

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AXON ENTERPRISE, INC.,  
Petitioner,

v.

DIGITAL ALLY, INC.,  
Patent Owner.

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Case PGR2018-00052  
Patent 9,712,730 B2

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Before PHILLIP J. KAUFFMAN, MINN CHUNG, and  
ROBERT L. KINDER, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION  
Denying Institution of Post-Grant Review  
35 U.S.C. § 324(a)

## I. INTRODUCTION

Axon Enterprise Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting a post-grant review of claims 1–24 (the “challenged claims”) of U.S. Patent 9,712,730 B2 (Ex. 1001, “the ’730 patent”). Digital Ally, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). We have authority to determine whether to institute a post-grant review. 35 U.S.C. § 324; 37 C.F.R. § 42.4(a).

The standard for instituting a post-grant review is set forth in 35 U.S.C. § 324(a), which provides that a post-grant review may not be instituted unless “the information presented in the petition . . . , if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” Upon consideration of the Petition and the Preliminary Response, we conclude that the information presented in the Petition does *not* demonstrate that it is more likely than not at least one of the challenged claims is unpatentable. Accordingly, we do not institute a post-grant review.

## II. BACKGROUND

### *A. Related Proceedings*

Petitioner indicates that there are no other proceedings involving the ’730 patent. Pet. 92. Similarly, Patent Owner indicates that the ’730 patent is not currently a subject of any related matters. Paper 5, 2.

*B. The '730 Patent*

The '730 patent relates to a portable video and imaging system comprising a camera and a video recording device. Ex. 1001, Abstract. Figure 1 of the '730 patent is reproduced below.

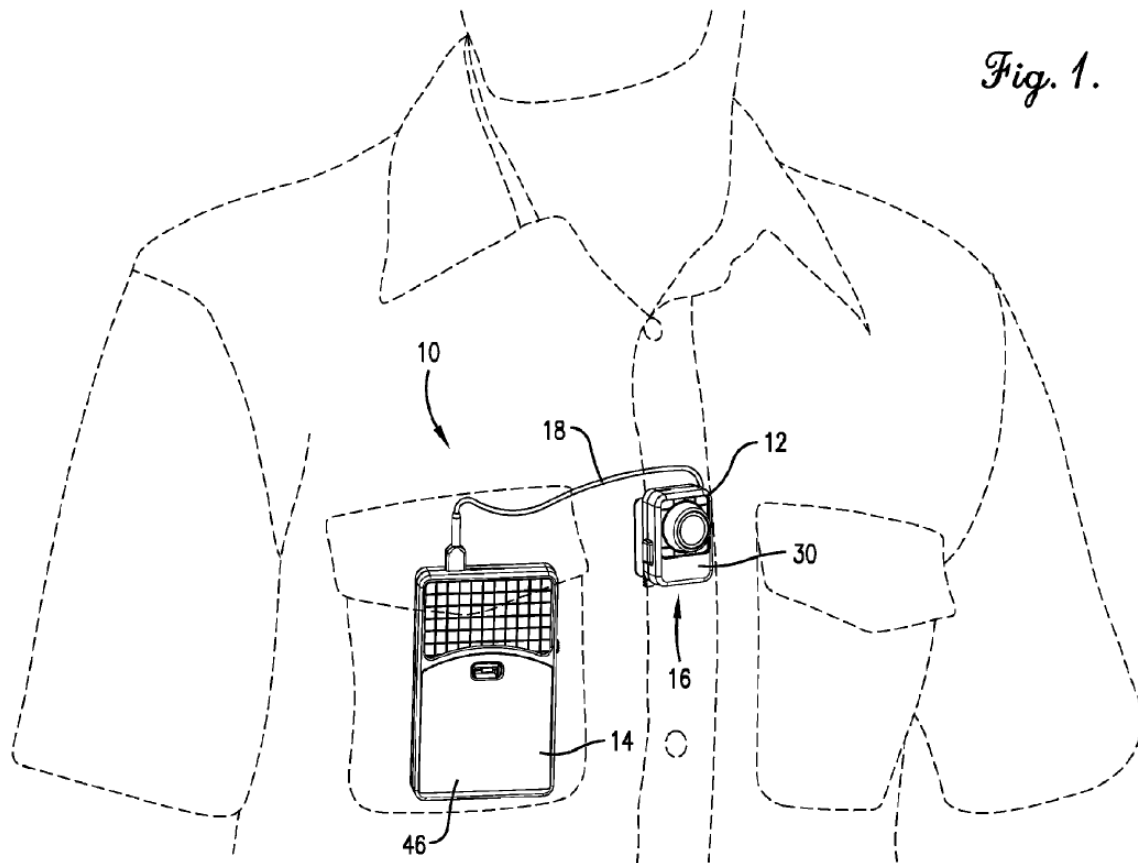
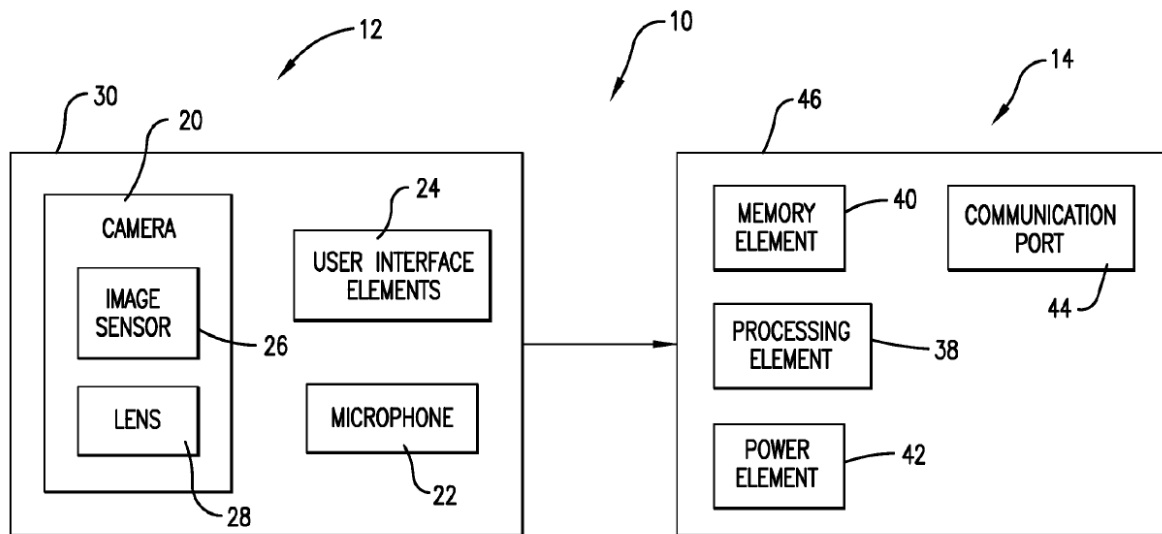


Figure 1 depicts an embodiment of the '730 patent in the form of a portable video and imaging system mounted on a user's body. *Id.* at 2:41–43. As shown in Figure 1 above, digital video recording system 10 comprises camera component 12, recording component 14, and mounting assembly 16. *Id.* at 4:39–42.

