

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AXON ENTERPRISE, INC.,
Petitioner,

v.

DIGITAL ALLY, INC.,
Patent Owner.

Case IPR2017-00375
Patent 8,781,292 B1

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

KAUFFMAN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. PROCEDURAL HISTORY

Axon Enterprise Inc. (“Petitioner”)¹ filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1, 3, 8, 18, 20, 21, 24, 26, 27, 29–31, 36, 38, 39, 42, 43, 45, 46, 48, 50, 51, 54, 55, 57, and 58 of U.S. Patent No. 8,781,292 B1 (Ex. 1001, “the ’292 patent) as unpatentable under 35 U.S.C. § 103(a) over (1) Pierce² and (2) Pierce and 20/20-W.³ Pet. 1, 26–71. Digital Ally, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”) to the Petition.

We instituted an *inter partes* review of all of the challenged claims on both grounds, except that we did not institute on Petitioner’s contingent assertion that if Pierce alone and Pierce combined with 20/20-W do not disclose a second communication signal as claimed, it would have been a variant of Pierce that was obvious to try (“the contingent assertion”). Paper 9 (“Dec.”) at 27, n. 18.

Subsequently, Patent Owner filed a Motion to Amend (Paper 22), Petitioner filed an Opposition to that Motion (Paper 30), and Patent Owner filed a Reply to Petitioner’s Opposition (Paper 31). Patent Owner filed a

¹ Petitioner indicates that, since the filing of the Petition, it has changed its name from Taser International, Inc. to Axon Enterprise, Inc. Paper 8, 1.

² U.S. 2005/0083404 A1, published Apr. 21, 2005 (Ex. 1014).

³ Raytheon JPS Communications, Raytheon Model 20/20-W, Raytheon 20/20 VISION, Digital In-Car Video Systems, White Paper WP-8002-11 (Ex. 1015). *See also* Exhibit 1016 regarding public availability of Exhibit 1015.

Response (Paper 23, “PO Resp.”), and Petitioner filed a Reply (Paper 29, “Pet. Reply”).

We held oral hearing on February 23, 2018, and a transcript is included in the record. Paper 46 (“Tr.”).

On April 27, 2018, we amended our Institution Decision to institute on the contingent assertion. Paper 47. In response, the parties requested, and we granted, additional briefing. See Papers 48 (authorization), 49 (Supplemental Patent Owner Response), 50 (Supplemental Petitioner’s Reply).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

We have considered the papers submitted by the parties and the evidence cited therein. For the reasons discussed below, we determine Petitioner has not shown by a preponderance of the evidence that the challenged claims are unpatentable. In light of that determination, we need not and do not address Patent Owner’s Motion to Amend.

B. RELATED PROCEEDINGS

The parties indicate that the ’292 patent is at issue in: *Digital Ally, Inc. v. TASER International, Inc.*, Case No. 2:16-cv-02032-CM-JPO, and *Digital Ally, Inc. v. Enforcement Video, LLC*, Case No. 2:16-cv-02349-JTM-JPO,

each pending in the United States District Court for the District of Kansas (“the related litigation”) (Ex. 1007 ¶ 26).⁴ Pet. 2; Paper 5, 2.

The ’292 patent is also the subject of IPR2017-00376, that was filed concurrently with the Petition at hand. We denied institution on June 6, 2017. IPR2017-00376, Paper 10.

The ’292 patent is a continuation of U.S. Patent No. 9,253,452 B2 (“the ’452 patent”).⁵ The ’452 patent is the subject of IPR2017-00515 and IPR2017-00775, both of which were filed by Petitioner. We denied institution in both cases. IPR2017-00775, Paper 12; IPR2017-00515, Paper 10.

II. THE CLAIMED SUBJECT MATTER

A. INTRODUCTION

1. *Background*

The ’292 patent describes that it was known in the related art of recording device management systems to coordinate recording devices to capture multiple recordings of an event. Ex. 1001, 1:28–31. For example, a user could press a button on a control board to start multiple video cameras. *Id.* at 1:31–35. Such systems did little if anything to react to inputs from electronic devices, to make decisions based on statuses of electronic devices, or to corroborate the recorded data from distinct devices. *Id.* at 1:33–39.

⁴ We reference Petitioner’s exhibits in a slightly different format. For example, Petitioner labels a page of Exhibit 1001 as “1001-017,” and we reference that page as “1001, 17.”

⁵ A copy of the ’452 patent is filed as Exhibit 1002.

The '292 patent describes that the law enforcement field frequently used recording devices to record evidence. *Id.* at 1:40–42. These devices often failed to record crucial evidence due to using different cues to start recording or manual operation. *Id.* at 1:40–49. Known drawbacks of such systems included lack of corroboration or other forensic verification, and time needed to correlate such evidence. *Id.* at 4:49–57.

2. *The '292 Patent*

The '292 patent is titled, “Computer Program, Method, and System for Managing Multiple Data Recording Devices.” Ex. 1001, [54], 1:61–64. The '292 patent describes an embodiment in the form of an intermediate recording device managing apparatus for use in a multiple recording device system that insures that multiple recording devices record an event. *Id.* at 1:61–2:8. The system is comprised of a controller having a receiver for receiving from a first recording device a first communication signal that the first recording device has started recording, and a transmitter for transmitting to a second recording device a second communication signal instructing the second recording device to begin recording. *Id.* at 1:67–2:6.

Figure 1 follows:

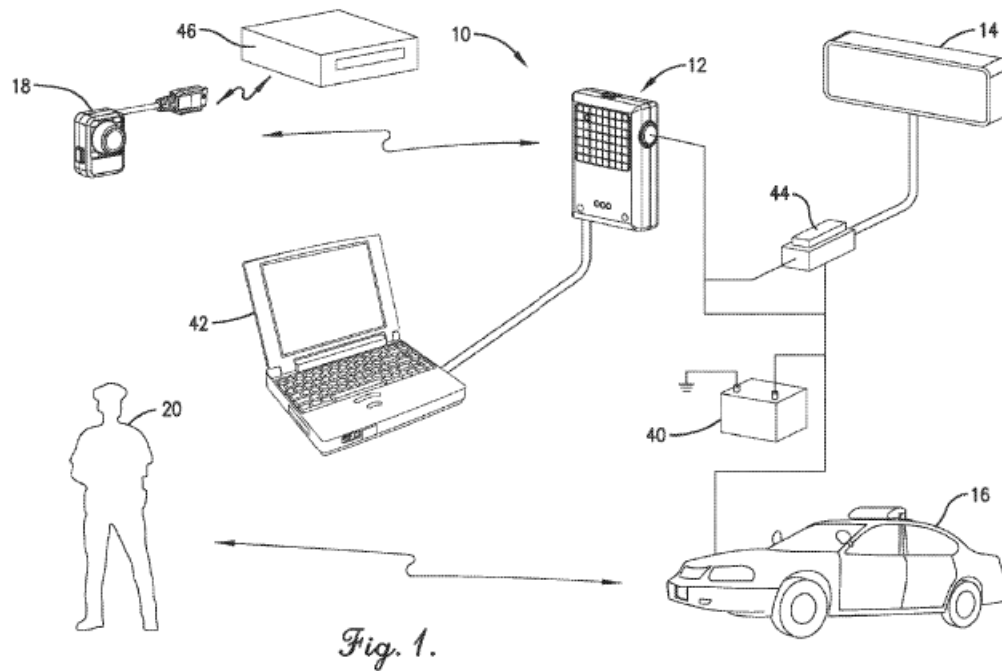


Figure 1 is a schematic plan view of multiple recording device management system 10. *Id.* at 2:32–37. System 10 includes intermediate vehicle video recording device 14 mounted in police vehicle 16 and personal video recording device 18 carried by police officer 20, each wirelessly synced to recording device manager 12. *Id.* at 3:21–30. Multiple personal recording devices 18 can be synced to recording device manager 12. *Id.* at 3:46–48, 4:30–34. When recording device manager 12 receives a signal that a first recording device (e.g., personal recording device 18) has begun recording, either due to an instruction to record or a triggering event, recording device manager 12 signals a second recording device (e.g., vehicle recording device 14) to record.⁶ *Id.* at 4:39–53.

