

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARASHI VISION (U.S.) LLC (D/B/A INSTA360),
Petitioner

v.

GOPRO, INC.,
Patent Owner

Case IPR2024-01434
U.S. Patent No. D789,435

**PATENT OWNER PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107(a)**

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Patent Trial and Appeal Board
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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Wayback Machine search result for https://gigazine.net/gsc_news/en/20141031-gopro-hero-4-black-silver/
2002	“GoPro HERO5 Black – 2017” Red Dot Award: Product Design accessed at http://red-dot.de/pd/online-exhibition/work/?lang=en&code=44-03839-2017&y=2017&c=255&a=0
2003	“GoPro Hero5 Black and Session Review Roundup: What Everyone’s Saying About the Hero4 Successor” Tech Times accessed at https://www.techtimes.com/articles/181522/20161011/gopro-hero5-black-and-session-review-roundup-what-everyones-saying-about-the-hero4-successor.htm

I. INTRODUCTION

Patent Owner, GoPro, Inc. (“GoPro”), is well-known throughout the United States and elsewhere as a source of high-quality cameras for outdoor activities, such as action sports. Founded in 2002 in San Mateo, California, GoPro is a pioneer in developing digital cameras, particularly for mountable and wearable use cases. As a company built on innovation, GoPro has received numerous patents protecting its camera designs. GoPro has become a leader in the industry, receiving scores of industry praise from professionals and consumers alike.

The Board should deny institution of *inter partes* review of the challenged claim of GoPro’s U.S. Patent No. D789,435 (“the ’435 patent”) because Petitioner does not identify with particularity a ground that presents a reasonable likelihood that the challenged claim would have been obvious. Rather, Petitioner presents 24 grounds based on six different primary references, with various combinations of secondary references listed in the alternative and with each ground being given short shrift and addressed only with conclusory arguments. Further, Petitioner’s first ground is based on a collection of references that Petitioner has not shown qualify as printed publications.

On the merits, the Petition fails to meet the reasonable likelihood threshold required for institution. All of Petitioner’s grounds fail to consider the visual

appearance of the claim and cited references as a whole. Petitioner ignores, and fails to address, differences between the cited primary references and the claimed design. Further, Petitioner's combinations of references do not result in the claimed design because Petitioner does not provide any secondary reference disclosing these differences or any record-supported reasons to modify the primary references to address these differences. In all instances, Petitioner's contentions are based on legal error and the asserted grounds are insufficient for institution of *inter partes* review.

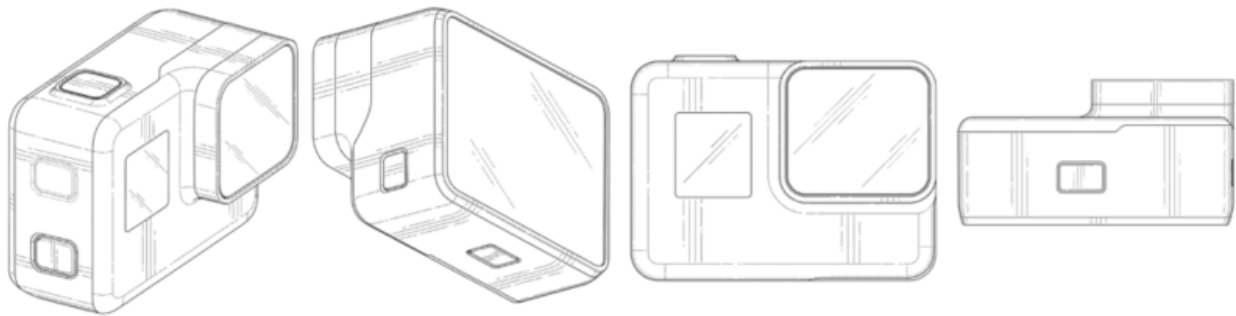
As will be demonstrated herein, *inter partes* review of the challenged claim of the '435 patent should be denied.

II. THE '435 PATENT

The '435 patent, titled "Camera," issued June 13, 2017, from U.S. App. No. 29/582,287 ("the '287 application"), which was filed on October 26, 2016. EX1001, (21), (22), (45). The '287 application is a continuation of and claims priority to two prior-filed U.S. design applications, the earliest of which (U.S. App. No. 29/545,934), was filed on November 17, 2015. Accordingly, the '435 patent is entitled to an effective filing date of November 17, 2015. This date is not challenged by the Petitioner.

The claim is directed to "the ornamental design for a *camera* as shown and described." *Id.*, (57). The drawings depict a camera with certain

unclaimed aspects of the camera illustrated by broken lines. *See id.* The '435 patent includes 10 figures. Representative figures 1, 2, 5, and 10, showing a front perspective view, a rear perspective view, a front elevational view, and a bottom view of the claimed camera design are reproduced below for reference.



EX1001, FIGs. 1, 2, 5, and 10.

The '435 patent covers GoPro's HERO5 camera, which has received industry praise as being an icon in the action camera market, including the prestigious Red Dot award, which specifically recognized that the appearance of the HERO5 had a "new, iconic quality" and "impressive," "elegant design." EX2002, 1. Consumers have also noted the significant innovation in the HERO5 design as being "noticeably different from its predecessor, the [HERO4] Black." EX2003, 1. The commercial success of the HERO5 design has played a significant role in shaping GoPro's prestigious and well-known brand identity.

III. PETITIONER’S ASSERTED GROUNDS ARE NOT PRESENTED “WITH PARTICULARITY” AS REQUIRED BY THE STATUTE.

A petition must identify “with particularity, each claim challenged, the grounds on which the challenges to each claim is based, and the evidence that supports the grounds for challenge to each claim.” 35 U.S.C. § 312(a)(3); *see also Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” (quoting 35 U.S.C. §312(a)(3))).

The Petition here does not comply with the particularity requirement of 35 U.S.C. §312(a)(3). In particular, Petitioner characterizes the Petition as including six asserted grounds, all based on obviousness. Pet., 17. However, Petitioner articulates each of these grounds in the alternative, resulting in 24 distinct grounds against a single claim, as shown in the below chart.¹

¹ It is not entirely clear whether Petitioner relies on “Huang/Heo” and “Li/McVicker” in an “and/or” context or as true alternatives. *See* Pet., 17. Despite indicating alternatives in the section headings, Pet., 41, 53, 69, 86, 98, 112, in the discussion of the grounds, the paired references are often discussed together and relied on for multiple aspects of the claim, *see, e.g.*, Pet., 45-46, 48-49, 51-52 (all

Ground	Asserted Combinations
1	Hero4 ² & Huang
	Hero4 & Heo
2	Gioscia & Huang
	Gioscia & Heo
3	Chen680 & Huang
	Chen680 & Heo
	Chen680, Huang, & Li
	Chen680, Heo, & Li

discussing Huang/Heo together for Ground 1); *id.*, 71-73, 89-90 (discussing Li/McVicker together for Grounds 3 and 4). For grounds 3-5 in particular, Petitioner expressly references the combinations using “and/or” language, *e.g.*, Pet., 86 (“the combination of Chen680 with Huang, Heo, Li, and/or McVicker”), 98 (“the combination of Wang with Huang, Heo, Li, and/or McVicker”), 112 (“the combination of Chen686 with Huang, Heo, Li, and/or McVicker”). The provided chart includes only the true alternative grounds, but if “and” combinations are included, there would be *even more* combinations.

² Compounding this issue, what Petitioner calls “Hero4” is not a single publication but is actually *five* different websites. As discussed further below, Petitioner provides no explanation or reasoning as to why these websites could or would be combined into a single prior art reference.

Ground	Asserted Combinations
	Chen680, Huang, & McVicker
	Chen680, Heo, & McVicker
4	Wang & Huang
	Wang & Heo
	Wang, Huang, & Li
	Wang, Heo, & Li
	Wang, Huang, & McVicker
	Wang, Heo, & McVicker
5	Chen686 & Huang
	Chen686 & Heo
	Chen686, Huang, & Li
	Chen686, Heo, & Li
	Chen686, Huang, & McVicker
	Chen686, Heo, & McVicker
6	Woodman & Huang
	Woodman & Heo

“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). Where, as here, failure to meet the particularity requirement “results in voluminous and excessive grounds,” the Board should exercise its discretion under 35 U.S.C. § 314(a) to deny an entire petition “in the interests of efficient administration of the Office and integrity of the patent system and as a matter of procedural fairness to Patent Owner.” *Adaptics Ltd. v. Perfect Co.*, IPR2018-

01596, Paper 20 at 24 (P.T.A.B. Mar. 6, 2019) (informative). Further, as discussed in more detail below, the Petition’s large number of grounds results in each ground being given short shrift and addressed only with mere conclusory arguments lacking sufficient explanation and support. *See* Section V.

Thus, the Board should exercise its discretion here and deny the Petition. *See IKEA Supply AG v. Everlight Elecs. Co.*, IPR2024-00988, Paper 6 (P.T.A.B. Dec. 12, 2024) (applying *Adaptics*, and exercising discretion to deny institution); *Scanstrut, Inc. v. National Products, Inc.*, IPR2020-01542, Paper 7 (P.T.A.B. March 16, 2021) (same); *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, PGR2020-00080, Paper 7 (P.T.A.B. Feb. 12, 2021) (same).

IV. PETITIONER FAILS TO DEMONSTRATE THE HERO4 PUBLICATIONS ARE PRIOR ART PRINTED PUBLICATIONS

Ground 1 relies on images from five documents identified as the “Hero4 Publications.” *See*, Pet., 17-20, 41-53 (citing EX1004³; EX1006; EX1008;

³ Despite including Exhibit 1004 as part of its asserted ground, none of the relied upon images appear to be from that document. As discussed below, Petitioner cannot rely generally on the HERO4 product as the basis for its asserted ground. Further, Patent Owner has relied upon images that are included in Exhibit 1008 (*see* chart in Section V.A.1), but Petitioner does not identify them as such, pointing only to Exhibit 1006 as the source of those images. Thus, the Board should not rely on

EX1010; EX1011). “[T]he burden is on the petitioner to identify with particularity evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent, and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 16 (P.T.A.B. Dec. 20, 2019) (precedential). Here, Petitioner has not made a sufficient showing that the “Hero4 Publications” are prior art printed publications to warrant institution of review.

The only evidence cited in the Petition for support of the public accessibility of the “Hero4 Publications” is Mr. Bressler’s Declaration. *See, e.g.*, Pet., 17-18 (citing EX1002, ¶¶42-44). But, Mr. Bressler testifies only that he is familiar with the various websites generally, and not the specific documents submitted in this proceeding. EX1002, ¶43. Further, he simply identifies alleged dates of publication provided on the articles themselves. He does not testify that he has any personal

Exhibits 1004 and 1008 in assessing Ground 1. *See* 35 U.S.C. §312(a)(1) (petition must identify “with particularity, . . . the evidence that supports the grounds for the challenge to each claim”); *SAS Inst., Inc. v. Iancu*, 138 S.Ct. 1348, 1355 (2018) (“[I]n an *inter partes* review the petitioner is master of its complaint.”).

knowledge of the actual dates of publication of these particular documents.

EX1002, ¶¶42-44.

Although Mr. Bressler points to Wayback Machine affidavits, these are not cited or discussed in the Petition. This is a transparent attempt to circumvent the word count, and these documents should not be considered. 37 C.F.R. §42.6(a)(3). Even if they are considered, simply submitting Wayback Machine affidavits, without more, is insufficient to prove public accessibility of a document. *See, e.g., First Solar, Inc. v. Rovshan Sade*, IPR2023-00827, Paper 13 at 13-19 (P.T.A.B. Nov. 16, 2023).

“Public accessibility requires more than technical accessibility.” *Id.* at 14-15. To prove public accessibility of a document, a petitioner must present sufficient evidence that an interested party exercising reasonable diligence would have been able to locate the document. *See Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1349 (Fed. Cir. 2016). Examples of evidence could include, for example, a showing of indexing or a research aid including a citation to the document. *Id.* at 1349–50. The burden to show public accessibility of any alleged printed publication is on Petitioner. *Hulu, LLC*, IPR2018-01039, Paper 29 at 16. Petitioner has not met that burden here as to any of Exhibits 1004, 1006, 1008, 1010, or 1011.

Further, Ground 1, as presented in the Petition, relies on specific images from only three of the five documents identified as the “Hero4 Publications.” *See,*

Pet., 41-53 (identifying specific images from Exhibits 1006, 1010, and 1011).

Petitioner has not met its burden to prove public accessibility under *Hulu* as to these documents for the following additional reasons.

A. EX1006

Exhibit 1006 is purportedly a review posted on the Digital Photography website on September 29, 2014, and archived October 1, 2014. EX1002, ¶¶43-44. But Petitioner does not show that the website submitted as Exhibit 1006 was publicly accessible prior to the November 17, 2015, priority date of the '435 patent.