According to the '730 patent, the camera component and the recording component are physically separate but “communicatively coupled” to each other. *Id.* at 2:22–24, Abstract. As shown in Figure 1, camera component 12 and recording component 14 are “communicatively coupled” via cabling 18. *Id.* at 5:4–6. In an alternative embodiment, camera component 12 and recording component 14 are “communicatively coupled” wirelessly such that instructions or data can be transmitted between the components as wireless signals over communication networks, such as Wi-Fi links. *Id.* at 5:8–14.

Figure 30 of the '730 patent is reproduced below.



*Fig. 30.*

Figure 30 is a schematic of camera component 12 and recording component 14 in an embodiment of the '730 patent. *Id.* at 3:50–51. As shown in Figure 30, recording component 14 includes processing element

38, memory element 40, and at least one communication port 44. *Id.* at 7:10–13.

Processing element 38 may “generally execute, process, or run instructions, code, software, firmware, programs, applications, apps, processes, services, daemons, or the like.” *Id.* at 7:20–23. In addition, memory element 40 may store “the instructions, code, software, firmware, programs, applications, apps, services, daemons, or the like” that are executed by processing element 40. *Id.* at 7:34–37.

Communication port 44 may be in communication with processing element 38 and memory element 40, and generally allows recording component 14 to communicate with camera component 12 over a communications network. *Id.* at 7:51–56. In an embodiment, communication port 44 is a mini-USB port to connect cabling 18 for transmission of data from camera component 12 to recording component 14. *Id.* at 7:59–64.

As shown in Figure 30 above, camera component 12 includes camera 20, microphone 22, and user interface elements 24 for providing input or instructions to camera 20. *Id.* at 5:35–38. In an embodiment, user interface elements 24 comprises first input 32, which is a power on/off switch, and second input 34. *Id.* at 6:17–21.

Second input 34 controls recording and marking of an event. *Id.* at 6:35–36. For example, a user can instruct recording of video by actuating second input 34. *Id.* at 6:36–39. During recording of an event, the user can also “mark” the captured video by actuating second input 34. *Id.* at 6:40–41. According to the ’730 patent, “marking” of the captured video provides an

indication of a point in time, i.e., the time when the user depressed second input 34. *Id.* at 6:41–43. In other words, “marking” of the captured video allows the user to identify the point in time at which a particular event in the captured video occurs. *Id.* at 6:46–48. Thus, actuation of second input 34 serves as both an instruction to begin recording and to mark the captured video to identify a time or location in the captured video corresponding to actuation of second input 34. *Id.* at 6:48–52. When viewing the video using standardized video-viewing software, the user can quickly move to the marked locations in the captured video. *Id.* at 6:43–46.

In another embodiment, digital video recording system 10 may be provided with a “pre-event” recording program and method in which system 10 records constantly in a loop of a selected duration of time, such as thirty seconds or sixty seconds. *Id.* at 8:41–45. When a triggering event occurs, camera component 12 transmits to recording component 14 the captured video for the selected duration of time, e.g., the thirty-second segment of captured video occurring prior to the triggering event. *Id.* at 8:45–49. Examples of a triggering event may include the user actuating second input 34 to instruct recording by the camera component 12, turning on a vehicle’s siren and/or signal lights, an accelerometer measurement outside a pre-established norm, a position of the vehicle and/or officer as measured by a GPS, a vehicle crash event or the police vehicle attaining a threshold speed (e.g., 80 m.p.h.), etc. *Id.* at 8:50–57.

In an embodiment, the recorded video can be downloaded to a laptop or other computer. *Id.* at 9:14–15. The captured video may also be viewed

on a mobile communications device using an app, a web site, or viewing software. *Id.* at 9:29–32.

*C. Illustrative Claim*

Claims 1, 15, and 22 are the independent claims in the '730 patent. Claim 15 is illustrative of the challenged claims and is reproduced below.

15. A portable video and imaging system for law enforcement comprising:

- a portable housing configured to be selectively mounted on a body of a law enforcement officer and in a law enforcement vehicle;
- a first mounting assembly configured for mounting the housing to the law enforcement officer's body;
- a second mounting assembly configured for mounting the housing in the law enforcement vehicle, such that the housing may selectively and interchangeably be mounted on the law enforcement officer's body via the first mounting assembly and the law enforcement vehicle via the second mounting assembly;
- a camera component housed within the housing and configured to capture video of an event;
- a memory element housed within the housing and configured to record the captured video of the event, wherein said captured and recorded video comprises a plurality of video frames of a video file;
- an input mounted on the housing and configured to be actuated by the law enforcement officer in the field and in response to being actuated, generate an activation signal; and
- a processing element associated with the memory element and the input and configured to:
  - receive said activation signal generated in response to the law enforcement officer actuating the input,

in response to the activation signal, store a mark in the video file for at least one of the plurality of video frames to thereby identify a point in time or location in the video file,

upon playback of the video file and in response to receipt from a user request, automatically advance the video file to the marked at least one video frame representing the point in time or location in the video file at which the law enforcement officer actuated the input,

wirelessly transmit the video file to a mobile communications device configured for viewing the video on the mobile communications device, and

instruct capturing of video by the camera component for recording the event in response to receiving information indicative of a triggering event, wherein the triggering event is a signal from the law enforcement vehicle.

Ex. 1001, 19:61–20:39.

*D. Asserted Prior Art and Grounds of Unpatentability*

Petitioner cites the following references in its art-based challenges to patentability.