⁶ Either recording device (14, 18) may be considered the first or second recording device. *See generally* Ex. 1001, 4:27–53.

B. ILLUSTRATIVE CLAIM⁷

Claims 1, 18, 36, and 48 are independent. Claim 1 is illustrative and follows:⁸

1. [A] A multiple recording device management system, comprising:

[B] a recording device manager including at least one receiver and at least one transmitter;

[C] a first recording device communicatively coupled with the recording device manager,

[D] wherein said at least one receiver is configured to receive a first communication signal from the first recording device indicating the first recording device has received an instruction initiated by a first law enforcement officer to record a first set of record data related to an event,

[E] wherein the first recording device includes a first input for receiving the first set of record data, and wherein the received first set of record data is recorded on a first computer-readable medium associated with the first recording device; and

[F] a second recording device communicatively coupled with the recording device manager,

[G] wherein said at least one transmitter is configured to transmit a second communication signal to the second recording device instructing the second recording device to begin recording a second set of record data related to the event,

[H] wherein the second recording device includes a second input for receiving the second set of record data, and wherein the

⁷ The '292 patent was subject to *ex parte* reexamination, and a Reexamination Certificate was issued on January 14, 2016. Ex. 1001, 17–22. We reference the claim language as amended in the Reexamination Certificate.

⁸ We identify portions of the claim with added bracketed letters because the parties reference the claim in this manner. See, e.g., Pet. 32; PO Resp. 22.

received second set of record data is recorded on a second computer-readable medium associated with the second recording device,

[I] wherein the first recording device is different from the second recording device, such that the first set of record data recorded by the first recording device is different than the second set of record data recorded by the second recording device,

[J] wherein the second communication signal is transmitted to the second recording device in response to the at least one receiver of the recording device manager receiving the first communication signal from the first recording device indicating the first recording device has received said instruction initiated by the first law enforcement officer to record, such that the recording device manager insures the first recording device records the first set of record data using the first input, and the second recording device records the second set of record data using the second input,

[K] wherein one of the first recording device and the second recording device is configured to be mounted on or carried by one of the first law enforcement officer and a second law enforcement officer.

Ex. 1001, 18 (claim 1 in reexamination certificate with bracketed [deleted] content removed).

C. APPLICABLE STANDARD

In an *inter partes* review, the Board interprets claim terms in an unexpired patent according to the broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R.

§ 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46

(2016) (upholding the use of the broadest reasonable interpretation approach).⁹

For the purposes of this decision, and on this record, we determine that only the claim term “record” needs express interpretation. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (only those terms which are in controversy need to be construed, and only to the extent necessary to resolve the controversy).

D. “RECORD” AND VARIANTS

Claim 1 recites a variety of forms of the word “record” in a variety of contexts. For example, claim 1 recites “a recording device manager,” “to record,” “record data,” and “to begin recording.”

Prior to institution, the parties disagreed regarding the meaning of “recording” in the claim terms “first recording device” and “second recording device.” Specifically, Petitioner asserted that a “recording device” is a device for recording. Pet. 20. Patent Owner countered that a “recording device” is “a device that captures and stores data for future retrieval” because “record” as claimed means, “to store captured data for future retrieval.” Prelim. Resp. 13–17. In the Institution Decision, we disagreed with Patent Owner’s assertion that a recording device as claimed must “store captured data for future retrieval” because the “associated” first computer

⁹ The Notice of Proposed Rulemaking regarding claim construction that is found at 83 FR 21221 (May 9, 2018) does not impact this case.

readable medium (CRM) stores the captured data, and that CRM need not be part of the first recording device.¹⁰ See Dec. 8–9.

During trial, the dispute between the parties shifted to focus on the meaning of “to begin recording” in the instruction of the second communication signal. Petitioner asserts that, “record” means, “to generate or capture data for the purpose of storing.” Pet. Reply 2–4. Patent Owner characterizes Petitioner’s assertion as contending that “record” means to transmit data. PO Resp. 5. Patent Owner contends that an instruction to transmit data is not an instruction to record, and that the second recording device must do the recording. *Id.* Patent Owner asks that we construe “record” and the variants of that term to at least encompass, “storing the captured data for future retrieval.” PO Resp. 5–7.

For the reasons that follow, the term “record” and its variants may refer to the entire recording process (i.e., generating or capturing data and storing that data for future retrieval) or to a portion of that process, depending on the context of the use of the term.

It is the claims that define the scope of the right to exclude, and for that reason, our inquiry begins and ends with the actual words of the claim. *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998) (citations omitted). Neither party properly accounts for the context of the use of the term “record” and its variants. See, e.g., *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016)

¹⁰ A CRM can be any non-transitory medium that can contain, store, or communicate computer programs. Ex. 1001, 10:23–46.

(“Construing individual words of a claim without considering the context in which those words appear is simply not ‘reasonable.’”).

Claim 1 recites that the second communication signal instructs the second recording device “*to begin recording* a second set of record data related to the event.” See limitation 1[G] (emphasis added). Claim 1 does not require that the second communication signal is an instruction to complete the entire recording process; rather, it is an instruction to the second recording device to begin recording a second set of record data. Elsewhere, claim 1 recites that the second set of record data is “recorded” (stored) on a second CRM. See limitation 1[H]. Consequently, the second communication signal includes an instruction to the second recording device “to begin recording” (generate or capture the second set of record data), and that data is subsequently “recorded” (stored) on the second CRM.

Claim 1 refers to the first and second recording devices as “recording” devices even though those devices capture or generate data and that data is stored by another device (the associated first or second CRM).

Consequently, the language of claim 1 uses the term “record” and its variants to refer to all or part of the recording process. This is consistent with our determination in the Institution Decision that the first and second recording devices are associated with a respective first and second CRM, and that associated CRM stores the data for subsequent retrieval. See Dec. 8–9. A CRM that is “associated” with a recording device may or may not be a part of that device. *Id.*

This interpretation is also consistent with the Specification.¹¹

In parity with the language of claim 1, the '292 patent refers to a device as a “recording” device even if that device does not store that data for subsequent retrieval. *See, e.g.*, Ex. 1001, 3:49–52 (describing vehicle recording device 14 and personal recording device 18 (first and second recording devices) as operable to record data, including audio and video data), 11:64–12:2 (describing that devices 14, 18 may include memory or may utilize memory in vehicle 16).

The record also contains extrinsic information that is consistent with our interpretation. Specifically, Pierce, like the '292 patent, uses the term “record” and its variants to refer to the entire recording process or a portion of that process. *See, e.g.* Ex. 1014 ¶ 56 (describing that data is “recorded” by camera 62 even though that data is stored on recording media 44).

The second communication signal must include an instruction to the second recording device to begin recording, but that signal need not include an instruction to store the data that is generated or captured.

In our patentability analysis below, we determine that Petitioner has not sufficiently shown that the prior art cited in the patentability challenges discloses or suggests a second communication signal as claimed because the alleged second recording device in the prior art is configured to continuously record and would not need to be instructed to begin recording. Whether an instruction to “begin recording” as claimed requires that the data be stored is

¹¹ The claims are part of the Specification and our use of the term Specification here means the portion other than the claims. We need not consult a dictionary for the ordinary meaning of “record” because it is clear from the claims and Specification.

not the determinative point. Consequently, our claim construction could be seen as not determinative; however, we provide that interpretation because it is useful to understand the claim and the prior art.

