



# GOPRO, INC. V. CONTOUR IP HOLDING LLC



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## *GoPro, Inc. v. Contour IP Holding LLC*

*GoPro, Inc. v. Contour IP Holding LLC*, 2017-1894, 2017-1936 (Fed. Cir. July 27, 2018) (“GoPro”) is an appeal from the Patent Trial and Appeal Board (PTAB) (Nos. IPR2015-01078, IPR2015-01080). At the PTAB, GoPro, Inc. challenged two patents owned by Contour IP Holding LLC as obvious in light of a GoPro catalog that GoPro distributed at a trade show in July of 2009. The PTAB found against GoPro, Inc. in the challenge. This decision was based on finding that the GoPro catalog was not prior art for the claims of the patents owned by Contour IP Holding LLC.

The patents at issue are U.S. Patent Nos. 8,890,954 (the ‘954 patent) and 8,896,694 (the ‘694 patent), which have a common specification. The common specification of these patents generally describe video cameras or camcorders that can be controlled remotely (e.g., for remote image capture and/or viewing). Specifically, these patents claim use of global positioning system (GPS) technology to track a location of a camera and/or a camcorder during use and further describe use a wireless connection to facilitate remote control of the camera and/or the camcorder. The common specification of these patents further describe that the claimed device can be deployed in areas that do not permit easy use by an individual, such as in a sports scenario. Both patents claim priority to a provisional application filed on September 13, 2010, resulting in a one year prior art date of September 13, 2009.

In July of 2009, GoPro, Inc. attended the Tucker Rocky Dealer Show (the trade show) hosted by Tucker Rocky Distributing, a trade organization related to off-road, all-terrain-type vehicles and related products (e.g., snowmobiles, ATVs, etc.). The trade show was attended by numerous dealers and there were over 1000 attendees, including some potentially interested in video cameras and/or camcorders. There was no evidence presented to the PTAB that the 2009 trade show was advertised to the public, nor was the trade show open to the public. At the trade show, GoPro, Inc. distributed copies of its catalog for its HD Motorsports HERO camera. The catalog described the camera as a “1080p [high-definition (HD)] wearable camera [with] optional wireless remote with an omnidirectional range of 30 feet.” In addition, the catalog included several images of the camera and wireless remote, including an image showing attachment of the camera to a helmet (specifically a motocross/ATV-type helmet).

In analyzing the evidence presented, the PTAB determined that a bachelor’s degree in computer science, electrical engineering, and/or the like and experience with video cameras and/or cameras (e.g., creating, programming, etc.) constituted the ordinary skill in the art. Next the PTAB determined that the GoPro, Inc. catalog was not a prior art printed publication by applying *Blue Calypso v. Groupon, Inc.*, 815 F.3d 1331 (Fed. Cir. 2016). In making this determination, the PTAB found that the trade show at which the GoPro catalog was distributed was not advertised or announced to the public, such that a person of ordinary skill in the art would have known about it, and in addition, the trade show was not publicly accessible and was only open to members of the Tucker Rocky Distributing trade organization. Essentially, the PTAB failed to see how the general public would have obtained the GoPro catalog from the trade show, especially in light of the fact that the trade show was closed to the general public and was for dealers only. Further, the PTAB did not find any evidence that the catalog was distributed at the show to any persons of ordinary skill in the art, or that any one of such skill was actually in attendance (besides

GoPro's representatives at the trade show) given that the trade show was focused on off-road, all-terrain-type vehicles and related products.

On appeal, the Court of Appeals for the Federal Circuit (the Court) analyzed whether the catalog constituted a printed publication under 35 U.S.C. 102(b) (Pre-AIA). In performing this analysis, the Court performed a de novo review and reviewed the PTAB's factual findings for substantial evidence. Under section 102(b), "a person shall be entitled to a patent unless the invention was described in a printed publication more than one year prior to the date of application for the patent in the United States." Contour IP Holding LLC did not dispute any of the evidence presented regarding distribution of the catalog, nor did they dispute that the trade show occurred more than one year before the application for patent of the '954 and '694 patents. As such, the issue before the Court was "whether the GoPro catalog was sufficiently accessible as contemplated under 102(b).

The Court agreed with GoPro, Inc.'s argument that the evidence submitted was sufficient to establish that the GoPro catalog was publicly accessible. Citing *Medtronic v. Barry*, 891 F.3d 1368 (Fed. Cir. 2018), the Court found that the PTAB relied too heavily on the target audience of the distributed GoPro catalog in finding that the GoPro catalog was not publicly accessible. In addition, the Court stated that the PTAB failed to consider other factors, such as "the nature of the conference or meeting at which material is distributed, whether there are restrictions on public discourse of the information, expectations of confidentiality, and expectations of sharing the information."

In examining these factors, the Court noted that there was no restriction on distribution of the GoPro catalog at the trade show and that the GoPro catalog was freely on display for anyone in attendance. The Court further rejected the notion that the trade show's focus on "action sports vehicles is not preclusive of persons ordinarily skilled in the art from attending to see what POV digital cameras were being advertised and displayed." Similarly, the Court found that the patents at issue described that "a primary purpose of POV cameras is for use on vehicles in extreme action environments, such as the ones advertised at the Tucker Rocky Dealer Show." With regard to attendees of the of the trade show, the Court determined that nothing about the trade show would have excluded cameras, camcorders, or related products from the trade show, and that it would have been likely for people attending the trade show to be interested in such products. Lastly, the Court determined that the vendor lists for the trade show included a number of vendors that would have likely been involved in selling and/or producing cameras and/or camcorders of the type shown and described in GoPro's catalog.

Based on these determinations, the Court determined that "a dealer show focused on extreme sports vehicles is an obvious forum for POV action sports cameras," and that "dealers of POV cameras would encompass the relevant audience such that a person ordinarily skilled and interested in POV action cameras, exercising reasonable diligence, should have been aware of the show," despite the trade show not being open to the general public or advertised to the general public. In addition, the Court determined that the lack of restrictions placed on the dissemination of the GoPro catalog indicates that the GoPro catalog was "intended to reach the general public." As such, the Court concluded that the GoPro catalog was a printed publication under 102(b) and that the GoPro catalog was prior art for purposes of the patents at issue. The Court remanded to the PTAB for an obviousness determination in light of the GoPro catalog.

This case provides a few practice insights for practitioners. This case highlights that when working with clients, practitioners should broadly interpret non-confidential disclosures of material as public disclosures. Despite the closed nature of the trade show and the lack of evidence that any persons skilled in the art, outside of GoPro, Inc.'s attendees, attended the trade show, the Court nonetheless found that dissemination of the GoPro catalog at the trade show constituted a prior art reference under 102(b). Similarly, this case highlights that a public disclosure can occur as long as the distributed material is not restricted from reaching the general public. Even if the material is not necessarily distributed to anyone of ordinary skill in the art, as long as there are no restrictions on further dissemination by those individuals, a court may find that such dissemination is a public disclosure as the material could, in theory, reach someone skilled in the art. As such, practitioners should work with clients to determine the exact nature of past or future disclosures of invention-related material for purposes of identifying relevant public disclosures.