Reference	Designation	Exhibit No.
U.S. Patent App. Pub. No. 2009/0276708 A1 (published Nov. 5, 2009)	Smith	Ex. 1012
U.S. Patent No. 6,563,532 B1 (issued May 13, 2003).	Strub	Ex. 1013
International Patent App. Pub. No. WO 2012/037139 A2 (published Mar. 22, 2012)	O'Donnell	Ex. 1014
U.S. Patent App. Pub. No. 2009/0002491 A1 (published Jan. 1, 2009)	Haler	Ex. 1015



<b>Reference</b>	<b>Designation</b>	<b>Exhibit No.</b>
U.S. Patent App. Pub. No. 2011/0018998 A1 (published Jan. 27, 2011)	Guzik	Ex. 1016
U.S. Patent App. Pub. No. 2011/0098924 A1 (published Apr. 28, 2011)	Balardeta	Ex. 1017

Petitioner asserts the following grounds of unpatentability in relation to the challenged claims in the '730 patent:

<b>Claim(s) Challenged</b>	<b>Statutory Basis</b>	<b>Reference(s) / Asserted Prior Art</b>
1–21	§ 112(a)	
1, 4, 7, and 9	§ 103	Smith
2 and 3	§ 103	Smith and Strub
5, 6, and 8	§ 103	Smith and O'Donnell
10 and 12	§ 103	Smith and Haler
11 and 22	§ 103	Smith and Guzik
13 and 23	§ 103	Smith, Haler, and Guzik
14	§ 103	Smith and Balardeta
15, 17, and 20	§ 103	Smith, O'Donnell, and Haler
16	§ 103	Smith, O'Donnell, Haler, and Strub
18 and 19	§ 103	Smith, O'Donnell, Haler, and Guzik
21	§ 103	Smith, O'Donnell, Haler, and Balardeta
24	§ 103	Smith, Guzik, and Strub

Pet. 8–9. Petitioner also relies on the Declaration of Kurtis P. Keller (Ex. 1027). Patent Owner relies on the Declaration of Dr. Vijay K. Madiseti (Ex. 2001) to support its Preliminary Response.

### III. ANALYSIS

#### *A. Statutory Disclaimer*

After the filing of the Petition on March 19, 2018, Patent Owner filed a statutory disclaimer, disclaiming claims 1–7, 9–14, and 22–24 of the '730 patent, effective July 5, 2018. Prelim. Resp. 4; Ex. 2007, 1.

“No post-grant review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.207(e). Further, as we have determined in the context of covered business method patents, “patent review eligibility is determined based on the claims of the challenged patent as they exist at the time of the decision whether to institute, and statutorily disclaimed claims must be treated as if they never existed.” *Facebook, Inc. v. Skky, LLC*, Case CBM2016-00091, slip op. at 11 (PTAB Sept. 28, 2017) (Paper 12) (precedential). Here, because claims 1–7, 9–14, and 22–24 have been statutorily disclaimed, we must treat them as if they never existed in determining whether to institute a post-grant review. Consequently, we will consider only claims 8 and 15–21 for purposes of determining post-grant eligibility. Similarly, our substantive analysis of Petitioner’s challenges will address only claims 8 and 15–21 based on the following grounds of unpatentability.

<b>Claim(s) Challenged</b>	<b>Statutory Basis</b>	<b>References / Asserted Prior Art</b>
8 and 15–21	§ 112(a)	
8	§ 103	Smith and O’Donnell
15, 17, and 20	§ 103	Smith, O’Donnell, and Haler
16	§ 103	Smith, O’Donnell, Haler, and Strub
18 and 19	§ 103	Smith, O’Donnell, Haler, and Guzik
21	§ 103	Smith, O’Donnell, Haler, and Balardeta

### *B. Post-Grant Review Eligibility*

Post-grant reviews are available only for patents that issue from applications that, at one point, contained at least one claim with an “effective filing date,” as defined by 35 U.S.C. § 100(i), on or after March 16, 2013. *See* AIA<sup>1</sup> §§ 6(f)(2)(A), 3(n)(1). Our rules require a petitioner for post-grant review to certify that the challenged patent is available for post-grant review. 37 C.F.R. § 42.204(a). Petitioner includes the requisite certification, and further, asserts that at least claim 15 has an effective filing date after March 16, 2013. Pet. 2–5.

The effective filing date of an application for a patent on an invention is “the filing date of the earliest application for which the . . . application is entitled, as to such invention, to a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b) or to the benefit of an earlier filing date under

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<sup>1</sup> Leahy-Smith America Invents Act (“AIA”), Pub L. No. 112-29, 125 Stat. 284 (2011).

section 120, 121, 365(c), or 386(c).” 35 U.S.C. § 100(i)(1)(B). Entitlement to the benefit of an earlier date under §§ 119 and 120 is premised on disclosure of the claimed invention “in the manner provided by § 112(a) (other than the requirement to disclose the best mode)” in the application for which the benefit of the earlier filing date is sought. *See* 35 U.S.C. §§ 119(e), 120.

According to the front page of the ’730 patent, the ’730 patent was filed on January, 8, 2016, and is a continuation of application no. 14/575,433, filed December 18, 2014, which in turn is a continuation of application no. 14/040,329, filed on September 27, 2013. Ex. 1001, [63]. The ’730 patent also lists, as related U.S. applications, provisional application nos. 61/707,348 (Ex. 1011, “the ’348 provisional”) and 61/707,326 (Ex. 1010, “the ’326 provisional”), both filed on September 28, 2012. *Id.* at [60]. Petitioner asserts that the ’730 patent is eligible for post-grant review because neither the ’326 provisional nor the ’348 provisional provides written-description support for at least claim 15. Pet. 3–5.

Whether the written description requirement of 35 U.S.C. § 112(a) has been satisfied “requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The specification must describe sufficiently an invention understandable to a person of ordinary skill in the art and “show that the inventor actually invented the invention claimed.” *Id.* “One shows that one is ‘in possession’ of the invention by describing the invention, with all its

claimed limitations, not that which makes it obvious.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (emphasis omitted).

Petitioner asserts that claim 15 requires a “processing element” that performs the following three functions: (1) “receive [an] activation signal”; (2) “in response to the activation signal, store a mark in the video file for at least one of the plurality of video frames”; and (3) “upon playback of the video file . . . automatically advance the video file to the marked at least one video frame.”<sup>2</sup> Pet. 3–4. Petitioner further contends that neither the ’326 provisional nor the ’348 provisional reasonably conveys to a person of ordinary skill in the art that the inventor had possession of a “processing element” that performed *all* of these three functions. *Id.* at 4.

