(b). *See* Pet. 24; 35 U.S.C. § 316(e); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375–80 (Fed. Cir. 2016); *Blue Calypso*, 815 F.3d at 1348–51 (affirming Board decision that the petitioner “failed to carry its burden of proving public accessibility”

of an asserted reference); *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1378–79 (Fed. Cir. 2015) (“In an *inter partes* review, the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ and that burden never shifts to the patentee. ‘Failure to prove the matter as required by the applicable standard means that the party with the burden of persuasion loses on that point—thus, if the fact trier of the issue is left uncertain, the party with the burden loses.’” (citations omitted)). The limited evidence and argument provided by Petitioner during trial did not suffice to meet that burden, for the reasons explained in the Final Decision. *See* Dec. 19–28.

Based on the foregoing discussion, we determine that Petitioner has not carried its burden of demonstrating that we misapprehended or overlooked any matters in the Final Decision as required by 37 C.F.R. § 42.71(d).

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Request for Rehearing is *denied*.

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