In addition to the complete insufficiency of the evidence described above, Exhibit 1006 includes a copyright date of 2024, and includes links to articles dated in June and July 2024. *See, e.g.*, EX1006, 2-6 (right side, under “Latest Articles” heading), 10 (“Copyright © 1998–2024”). This is simply inconsistent with Petitioner’s contention that it is a website from October 2014.

Further, the website submitted as Exhibit 1006 does not appear on its face to be the same as the website attached to the Wayback Machine affidavit (Exhibit 1007). In addition to the discrepancy in dates, the number of comments is different, e.g., 84 in Exhibit 1007 as compared to 109 hidden comments in Exhibit 1006. *Compare* EX1007, 8-16, *with* EX1006, 7. Additionally, and importantly, the photos upon which Petitioner relies in the asserted grounds appear differently in

Exhibit 1006 than in Exhibit 1007, e.g., they are shown in black and white in Exhibit 1007, as opposed to in color in Exhibit 1006.

Petitioner has not even attempted to explain any of these discrepancies. Further, as the Board has noted previously, “a print out of a webpage from 2024 does not provide sufficient evidence of what was publicly available on the website years earlier prior to the critical date.” *Next Step Group, Inc. v. Deckers Outdoor Corp.*, IPR2024-00525, Paper 16 at 18 (P.T.A.B. Aug. 6, 2024). Petitioner has not met its burden to show that Exhibit 1006 was publicly accessible prior to November 17, 2015. *Hulu, LLC*, IPR2018-01039, Paper 29 at 16.

B. EX1010

Exhibit 1010 is purportedly an article posted on the Gigazine website on October 31, 2014. EX1002, ¶¶43-44. But Petitioner does not show that the alleged website submitted as Exhibit 1010 was publicly accessible prior to the November 17, 2015, priority date of the '435 patent.

In addition to the complete insufficiency of the evidence described above, as an initial matter, Exhibit 1010 itself does not include any indication of the URL from which it was allegedly captured. Further, as for Exhibit 1006, Exhibit 1010 also includes indications that it was captured in 2024. *See, e.g.*, EX1010, 24 (link to article titled: “Review: I took some nice photos of the Osaka cityscape in 2024 with the new film camera ‘PENTAX 17’”), 25 (link to article titled: “Headline

news for July 5, 2024”), 26 (archives calendar for the month “7, 2024”). This is simply inconsistent with Petitioner’s contention that it is a website from October 2014.

Notably, neither Petitioner nor Mr. Bressler cites to any evidence, Wayback Machine or otherwise, corroborating the alleged posting date of this article. An attempt to locate the webpage⁴ on the Wayback Machine returned a message that “This URL has been excluded from the Wayback Machine.” EX2001.

Again, “a print out of a webpage from 2024 does not provide sufficient evidence of what was publicly available on the website years earlier prior to the critical date.” *Next Step*, IPR2024-00525, Paper 16 at 18. Petitioner has not met its burden to show that Exhibit 1010 was publicly accessible prior to November 17, 2015. *Hulu, LLC*, IPR2018-01039, Paper 29 at 16.

C. EX1011

Exhibit 1011 is purportedly a post on the Amazon website from October 3, 2014. EX1002, ¶¶43-44. Petitioner relies on the below images purportedly from this exhibit (Pet., 19, 41-42):

⁴ Presumably, the URL is that listed on Petitioner’s exhibit list.



Pet., 19, 41-42.

But the “Front View”⁵ is not even included in Exhibit 1011, and Petitioner does not sufficiently show that the “Rear, Bottom, and Right Side View” was publicly accessible prior to the November 17, 2015 priority date of the ’435 patent.

In addition to the complete insufficiency of the evidence described above, the website submitted as Exhibit 1011 does not appear on its face to be the same as the website attached to the Wayback Machine affidavit (Exhibit 1012). For example, the primary image is not the same. *Compare* EX1011, 1, *with* EX1012, 1.

⁵ To the extent Petitioner contends this “Front View” is shown in the thumbnail format, the quality of that image is too poor to be of any use.

Additionally, and importantly, the “Rear, Bottom, and Right Side View” image⁶ from Exhibit 1011 upon which Petitioner relies is only ostensibly visible as a thumbnail in Exhibit 1012, making it impossible to confirm whether the image in Exhibit 1011 is the same as that from the Wayback Machine affidavit.

Petitioner has not even attempted to explain any of these discrepancies. Petitioner has not met its burden to show that the relied upon images from Exhibit 1011 were publicly accessible prior to November 17, 2015. *Hulu, LLC*, IPR2018-01039, Paper 29 at 16.

* * *

Because Petitioner has not shown the “Hero4 Publications” are prior art printed publications, Ground 1 must fail.

V. PETITIONER FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD THAT THE CHALLENGED CLAIM WOULD HAVE BEEN OBVIOUS.

In an IPR, “the burden of proving a proposition of unpatentability” is borne by (and remains at all times with) the petitioner. 35 U.S.C. §§ 314(a), 316(e); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir.

⁶ Additionally, the image included in the Petition is not even the same as the image seen in Exhibit 1011. In the exhibit, icons from the website are obscuring a portion of the image.

2016). To satisfy its burden, a petitioner must “articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness”—“mere conclusory statements” will not suffice. *Magnum Oil*, 829 F.3d at 1380. Indeed, “[i]t is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Sys.*, 821 F.3d at 1369 (quoting 35 U.S.C. § 312(a)(3)). Given the “expedited nature of IPR proceedings, it is of the utmost importance that petitioners . . . adhere to the requirement that the initial petition identify with particularity the evidence that supports the grounds for the challenge to each claim.” *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330 (Fed. Cir. 2019) (cleaned up). “[I]f the fact trier of the issue is left uncertain, the party with the burden loses.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378-79 (Fed. Cir. 2015).

The touchstone of obviousness is, and always has been, whether “the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention.” 35 U.S.C. § 103. As the Board recently recognized in *Next Step Group, Inc. v. Deckers Outdoor Corp.* (IPR2024-00525), this did not change after the Federal Circuit’s *en banc* decision in

LKQ, which made clear that the proper analysis for obviousness of a design patent claim is the same as that for a utility patent claim – the *Graham* factors. See *LKQ Corp. v. GM Glob. Tech. Operations LLC*, 102 F.4th 1280, 1295 (Fed. Cir. 2024) (citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1996)); *Next Step*, IPR2024-00525, Paper 16 at 32-34.

Consideration of the claimed design as a whole is necessary for conducting a proper analysis under *Graham* for several reasons. First, consideration of the design as a whole is necessary when identifying a primary reference that is “something in existence—not . . . something that might be brought into existence by selecting individual features from prior art and combining them.” *LKQ*, 102 F.4th at 1298. This primary “something in existence” will “likely be the closest prior art, i.e., the prior art design that is *most visually similar* to the claimed design.” *Id.* (emphasis added). Indeed, the analysis should focus on the overall appearance of the claimed article and prior art as a whole because “[a] design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract.” *In re Surgisil, LLP*, 14 F.4th 1380, 1382 (Fed. Cir. 2021).

Second, it is necessary when determining the scope and content of the prior art. “[I]n addressing the differences between the claimed design and prior art designs for validity purposes, we compare the visual appearance of

the claimed design with prior art designs.” *LKQ*, 102 F.4th at 1298. This requires comparing the visual appearance of the claimed design with prior art designs from the perspective of an ordinary designer in the field of the article of manufacture. *See id.*

Third, consideration of the design as a whole is necessary when evaluating whether a designer of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design. *Id.* (citing *Apple, Inc. v. Samsung Elecs., Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012)). The Federal Circuit in *LKQ* reaffirmed the “inquiry focuses on the *visual impression of the claimed design as a whole and not on selected individual features.*” *Id.* at 1299 (emphasis added).

Primary and secondary references cited to establish obviousness must be analogous art to the patented design. *Id.* Further, “there must be some record-supported reason (without hindsight) that an ordinary designer in the field of the article of manufacture would have modified the primary reference with the feature(s) from the secondary reference(s) to create the same overall appearance as the claimed design.” *Id.*, *see also Campbell Soup, Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021) (discussing the question of whether “an ordinary designer would have

modified the primary reference to create a design that has the same overall visual appearance as the claimed design”).

Here, Petitioner does not advance any obviousness ground based on a proper determination of the overall visual appearances of the claimed design or of the cited references. Instead, Petitioner argues the claimed design would have been obvious based on a selective feature-by-feature comparison of design concepts allegedly present in the claimed design and in six very different looking potential primary references. It is legal error to compare “the visual impressions of selected, separate features of the prior art designs to the [claimed] designs, rather than the visual impression of the designs as a whole.” *See In re Harvey*, 12 F.3d 1061, 1065 (Fed. Cir. 1993).

As demonstrated below, Petitioner’s failure to consider the overall visual appearances of both the claim and the cited art is fatal to all of Petitioner’s grounds. As a result, Petitioner has not identified any prior art reference that is visually similar in overall appearance to the claimed design, as required in the first *Graham* factor, and has ignored differences between the claimed design and the cited primary references, a requirement of the second *Graham* factor. In addition, Petitioner has not addressed these differences with one or more secondary references or provided record-

supported reasons that would lead to a conclusion that the claimed design would have been obvious.

A. Hero4 references (Ground 1)

Petitioner's Ground 1 relies on images of a GoPro camera and case,⁷ which purportedly appeared on five different websites by at least November 15, 2014 (the effective filing date of the '435 patent). Pet., 19, 41-53 (citing EX1004; EX1006; EX1008; EX1010; EX1011). Petitioner has not met its burden to prove that the "Hero4 Publications" are prior art to the claimed design as demonstrated above; even if they were, Petitioner has not demonstrated a reasonable likelihood of prevailing to show that any of the combinations presented in Ground 1 renders the claimed design obvious for the following reasons.

⁷ Patent Owner refers to this camera-case combo as the Hero4 references throughout, for ease of discussion and consistency with Petitioner's terminology. However, Patent Owner emphasizes that the images on which Petitioner relies are not of a camera or a camera case, but of a combination thereof, i.e., a camera inside of a camera case.

1. The Hero4 references, as applied by Petitioner from multiple different websites, do not disclose “something in existence.”

Petitioner’s obviousness analysis is facially deficient because Petitioner improperly relies on multiple references in an attempt to identify “something in existence” visually similar to the claimed design. As noted, Petitioner’s Ground 1 relies on specific images from multiple documents as “different views of Hero4’s design.” Pet., 19. The chart below includes the seven images included in the Petition, as well as identifying both their source and the specific product they depict.

Relied upon image (<i>see</i> Pet., 19)	Identified source	Product
	EX1006, 3; Pet., 44-45, 48	HERO4 Black (EX1006, 3)

Relied upon image (<i>see</i> Pet., 19)	Identified source	Product
 Hero4 Rear, Bottom, and Right Side View	EX1011, 1 ⁸	HERO4 Silver (EX1011, 1)
 D'435 Front, Top, and Right Side View	EX1006, 4 ⁹ (also at EX1008, 4 ¹⁰)	HERO4 Silver (EX1006, 4)

⁸ Petitioner does not rely on this figure in its discussion of the asserted ground.
See Pet., 41-53.

⁹ Petitioner does not rely on this figure in its discussion of the asserted ground.
See Pet., 41-53.

¹⁰ As noted above, Petitioner does not specifically identify Exhibit 1008 as the source of any particular images. *See* Pet., 41-53.

Relied upon image (<i>see</i> Pet., 19)	Identified source	Product
Hero4 Front View 	EX1011¹¹; Pet., 41-42	HERO4 Silver (EX1012, 5)
Hero4 Rear View 	EX1006, 4; Pet., 42-43 (also at EX1008, 4)	HERO4 Silver (EX1006, 4)

¹¹ As noted above, despite Petitioner's contention, this figure is not included in Exhibit 1011 in any useful form.

Relied upon image (<i>see</i> Pet., 19)	Identified source	Product
 Hero4 Right Side View	EX1006, 4; Pet., 47 (also at EX1008, 4)	HERO4 Silver (EX1006, 4)
 Hero4 (Without Case) Bottom View	EX1010, 11; Pet., 50-51	HERO4 Black (EX1010, 8)

As shown in the chart above, Petitioner appears to rely on images depicting *different* HERO4 products—the HERO4 Black and the HERO4 Silver. Petitioner ignores this issue entirely. Despite similarities between them, the evidence shows these products are not identical. *See, e.g.*, EX1004, 16 (“The Silver edition include three doors (instead of two [in the Black edition])”), 19 (showing all 3 doors of the camera case, which look different from each other); EX1010, 10 (the Black edition has no screen at all on the back). By relying on images depicting multiple, different HERO4 products, Petitioner’s first ground is not based on “something in existence.” Rather, Petitioner’s first ground is based on a combination of different

designs. This is fatal to the first factor in the *Graham* analysis. *See LKQ*, 102 F.4th at 1298.