III. PATENTABILITY

A. WITNESSES

1. *Dr. Houh*

Petitioner's expert witness, Dr. Henry Houh, works in the area of digital and streaming media, and has a doctorate and Master of Science in Electrical Engineering and Computer Science, and a Bachelor of Science degree in Physics. *See* Ex. 1003 ¶¶ 3–4 (Declaration), Ex. 1004 (Curriculum Vitae), Ex. 1027 (Reply Declaration); *see also* Ex. 2005 (Deposition); Pet. 4, 25.

Patent Owner contends that Dr. Houh, “could not or would not provide any explanation of what he believes ‘activation’ as used in Pierce means.” PO Resp. 37–38 (citing Dr. Houh's testimony at Ex. 2005, 19:16–33:20, 40:17–49:16). Patent Owner's general proposition that Dr. Houh could not or would not provide “any explanation” is an overstatement. To the contrary, Dr. Houh provided explanations. It is more accurate to say that Patent Owner disagrees with the validity of these explanations.

Patent Owner's more specific assertions regarding Dr. Houh's testimony are addressed in our obviousness analysis below.

2. *Dr. Madisetti*

Patent Owner's first expert witness, Dr. Vijay Madisetti, is a professor in Electrical and Computer Engineering at Georgia Institute of Technology, and has a Bachelor's degree and doctorate in Electronics and Electrical

Communications Engineering. Ex. 2001 ¶ 5, App'x 1, 4 (curriculum vitae)); *see also* Ex. 1028 (Deposition).

Petitioner contends that “[b]ecause Dr. Madisetti failed to consider the content of the prior art in its entirety, the Board should accord his opinions and testimony little to no weight.” Pet. Reply 24 (citing Ex. 1028, 77:1–81:4, 142:10–143:2, 144:7–149:3).

We disagree with Petitioner’s assessment. In the portions of Dr. Madisetti’s testimony cited by Petitioner, Dr. Madisetti consistently maintains that Pierce only discloses embodiments having continuous recording (pre-event recording).¹² This does not indicate that Dr. Madisetti failed to consider Pierce in its entirety; rather, it indicates only that Dr. Madisetti’s interpretation of Pierce differs from Petitioner’s interpretation. Indeed, Dr. Madisetti expressly indicated that he reviewed Pierce. *See* Ex. 2001 ¶ 2.

3. *Captain Ayers*

Patent Owner’s second expert witness, Captain Matthew Ayers, is a law enforcement officer with experience with event recorder systems for law enforcement use. Ex. 2002 ¶ 2; *see also* Ex. 1029 (Deposition).

Patent Owner submitted the Declaration of Captain Ayers “to opine on what a law enforcement officer would understand as the features and operation of event recording systems for law enforcement use.” PO Resp. 10–11. The ’292 patent and the prior art of record were readily

¹² As shorthand, the parties sometimes refer to Pierce’s disclosure of continuous recording of up to one minute as “pre-event recording.” *See* Ex. 1014 ¶ 86; *see, e.g.*, Pet. Reply 1, 8; PO Resp. 16.

understandable in view of the arguments of each party and the Declarations of Dr. Houh and Dr. Madiseti. Consequently, we did not rely on Captain Ayers's testimony, and Petitioner's arguments regarding this testimony are moot. *See* Pet. Reply 22–24.

B. LEVEL OF SKILL IN THE ART

In our Institution Decision, we observed that the parties are largely in agreement regarding the level of skill in the art. Dec. 14–16. Based on our review of the record at institution, we determined that a person of ordinary skill would have had at least a bachelor's degree in electrical engineering or a related field. *Id.* That person would have had two years of experience in an industrial or educational setting, to include design experience. *Id.* Given this education level and experience, that person would have had a working knowledge of computing devices and associated hardware and software. *Id.*

We instructed the parties that additional argument and evidence related to the level of skill in the art should focus on how that level impacts the obviousness analysis. *Id.* at 15–16. After institution, neither party contested this determination, and consequently, we apply the level of skill set forth above to our analysis.

C. OBJECTIVE INDICIA OF NONOBVIOUSNESS

Patent Owner did not present objective indicia of nonobviousness.

D. ISSUE

For the reasons discussed below, we find that there is insufficient evidence of record to support Petitioner's contention that the claimed second communication signal would have been obvious. Thus, we need not consider whether Petitioner has met its burden with respect to any other claim limitations.

Each of the challenged independent claims (1, 18, 36, and 48) requires the second communication signal to include an instruction that the second recording device "begin recording" a second set of record data related to an event. As explained above, this means that the second communication signal must include an instruction for the second recording device to begin recording (generate or capture data), but that signal need not include an instruction to store the data that is generated or captured. Additionally, the second communication signal interrelates to the first communication signal in that the at least one transmitter must be configured to transmit the second communication signal in response to receiving the first communication signal from the first recording device indicating that the first recording device has received the first law enforcement officer's instruction to record. In other words, the second communication signal must be triggered by the first communication signal.

Petitioner contends that the claimed second communication signal would have been obvious over either: (1) Pierce alone or (2) Pierce and 20/20-W. Pet. 26–71; *see also* Pet. 5–15 (regarding the scope and content of the prior art), 17–18 (regarding the level of skill in the art).

E. ASSERTED GROUNDS OF UNPATENTABILITY

In the Petition, Petitioner asserted that the challenged claims are unpatentable under 35 U.S.C. § 103(a) over (1) Pierce¹³ and (2) Pierce and 20/20-W.¹⁴ Pet. 26–71.

1. *Introduction to the References*

a) *Pierce*

Pierce discloses a vehicle mounted data acquisition and display system and method of recording referred to as the ICOP 20/20. Ex. 1014 ¶¶ 2, 7, 18, Fig. 4a (“ICOP 20/20” in top left corner of the device); see Pet. 26. Pierce’s system addresses the concern that law enforcement officers often fail to record valuable data because the recording apparatus is not activated until after an incident is resolved. Ex. 1014 ¶ 4. Further, it was thought that recording the activities of officers and suspects could reduce or eliminate incidents of police brutality and false allegations of police brutality. *Id.* ¶ 6.

Pierce’s data acquisition and display system 10 includes cameras 62 (e.g., first camera 62a, second camera 62b), microphones 68 (e.g., first and second microphone 68a and 68b), and speed measuring apparatus 77. Ex. 1014 ¶¶ 35, 52, 61, 69, Figs. 1–3. Central unit 30 of the system houses controller 31 that is programmable to coordinate operation of system 10. *Id.* ¶ 39.

¹³ U.S. 2005/0083404, published Apr. 21, 2005 (Ex. 1014).

¹⁴ Raytheon JPS Communications, Raytheon Model 20/20-W, Raytheon 20/20 VISION, Digital In-Car Video Systems, White Paper WP-8002-11 (Ex. 1015). See also Exhibit 1016 regarding public availability of Exhibit 1015.

Figure 1 of Pierce follows.