Petitioner asserts that, although the ’348 provisional describes a “camera” that includes “an electronic controller” (i.e., the claimed “processing element”) and “a second button . . . [that] causes the camera to ‘bookmark’ a video during video recording,” it does not disclose that the “electronic controller” “upon playback of the video file . . . automatically advance[s] the video file to the marked . . . video frame,” as recited in claim 15. *Id.* at 4–5 (citing Ex. 1011, 5). Petitioner argues that, because the ’348 provisional describes that the “jump to the bookmark” function is performed by a computer when the user views the video “*once transferred to the computer*,” a person of ordinary skill in the art would have understood that the camera’s electronic controller is separate from the computer and,

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<sup>2</sup> Petitioner asserts that claim 1 also requires the same three functions. Pet. 3–4. As discussed above, in determining post-grant review eligibility, we treat claim 1 as if it never existed because claim 1 has been disclaimed.

therefore, does not perform the “jump to the bookmark” function. *Id.* at 5 (citing Ex. 1011, 5; Ex. 1027 ¶ 42).

We have reviewed Petitioner’s evidence and agree with Petitioner that neither the ’326 provisional nor the ’348 provisional describes the claimed invention, with all of the limitations recited in claim 15. Patent Owner does not dispute the post-grant review eligibility of the ’730 patent. *See generally* Prelim. Resp.

An additional requirement for post-grant review eligibility is that “[a] petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent.” 35 U.S.C. § 321(c); *see* 37 C.F.R. § 42.202(a). The Petition was accorded a filing date of March 19, 2018 (Paper 3), which is not later than the date that is 9 months after July 18, 2017, the date of the grant of the ’730 patent. Accordingly, we determine that Petitioner has demonstrated sufficiently that the ’730 patent is eligible for post-grant review.

### *C. Level of Ordinary Skill in the Art*

The parties appear to dispute the level of skill in the art at the time of the invention of the ’730 patent. The main point of dispute appears to be whether a person of ordinary skill in the art would have had a degree in mechanical engineering or electrical (or computer) engineering. Pet. 13; Prelim. Resp. 2–3. Although the parties’ proposals for the level of skill in the art have differences in wording, we do not find the proposals to be materially different because Petitioner asserts broadly that a person of ordinary skill in the art would have “an interdisciplinary engineering background that includes experience and/or education in mechanical

engineering and in electrical or computer engineering (or a related field such as computer science).” Pet. 13 (citing Ex. 1027 ¶ 20). For purposes of this Decision, we find no meaningful differences between the parties’ respective definitions that would materially alter the outcome of this Decision.

Further, the level of ordinary skill in the art may be reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (prior art itself can reflect appropriate level of ordinary skill in the art). We find the parties’ definitions to be comparable to the level of skill reflected in the asserted prior art. Hence, for purposes of this Decision, the prior art itself is sufficient to demonstrate the level of ordinary skill in the art.

#### *D. Claim Construction*

In a post-grant review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.200(b). Under the broadest reasonable interpretation standard, and absent any special definitions, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art, in view of the specification. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Neither Petitioner nor Patent Owner proposes an express construction for any claim term. *See* Pet. 13; Prelim. Resp. 4–5. Based on the current record, and for purposes of this Decision, we do not find it necessary to make formal claim constructions for any claim terms. *See, e.g., Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and

only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

*E. Lack of Written Description*

Petitioner contends that claims 8 and 15–21 are unpatentable as lacking written description support under 35 U.S.C. § 112(a) because the originally filed specification of the ’730 patent (Ex. 1003, “the Original Specification”) does not disclose a “processing element” that performs the three functions identified by Petitioner (set forth above) in the context of assessing post-grant review eligibility. Pet. 19–21. Petitioner does not dispute that the ’730 patent discloses processing element 38 or performance of the three functions identified by Petitioner. Rather, Petitioner argues that the Original Specification does not disclose that “processing element 38 is *involved*, in any way, *with* marking video,” or in performing the other two functions mentioned above. *Id.* at 20–21 (emphases added). In other words, Petitioner essentially argues that a person of ordinary skill would not understand that the element that performs the disclosed functions in the ’730 patent is the processing element disclosed in the patent.

Patent Owner disagrees and argues that a person of ordinary skill in the art would understand that processing element 38 described in the Original Specification performs all three functions identified by Petitioner. Prelim. Resp. 5–15.

Upon considering the parties’ arguments and the record presented, we are not persuaded by Petitioner’s argument and agree with Patent Owner’s argument. As discussed above in our overview of the ’730 patent (§ II.B), the ’730 patent describes that camera component 12 and recording



component 14 are “communicatively coupled” via cabling 18 or a wireless communication link such that instructions or data can be transmitted between the components. Ex. 1001, 5:4–6, 5:8–14. The ’730 patent further describes that communication port 44 is in communication with processing element 38 and generally allows recording component 14 to communicate with camera component 12 over a communications link, such as cabling 18 connected to a mini-USB port. *Id.* at 7:59–64. In addition, the ’730 patent describes that actuation of second input 34 serves as both an instruction to begin recording and to mark the captured video. *Id.* at 6:36–41, 6:48–52.

Patent Owner cites the same or similar disclosures in the Original Specification, as well as the testimony of Dr. Madisetti, and argues that a person of ordinary skill in the art would understand that the Original Specification discloses a “processing element” that receives an activation signal and, in response to the activation signal, stores a mark in the video file. Prelim. Resp. 7–12 (citing Ex. 1003 ¶¶ 40, 45–48, 52; Ex. 2001 ¶¶ 40, 46). We agree with Patent Owner’s argument.

We also agree with Patent Owner that the ’730 patent discloses a “processing element” that “automatically advance[s] the video file to the marked . . . video frame” during playback because the ’730 patent describes that, when viewing the video using standardized video-viewing software, the user can quickly move to the marked locations in the captured video. Ex. 1001, 6:43–46. The ’730 patent also describes that processing element 38 can “generally execute” any software or program (*id.* at 7:20–23) and that memory element 40 can store any software or program executed by processing element 40 (*id.* at 7:34–37). In other words, the ’730 patent

describes processing element 38 as a general-purpose processor that can execute standardized video-viewing software that provides the function of quickly moving to the marked locations in the captured video.

More importantly, we note that the Original Specification included claims that recite a “processing element” that performs the same or essentially the same functions identified by Petitioner. For example, originally filed claim 17 recites

*a processing element* associated with the memory element and the input and configured to:  
*receive said activation signal* generated in response to the law enforcement officer actuating the input,  
*in response to the activation signal, mark the captured video* to thereby identify a point in time or location in the marked, captured video for enabling a user viewing the captured video to *move to said point in time or location in the marked, captured video*,  
. . . .

Ex. 1003, 41–42 (emphases added).