Even if it were proper to rely on teachings from the different HERO4 designs, Petitioner has not explained why teachings from multiple websites can be combined to show a single “something in existence.” *See MacSports, Inc. v. Idea Nuevo, Inc.*, IPR2018-01006, Paper 6 at 19-21 (P.T.A.B. Nov. 13, 2018) (rejecting petitioner’s attempt to combine multiple website images for the same product in attempting to show “something in existence” for its obviousness analysis). In *MacSports*, the images were allegedly from the same website and of the same product (a chair). IPR2018-01006, Paper 6 at 20. Here, there is even less reason the “Hero4 Publications” should be considered together because Petitioner’s images are from different websites and are of different products. The panel in *MacSports* emphasized that “[t]he alleged prior art is not the chair itself, but instead the references depicting the chair.” IPR2018-01006, Paper 6 at 21. Petitioner bears the burden to prove the challenged claims are unpatentable, and silence on establishing that multiple websites showing different products can be relied on as “something in existence,” as required by *LKQ* is fatal to Ground 1.

To the extent Petitioner attempts to salvage this error by relying on the HERO4 product itself, rather than the combination of teachings from the “Hero4 Publications,” this is improper. In an IPR, grounds of unpatentability may be raised

“only on the basis of prior art consisting of patents or printed publications.”

35 U.S.C. § 311(b). Challenges based on other types of prior art, such as commercial sales and public uses, are impermissible in an IPR. *Id.*; *see, e.g., Spectrum Labs., LLC v. Woodstock Enters., Inc.*, IPR2017-00026, Paper 10 at 14-15 (P.T.A.B. Apr. 21, 2017) (“The fact that a [product] may have been on sale or in public use prior to any priority date is insufficient for an *inter partes* review challenge; what is taught by the asserted prior art references is the appropriate inquiry.”).

2. Petitioner fails to consider the visual appearance of the design shown in the Hero4 references as a whole and has instead focused exclusively on general design concepts.

As shown below, the design in the Hero4 references comprises a camera located within a transparent case. Petitioner argues the Hero4 references show a “‘box-like’ design” with the following features listed on page 20 of the Petition.

- “a rectangular body with flat faces”
- “a rectangular lens cover extending outward from the front of the body and showing a line”
- “a rectangle for a display at the front that is flush with its front face, and a rectangle for a display that occupies a large part of the back”

- “buttons/access elements at the top, left side, right side, and bottom”

What Petitioner is describing are features of the case, not the internal camera. Also, in reality, the design shown in the references is much more than what Petitioner describes.

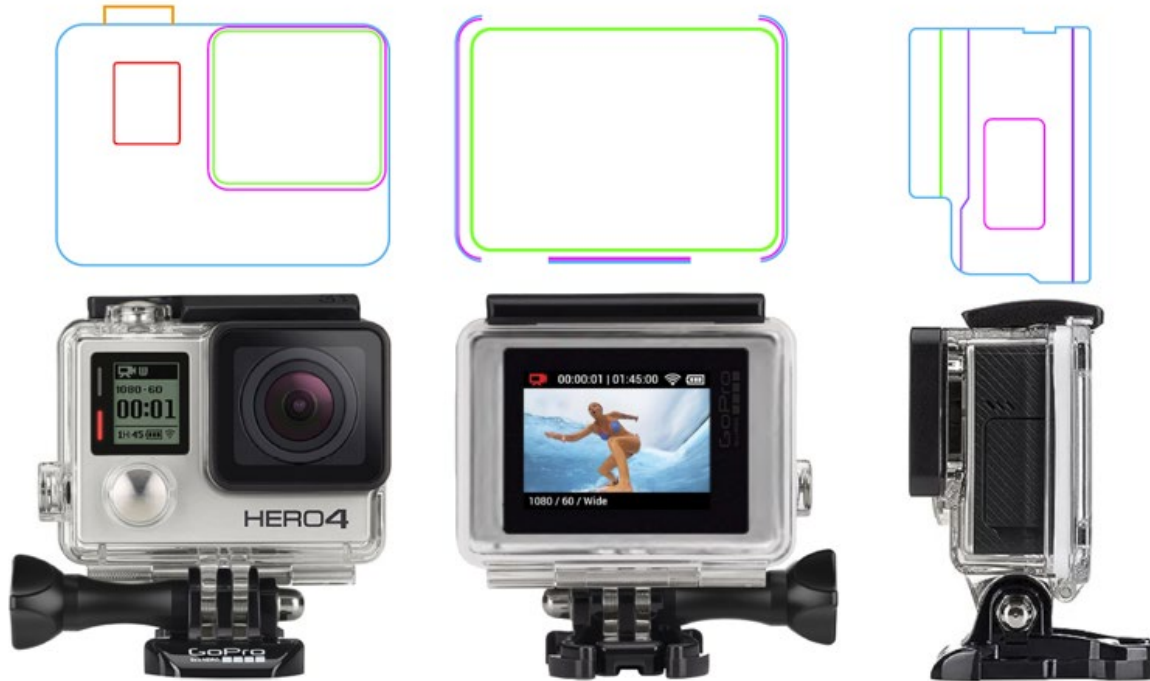
To try to draw attention away from the appearance of the actual Hero4 references, Petitioner provides colored annotated images from the references, some of which are reproduced below.



Pet., 42, 43, 47.

But these images, and the corresponding discussion of them, are inconsistent with and misrepresent the overall visual appearance of the Hero4 references. Shown below are the same images with the annotations separated from the images. As is clear, the appearance of the Hero4

references is significantly different from Petitioner's simplified shapes,
which factor out or ignore many significant features of the design.



Pet., 42, 43, 47 (separated).

The proper comparison for analysis under the *Graham* factors should be of the images from the references to the claimed design, and not of the dissociated lines and shapes created by Petitioner. A proper obviousness challenge cannot be based on “the visual impressions of selected, separate features of the prior art designs to the [claimed] designs,” it must be based on “the visual impression of the designs as a whole.” *Harvey*, 12 F.3d at 1065.

When comparing the actual images of the Hero4 references to the color-annotated, superimposed shapes, it is clear the Hero4 references look nothing like Petitioner's color-annotated shapes or the claimed design. For example, at least the transparent removable case, closure, mount, and fixture are not present in Petitioner's color-annotated shapes or the claimed design, all of which contribute to the overall ornamental appearance of the design in the Hero4 references.



Pet., 19 (annotated); EX1001, FIGs. 1, 3.

Petitioner's attempt to ignore these features of the Hero4 references is improper. A design's overall visual impression is impacted by all its

features. Ignoring features when evaluating the design improperly changes that overall visual impression. When evaluating obviousness, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention. *See W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550-51 (Fed. Cir. 1983) (the totality of a reference's teachings must be considered), *cert. denied*, 469 U.S. 851 (1984).

By focusing solely on the color-annotated shapes, Petitioner makes a false comparison between the Hero4 references and the claimed design under the first *Graham* factor. Petitioner does not compare the claimed design to “something in existence,” but rather to a collection of separate design concepts allegedly present in the cited references. This is improper. *See Masimo Corp. v. Apple Inc.*, IPR2023-00831, Paper 9 at 33 (P.T.A.B. Nov. 21, 2023) (“Both designs have a circular and cylindrical shape, however, as discussed in our claim construction, to focus solely on this general description would be improper where the [patented design] and [the cited reference] include additional visually apparent elements which make up the overall appearances of the designs”).

Petitioner's flawed analysis is exacerbated on pages 50-51 of the Petition, where Petitioner inexplicably compares the bottom view of the

internal camera alone—not in the case—to the bottom view of the claimed design. Though not provided by Petitioner, it is clear that the bottom of the design in the Hero4 references, which would be dominated by the mount, looks nothing like the bottom of the claimed camera.



Pet., 19.

Petitioner fails to consider the visual appearance of the Hero4 references as a whole and instead focuses exclusively on general design concepts. For at least this reason, Petitioner fails to properly apply the first factor in the *Graham* analysis. Without properly applying the first factor, Petitioner cannot establish that the Hero4 references, alone or in combination with one or more secondary references, teaches or suggests a camera having the same overall visual appearance as the claimed design.

3. Petitioner ignores differences between the Hero4 references and the claimed design.

By focusing on discrete design elements of the Hero4 references, Petitioner fails to account for differences between the Hero4 references and

the claimed design, and therefore fails to evaluate the designs in terms of their overall visual appearances. This failure is fatal to the Petition. “The ultimate question is whether differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious to a person of ordinary skill in the pertinent art at the time of the invention.” *LKQ*, 102 F.4th at 1291.

A simple visual comparison of the references and the claimed design makes clear there are numerous differences between the two. But, Petitioner does not even mention many of the differences, including the closure, fixture, and mount.



Pet., 19 (annotated); EX1001, FIGs. 1, 3.

Rather than address the effect that these differences have on the overall visual appearance of the designs, Petitioner and Petitioner's declarant, Mr. Bressler, summarily conclude that the two have an overall appearance that is similar. This is fatal to Petitioner's Ground 1 for at least the following reasons.

First, conclusory statements that differences are insubstantial cannot support a valid obviousness challenge. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15-16 (P.T.A.B. Aug. 24, 2022) (precedential) (rejecting expert testimony when “the cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.”). When assessing the presence of the closure on the rear view of the Hero4 references, Mr. Bressler agrees the design is different from what is claimed because it has “extra pieces at the top and the bottom,” but summarily dismisses “the presence of these extra pieces as insubstantial/slight/insignificant because the rectangles still occupy a large part of the back of the design, and the body still has a rectangular shape and a rectangular lens cover.” EX1002, ¶71. This statement about the insubstantial/slight/insignificant effect of prominent design features is not supported by any evidence or meaningful analysis of the designs.

Second, by failing to take into account differences, Petitioner fails to evaluate the Hero4 references and the claimed design in terms of their overall visual appearances. To support a valid obviousness ground, a petitioner must adequately address all differences. “After ascertaining the knowledge of an ordinary designer in the relevant field, the scope and content of the prior art, *and the differences between the prior art and the claimed design*, the obviousness or nonobviousness of the claimed design is evaluated.” *LKQ*, 102 F.4th at 1299 (emphasis added). This inquiry focuses on “whether an ordinary designer in the field to which the claimed design pertains would have been motivated to modify the prior art design ‘to create the same overall visual appearance as the claimed design.’” *Id.*

It is legal error to focus solely on similarities, as Petitioner does here. *See W.L. Gore & Assoc.*, 721 F.2d at 1550-51 (the totality of a reference’s teachings must be considered). Without adequately considering and addressing at least the above-noted differences, it is not possible for Petitioner to establish that the Hero4 references in combination with secondary references results in *the same* camera design as claimed. The obviousness inquiry must focus on “whether an ordinary designer in the field to which the claimed design pertains would have been motivated to modify

the prior art design ‘to create the same overall visual appearance as the claimed design.’” *LKQ*, 102 F.4th at 1299.

4. Petitioner’s combination of the Hero4 references with secondary references does not result in the claimed design.

Petitioner admits the Hero4 references alone do not render the claimed design obvious. Pet. 41-53. To fill the gaps, Petitioner relies on Huang or Heo.¹² In particular, Petitioner relies on Huang or Heo to make buttons rectangular (Pet., 45-47), and to change the size of buttons (Pet., 47-49).

Yet, as discussed above in Section V.A.3 and illustrated below, these are not the only differences between the claimed design and the references.

¹² When modifying the Hero4 references, Petitioner repeatedly refers to “Huang/Heo” as disclosing various features. It is unclear whether Petitioner relies on Huang alone, Heo alone, or a combination of Huang and Heo to modify the Hero4 references. But in either case, Patent Owner does not concede that Huang or Heo disclose features similar to those claimed.



Pet., 19 (annotated); EX1001, FIGs. 1, 3.

As a result of Petitioner ignoring at least the above-noted differences between the claimed design and the Hero4 references, even if there were motivation to combine the Hero4 references with Petitioner's cited secondary references, the claimed design would not result. That is because at least these same differences would still be present in the hypothetical combination design.

The *Graham* factors require that *all* differences between the designs be evaluated when assessing whether the prior art renders a claimed design obvious. *See LKQ*, 102 F.4th at 1299.

Moreover, beyond impermissible hindsight based on knowledge of the claimed design, Petitioner does not provide any record-supported reasons for modifying the design in the Hero4 references to remove or change the closure, fixture, and mount in view of Huang/Heo to arrive at the claimed design. Without any record-supported reasons to make these changes, it is not possible for Petitioner to establish that the Hero4 references in combination with Huang/Heo results in *the same* camera design as claimed.

Moreover, Mr. Bressler's conclusory arguments for motivation to modify the Hero4 references to include additional rectangles because doing so would "compliment an overall visual impression of a rectangular visual language" (EX1002, ¶75) fail to meaningfully consider how these changes would be incorporated into the Hero4 references. Mere compatibility of the references is not sufficient. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993 (Fed. Cir. 2017) (it is not enough to show that "a skilled artisan, once presented with the two references, would have understood that they could be combined").