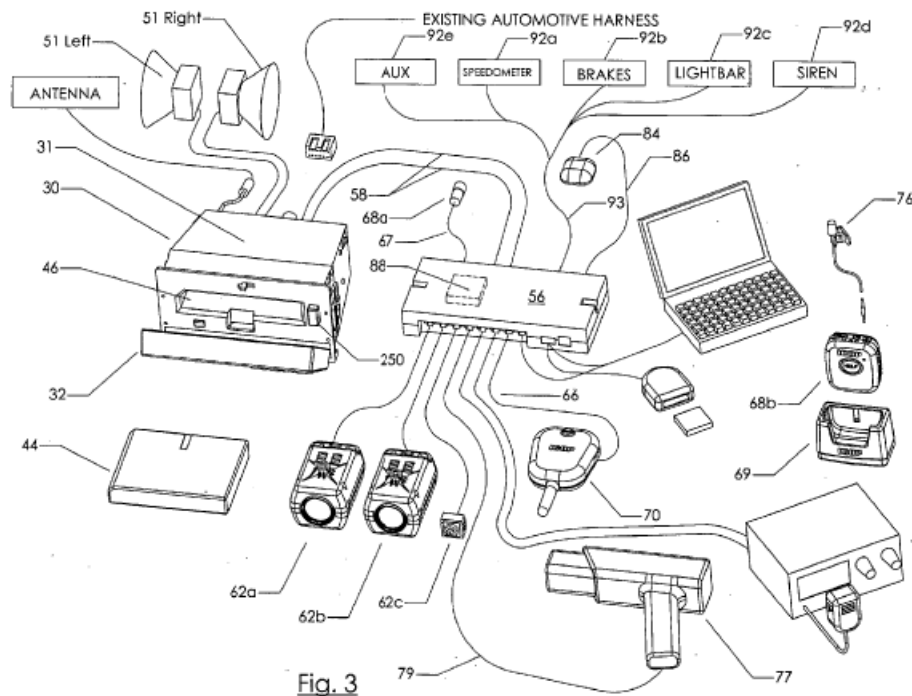


Figure 1 is a perspective view of Pierce's vehicle and data acquisition and display system. Ex. 1014 ¶ 15.

Pierce's system 10 includes a recording device manager (central unit 30 housing controller 31) having at least one receiver and at least one transmitter (communication connections, ports, or jacks 54 that receive data and transmit control signals). Ex. 1014 ¶¶ 30, 39, 51, 57, Fig. 3; Ex. 1003 ¶ 165; Pet. 32–39.

Pierce's user interface 40 includes buttons for controlling operation of video cameras 62 (e.g., "REC1," "STOP"), internal microphone 68a (an "INT MIC" button), and speed measuring apparatus 77 (a record button). Ex. 1014 ¶¶ 43, 44, 61, 70, 85, Figs. 2, 4a. Figure 4a of Pierce follows.

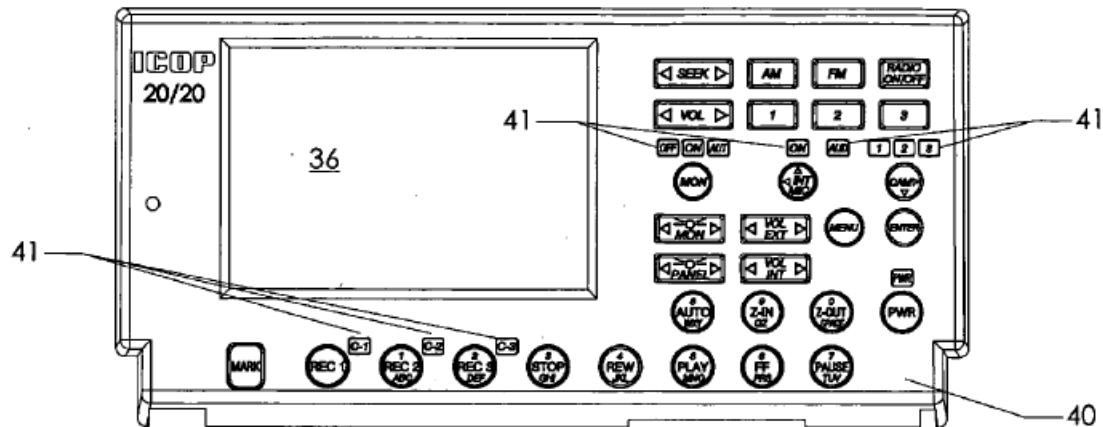


Fig. 4a

Figure 4a is a front view of a portion of system 10. Ex. 1014 ¶¶ 18, 35. Thus, the controls at user interface 40 are triggered by an operator and not by activation of 72b of wireless microphone 68b.

b) 20/20-W

20/20-W discloses a digital in-car video system (Model 20-20-W) based on the ICOP 20/20 system. Pet. 28; Ex. 1015 ¶ 1. Consequently, Pierce and 20/20-W are similar systems.

F. OBVIOUSNESS OVER PIERCE¹⁵

Petitioner contends that Pierce discloses a multiple recording device management system that includes a recording device manager (central unit

¹⁵ As mentioned above, each of the independent claims and therefore all of the challenged claims, call for a second communication signal. Therefore, our analysis of claim 1 applies to all of the challenged claims.

30 housing controller 31) including at least one receiver and at least one transmitter (communication connections, ports, or jacks 54 that receive data and transmit control signals). Pet. 32–35.

Petitioner contends that Pierce discloses a first recording device (wireless microphone 68*b*) communicatively coupled with the recording device manager (central unit 30), and a second recording device (either first camera 62*a*, internal microphone 68*a*, or speed measuring apparatus 77) communicatively coupled with the recording device manager (central unit 30). Pet. 39–41, 44–46; Pet. Reply 6–7.

With regard to the first communication signal, Petitioner contends that Pierce’s receiver (jack 54) is configured to receive a first communication signal from the first recording device (wireless microphone 68*b*) indicating that device received an instruction initiated by a first law enforcement officer to record a first set of record data related to an event (either when RECORD button 72*a* or HELP/CALL¹⁶ button 72*b* is depressed).¹⁷ Pet. 41–42; Pet. Reply 7. In other words, Petitioner contends that the signal from wireless microphone 68*b* to one of jacks 54 of central unit 30 corresponds to a first communication signal as claimed.

With regard to the second communication signal, Petitioner contends that Pierce’s central unit 30 includes communication ports 54 that transmit

¹⁶ Patent Owner does not contest Dr. Houh’s opinion that Pierce refers to button 72*b* both as the “CALL button” and as the “HELP button.” See Ex. 1003 ¶¶ 152, 172. We agree. For clarity, we refer to it as the “HELP/CALL button 72*b*.”

¹⁷ Petitioner mistakenly refers to the HELP button as 72*a* (Pet. 41), but subsequently correctly identifies it as 72*b* (Pet. 42).

activation signals to each of first camera 62a, internal microphone 68a, and speed measuring apparatus 77. Pet. 46 (citing Ex. 1014 ¶¶ 44, 70, 85; Ex. 1003 ¶¶ 173, 234). Petitioner contends that, “Pierce explains that in response to an officer’s activation of the wireless microphone 68b via the HELP button, the controller causes the first camera 62a, the internal microphone 68a, and the speed measuring apparatus 77 to all begin recording data.” *Id.* (citing Ex.1014 ¶¶ 68, 84; Ex.1003 ¶¶ 152, 172); *see also* Pet. 51 (asserting that Pierce discloses that depression of the HELP/CALL button on microphone 68b “is an instruction for the wireless microphone [microphone 68a] to record”); Pet. Reply 7. In other words, Petitioner contends that each of the signals from communication port 54 of Pierce’s central unit 30 to first camera 62a, internal microphone 68a, and speed measuring apparatus 77 corresponds to a second communication signal as claimed.

In the Preliminary Response, Patent Owner argued that the alleged second recording devices (first camera 62a, internal microphone 68a, or speed measuring apparatus 77) are already recording when an operator depresses button 72b of microphone 68b so that a signal for those devices to begin recording is not needed. Prelim. Resp. 28–29. In our Institution Decision we preliminarily determined, based on the record at that point, that Petitioner had shown a reasonable likelihood of prevailing because Pierce’s disclosure that in some constructions (embodiments) data is continuously recorded suggests that in other constructions (embodiments) data is not

continuously recorded.¹⁸ Dec. 24–25. Now we consider that issue in light of the entire record and against the standard that Petitioner must demonstrate unpatentability by a preponderance of the evidence.