“Original claims are part of the original specification and in many cases will satisfy the written description requirement.” *Mentor Graphics Corp. v. EVE-USA, Inc.*, 851 F.3d 1275, 1297 (Fed. Cir. 2017) (citations omitted). Although “certain claims, such as claims to a functionally defined genus, will not satisfy the written description requirement without a disclosure showing that the applicant had invented species sufficient to support the claim,” *Crown Packaging Tech., Inc. v. Ball Metal Beverage Container Corp.*, 635 F.3d 1373, 1380 (Fed. Cir. 2011) (citing *Ariad Pharms.*, 598 F.3d at 1349), the challenged claims in this case do not raise such genus/species concerns. Therefore, because original claim 17 recites a

“processing element” that performs the same or essentially the same functions as those recited in the challenged claims, we determine that the originally filed claim 17, in view of the disclosures in the Specification or the Original Specification discussed above, satisfies the written description requirement under § 112(a) for the limitations argued by Petitioner. *See Mentor Graphics*, 851 F.3d at 1297 (holding that the original claim language demonstrates that the inventor possessed an invention including the disputed limitation); *Crown Packaging*, 635 F.3d at 1381 (finding that the original claims show “the applicants had in mind the invention as claimed” and described it); *ScriptPro LLC v. Innovation Assocs., Inc.*, 833 F.3d 1336, 1341 (Fed. Cir. 2016) (finding written description support when the original claims and the challenged claims recited the same limitation).

Accordingly, based on the record presented, we determine that Petitioner has *not* demonstrated that it is more likely than not at least one of claims 8 and 15–21 is unpatentable as lacking written description support under 35 U.S.C. § 112(a).

*F. Obviousness over the Combination of Smith and O’Donnell or over the Combination of Smith, O’Donnell, and Haler*

Petitioner contends that claim 8 is unpatentable under 35 U.S.C. § 103 as obvious over the combination of Smith and O’Donnell. Pet. 62–64. Petitioner also asserts that claims 15, 17, and 20 are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Smith, O’Donnell, and Haler. *Id.* at 83–88. We have reviewed the parties’ contentions and supporting evidence. Given the evidence of record, we are not persuaded that Petitioner has established that it is more likely than not claim 8 is

unpatentable as obvious over the combination of Smith and O'Donnell or claims 15, 17, and 20 are unpatentable as obvious over the combination of Smith, O'Donnell, and Haler.

### *1. Relevant Principles of Law*

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, so-called secondary considerations.<sup>3</sup> *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). We analyze this asserted ground based on obviousness with the principles identified above in mind.

### *2. Overview of Smith (Ex. 1012)*

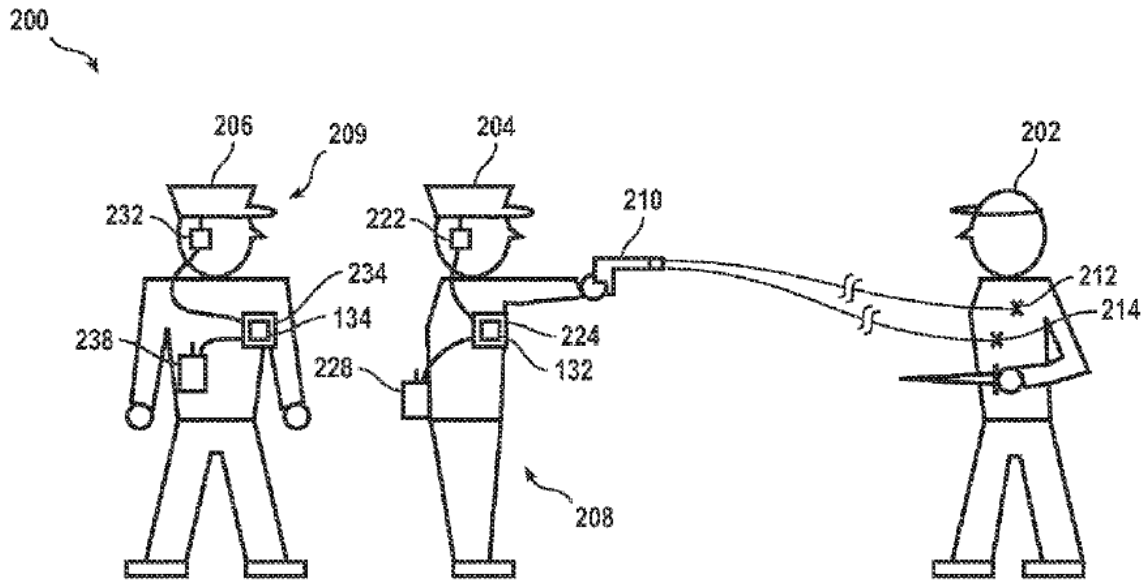
Smith describes a system for collecting and managing information about incidents comprising primary and secondary subsystems. Ex. 1012 ¶ 28. Primary subsystems are generally used at the time and place of the

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<sup>3</sup> Patent Owner does not present arguments or evidence of such secondary considerations in its Preliminary Response. Therefore, at this preliminary stage, secondary considerations do not constitute part of our analysis.

incident. *Id.* Secondary subsystems generally are *not* used at the time and place of the incident. *Id.*

Figure 2 of Smith is reproduced below.