Petitioner's modifications are nothing more than unsupported modifications based on impermissible hindsight gleaned from the '435 patent, which must be avoided. *LKQ*, 102 F.4th at 1300. An analysis focused on assembling design concepts from the prior art in isolation to

arrive at the claimed design is improper. *See Premier Gem Corp. v. Wing Yee Gems & Jewellery Ltd.*, IPR2016-00434, Paper 9 at 16–17 (P.T.A.B. July 5, 2016). In *Premier Gem*, the Board explained that selectively choosing certain design features for various references while deliberately ignoring others just so the claimed design would result is improper hindsight. *Id.*

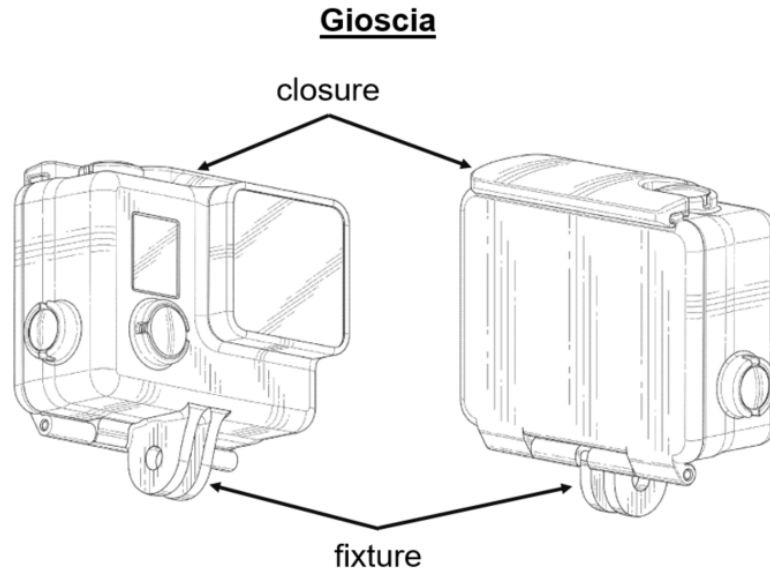
* * *

For at least the above reasons, Petitioner has not demonstrated a reasonable likelihood of prevailing to show that any of the combinations presented in Ground 1 renders the claim obvious, and Petitioner’s Ground 1 should fail.

B. Gioscia (Ground 2)

Petitioner’s Ground 2 relies on US D710,921¹³ (“Gioscia”), which discloses a design for a camera housing. EX1013, 1. The camera housing of Gioscia, as shown in the following annotated image, comprises various features, including a top closure and a bottom fixture.

¹³ US D725,169, which is a continuation of US D710,921, is cited on the ’435 patent. EX1001, (56).



Pet., 21 (annotated).

Petitioner has not demonstrated a reasonable likelihood of prevailing to show that any of the combinations presented in Ground 2 renders the claimed design obvious for the following reasons.

- 1. Petitioner fails to consider the visual appearance of Gioscia’s camera housing as a whole and has instead focused exclusively on general design concepts.**

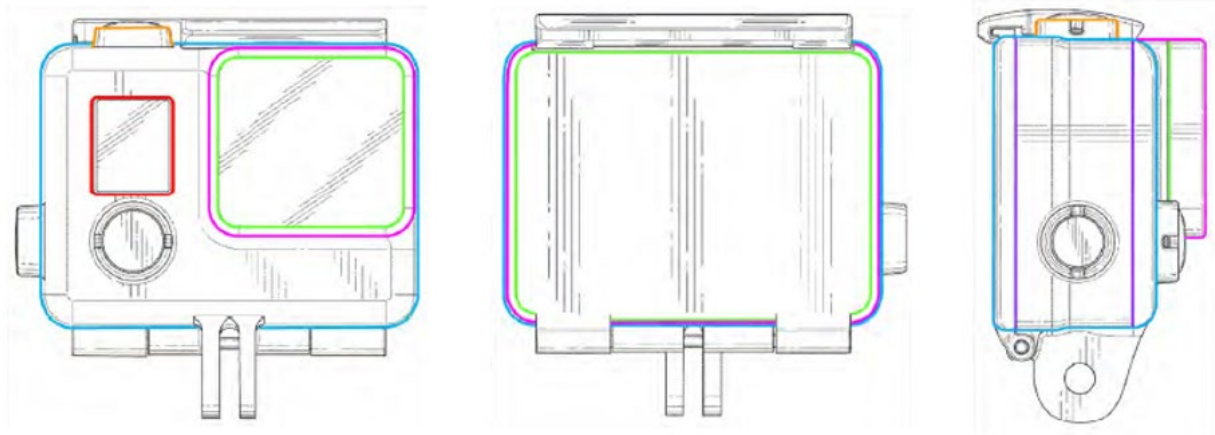
Petitioner argues that Gioscia shows a “‘box-like’ design” with the following features listed on page 22 of the Petition.

- “a rectangular body with flat faces”
- “a rectangular lens cover extending outward from the front of the body and showing a line”

- “a rectangle for a display at the front that is flush^[14] with its front face”
- “buttons/access elements at the top, left side, and right side”

Petitioner is describing features of the camera housing of Gioscia, but in reality, the camera housing of Gioscia is much more than what Petitioner describes.

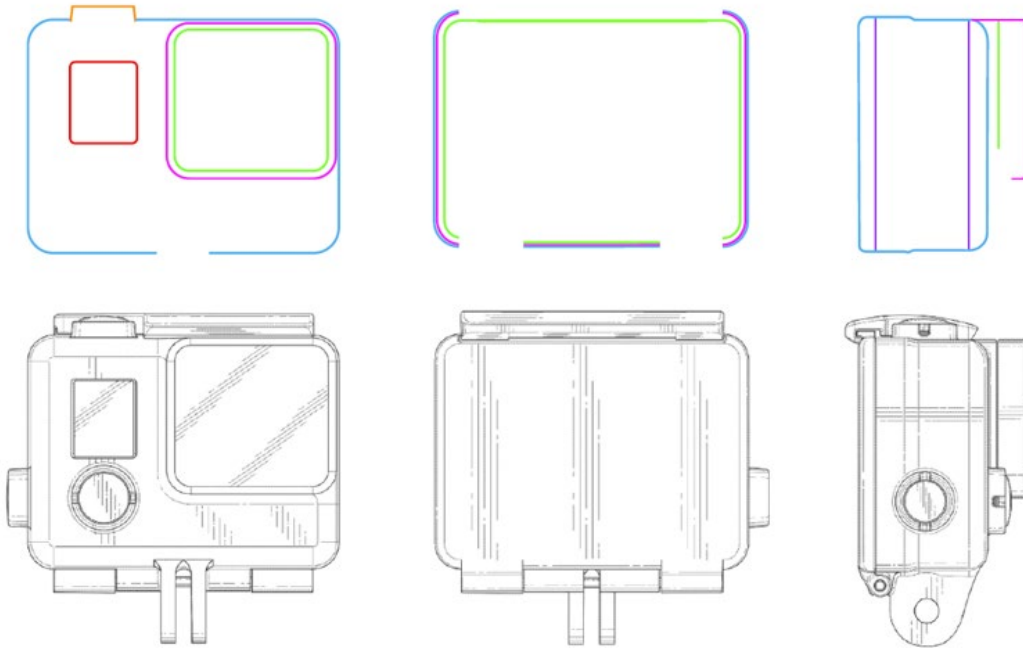
To try to draw attention away from the appearance of the actual Gioscia camera housing design, Petitioner provides colored annotated images, some of which are reproduced below.



Pet., 54, 55, 57.

¹⁴ Petitioner incorrectly states the rectangle is flush with the body. As shown in at least figure 1 of Gioscia, the rectangle appears recessed from the front surface. EX1013, 2.

But these images, and the corresponding discussion of them, are inconsistent with and misrepresent the overall visual appearance of Gioscia's camera housing design. Shown below are the same images with the annotations separated from the images. As is clear, the appearance of Gioscia's camera housing is significantly different from Petitioner's simplified shapes, which factor out or ignore many significant features of the housing.

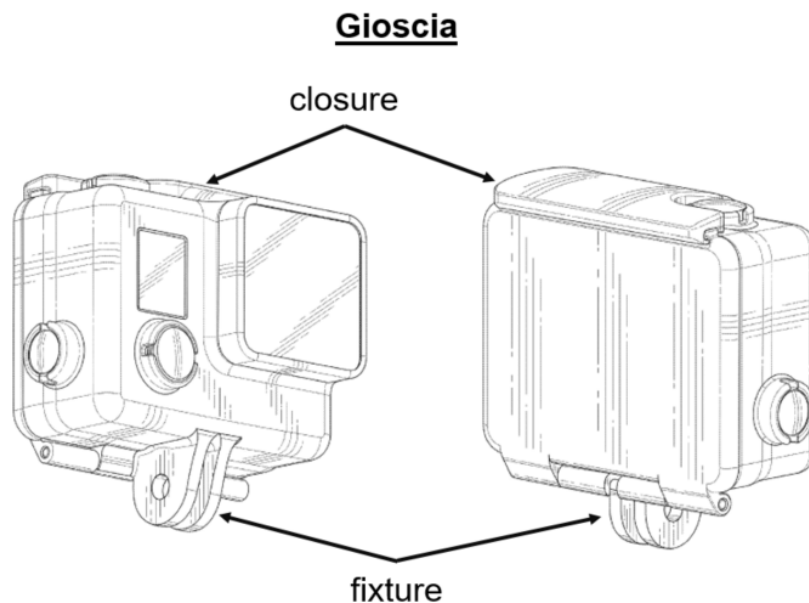


Pet., 54, 55, 57 (separated).

The proper comparison for analysis under the *Graham* factors should be of the drawings from Gioscia to the claimed design, and not of the dissociated lines and shapes created by Petitioner. A proper obviousness challenge cannot be based on “the visual impressions of selected, separate

features of the prior art designs to the [claimed] designs” it must be based on “the visual impression of the designs as a whole.” *Harvey*, 12 F.3d at 1065.

When comparing the actual drawings from Gioscia to the color-annotated, superimposed shapes, it is clear Gioscia’s camera housing looks nothing like Petitioner’s color-annotated shapes or like the claimed design. For example, at least the closure and fixture are not present in Petitioner’s color-annotated shapes or the claimed design, both of which contribute to the overall ornamental appearance of Gioscia’s housing.



Pet., 21 (annotated)

Petitioner’s attempt to ignore these features of the camera housing in Gioscia is improper. A design’s overall visual impression is impacted by all its features. Ignoring features when evaluating the design improperly changes that overall visual impression. When evaluating obviousness, a prior

art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention. *See W.L. Gore & Assoc., Inc.*, 721 F.2d at 1550-51.

By focusing solely on the color-annotated shapes, Petitioner makes a false comparison between Gioscia and the claimed design under the first *Graham* factor. Petitioner is not comparing the claimed design to “something in existence,” but rather to a collection of separate design concepts allegedly present in the cited reference. This is improper. *See Masimo*, IPR2023-00831, Paper 9 at 33.

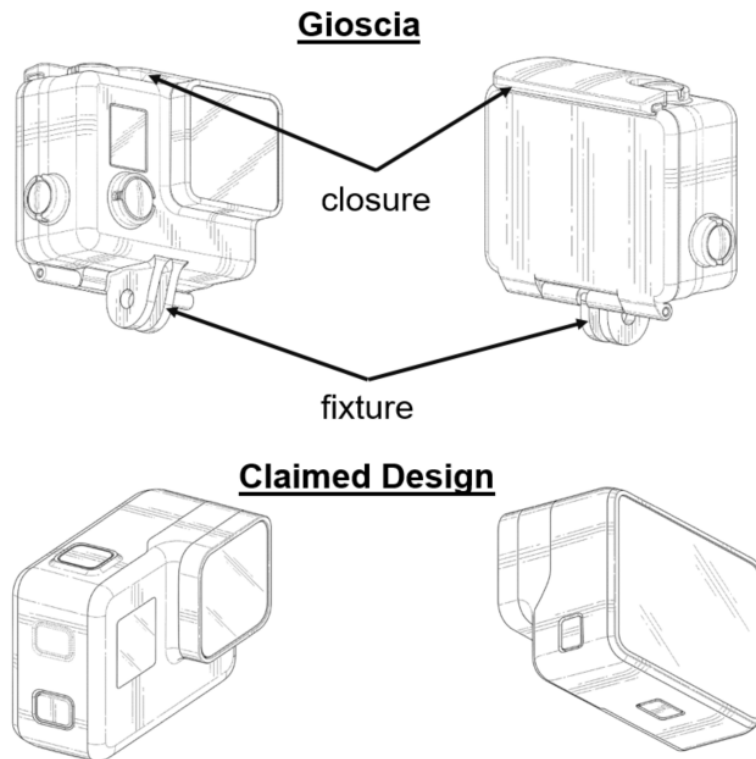
Petitioner fails to consider the visual appearance of the Gioscia camera housing as a whole and instead focuses exclusively on general design concepts. For at least this reason, Petitioner fails to properly apply the first factor in the *Graham* analysis. Without properly applying the first factor, Petitioner cannot establish that Gioscia, alone or in combination with one or more secondary references, teaches or suggests a camera having the same overall visual appearance as the claimed design.