1. *Pierce Does Not Disclose the Claimed Second Communication Signal*¹⁹

Petitioner contends that Pierce discloses or explains that depressing HELP/CALL button 72*b* of wireless microphone 68*b* causes a signal (the alleged second communication signal) instructing first camera 62*a*, internal microphone 68*a*, or speed measuring apparatus 77 to begin recording data. Pet. 46–48, 51–52; Pet. Reply 7. Dr. Houh echoes this interpretation. See Ex. 1003 ¶¶ 152, 172–173, 234–237.

Several factors undermine Petitioner’s contention.

First, and significantly, as discussed above, Pierce discloses that an operator may control cameras 62, microphone 68*a*, and speed measuring apparatus 77 via user interface 40. However, the claimed second

¹⁸ In the Institution Decision we stated that in an embodiment of Pierce that was not continuously recording, a signal to recording devices to begin recording would be “necessary.” See Dec. 25. Use of the term “necessary” led the parties to discuss whether Pierce inherently disclosed a second communication signal as claimed. See, e.g., Tr. 13:17–14:6, 33:7–34:10; PO Resp. 13; Pet. Reply. 11–12. Our use of the term “necessary,” was not intended to indicate that Pierce inherently discloses a second communication signal. Had we intended to apply the inherent disclosure doctrine we would have explicitly stated that.

¹⁹ We do not rely on some of Patent Owner’s arguments, such as the argument regarding comments during prosecution of the Pierce application, and the argument regarding Pierce’s ability to toggle between cameras. See PO Resp. 41–42, 44. Consequently, we address only Petitioner’s corresponding arguments in the Reply relevant to our determination.

communication signal must be triggered²⁰ by the first communication signal,²¹ not by operator input at the controller (recording device manager). Consequently, Petitioner's assertions regarding the ability of an operator to transmit activation signals to camera 62a, internal microphone 68a, or speed measuring apparatus 77 *from user interface 40* do not support Petitioner's assertion that Pierce discloses a second communication signal as claimed. See Pet. 46–47, 52; Ex. 1003 ¶¶ 178, 183, 234.

Second, neither the Petition, nor Dr. Houh's testimony, cogently addresses how the disclosure in Pierce's paragraph 86 relates to, and can be read in concert with, the remainder of the reference.

Third, and perhaps most importantly, as explained below, Pierce does not contain a disclosure or explanation as Petitioner contends.

Pierce discloses that if an operator is injured and/or unable to speak, the operator may depress HELP/CALL button 72b of microphone 68b to send a distress signal to controller 31. Ex. 1014 ¶ 68. Controller 31 then records the distress call and sends a distress signal to a second location. *Id.*

Pierce discloses that depressing HELP/CALL button 72b is one of several ways to trigger EVENT recording. Ex. 1014 ¶¶ 68, 84, Fig. 11A (act 118 data recording); Figure 11B (act 120 initiation of data recording).

²⁰ In the language of the claims, the first communication signal must trigger the second in that the second is transmitted in response to the at least one receiver receiving the first communication signal from the first recording device indicating that the first recording device has received the first law enforcement officer's instruction to record.

²¹ As discussed above, Petitioner alleges that the first communication signal is caused by depressing button 72b of microphone 68b. See Pet. 41–42; Pet. Reply 7.

During EVENT recording, Pierce's system automatically records data from two predetermined cameras (e.g., cameras 62a and 62b), first and second microphones 68a and 68b, and speed measuring apparatus 77. *Id.* at 84.

Pierce further discloses:

To ensure that the controller **31** and the recording media **44** record as much relevant data as possible, in some constructions, the data acquisition and display system 10 is programmed to continuously record video data, sound data, time and date data, vehicle status data, and vehicle location data for a predetermined time (up to 1 minute) and then to record over the previously recorded data. In these constructions, the recording media **44** continuously records data and then records over that data until OPERATOR-INITIATED or EVENT recording is initiated and once OPERATOR-INITIATED or EVENT recording is initiated, the recording media **44** saves the previously recorded data (up to 1 minute of data) and all data collected after OPERATOR-INITIATED or EVENT recording is initiated until the operator presses STOP in act **124** or act **126**. In this manner, the recording media **44** also stores data from a relatively short period before OPERATOR-INITIATED or EVENT recording is initiated and stores data collected after OPERATOR-INITIATED or EVENT recording is initiated. The data recorded before OPERATOR-INITIATED or EVENT recording is initiated provides context to the data recorded after OPERATOR-INITIATED or EVENT recording is initiated and can be of particular investigative and/or evidentiary value.

Ex. 1014 ¶ 86.

From this disclosure, a person of ordinary skill would have understood that an embodiment of Pierce's system 10 continuously records a variety of data (record video data, sound data, time and date data, vehicle status data, and vehicle location data)²² for up to one minute and then

²² Pierce does not identify speed data as a type of data collected.

records over that data.²³ When EVENT recording is initiated by an operator depressing HELP/CALL button 72*b* of microphone 68*b*, this causes recording media 44 to save (store) the up to one minute of prerecorded data and the data collected (generated or captured) post initiation (after HELP/CALL button 72*b* is depressed). This technique records “as much relevant data as possible” and preserves the data collected in the up to one minute time prior to depression of the HELP/CALL button. Ex. 1014 ¶ 86. The pre-initiation data provides context to the data collected post initiation and can be of particular investigative and/or evidentiary value.

This embodiment would not send a signal to the alleged second recording devices (car-mounted video camera 62*a* and internal microphone 68*a*) to begin recording when HELP/CALL button 72*b* of microphone 68*b* is depressed because those devices would already have begun recording (preserving the up to one minute of data).

In contrast to Petitioner, Patent Owner addresses how paragraph 86 of Pierce can be read in concert with the entire reference. Specifically, Patent Owner contends that Pierce’s disclosure of automatically recording in paragraph 84 is consistent with continuously recording a variety of data for up to one minute and then recording over that data as disclosed in paragraph 86. PO Resp. 13–14. In support, Dr. Madisetti opines that Pierce’s automatic recording and continuous recording are compatible because Pierce discloses that, “*during* EVENT recording, the controller and the recording media 44 automatically record” and discloses that EVENT recording can be

²³ The parties sometimes refer to this technique as “pre-event recording.” See, e.g., PO Resp. 16; Pet. Reply 1, 8, 9.

initiated with the pre-event recording feature. Ex. 2001 ¶ 51 (citing Ex. 1014 ¶¶ 84, 86). This interpretation comports with our understanding of the reference.

Next, we examine how speed measuring apparatus 77 similarly fails to teach the signal limitation. Speed measuring apparatus 77 may take the form of a radar-based gun or a laser-based speed gun, and is operable to record the speed of target vehicles in a known manner. Ex. 1014 ¶ 69. Speed measuring apparatus 77 transmits speed data to controller 31 and this data is stored on recording media 44. *Id.*

Patent Owner's expert, Dr. Madisetti, explains that speed data is continuously received and processed by controller 30 to identify a speed above a predetermined level and such determination triggers EVENT recording. Ex. 2001 ¶ 71; PO Resp. 30. Consequently, an EVENT would cause a signal instructing controller 30 to store, on recording device 40, the data that was previously generated or captured by speed measuring apparatus 77. A signal including an instruction for speed measuring apparatus 77 to begin recording would not be needed because that device was already generating or capturing data at the time of the EVENT (e.g., a speed detected above a predetermined level). Patent Owner's explanation comports with our understanding of the reference.

Petitioner argues that Patent Owner's reading is overly restrictive because it requires the speed gun to initiate EVENT recording. Pet. Reply 13. Petitioner's argument is unpersuasive because it is conclusory and unsupported by evidence.