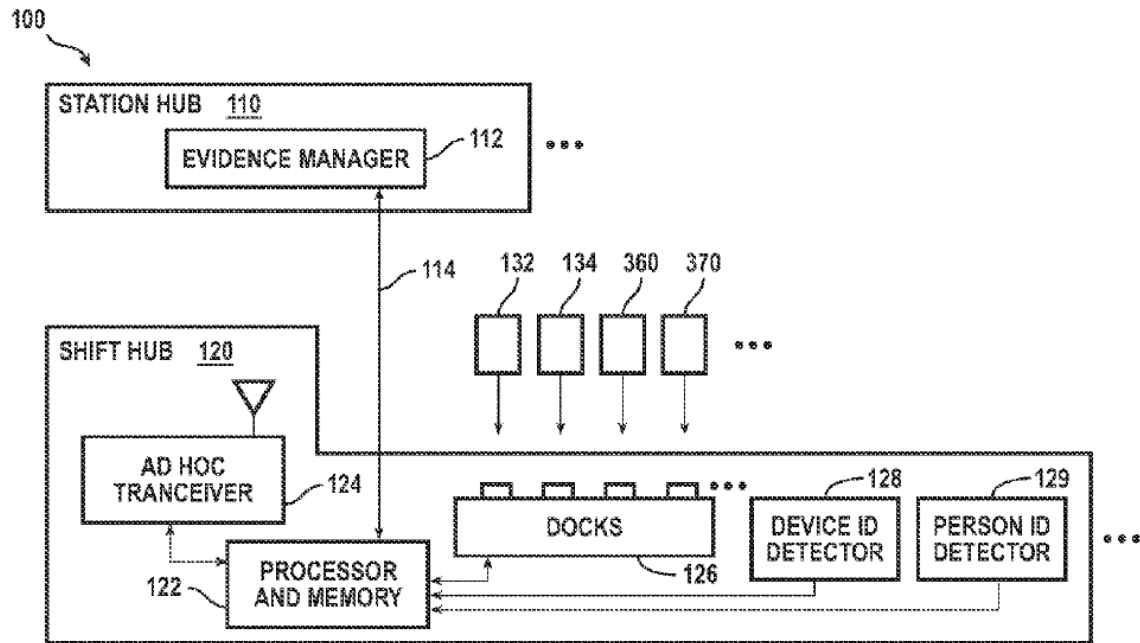


**FIG. 2**

Figure 2 is a pictorial representation of a hypothetical incident involving two law enforcement officers apprehending a suspect while each officer is operating a respective primary subsystem for collecting and managing information about incidents. *Id.* ¶ 11.

As depicted in Figure 2, each of primary subsystem 208 or 209 is worn by an officer and records a movie during the incident. *Id.* ¶ 62. Primary subsystem 208 (209) includes headset 222 (232), handset 132 (134), and on-duty transceiver 228 (238). *Id.* ¶ 63. Each headset 222 or 232 includes a camera and a microphone. *Id.*

Figure 1 of Smith is reproduced below.



**FIG. 1**

Figure 1 is a block diagram of a secondary subsystem of Smith. *Id.* ¶ 10. As shown in Figure 1, secondary system 100 comprises station hub 110 and shift hub 120, which are coupled to each other by network 114. *Id.* ¶ 55.

Shift hub 120 includes processor 122, ad hoc transceiver 124 for wireless communication with primary subsystems, and docks 126 for wired communication with primary subsystems. *Id.* Docks 126 accept, by plug-in to a wired network, any suitable number of primary subsystems. *Id.* ¶ 59. As depicted in Figure 1, handset 132 can be electrically coupled to dock 126 to communicate information between handset 132 and shift hub 120 via a wired interface. *Id.* ¶ 98. If primary subsystems are nearby but not plugged into docks 126, data transfer may occur via ad hoc transceiver 124 from primary subsystems with wireless communication capability. *Id.* ¶ 60. For

example, handset 132 can communicate wirelessly with ad hoc transceiver of shift hub 120 via a wireless interface. *Id.* ¶ 98.

As also shown in Figure 1, station hub 110 hosts evidence manager 112. *Id.* ¶ 55. A user of an evidence manager may obtain summaries of incident reports using database queries and reporting technologies. *Id.* ¶ 31.

### *3. Overview of O'Donnell (Ex. 1014)*

As background, O'Donnell states that, when recording video or taking photographs in a sports application, digital video cameras are often mounted in a location that does not permit the user to easily see the camera. Ex. 1014 ¶ 136. To address this problem, O'Donnell describes embodiments that integrate Bluetooth® wireless technology in wearable digital video cameras to implement remote control and remote viewing functions. *Id.*

In an exemplary embodiment, a Bluetooth®-enabled viewer/controller is paired with a digital video camera mounted on a user's helmet to implement a camera position adjustment procedure carried out by a helmet-wearing user, such as a bicycle or snowboard rider or skier. *Id.* ¶ 146.

Figure 33 of O'Donnell is reproduced below.