2. Petitioner ignores differences between Gioscia and the claimed design.

By focusing on discrete design elements of Gioscia’s camera housing, Petitioner fails to account for differences between Gioscia’s camera housing and the claimed design. Petitioner therefore fails to evaluate Gioscia’s

camera housing and the claimed design in terms of overall visual appearance. This failure is fatal to the Petition.

A simple visual comparison of Gioscia's camera housing and the claimed design makes clear there are numerous differences between the two. But Petitioner does not even mention many of them, including the closure and the fixture.



Pet., 21 (annotated); EX1001, FIGs. 1, 2.

Rather than address the effect that these differences have on the overall visual appearance of Gioscia's camera housing and the claimed design, Petitioner and Mr. Bressler summarily conclude that the two have an

overall appearance that is similar. This is fatal to Petitioner's Ground 2 for at least the following reasons.

First, conclusory statements that differences are insubstantial cannot support a valid obviousness challenge. *See Xerox Corp.*, IPR2022-00624, Paper 9 at 15-16. When assessing the presence of the closure on the rear view of Gioscia, Mr. Bressler agrees the camera housing is different from what is claimed “due to its design having extra pieces at the top and the bottom,” but summarily dismisses “the presence of these extra pieces as insubstantial/slight/insignificant because the rectangles still occupy a large part of the back of the design, and the body still has a rectangular shape.” EX1002, ¶89. This statement about the insubstantial/slight/insignificant effect of prominent design features is not supported by any evidence or meaningful analysis of the designs.

Second, by failing to take into account the differences, Petitioner fails to evaluate Gioscia's camera housing and the claimed design in terms of their overall visual appearances. To support a valid obviousness ground, a petitioner must adequately address all differences. *See LKQ*, 102 F.4th at 1299. It is legal error to focus solely on similarities, as Petitioner does here. *See W.L. Gore & Assoc.*, 721 F.2d at 1550-51 (the totality of a reference's teachings must be considered).

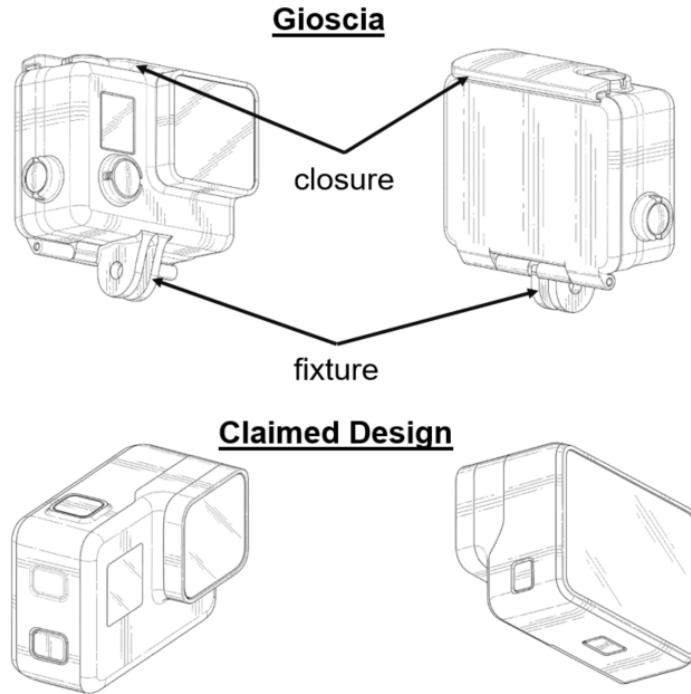
Without adequately considering and addressing at least the above-noted differences, it is not possible for Petitioner to establish that Gioscia's camera housing in combination with secondary references results in *the same* camera design as claimed.

3. Petitioner's combination of the camera housing of Gioscia with secondary references does not result in the claimed design.

Petitioner admits Gioscia's camera housing alone does not render the claimed design obvious. Pet. 53-69. To fill the gaps, Petitioner relies on Huang/Heo.¹⁵ In particular, Petitioner relies on Huang/Heo to make buttons rectangular (Pet., 58-60, 63-65), and to add rectangular features to the right side and bottom of Gioscia's camera housing (Pet., 61, 66-68).

Yet, as discussed above in Section V.B.2 and illustrated below, these are not the only differences between the claimed design and Gioscia's camera housing.

¹⁵ When modifying Gioscia's camera housing, Petitioner repeatedly refers to "Huang/Heo" as disclosing various features. It is unclear whether Petitioner relies on Huang alone, Heo alone, or a combination of Huang and Heo to modify Gioscia's camera housing. But in either case, Patent Owner does not concede that Huang or Heo disclose features similar to those claimed.



Pet., 21 (annotated); EX1001, FIGs. 1, 2.

As a result of Petitioner ignoring at least the above-noted differences between the claimed design and Gioscia, even if there were motivation to combine Gioscia with Petitioner's cited secondary references, the claimed design would not result. That is because at least these same differences would still be present in the hypothetical combination design.

The *Graham* factors require that *all* differences between the designs be evaluated when assessing whether the prior art renders a claimed design obvious. *See LKQ*, 102 F.4th at 1299.

Moreover, beyond impermissible hindsight based on knowledge of the claimed design, Petitioner does not provide any record-supported reasons for

modifying Gioscia’s camera housing to remove or change the closure or fixture in view of Huang/Heo to arrive at the claimed design. Without any record-supported reasons to make these changes, it is not possible for Petitioner to establish that the camera housing in combination with Huang/Heo results in *the same* camera design as claimed.

Moreover, Mr. Bressler’s conclusory arguments for motivation to modify Gioscia to include additional rectangles because doing so would “compliment an overall visual impression of a rectangular ‘box-like’ design” (EX1002, ¶106) fail to meaningfully consider how these changes would be incorporated into Gioscia. Mere compatibility of the references is not sufficient. *Personal Web Techs.*, 848 F.3d at 993 (it is not enough to show that “a skilled artisan, once presented with the two references, would have understood that they could be combined”).

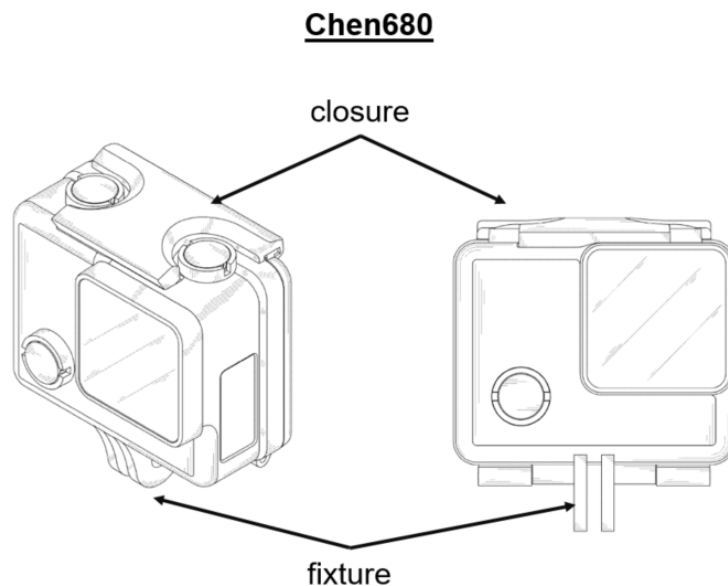
Petitioner’s modifications are nothing more than unsupported modifications based on impermissible hindsight gleaned from the ’435 patent must be avoided. *LKQ*, 102 F.4th at 1300. An analysis focused on assembling design concepts from the prior art in isolation to arrive at the claimed design is improper hindsight. *See Premier Gem*, IPR2016-00434, Paper 9 at 16–17.

* * *

For at least these reasons, Petitioner has not demonstrated a reasonable likelihood of prevailing to show that any of the combinations presented in Ground 2 renders the claim obvious, and Petitioner's Ground 2 should fail.

C. Chen680 (Ground 3)

Petitioner's Ground 3 relies on US D750,680¹⁶ ("Chen680"), which discloses a design for a camera housing. EX1014, 1. Chen680's camera housing, as shown in the following annotated image, comprises various features, including a top closure and a bottom fixture.



Pet., 24 (annotated).

¹⁶ US D750,680 is listed on the face of the '435 patent, and therefore was considered by the Examiner during prosecution. EX1001, (56).

Petitioner has not demonstrated a reasonable likelihood of prevailing to show that any of the combinations presented in Ground 3 renders the claimed design obvious, for the following reasons.

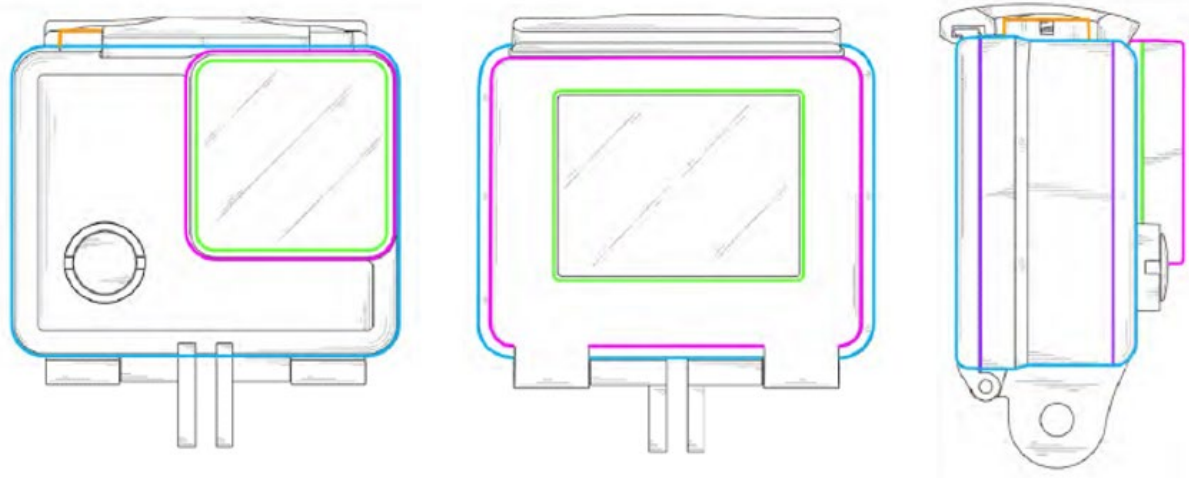
1. Petitioner fails to consider the visual appearance of Chen680's camera housing as a whole and has instead focused exclusively on general design concepts.

Petitioner argues that Chen680 shows a “‘box-like’ design” with the following features listed on page 25 of the Petition.

- “a rectangular body with flat faces”
- “a rectangular lens cover extending outward from the front of the body and showing a line”
- “a rectangle for a display that occupies a large part of the back”
- “buttons/access elements at the top and right side”

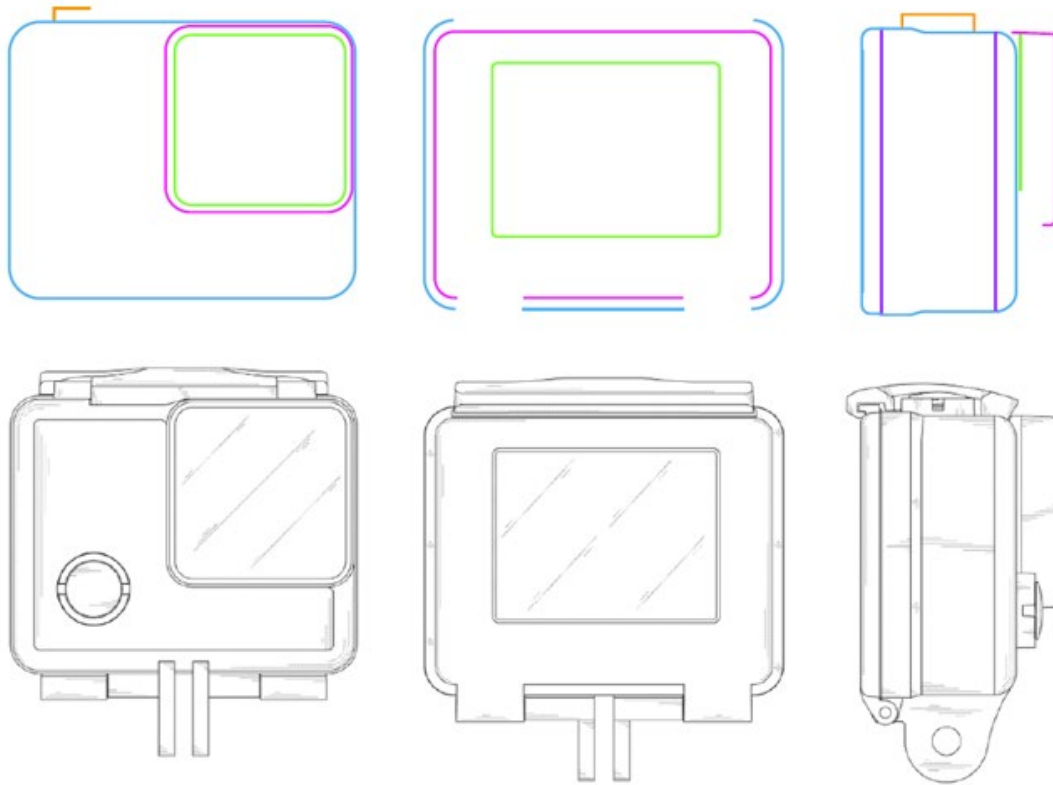
Petitioner is describing features of Chen680, but in reality, Chen680 is much more than what Petitioner describes.

