

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOPRO, INC.,  
Petitioner,

v.

CONTOUR IP HOLDING LLC,<sup>1</sup>  
Patent Owner.

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Case IPR2015-01078 (Patent 8,896,694 B2)  
Case IPR2015-01080 (Patent 8,890,954 B2)<sup>2</sup>

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

ARBES, *Administrative Patent Judge*.

DECISION

Petitioner's Motion to Submit Supplemental Information  
*37 C.F.R. § 42.123(a)*

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<sup>1</sup> On November 25, 2015, Patent Owner filed notices indicating that ownership of the challenged patents was transferred from Contour, LLC to Contour IP Holding LLC. *See* IPR2015-01078, Paper 19; IPR2015-01080, Paper 19.

<sup>2</sup> 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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As previously authorized, Petitioner filed in each of the instant proceedings a Motion to Submit Supplemental Information, and Patent Owner filed an Opposition. *See* IPR2015-001078, Papers 20 (“Mot.”), 25 (“Opp.”); IPR2015-01080, Papers 20, 25. Petitioner seeks to submit as supplemental information a supplemental declaration (Ex. 1021)<sup>3</sup> pertaining to the alleged public accessibility of one of the prior art references relied upon by Petitioner in its Petitions. For the reasons stated below, Petitioner’s Motion is *granted*.

#### ANALYSIS

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Under 37 C.F.R. § 42.123(a), a party may file a motion to submit supplemental information if the following requirements are met: (1) a request for authorization to file the motion is made within one month of the date the trial was instituted, and (2) the supplemental information is relevant to a claim for which trial has been instituted. Both requirements are met here.

First, trial was instituted in both proceedings on October 28, 2015, and Petitioner requested authorization less than one month later during the initial conference call on November 20, 2015. *See* Papers 8, 18.

Second, in each proceeding, Petitioner relied on the GoPro Catalog (Ex. 1011) in its assertions of unpatentability, and submitted a declaration from Damon Jones (Ex. 1012), an employee of Petitioner, describing how

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<sup>3</sup> The facts of the two proceedings are similar. Unless otherwise noted, references to papers and exhibits herein are to those filed in Case IPR2015-01078.

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the GoPro Catalog allegedly was distributed publicly in connection with the 2009 Tucker Rocky Dealer Show. Paper 1, 24. Patent Owner argued in its Preliminary Responses that Petitioner failed to establish that the GoPro Catalog is a prior art printed publication under 35 U.S.C. § 102(b). Paper 6, 4–17. We concluded, based on the record at the time, that Petitioner had demonstrated a reasonable likelihood of prevailing on certain asserted grounds based on the GoPro Catalog. Paper 8, 13–26. Petitioner now seeks to submit a supplemental declaration from Mr. Jones that “provides further detail about the distribution of the GoPro Catalog at the 2009 Tucker Rocky Dealer Show and supports Petitioner’s assertions that the GoPro Catalog . . . is prior art to the challenged claims.” Mot. 3.

We agree that the supplemental declaration is relevant to the claims for which trial has been instituted. The declaration is directed to the alleged public accessibility of the GoPro Catalog and provides information not included in Mr. Jones’s original declaration. For example, Mr. Jones describes how copies of the GoPro Catalog were shipped to him at his hotel prior to the show, and states that he “personally distributed” the copies and “witnessed another GoPro employee distribute the GoPro Catalog to attendees.” Ex. 1021 ¶ 6. Mr. Jones also provides, as “Exhibit A” to the supplemental declaration,<sup>4</sup> a series of emails between him and Nicholas Woodman, the Chief Executive Officer of Petitioner, discussing the shipping of the GoPro Catalog copies to Mr. Jones. *Id.* ¶ 5, “Exhibit A.”

Petitioner, therefore, has satisfied the requirements of 37 C.F.R. § 42.123(a). We also are persuaded that allowing Petitioner to submit the

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<sup>4</sup> The parties are reminded that all exhibits must be filed and numbered separately. *See* 37 C.F.R. § 42.63.

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supplemental information at this time (rather than, for example, with its reply in response to Patent Owner's response) is appropriate. Doing so will supplement the existing record on whether the GoPro Catalog was sufficiently accessible to the public interested in the art and allow a more complete record for cross-examination and briefing during trial, and should not delay the trial schedule. *See* Mot. 4–5; *Ericsson Inc. v. Intellectual Ventures I LLC*, Case IPR2014-01149 (PTAB Mar. 30, 2015) (Paper 19) (granting a motion to submit supplemental information pertaining to the alleged public accessibility of a prior art reference in similar circumstances); *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case IPR2013-00369 (PTAB Feb. 5, 2014) (Paper 37) (same).

Patent Owner makes two arguments. First, Patent Owner argues that the supplemental declaration is “an attempt to bolster the challenges presented in the Petition[s] and effectively change the evidence originally relied upon.” Opp. 2–3. Patent Owner contends that the supplemental declaration “presents new evidence not previously offered by [Petitioner] or Mr. Jones that is unrelated to evidence presented in the Petition.” *Id.* at 3–4. We agree that the evidence is “new,” in that it was not included with the Petitions, but that is the case with any proposed supplemental information. We also are not persuaded that the supplemental declaration is unrelated to what Petitioner originally argued or that it effectively changes the substance of Petitioner's contentions. Both Mr. Jones's original declaration and his supplemental declaration pertain to how Petitioner allegedly distributed the GoPro Catalog at and after the 2009 Tucker Rocky Dealer Show. Submission of the supplemental information does not change the asserted grounds based on the GoPro Catalog. Again, although we concluded—

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based on the record at the institution stage—that Petitioner had shown a reasonable likelihood of prevailing on certain asserted grounds, the final written decision in each proceeding will be based on a fully developed record and assessed on a preponderance of the evidence standard.

Second, Patent Owner argues that Petitioner’s only basis for seeking to submit supplemental information is Patent Owner’s evidentiary objections to the GoPro Catalog and Mr. Jones’s original declaration. Opp. 4–5; *see* Paper 14 (Patent Owner’s objections). Patent Owner’s argument is not persuasive. Although there appears to be some overlap in issues, most of the supplemental declaration pertains to facts regarding public accessibility, rather than the alleged evidentiary admissibility of the GoPro Catalog. *See* Ex. 1021 ¶¶ 5–6, 8, “Exhibit A.” We note, however, that our decision to grant Petitioner’s Motion is not an advisory decision on the admissibility of the supplemental declaration or any other evidence. Issues of admissibility will be decided in accordance with 37 C.F.R. §§ 42.62 and 42.64.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Motion to Submit Supplemental Information is *granted*; and

FURTHER ORDERED that Petitioner, within five business days of this Decision, shall re-file Exhibit 1021 in each proceeding as two separately numbered exhibits, one as the supplemental declaration and the other as the emails originally designated as “Exhibit A,” after which Exhibit 1021 will be expunged.

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