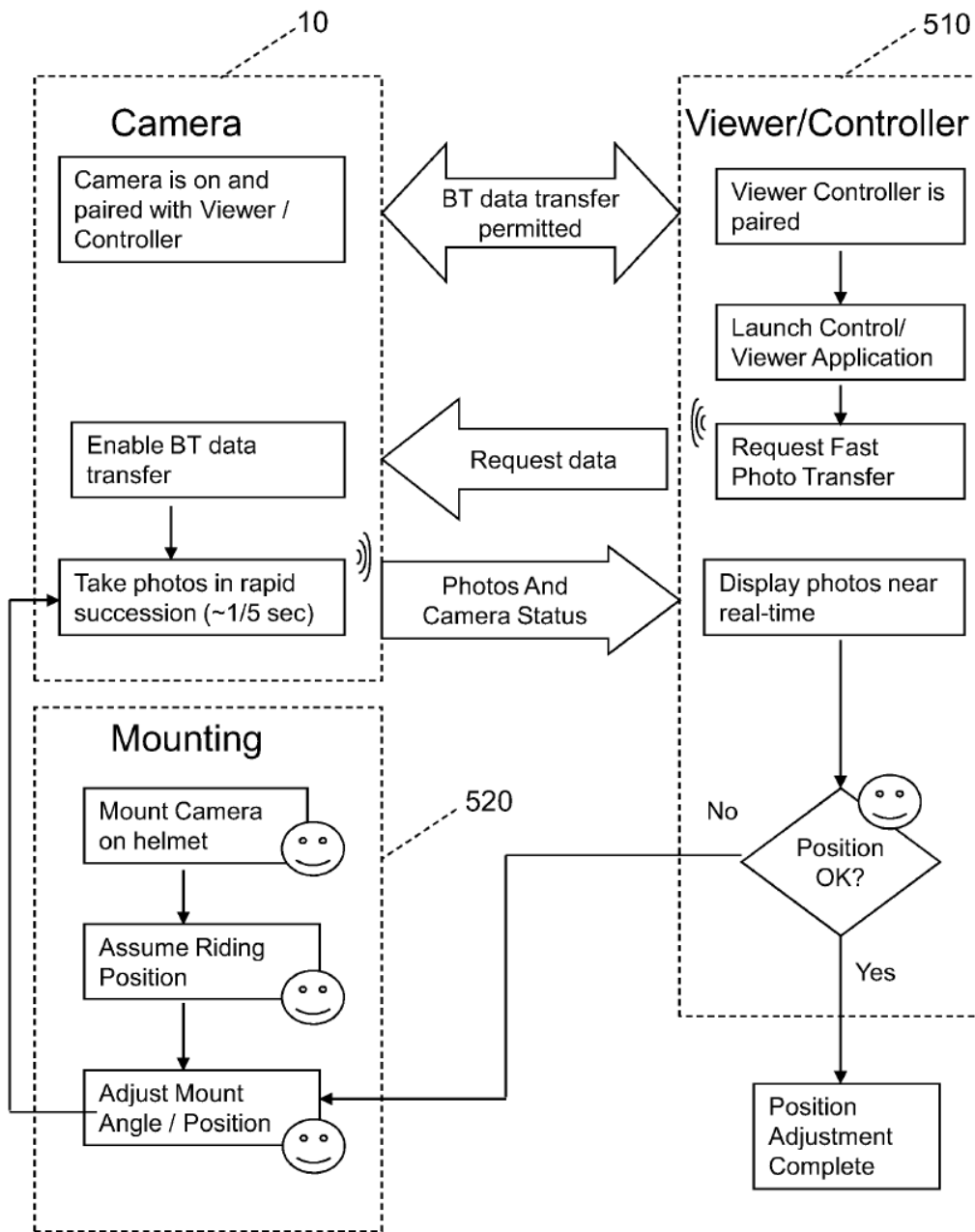


FIG. 33

Figure 33 is a flowchart showing a preferred camera position adjustment procedure to align digital video camera 10 mounted on a user's helmet. *Id.*



Initially, digital video camera 10 and viewer/controller 510 are paired to establish a Bluetooth® wireless connection. *Id.* As shown in Figure 33, the user initiates the procedure for angle/position mounting adjustment by taking photographs with the helmet-mounted digital video camera in rapid succession and transmitting them to viewer/controller 510. *Id.* The captured photographs are displayed on the display screen of viewer/controller 510 near real-time, and, upon observing the display, the user adjusts the angle/position of the helmet-mounted camera. *Id.* The process is repeated until the user is satisfied with the position of the camera. *Id.*

#### *4. Discussion*

##### *a. Claims 8 and 15*

Claim 15 recites a “processing element” configured to “wirelessly transmit the video file to a mobile communications device configured for viewing the video on the mobile communications device.” Ex. 1001, 20:32–34. Claim 8 includes similar limitations by virtue of its dependency from claims 1 and 7. Claim 7 depends from claim 1 and additionally recites “the processing element is configured to wirelessly transmit the video file to a remote device.” *Id.* at 19:23–25. Claim 8, in turn, depends from claim 7 and further recites “the remote device is a mobile communications device configured for viewing the video file on the mobile communications device.” *Id.* at 19:26–29. We focus our analysis on these limitations disputed by Patent Owner.

Petitioner contends that Smith teaches or suggests that “the processing element is configured to wirelessly transmit the video file to a remote device.” Pet. 40 (claim 7), 86 (claim 15). Pointing to Figure 3 of Smith (not

reproduced herein), Petitioner asserts that processor 340 of handset 132 transmits data to a secondary subsystem via wired/wireless interface 349. *Id.* at 40 (citing Ex. 1012 ¶¶ 55–56, 66, 98, Figs. 1, 3). Petitioner argues that a person of ordinary skill in the art would have understood that processor 340 of handset 132 is configured to wirelessly transmit video files to station hub 110 because data transfer to station hub 110 may wirelessly occur via ad hoc transceiver 124. *Id.* at 41 (citing Ex. 1012 ¶ 60, Fig. 1). Citing the testimony of Mr. Keller, Petitioner further asserts that station hub 110 is a “remote device” recited in claim 8. *Id.* (citing Ex. 1027 ¶ 119).

Petitioner further contends that Smith also teaches or suggests “the remote device is a mobile communications device configured for viewing the video file on the mobile communications device” because Smith’s “secondary subsystem (including shift hub 120)” may include “any computer system (e.g., personal computer, server, network of servers)” that can display the incident reports (including the captured video). *Id.* at 62 (citing Ex. 1012 ¶ 30). Citing the Declaration of Mr. Keller, Petitioner argues that a person of ordinary skill in the art would have understood that a “personal computer” at the time of the invention included a “mobile communications device,” such as a laptop computer, a tablet computer, or a mobile phone that would have been “configured for viewing the video file on the mobile communications device.” *Id.* (citing Ex. 1027 ¶ 168).

Patent Owner asserts that, contrary to Petitioner’s contention, in Smith, processor 340 of handset 132 wirelessly transmits video files to shift hub 120, *not* to station hub 110. Prelim. Resp. 18 (citing Ex. 1012 ¶ 56).

Patent Owner further argues Smith does not teach transmitting a video file wirelessly to a device where the video file can be viewed because (1) station hub 110 does not communicate wirelessly with the handset and (2) shift hub 120 is not used to view the video file. *Id.* at 17–18.

We agree with Patent Owner’s argument. Smith discloses that a shift hub is used to transfer data from a primary system (wirelessly using ad hoc transceiver 124 and via a wired connection using docks 126), whereas a station hub (which is coupled to the shift hub by a network) is used to manage and display incident information. Ex. 1012 ¶¶ 54–55. Paragraph 60 of Smith relied upon by Petitioner (*see* Pet. 41) states that “[d]ocks 126 locate and link for communication components and primary subsystems for data transfer to secondary subsystem 110 as coordinated by processor 122” and, if primary subsystems are not plugged into docks 126, “data transfer may occur via *ad hoc transceiver 124* as controlled by processor 122 for *communication with . . . primary subsystems capable of wireless communication.*” Ex. 1012 ¶ 60 (emphases added). As shown in Figure 1 (reproduced above), docks 126, processor 122, and ad hoc transceiver 124 are all components of shift hub 120. Hence, Smith describes that primary subsystems can wirelessly transmit data to shift hub 120, which, in turn, may transfer the data to station hub 110 over a network connection. Petitioner does not cite, nor do we discern, anything in Smith that describes a primary subsystem (or the handset of a primary subsystem) communicating with station hub 110 via ad hoc transceiver 124. Neither Petitioner nor Mr. Keller explains adequately why Smith nonetheless teaches or suggests processor

340 of handset 132 transmitting data wirelessly to station hub 110 via ad hoc transceiver 124. *See* Pet. 41; Ex. 1027 ¶ 119.