As in Ground 2, to try to draw attention away from the appearance of the actual housing design, Petitioner provides colored annotated images from Chen680, some of which are reproduced below.



Pet., 70, 74, 76.

But these images, and the corresponding discussion of them, are inconsistent with and misrepresent the overall visual appearance of the camera housing disclosed by Chen680. Shown below are the same images with the annotations separated from the images. As is clear, the appearance of the camera housing disclosed by Chen680 is significantly different from Petitioner's simplified shapes, which factor out or ignore many significant features of the housing.

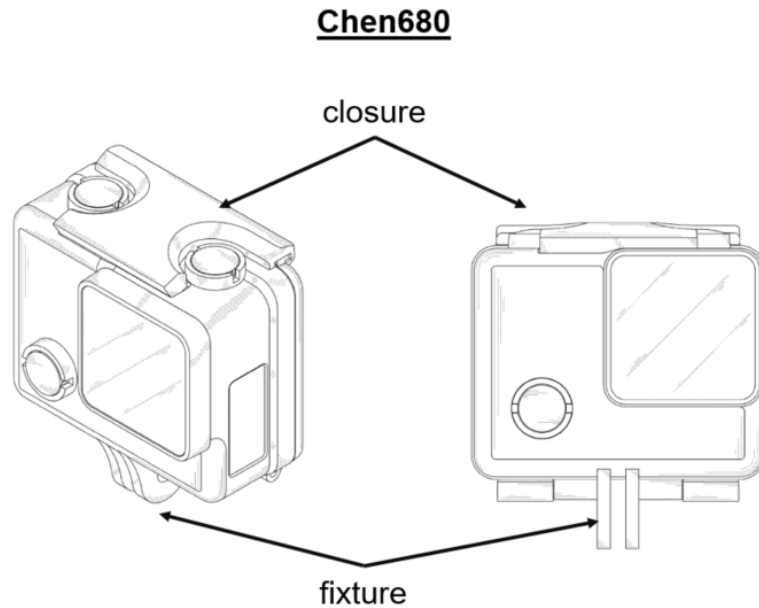


Pet., 70, 74, 76 (separated).

The proper comparison for analysis under the *Graham* factors should be of the drawings from Chen680 to the claimed design, and not of the dissociated lines and shapes created by Petitioner. A proper obviousness challenge cannot be based on “the visual impressions of selected, separate features of the prior art designs to the [claimed] designs” it must be based on “the visual impression of the designs as a whole.” *Harvey*, 12 F.3d at 1065.

When comparing the actual drawings from Chen680 to the color-annotated, superimposed shapes, it is clear the camera housing of Chen680 looks nothing like Petitioner’s color-annotated shapes or the claimed design.

For example, at least the closure and the fixture are not present in
Petitioner's color-annotated shapes or the claimed design, both of which
contribute to the overall ornamental appearance of Chen680.



Pet., 24 (annotated).

Petitioner's attempt to ignore these features of the camera housing in
Chen680 is improper. A design's overall visual impression is impacted by
all its features. Ignoring features when evaluating the design improperly
changes that overall visual impression. A prior art reference must be
considered in its entirety, i.e., as a whole, including portions that would lead
away from the invention. *See W.L. Gore & Assoc., Inc.*, 721 F.2d at 1550-
51.

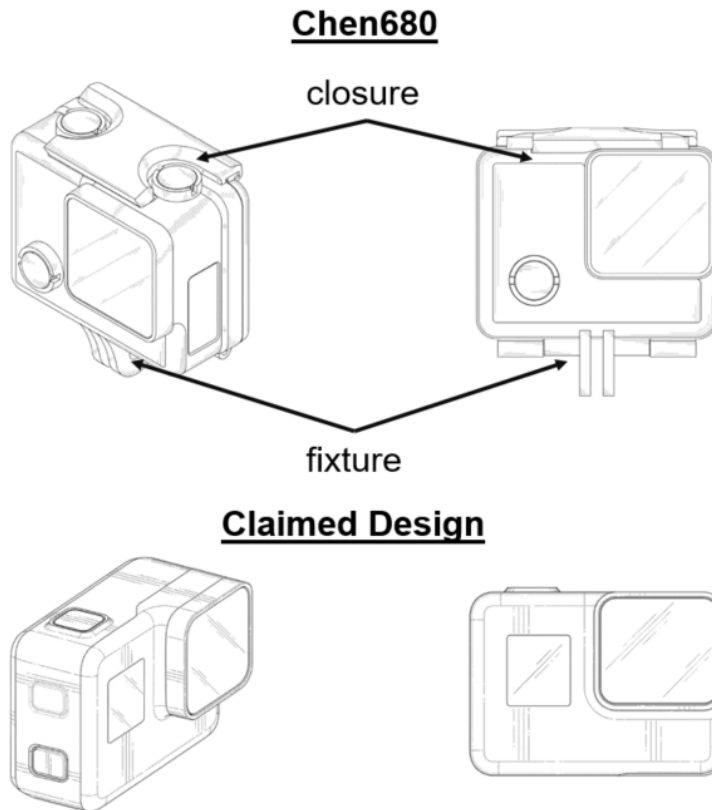
By focusing solely on the color-annotated shapes, Petitioner is making a false comparison between Chen680 and the claimed design under the first *Graham* factor. Petitioner is not comparing the claimed design to “something in existence,” but rather to a collection of separate design concepts allegedly present in the cited reference. This is improper. *See Masimo*, IPR2023-00831, Paper 9 at 33.

Petitioner fails to consider the visual appearance of the Chen680 camera housing as a whole and instead focuses exclusively on general design concepts. For at least this reason, Petitioner fails to properly apply the first factor in the *Graham* analysis. Without properly applying the first factor, Petitioner cannot establish that Chen680, alone or in combination with one or more secondary references, teaches or suggests a camera having the same overall visual appearance as the claimed design.

2. Petitioner ignores differences between Chen680 and the claimed design.

By focusing on discrete design elements of Chen680, Petitioner fails to account for differences between Chen680 and the claimed design. Petitioner therefore fails to evaluate Chen680 and the claimed design in terms of overall visual appearance. This failure is fatal to the Petition.

A simple visual comparison of Chen680 and the claimed design makes clear there are numerous differences between the two. But Petitioner does not even mention many of them, including the closure and the fixture.



Pet., 24 (annotated); EX1001, FIGs. 1, 2.

Rather than address the effect that these differences have on the overall visual appearance of the Chen680 and the claimed design, Petitioner and Mr. Bressler summarily conclude that the two have an overall appearance that is similar. This is fatal to Petitioner's Ground 3 for at least the following reasons.

First, conclusory statements that differences are insubstantial cannot support a valid obviousness challenge. *See Xerox Corp.*, IPR2022-00624, Paper 9 at 15-16. When assessing the presence of the closure on the rear view of Chen680, Mr. Bressler agrees the camera housing is different from what is claimed “due to its design having extra pieces at the top and the bottom,” but summarily dismisses “the presence of these extra pieces as insubstantial/slight/insignificant because rectangles both still occupy a large part of the back of the design, and the body still has a rectangular shape.” EX1002, ¶115. This statement about the insubstantial/slight/insignificant effect of prominent design features is not supported by any evidence or meaningful analysis of the designs.

Second, by failing to take into account the differences, Petitioner fails to evaluate Chen680 and the claimed design in terms of their overall visual appearances. To support a valid obviousness ground, a petitioner must adequately address all differences. *See LKQ*, 102 F.4th at 1299. It is legal error to focus solely on similarities, as Petitioner does here. *See W.L. Gore & Assoc.*, 721 F.2d at 1550-51 (the totality of a reference’s teachings must be considered).

Without adequately considering and addressing at least the above-noted differences, it is not possible for Petitioner to establish that the camera

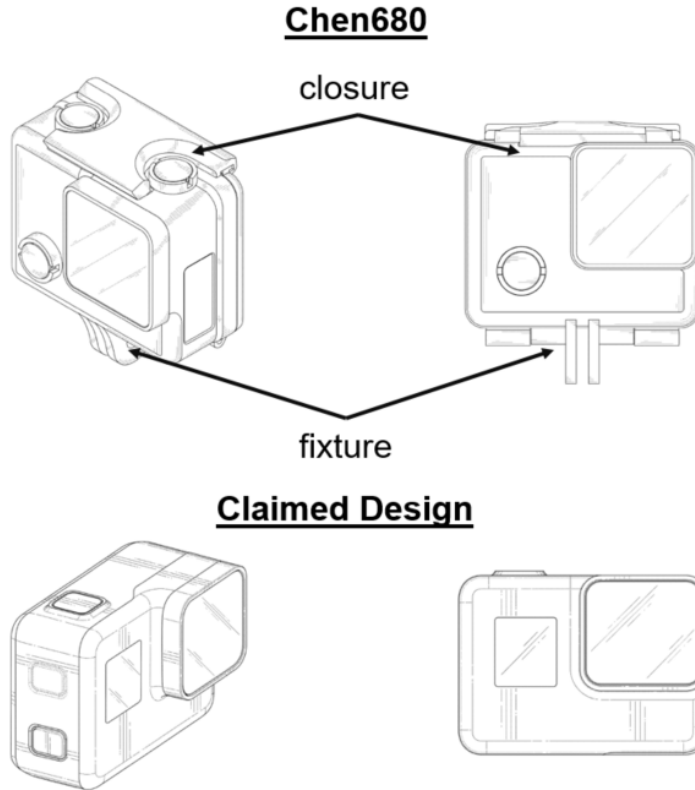
housing of Chen680 in combination with secondary references results in *the same* camera design as claimed.

3. Petitioner's combination of Chen680 with secondary references does not result in the claimed design.

Petitioner admits Chen680's camera housing alone does not render the claimed design obvious. Pet. 69-86. To fill the gaps, Petitioner relies on Huang/Heo and Li/McVicker.¹⁷ In particular, Petitioner relies on Huang, Li, or McVicker to add rectangular display on the front surface (Pet., 71-73), Huang or Heo to make buttons rectangular (Pet., 81-82), and Huang or Heo to add rectangles to the left side and bottom surface of Chen680 (Pet., 75-77, 84-86).

Yet, as discussed above in Section V.C.2 and illustrated below, these are not the only differences between the claimed design and Chen680.

¹⁷ When modifying Chen680, Petitioner relies on one or more of these four references. It is unclear exactly which combination references Petitioner relies on to modify Chen680 to arrive at the claim. In any case, Patent Owner does not concede that Huang, Heo, Li, and/or McVicker disclose features similar to those claimed.



Pet., 24; EX1001, FIGs. 1, 2.

As a result of Petitioner ignoring at least the above-noted differences between the claimed design and Chen680, even if there were motivation to combine Chen680 with Petitioner's cited secondary references, the claimed design would not result. That is because at least these same differences would still be present in the hypothetical combination design.

The *Graham* factors require that *all* differences between the designs be evaluated when assessing whether the prior art renders a claimed design obvious. *See LKQ*, 102 F.4th at 1299.

Moreover, beyond impermissible hindsight based on knowledge of the claimed design, Petitioner does not provide any record-supported reasons for modifying the camera housing of Chen680 to remove or change the closure or fixture in view of Huang, Heo, Li, and/or McVicker to arrive at the claimed design. Without any record-supported reasons to make these changes, it is not possible for Petitioner to establish that the camera housing in combination with Huang, Heo, Li, and/or McVicker results in *the same* camera design as claimed.

Moreover, Mr. Bressler’s conclusory arguments for motivation to modify Chen680 to include additional rectangles because doing so would “compliment an overall visual impression of a rectangular ‘box-like’ design with rectangular visual language” (EX1002, ¶128) fail to meaningfully consider how these changes would be incorporated into Chen680. Mere compatibility of the references is not sufficient. *Personal Web Techs.*, 848 F.3d at 993 (it is not enough to show that “a skilled artisan, once presented with the two references, would have understood that they could be combined”).

Petitioner’s modifications are nothing more than unsupported modifications based on impermissible hindsight gleaned from the ’435 patent must be avoided. *LKQ*, 102 F.4th at 1300. An analysis focused on

assembling design concepts from the prior art in isolation to arrive at the claimed design is improper hindsight. *See Premier Gem*, IPR2016-00434, Paper 9 at 16–17.