Consequently, Petitioner has not sufficiently demonstrated that Pierce discloses that depressing HELP/CALL button 72b of wireless microphone

68*b* causes a signal instructing any of first camera 62*a*, internal microphone 68*a*, or speed measuring apparatus 77 to begin recording data.

2. *Pierce Does Not Suggest the Claimed Second Communication Signal*

As detailed above, Pierce does not explicitly disclose that activating HELP/CALL button 72*b* of wireless microphone 68*b* causes jack 54 of controller 31 to send a signal instructing the alleged second recording devices (camera 62*a*, microphone 68*a*, or apparatus 77) to begin recording. Petitioner argues that Pierce implicitly discloses or suggests the claimed second communication signal. See Pet. 46–48, 51–53 (relying on paragraph 86 of Pierce). To some extent, Petitioner acknowledges that Pierce does not explicitly disclose a second communication signal as claimed. See Ex. 1003 ¶ 178 (Mr. Houh, opining that Pierce “may not provide an express disclosure”), cited in Pet. 52; Tr. 12:4–13:4 (citing both *In re Preda*, 401 F.2d 825, 826 (CCPA 1968) and MPEP § 2144.01, and arguing that Pierce implicitly discloses or suggests the claimed second communication signal).

Patent Owner argues that Pierce does not disclose or suggest the claimed second communication signal because Pierce’s alleged second recording devices are continuously recording. PO Resp. 12–52. Petitioner responds that contrary to Patent Owner’s characterization, Pierce’s recording devices are not always recording. Pet. Reply 8–17.

Before addressing the contentions of the parties, we clarify two aspects of our inquiry.

First, Petitioner argues as if the issue before us is whether Pierce discloses any embodiment that is not continuously recording. Framing the issue in that manner is somewhat of an improper burden shift to Patent

Owner. The proper inquiry is whether Petitioner has established by a preponderance of the evidence that the embodiment of Pierce relied on by Petitioner teaches or suggests a second communication signal as claimed. *See generally* Tr. 33:7–35:3 (addressing Patent Owner’s concerns regarding the burden of proof); Pet. Reply 12.

Second, rather than framing the issue in terms of what Pierce implicitly discloses, the relevant inquiry is what a reference fairly discloses to a person of ordinary skill in the art. *Compare Syntex LLC v. Apotex, Inc.*, 407 F.3d 1371 (Fed. Cir. 2005) (“What a reference teaches or suggests must be examined in the context of the knowledge, skill, and reasoning ability of a skilled artisan.”), with *In re Preda*, 401 F.2d at 826 (dealing with what an allegedly anticipatory reference implicitly discloses).

In the embodiment of the reference that Petitioner relies on, Pierce discloses that “in some constructions” (some embodiments) system 10 is programed to continuously record a variety of data (i.e., video, sound, time and date, vehicle status, and vehicle location data) for up to one minute and then records over that data. Ex. 1014 ¶ 86. As detailed below, a person of ordinary skill in the art would have recognized that Pierce suggests another embodiment or embodiments, but does not suggest that the other embodiment(s) transmit a signal that includes an instruction for the alleged second recording devices to begin recording. Nor does Pierce suggest that the signal is in response to the first communication signal from the first recording device indicating that the first recording device has received the first law enforcement officer’s instruction to record.

Patent Owner provides three examples of embodiments that are different from the embodiment disclosed in paragraph 86 of Pierce that do

not include a second communication signal as claimed: (1) an embodiment that continuously records different data (data other than video, sound, time and date, vehicle status, and vehicle location data) for up to one minute and then records over that data, (2) an embodiment having a video buffer storing a fixed quantity of data rather than predefine period of time (up to one minute), (3) and an embodiment that records continuously but does not overwrite the previously recorded data. *See* Ex. 2001 ¶ 56. To this list of possibilities, we add an embodiment that records for a period other than up to one minute, such as up to ten minutes. This is not an exhaustive list. The salient point is that although Pierce suggests to a person of ordinary skill another embodiment or embodiments, it does not suggest the characteristics of such other embodiment or embodiments.

Additionally, we agree with Patent Owner that because Pierce and 20/20-W are similar systems (both versions of “ICOP 20/20”), the fact that 20/20-W discloses only embodiments that continuously record a variety of data for up to one minute and then record over that data, suggests that Pierce would also perform according to such embodiments. PO Resp. 18; Ex. 2001 ¶¶ 53–54; Ex. 1015, 8.

Petitioner’s various arguments do not persuade us otherwise.

Petitioner contends that paragraphs 68 and 84 of Pierce “explain” or “disclose” that a signal that includes an instruction for the alleged second recording devices (camera 62a, microphone 68a, or speed measuring apparatus 77) to begin recording. *See* Pet. 46, 51; *see also* Ex. 1003 ¶ 178 (Dr. Houh echoing Petitioner and opining that Pierce “implicitly teaches or suggests” the second communication signal (citing Ex. 1014 ¶¶ 44, 66, 68,

70, and 83–85).²⁴ As detailed above, Pierce contains no such disclosure, further, Petitioner’s contention does not adequately explain how Pierce’s disclosure (Ex. 1014 ¶ 86) of an embodiment that continuously records a variety of data for up to one minute and then records over that data suggests a second communication signal as claimed.

Petitioner contends, with supporting testimony from Dr. Houh, that, “Pierce teaches that ‘pre-event recording^[25]’ is an optional feature, not essential to every disclosed embodiment,” and likens the disclosure in Pierce to that at issue in *Upsher-Smith Labs. v. PamLab, LLC*, 412 F.3d 1319 (Fed. Cir. 2005). Pet. Reply 9–11; Ex. 1003 ¶¶ 18–19.

In *Upsher-Smith*, Upsher-Smith conceded that the allegedly anticipatory prior art disclosed every element of the asserted claims except the limitation that the compound was essentially free of antioxidants. *Upsher-Smith*, 412 F.3d at 1321. That prior art expressly recognized that certain antioxidants were known to destroy vitamin B₁₂ and folate, and described a compound that “optionally include[s]” antioxidants. *Id.* at 1321–22. The Federal Circuit agreed with the District Court’s determination that in these circumstances the prior art disclosed vitamin supplement compositions that both do and do not contain antioxidants. *Id.* at 1322.

Upsher-Smith is distinguishable from the case at hand. In *Upsher-Smith* the prior art disclosed that a compound may optionally include antioxidants and expressly acknowledged the desirability of a compound

²⁴ Notably, Dr. Houh does not cite to or account for paragraph 86 of Pierce.

²⁵ Meaning continuously recording a variety of data (i.e., video, sound, time and date, vehicle status, and vehicle location data) for up to one minute and then recording over that data. See Section III.F.1.

being free of antioxidants. That is, the prior art suggested both possibilities, namely, a compound that included antioxidants and one that did not. Here, Petitioner has not identified, nor do we discern, any disclosure in Pierce of the desirability of not recording continuously with any of the alleged second recording devices (microphone 68*b*, camera 62*a*, speed measuring device 77). Stated differently, Pierce does not disclose the desirability of waiting until an event occurs to begin the recording process. To the contrary, Pierce discloses the desirability of preserving the most relevant evidence by continuously generating or capturing data. Ex. 1014 ¶ 86; PO Resp. 15–18.

While we agree that Pierce suggests an embodiment other than the disclosed embodiment²⁶, it does not disclose or suggest details of that other embodiment or embodiments. Further, Petitioner has not adduced sufficient evidence of record to establish that it would have been obvious to arrive at the claimed elements in light of that other embodiment.