Patent Owner also asserts that the secondary subsystems of Smith are not a “mobile communications device” recited in claims 8 and 15. Prelim. Resp. 20–21. Patent Owner argues that Smith discloses that “[s]econdary subsystems generally are *not* used at the time and place of the incident,” in contrast to primary subsystems, which are “generally used at the time and place of the incident.” *Id.* at 21 (emphasis added) (citing Ex. 1012 ¶ 28). Patent Owner argues that, because Smith’s secondary systems are generally immobile, Petitioner’s mapping would read the word “mobile” out of the claims. *Id.*

We agree with Patent Owner that the secondary subsystems of Smith are not a “mobile communications device” recited in claims 8 and 15. As discussed above, Petitioner argues that Smith teaches or suggests a “mobile communications device” because Smith’s secondary subsystems may include “any computer system (e.g., personal computer, server, network of servers),” which one of ordinary skill would have understood to include “a laptop computer, a tablet computer, or a mobile phone.” Pet. 62 (citing Ex. 1027 ¶ 168). But Petitioner relies on station hub 110 (or the secondary subsystem) *itself* to teach a mobile communications device which receives video files transmitted wirelessly by the processing element (i.e., processor 340 of handset 132). *See id.* at 40–41, 62. We are not persuaded by Petitioner’s argument because neither Petitioner nor Mr. Keller explains adequately why mere inclusion of “a laptop computer, a tablet computer, or a mobile phone” in station hub 110 (or the secondary subsystem) transforms

the entire station hub or secondary subsystem into a “mobile communications device” recited in claims 8 and 15.

In the alternative, Petitioner combines the teachings of O’Donnell with those of Smith to argue that the combination teaches or suggests a processing element configured to “wirelessly transmit the video file to a mobile communications device configured for viewing the video file on the mobile communications device.” Pet. 86 (claim 15), 62–63 (claim 8). In support of its contention, Petitioner argues that O’Donnell discloses that its camera 10 communicates with viewer/controller 510 via a Bluetooth wireless connection. *Id.* at 62–63 (citing Ex. 1014 ¶¶ 144, 146, 148–49, 154, 156, 160–62, Figs. 31, 33–35, 37–39). Petitioner further argues that viewer/controller 510 is “configured for viewing the video file on the mobile communications device” because a user can observe images displayed on a display screen of the viewer/controller. *Id.* at 63 (citing Ex. 1014 ¶¶ 146, 152, 154, Fig. 36).

Patent Owner asserts that, contrary to Petitioner’s contention, O’Donnell does *not* teach or suggest that a *video file* is wirelessly transmitted to viewer/controller 510 for viewing. Prelim. Resp. 22. Patent Owner argues that, instead, O’Donnell teaches transmitting *still photographs* from a video camera to viewer/controller 510 via the Bluetooth connection before the video recording begins, to verify that the camera is aimed correctly. *Id.* at 22–23 (citing Ex. 1014 ¶ 146, Figs. 33–35).

Patent Owner further argues that, to transfer a video file from the video camera, O’Donnell teaches using “USB or SD card reader” for the

video transfer, *not* the Bluetooth wireless connection. *Id.* at 23–25 (citing Ex. 1014 ¶ 166, Fig. 40; Ex. 2001 ¶ 70).

Patent Owner further discusses in detail the paragraphs and figures from O’Donnell cited by Petitioner (*id.* at 25–31 (citing Ex. 1014 ¶¶ 146, 151, 152, 154, Figs. 33, 35, 36, 37)) and persuasively argues that all of Petitioner’s citations purporting to show that viewer/controller 510 is “configured for viewing the video file on the mobile communications device” merely teach that viewer/controller 510 displays only still images from camera 10 (*id.* at 31).

We agree with Patent Owner’s argument. Although Petitioner and Mr. Keller cite to multitudes of paragraphs and figures from O’Donnell, neither of them explain adequately how O’Donnell teaches wirelessly transmitting video files to viewer/controller 510 for viewing the videos on the viewer/controller of O’Donnell. *See* Pet. 62–63 (citing Ex. 1014 ¶¶ 144, 146, 148–49, 152, 154, 156, 160–62, Figs. 31, 33–39); Ex. 1027 ¶ 169.

Therefore, based on the record presented, Petitioner does not demonstrate sufficiently that Smith alone or Smith combined with O’Donnell teaches or suggests the processing element is configured to “wirelessly transmit the video file to a mobile communications device configured for viewing the video on the mobile communications device,” as recited in claim 15 or similarly recited in claim 8.

Petitioner relies on Haler only to teach the last limitation of claim 15 reciting “wherein the triggering event is a signal from the law enforcement vehicle.” Pet. 87. Hence, Petitioner’s citation to Haler does not remedy the

deficiencies in Petitioner's analysis of the rest of the limitations of claim 15 discussed above.

Accordingly, based on the record presented, we determine that Petitioner has not demonstrated that it is more likely than not claim 8 is unpatentable under 35 U.S.C. § 103 as obvious over the combination of Smith and O'Donnell. Similarly, Petitioner does not demonstrate that it is more likely than not claim 15 is unpatentable under 35 U.S.C. § 103 as obvious over the combination of Smith, O'Donnell, and Haler.

*b. Claims 17 and 20*

Claims 17 and 20 each depend from claim 15. Petitioner's arguments and evidence presented with respect to claims 17 and 20 address only the additionally recited limitations of these dependent claims, and, therefore, do not remedy the deficiencies in Petitioner's analysis of claim 15 discussed above. *See* Pet. 88.

Accordingly, Petitioner does not demonstrate that it is more likely than not claims 17 and 20 are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Smith, O'Donnell, and Haler.

*G. Remaining Obviousness Grounds*

Petitioner adds the teachings of Strub, Guzik, or Balardeta to the combination of Smith, O'Donnell, and Haler in asserted grounds of obviousness as to dependent claims 16, 18 and 19, or 21, respectively. Pet. 88–91. Claims 16, 18, 19, and 21 each depend directly or indirectly from claim 15. In support of these asserted grounds, Petitioner relies on Strub, Guzik, or Balardeta only to teach the additionally recited limitations

of these dependent claims. *See id.* Therefore, Petitioner's evidence and arguments presented with respect to these asserted grounds of obviousness do not remedy the deficiencies in Petitioner's analysis of the ground based on the combination of Smith, O'Donnell, and Haler discussed above in connection with claim 15.

Accordingly, Petitioner does not demonstrate that it is more likely than not claims 16, 18, 19, and 21 are unpatentable under 35 U.S.C. § 103 as obvious over Smith, O'Donnell, and Haler in further view of Strub, Guzik, or Balardeta.

#### IV. CONCLUSION

After considering the Petition and the Preliminary Response, and the evidence cited therein, we determine that Petitioner has not demonstrated that it is more likely than not that at least one of claims 8 and 15–21 of the '730 patent is unpatentable based on any asserted ground of unpatentability. Accordingly, we do not institute a post-grant review of any of the challenged claims of the '730 patent.

#### V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* as to all of the challenged claims of the '730 patent, and no trial is instituted.



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