* * *

For at least these reasons, Petitioner has not demonstrated a reasonable likelihood of prevailing to show that any of the combinations presented in Ground 3 renders the claim obvious, and Petitioner’s Ground 3 should fail.

D. Wang (Ground 4)

Wang discloses a “camera heat dissipation protection housing.” EX1016, 1. Petitioner has not demonstrated a reasonable likelihood of prevailing to show that any of the combinations presented in Ground 4 renders the claimed design obvious for the following reasons.

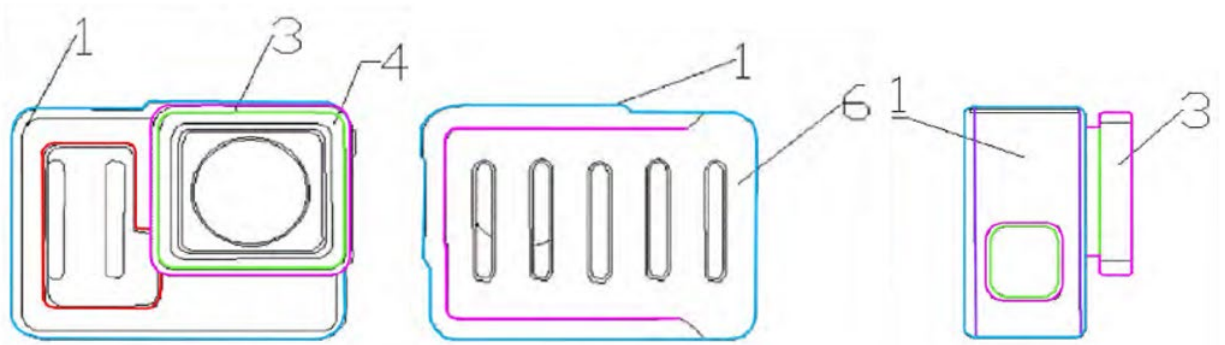
1. Petitioner fails to consider the visual appearance of Wang’s camera housing as a whole and has instead focused exclusively on general design concepts

Petitioner argues that Wang shows a “‘box-like’ design” with the following features listed on page 27 of the Petition.

- “a rectangular body with flat faces”
- “a rectangular lens cover extending outward from the front of the body”

- “a rectangle-like shape for a display at the front that is flush with its front face”
- “rectangular access elements at the top, left side, and right side”

Petitioner provides various color-annotated images of Wang, which attempt to show these separate features in the design, some of which are reproduced below.

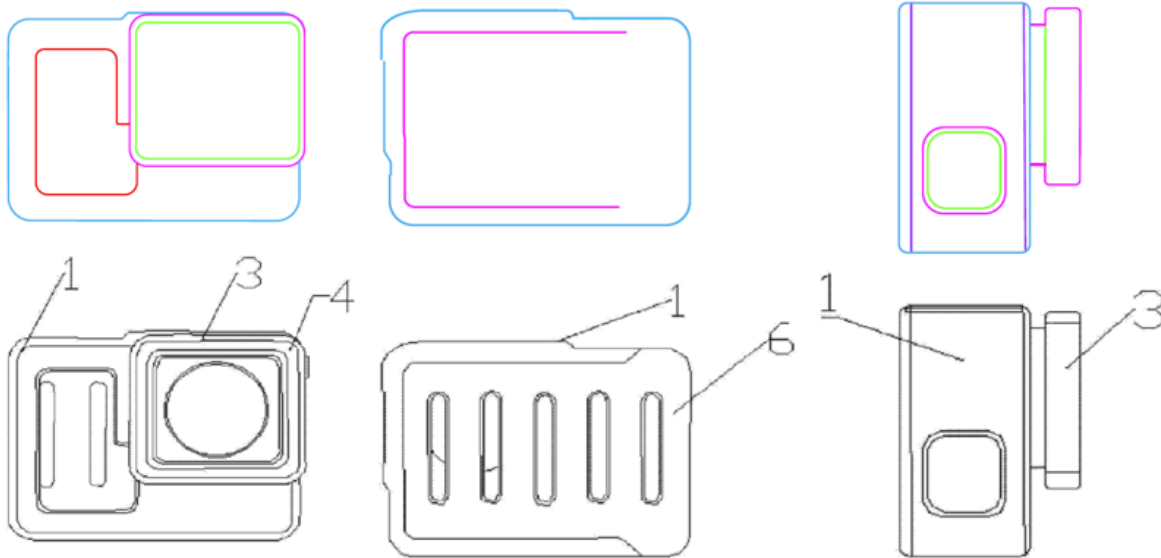


Pet., 87, 90, 92.

Petitioner uses these color-annotated images to argue the Wang camera housing is visually similar the claimed design. Pet., 86.

But these images, and the corresponding discussion of them, are inconsistent with and misrepresent the overall visual appearance of the camera housing disclosed by Wang. Shown below are the same images with the annotations separated from the images. As is clear, the appearance of the camera housing in Wang is significantly different from Petitioner’s simplified shapes, which factor out or ignore significant features of the

camera housing in Wang, for example, the five vertical openings on the rear side of the camera housing.



Pet., 87, 90, 92 (separated).

The proper comparison for analysis under the *Graham* factors should be of the drawings from Wang to the claimed design, and not of the dissociated lines and shapes created by Petitioner. A proper obviousness challenge cannot be based on “the visual impressions of selected, separate features of the prior art designs to the [claimed] designs” it must be based on “the visual impression of the designs as a whole.” *Harvey*, 12 F.3d at 1065.

By focusing solely on the color-annotated shapes, Petitioner is making a false comparison between Wang and the claimed design under the first *Graham* factor. Petitioner is not comparing the claimed design to “something in existence,” but rather to a collection of separate design

concepts allegedly present in the cited reference. This is improper. *See*

Masimo, IPR2023-00831, Paper 9 at 33.

Petitioner fails to consider the visual appearance of Wang as a whole and instead focuses exclusively on general design concepts. For at least this reason, Petitioner fails to properly apply the first factor in the *Graham* analysis. Without properly applying the first factor, Petitioner cannot establish that Wang, alone or in combination with one or more secondary references, teaches or suggests a camera having the same overall visual appearance as the claimed design.

2. Petitioner ignores differences between Wang and the claimed design.

Petitioner admits Wang alone does not render the claimed design obvious. Pet. 86-98. To fill the gaps, Petitioner relies on Huang, Heo, Li, and/or McVicker.¹⁸ For example, Petitioner relies on Huang, Heo, or McVicker to include a display rectangle on the front surface (Pet., 88-90),

¹⁸ When modifying Wang, Petitioner relies on one or more of these four references. It is unclear exactly which combination references Petitioner relies on to modify Wang to arrive at the claim. In any case, Patent Owner does not concede that Huang, Heo, Li, and/or McVicker disclose features similar to those claimed.

Heo or Li to include a display rectangle on the rear surface (Pet., 90-91), and Huang or Heo to added a rectangle to the bottom of Wang (Pet., 95-97).

Petitioner's attempt to modify Wang with *four* different secondary references in various combinations fails to properly consider the overall visual appearances of the claimed design and Wang, or adequately address all differences between the claimed design and Wang. As a result, the combination of references does not result in the claimed design.

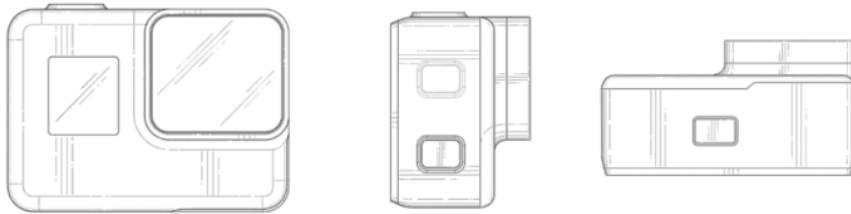
Petitioner fails to take into account differences between Wang and the claimed design. To support a valid obviousness ground, a petitioner must adequately address all differences. "After ascertaining the knowledge of an ordinary designer in the relevant field, the scope and content of the prior art, and the differences between the prior art and the claimed design, the obviousness or nonobviousness of the claimed design is evaluated." *LKQ*, 102 F.4th at 1299.

A simple visual comparison of Wang and the claimed design makes clear there are differences between the two that affect their overall visual appearance. But neither Petitioner nor Mr. Bressler mention many of the differences. For example, absent from their analysis are discussion of the following claimed features:

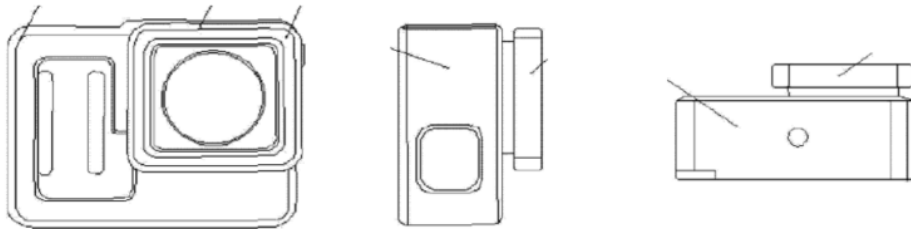
(1) a curved contour at the base of a rectangular protrusion at the top right of the claimed design; and

(2) a flush extension on the right side and top of the rectangular protrusion, which when combined with difference (1) above creates an asymmetrical design.

Claimed Design



Wang



EX1001, FIGs. 5, 7, 10; Pet., 26-27.

This is fatal to Petitioner's Ground 4.

Without adequately acknowledging and addressing at least the above-noted differences, it is not possible for Petitioner to establish that Wang or its combination with Huang, Heo, Li and/or McVicker, results in *the same* camera design as claimed.

3. Petitioner's combination of Wang with secondary references does not result in the claimed design.

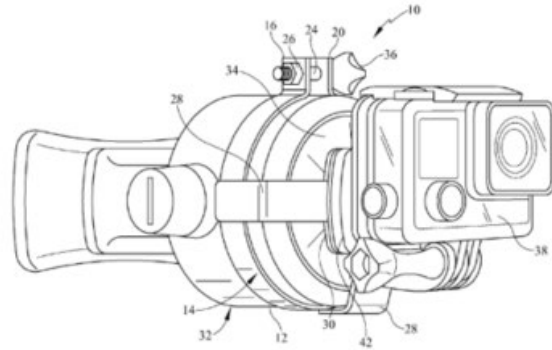
As a result of Petitioner ignoring at least the above-noted differences between the claimed design and Wang, even if there were motivation to combine Wang with Petitioner's cited secondary references, the claimed design would not result. That is because at least these same claimed features are not found in any of Wang, Huang, Heo, Li, or McVicker.

Huang and McVicker disclose a rectangular protrusion. But neither disclose (1) a curved contour at the base of the rectangular protrusion and (2) a flush extension of the protrusion on the right side and top of the camera, creating an asymmetrical design like that claimed. As shown on the left below, the rectangular protrusion in Huang includes sharp edges at its base where it meets the camera body and is significantly offset from the right side of the camera. As shown on the right below, McVicker only discloses left side perspective views of the camera making it impossible to tell the exact shape of the rectangular protrusion, if it has an asymmetrical design, or how it meets the camera housing.

Huang



McVicker



EX1020, 2 (left); EX1029, FIG. 1 (right).

Therefore, even if there were motivation to combine the cited references, the claimed design would not result because salient features of the claim are not present in the cited art. Petitioner does not even attempt to show at least the two above-noted claimed features in the cited references. Without any record-supported reasons to address these differences, it is not possible for Petitioner to establish that Wang, or its combination with Huang, Heo, Li and/or McVicker, results in *the same* camera design as claimed.

* * *

For at least these reasons, Petitioner has not demonstrated a reasonable likelihood of prevailing to show that any of the combinations presented in Ground 4 renders the claim obvious, and Petitioner's Ground 4 should fail.

E. Chen686 (Ground 5)

Petitioner's Ground 5 relies on US D750,686¹⁹ ("Chen686"), which discloses a design for a camera. EX1018, 1. Petitioner has not demonstrated a reasonable likelihood of prevailing to show that any of the combinations presented in Ground 5 renders the claim obvious, for the following reasons.

1. Petitioner fails to consider the visual appearance of Chen686 as a whole and has instead focused exclusively on general design concepts

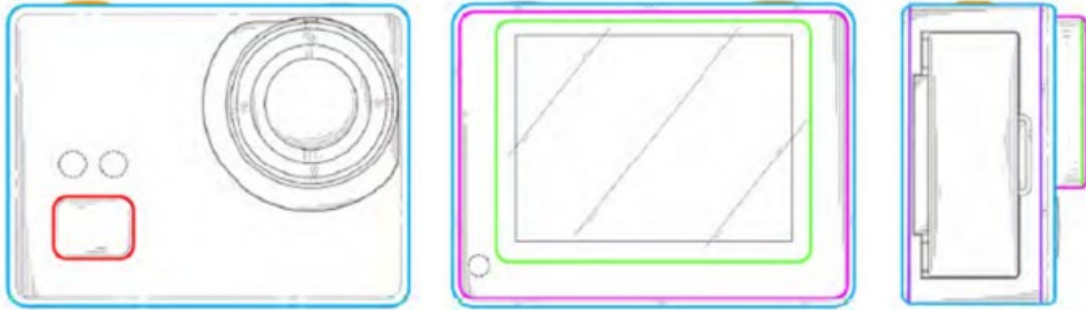
Petitioner argues that Chen686 shows a "'box-like' design" with the following features on pages 29-30 of the Petition.