Similarly, Petitioner contends that Patent Owner's arguments are analogous to those rejected by the Federal Circuit in *Prolitec, Inc. v. ScentAir Techs., Inc.*, 807 F.3d 1353 (Fed. Cir. 2015) (*overruled on other grounds* by *Aqua Prods. v. Matal*, 872 F.3d 1290, 1296 n.1 (Fed. Cir. 2017)). Pet. Reply 11. Petitioner's reliance on *Prolitec* is simply a repetition of Petitioner's unpersuasive reliance on *Upsher-Smith*. See *Prolitec*, 807 F.3d at 1362 (citing *Upsher-Smith*, 412 F.3d at 1322).

In support of the assertion that Pierce discloses embodiments that are not continuously recording, Petitioner contends that Pierce's still cameras

²⁶ An embodiment that continuously records a variety of data (i.e., video, sound, time and date, vehicle status, and vehicle location data) for up to one minute and then records over that data. Ex. 1014 ¶ 86.

are not continuously recording data. Pet. Reply 12 (citing Ex. 1014 ¶ 53; Ex. 1027 ¶¶ 22–23 (echoing Petitioner’s Reply)). Even if Petitioner is correct that Pierce discloses an embodiment having still cameras that do not continuously record, that does not demonstrate that Pierce discloses a second communication signal as claimed because the Petition relies upon Pierce’s video cameras 62 and not upon Pierce’s still cameras. *See, e.g.*, Pet. 34 (referring to “video cameras 62a, 62b”), 44 (“car mounted video cameras,” “first and second video cameras”), 45 (“video camera”), 49 (“wireless video camera”). Petitioner cannot change the basis of its ground of unpatentability in such a manner in the Petitioner’s Reply. *See* 37 C.F.R. § 42.104(b)(4)–(5) (requiring the petition to explain how the construed claim is unpatentable and to explain the exhibit number and relevance of evidence); *Belden v. Berk–Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015).

Petitioner contends that even if Patent Owner is correct that (1) pre-event recording is consistent with automatic recording, and that (2) automatic recording is highly desirable, that does not mean that Pierce is limited to embodiments that use pre-event recording. Pet. Reply 10. Petitioner adds that the law requires that we consider Pierce for all that it teaches to those of ordinary skill in the art. *Id.* at 10–11. We reiterate that the issue before us is not whether Pierce discloses any embodiment that is not continuously recording. The proper inquiry is whether Petitioner has established by a preponderance of the evidence that the embodiment of Pierce relied on by Petitioner discloses a second communication signal as claimed.

Dr. Houh likens the disclosure in Pierce’s paragraph 58 to that in paragraph 86. Specifically, Dr. Houh opines that Pierce’s disclosure in

paragraph 58 that “in some constructions” recording media 44 records video on a single channel and that “[i]n other constructions, the recording media 44 records two channels of video data simultaneously” demonstrates that use of the phrase “in some constructions,” as used in paragraph 86, indicates an optional feature. Ex. 1027 ¶ 20.

The disclosure in paragraph 58 of Pierce is not like that in paragraph 86. A person of ordinary skill would have understood that paragraph 58 describes both an embodiment that records on a single channel and an embodiment that records on two channels. In contrast, paragraph 86 discloses one embodiment (i.e., one that continuously records a variety of data for up to one minute and then records over that data) and one or more undescribed variants of that embodiment. A person of ordinary skill would have understood that variants of that embodiment are different, but further details are not provided.

Dr. Houh opines that a person of ordinary skill would have understood that if an operator is injured or unable to speak and depresses HELP/CALL button 72*b*, recording information from microphone 68*b* would be important. Ex. 1003 ¶ 152. Our interpretation of the reference is that depressing HELP/CALL button 72*b* would preserve (by storing the data) the up to one minute of data that was previously obtained, and thus our interpretation recognizes the importance of that information and is consistent with Dr. Houh’s opinion.

3. *Conclusion*

Petitioner has not sufficiently established that Pierce discloses or suggests a second communication signal that instructs the alleged second recording devices (camera 62a, internal microphone 68a, and speed measuring apparatus 77) to begin recording.

G. OBVIOUSNESS OVER PIERCE AND 20/20-W

Petitioner contends that the second communication signal would have been obvious over Pierce and 20/20-W. Pet. 46–48; Pet. Reply 7–20.

Petitioner contends that the 20/20-W system triggers the internal microphone to record when the wireless microphone is activated to record. Pet. 37; Pet. Reply 19; see Ex. 1015, 8–9, 17–18. Petitioner contends that it would have been obvious to modify Pierce’s system in view of the 20/20-W Publication “in order to trigger the internal microphone 68a to begin recording in response to activation of the wireless microphone 68b.”²⁷ Pet. 36 (citing Ex. 1003 ¶¶ 175–177, 237, 238). Further, according to Petitioner, it would have been obvious to trigger other data recorders, such as Pierce’s camera 62 to begin recording in response to activation of the wireless microphone 68b. *Id.* (citing Ex. 1003 ¶¶ 177–179, 237, 238). Petitioner contends this would allow Pierce to record and store data from underutilized data recorders for a more complete evidentiary record. Pet. 38. Petitioner further contends that the proposed modification would not require undue

²⁷ Petitioner quotes claim 1 as requiring “transmitting the second signal in response to receiving the first communication signal.” Pet. 36. This appears to be an incorrect quotation of clause 1[J].

experimentation²⁸ and is nothing more than combining “prior art elements according to known methods to yield predictable results” and/or the “[u]se of known technique[s] to improve similar devices (methods, or products) in the same way.” *Id.* (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417–22 (2007); Ex.1003 ¶ 177).

20/20-W discloses that when the Officer Help button is depressed, “it activates video and audio recordings if not previously activated.” Ex. 1015, 17. 20/20-W also discloses that “[a]ll ICOP solutions operate up to 3 cameras (records 2 simultaneously) and captures [sic] 60 seconds of pre-event video and audio (audio can be disabled by administrator).” Ex. 1015, 8 (emphasis added).

We must consider the prior art as a whole. *In re Hedges*, 783 F2d 1038, 1041 (Fed. Cir. 1986) (“[T]he prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill.”). That is, we consider 20/20-W as a whole, taking into account both of the above-cited disclosures (Ex. 1015, 8, 17).

Patent Owner contends, and we agree, that because all ICOP solutions continuously record 60 seconds, the cameras are already capturing audio and video data (have begun recording), and depressing the Officer Help button “activates video and audio recording” in that it causes the DVR to begin preserving that data. PO Resp. 53–54; Ex. 2001 ¶ 84. In that sense, activation of the Officer Help button does not trigger an instruction to begin recording; rather, it triggers an instruction to store data that was already

²⁸ We note that ordinarily “undue experimentation” is a concern under 35 U.S.C. § 112(a) while a “reasonable expectation of success” is a concern in an obviousness analysis.

captured or generated. This interpretation is consistent with our claim construction that “record” and its variants can refer to all or part of the recording process, depending on context.

Petitioner argues that Patent Owner’s argument is misplaced because Petitioner did not rely only on 20/20-W’s cameras as corresponding to a second recording device; rather, Petitioner also relied on 20/20-W’s internal microphone. Pet. Reply 19.

We are unpersuaded by Petitioner’s argument for two reasons. First, by responding that 20/20-W’s internal microphone may be a second recording device as claimed, Petitioner essentially concedes that 20/20-W’s cameras and speed measuring apparatus each do not correspond to a second recording device as claimed.²⁹ Second, Petitioner inappropriately narrows that disclosure in 20/20-W. Specifically, Petitioner’s argument suggests that the disclosure only relates to cameras (video) when in fact the disclosure relates to both audio and video. *See* Ex. 1015, 8. (“[a]ll ICOP solutions operate up to 3 cameras (records 2 simultaneously) and captures [sic] 60 seconds of pre-event video *and audio* (audio can be disabled by administrator)”); *see also* PO Resp. 53–54; Ex. 2001 ¶ 84. As explained above, because all ICOP solutions continuously record 60 seconds, depressing the Officer Help button “activates video and audio recording” in that it causes the DVR to begin preserving that data that was previously captured.

²⁹ Because that device does not receive a second communication signal as claimed.

Petitioner has not adequately established that the combination of Pierce and 20/20-W discloses or suggests a second communication signal that instructs the alleged second recording devices (camera 62a, internal microphone 68a, and speed measuring apparatus 77) to begin recording.

H. OBVIOUSNESS OVER THE ADDED GROUND³⁰

Petitioner alleges that to the extent that Pierce alone, and Pierce as modified by 20/20-W do not disclose a second communication signal as claimed, it would have been an obvious variation for a person of ordinary skill to modify either Pierce or Pierce and 20/20-W to transmit a second communication signal to the second recording device (camera 62a, wireless microphone 68b, or speed measuring apparatus 77). Pet. 47. Specifically, Petitioner contends that the proposed modification would have been obvious to try, or was an obvious design choice that was a “known predictable solution.” Pet., 47–48 (citing Ex.1003 ¶¶ 237–238).

Before addressing this ground of unpatentability, we clarify an important point. We authorized the parties to address the added ground of unpatentability, but we did not authorize further argument regarding the two originally instituted grounds. See Paper 48, 2–3. For that reason, we do not consider Petitioner’s unauthorized arguments regarding the two originally instituted grounds. See Paper 50, 1–4 (asserting that the Petitioner demonstrates that Pierce alone or Pierce in view of 20/20-W teaches all the claim limitations).

³⁰ As mentioned above, we added this contingent ground of unpatentability by amending our Institution Decision. See Paper 47.

1. *Obvious to Try*

We agree with Petitioner that Pierce, like the '292 patent, recognized the problem that police recording systems can be difficult to operate in high stress situations and may be underutilized. See Paper 50, 4; Pet. 26–27; Ex. 1003 142–143; Ex. 1014 ¶¶ 4, 6; Section II.A, *infra*. This argument and evidence suggest the general desirability of modifying a system to be easy to operate in high stress situations so that the recording system could be properly utilized to preserve evidence; however, Petitioner does not persuasively explain why the proposed modification would have been obvious to try.

Patent Owner contends that Dr. Houh, “provides no reasoned analysis or evidentiary support” for what the solutions are or why those solutions are finite or predictable. Paper 49, 4–5. Petitioner responds by asserting that: (1) Dr. Houh’s opinion is supported by evidence (Ex. 1021), and (2) Dr. Houh identified a finite number of predictable solutions. Paper 50, 4–5.

For the reasons that follow, we agree with Patent Owner.

Regarding evidentiary support, Dr. Houh relies on Exhibit 1021 for the proposition that a person of ordinary skill would have understood that cameras may need to be activated and deactivated for recording purposes. See Ex. 1003 ¶ 237 (citing Ex. 1021). Pierce discloses a system that continuously records a variety of data for up to one minute and then when an EVENT occurs, stores that up to one minute of data and subsequently obtained data. Petitioner proposes modifying that system to start recording when an event occurs. The knowledge that cameras need to be activated or deactivated for recording purposes does not persuasively explain how or why one would modify the continuous recording that is important to Pierce’s

operation to intermittent recording. Such a modification would not capture the prevent data Pierce teaches is so valuable. Consequently, we disagree with Petitioner's assertion that Exhibit 1021 provides evidentiary support for Dr. Houh's opinion that the proposed modification would have been obvious to try. *See* 37 C.F.R. § 42.65(a); *see also* Paper 49, 5 (contending that Dr. Houh's opinion is entitled to little or no weight because it does not disclose the underlying facts or data).

Regarding a finite number of predictable solutions, in the testimony cited by Petitioner, Dr. Houh opines that it would be possible to activate the second recording devices (camera 62a, microphone 68a, and speed measuring apparatus 77) in three manners (i.e., by "sending a command, raising a signal on a control line, and providing power to the device"). Ex. 1003 ¶ 238; Paper 50, 4–5. This testimony is unpersuasive for two reasons.

First, Dr. Houh provides a list of possible ways to activate the second recording devices, but does not cogently explain why that list is finite as to the possible ways to activate the second recording device. Additionally, our analysis in Section III.F.2 above further undermines Petitioner's contention by identifying four other possible solutions. Consequently, Petitioner has not persuaded us that the proposed modification was one of a finite number of predictable solutions.

Second, Dr. Houh does not fully address the limitation at issue. The claimed second communication signal must be transmitted in response to the at least one receiver receiving the first communication signal from the first recording device indicating that the first recording device has received the first law enforcement officer's instruction to record. Dr. Houh simply lists

techniques for activating the alleged second recording devices, and does not address what triggers that activation (i.e., the first communication signal).

2. *Design Choice, etc.*

Petitioner contends that a person of ordinary skill in the art possesses ordinary creativity, and the proposed modification would have been a matter of design choice that was a known predictable solution that would not have required undue experimentation. Pet. 47–48 (citing Ex.1003 ¶¶ 237–238; *KSR*, 550 U.S. at 417–420). In support, Dr. Houh opines that the proposed modification would not require undue experimentation and would produce predictable results. Ex.1003 ¶ 237.

Patent Owner argues that just as “common sense” may not be relied upon to supply a missing claim limitation, so to ordinary creativity may not be so relied upon in that manner. Paper 49, 2–7. Petitioner responds to Patent Owner’s obvious to try arguments as discussed above, but Petitioner does not respond regarding the contentions at issue here. Such silence is telling.

Dr. Houh does not provide supporting testimony for the design choice assertion. Further, Petitioner presents the conclusion that the proposed modification would have been obvious but does not provide a supporting explanation. Such a naked assertion is not persuasive. *See generally Polaris Industries, Inc. v. Artic Cat, Inc.*, 882 F.3d 1056, n. 4 (Fed. Cir. 2018).

3. *Pierce’s Teachings*

As discussed above, Pierce’s system continuously records a variety of data for up to one minute and then records over that data. Pierce’s system addresses the concern that law enforcement officers often fail to record valuable data because the officers do not activate the recording apparatus

until after an incident is resolved. Ex. 1014 ¶ 4. Further, it was thought that by recording the activities of officers and suspects, incidents of police brutality and false allegations of police brutality could be reduced or eliminated. *Id.* ¶ 6. In sum, Pierce expressly recognized the value of automatically preserving data from the time prior to an EVENT.

Petitioner contends that it would have been obvious to modify a device that preserves the valuable data from before an EVENT occurs to one that does not. Weighing the loss of a primary objective of Pierce against the purported benefits gained from the modification, we do not agree that a person of ordinary skill in the art would have made such a modification.

IV. CONCLUSION

We conclude that Petitioner has not demonstrated by a preponderance of the evidence that the challenged claims are unpatentable.

V. ORDER

For the reasons given, it is:

ORDERED that claims 1, 3, 8, 18, 20, 21, 24, 26, 27, 29–31, 36, 38, 39, 42, 43, 45, 46, 48, 50, 51, 54, 55, 57, and 58 have not been shown by a preponderance of the evidence to be unpatentable as obvious over Pierce;³¹

FURTHER ORDERED that claims 1, 3, 8, 18, 20, 21, 24, 26, 27, 29–31, 36, 38, 39, 42, 43, 45, 46, 48, 50, 51, 54, 55, 57, and 58 have not been

³¹ This includes the alternative ground of unpatentability added by amending our Institution Decision.

shown by a preponderance of the evidence to be unpatentable as obvious over Pierce and 20/20-W;³²

FURTHER ORDERED that Patent Owner's Motion to Amend is dismissed as moot; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

³² This includes the alternative ground of unpatentability added by amending our Institution Decision.

IPR2017-00375
Patent 8,781,292 B1

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