- "a rectangular body with flat faces"
- "a rectangle at the front of the body that is flush^[20] with its front face, and a rectangle for a display that occupies a large part of the back"
- "buttons/access elements at the top, left side, and right side"

¹⁹ US D750,686 is listed on the face of the '435 patent, and therefore was considered by the Examiner during prosecution. EX1001, (56).

²⁰ Petitioner incorrectly states the rectangle is flush with the body. As shown in at least figure 4 of Chen686, the rectangle protrudes from the front surface. EX1018, 5.

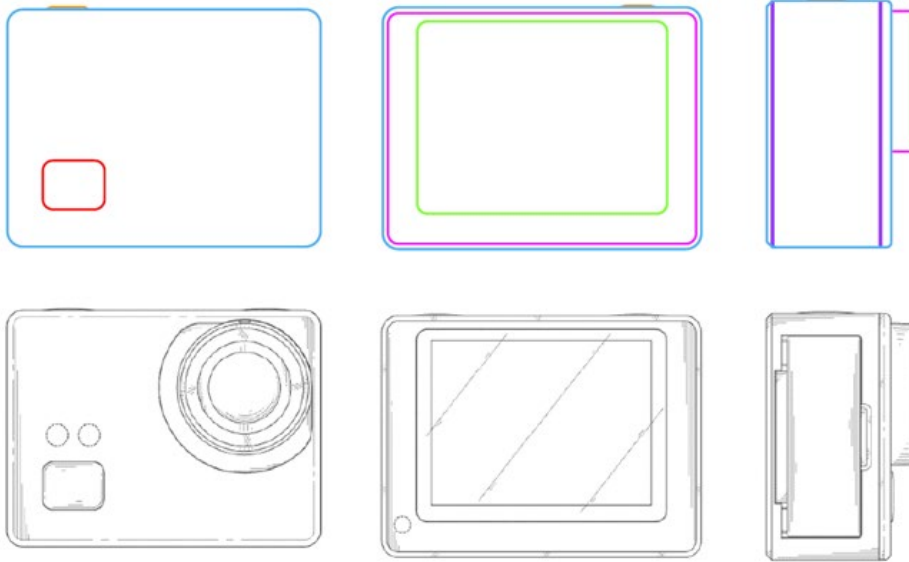
Petitioner provides various color-annotated images of Chen686, which attempt to show these separate features in the design, some of which are reproduced below.



Pet., 99, 102, 104.

Petitioner uses these color-annotated images to argue Chen686's camera is visually similar the claimed design. Pet., 98.

But these images, and the corresponding discussion of them, are inconsistent with and misrepresent the overall visual appearance of the camera disclosed by Chen686. Shown below are the same images with the annotations separated from the images. As is clear, the appearance of Chen686's camera is significantly different from Petitioner's simplified shapes, which factor out or ignore significant features of Chen686's camera, for example, the circular-shaped protruding lens.



Pet., 99, 102, 104 (separated).

The proper comparison for analysis under the *Graham* factors should be of the drawings from Chen686 to the claimed design, not of the dissociated lines and shapes created by Petitioner. A proper obviousness challenge cannot be based on “the visual impressions of selected, separate features of the prior art designs to the [claimed] designs” it must be based on “the visual impression of the designs as a whole.” *Harvey*, 12 F.3d at 1065.

By focusing solely on the color-annotated shapes, Petitioner is making a false comparison between Chen686 and the claimed design under the first *Graham* factor. Petitioner is not comparing the claimed design to “something in existence,” but rather to a collection of separate design concepts allegedly present in the cited reference. This is improper. *See Masimo*, IPR2023-00831, Paper 9 at 33.

Petitioner fails to consider the visual appearance of Chen686's camera as a whole and instead focuses exclusively on general design concepts. For at least this reason, Petitioner fails to properly apply the first factor in the *Graham* analysis. Without properly applying the first factor, Petitioner cannot establish that Chen686, alone or in combination with one or more secondary references, teaches or suggests a camera having the same overall visual appearance as the claimed design.

2. Petitioner ignores differences between Chen686 and the claimed design.

Petitioner admits Chen686 alone does not render the claimed design obvious. Pet. 99-109. To fill the gaps, Petitioner relies on Huang, Heo, Li, and/or McVicker.²¹ For example, Petitioner relies on Huang or McVicker to modify the circular lens cover of Chen686 to a protruding rectangular lens cover (Pet., 99-101), Heo or Li to include a larger display rectangle on Chen686 (Pet., 101-103), and Huang or Heo to make buttons rectangular and add a rectangle to the bottom of Chen686 (Pet., 107-111).

²¹ When modifying Chen686, Petitioner relies on one or more of these four references. It is unclear exactly which combination references Petitioner relies on to modify Chen686 to arrive at the claim. In any case, Patent Owner does not concede that Huang, Heo, Li, and/or McVicker disclose features similar to those claimed.

Petitioner's attempt to modify Chen686 with *four* different secondary references in various combinations fails to properly consider the overall visual appearances of the claimed design and Chen686, or adequately address all differences between the claimed design and Chen686. As a result, the combination of references does not result in the claimed design.

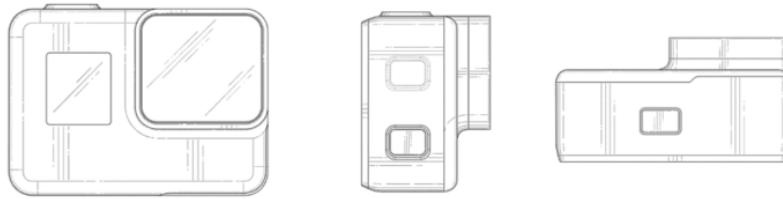
A simple visual comparison of Chen686 and the claimed design makes clear there are differences between the two that affect their overall visual appearance. But neither Petitioner nor Mr. Bressler mention many of the differences. For example, absent from their analysis are discussion of the following claimed features:

(1) a curved contour at the base of a rectangular protrusion at the top right of the claimed design;

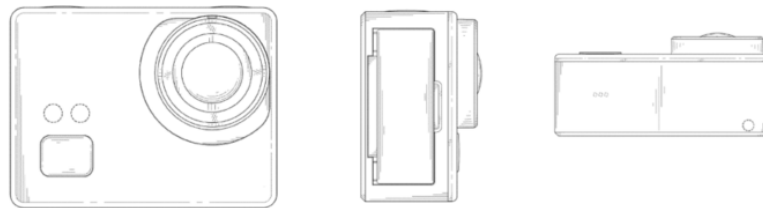
(2) a flush extension on the right side and top of the of the rectangular protrusion, which when combined with difference (1) above creates an asymmetrical design; and

(3) the location and prominence of the obliquely shaded rectangle to the left of the rectangular protrusion on the front surface of the camera.

Claimed Design



Chen 686



EX1001, FIGs. 5, 7, 10; Pet., 28-29.

This lack of addressing these differences is fatal to Petitioner's Ground 5 for at least the following reasons.

The only one of the three above-mentioned differences Petitioner and Mr. Bressler peripherally mention are the rectangles on the front of the claimed design and Chen686. Pet., 99; EX1002, ¶¶164-165. However, not once do they discuss the differences in oblique line shading, size, or position of the rectangles relative to the front of the cameras.

Without adequately acknowledging and addressing at least the above-noted differences, it is not possible for Petitioner to establish that Chen686, or its combination with Huang, Heo, Li and/or McVicker, results in *the same* camera design as the claimed design.

3. Petitioner's combination of Chen686 with secondary references does not result in the claimed design.

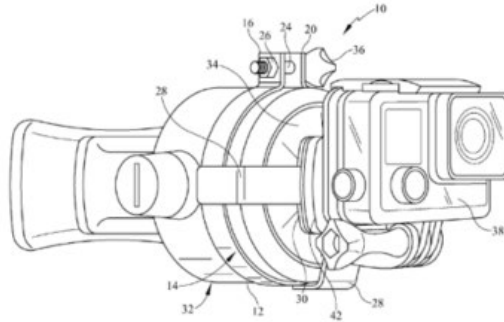
As a result of Petitioner ignoring at least the above-noted differences between the claimed design and Chen686, even if there were motivation to combine Chen686 with Petitioner's cited secondary references, the claimed design would not result. That is because at least these same claimed features are not found in any of Chen686, Huang, Heo, Li, or McVicker.

Huang or McVicker are cited by Petitioner and Mr. Bressler for disclosing a rectangular protrusion. Pet., 99-101; EX1002, ¶¶164-165. But neither Huang nor McVicker discloses (1) a curved contour at the base of the rectangular protrusion and (2) a flush extension of the protrusion on the right side and top of the camera, creating an asymmetrical design like that claimed. As shown on the left below, the rectangular protrusion in Huang includes sharp edges at its base where it meets the camera body and is significantly offset from the right side of the camera. As shown on the right below, McVicker only discloses left side perspective views of the camera making it impossible to tell the exact shape of the rectangular protrusion, if it has an asymmetrical design, or how it meets the camera housing.

Huang

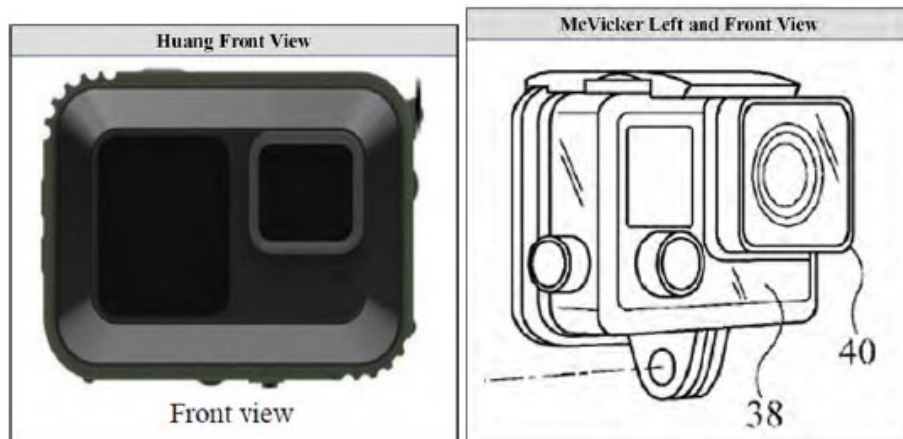


McVicker



EX1020, 2 (left); EX1029, FIG. 1 (right).

For difference (3), while Huang or McVicker are also referred to in Petitioner's and Mr. Bressler's discussion of the front view of the claimed design, neither discloses an obliquely shaded rectangle like that claimed. The rectangle in Huang is more prominent and occupies half of the front of the camera. The rectangle in McVicker is smaller but does not have oblique line shading, despite other aspects of the McVicker design, such as the lens, clearly being shown with oblique shading.



Pet., 100; EX1002, ¶164.

Therefore, even if there were motivation to combine the cited references, the claimed design would not result because salient features of the claim are not present in the cited art. Petitioner does not even attempt to show at least the three above-noted claimed features in the cited references. Without any record-supported reasons to address these differences, it is not possible for Petitioner to establish that the Chen686 camera, or its combination with Huang, Heo, Li and/or McVicker, results in *the same* camera as the claimed design.

* * *

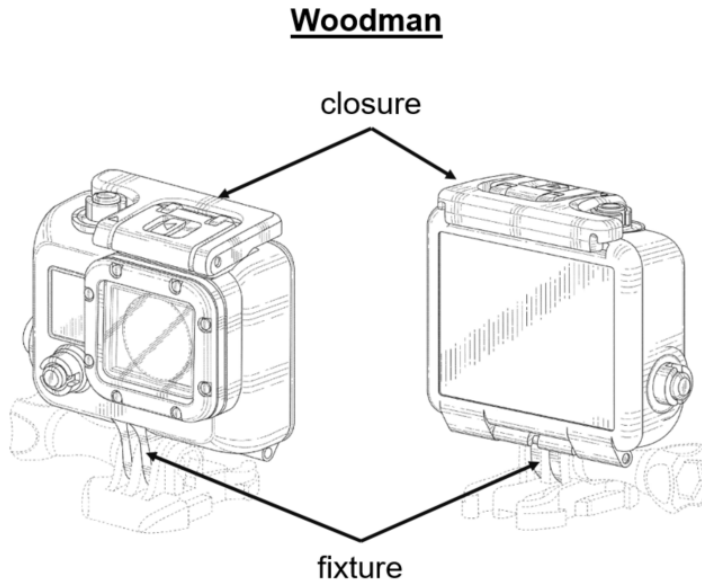
For at least these reasons, Petitioner has not demonstrated a reasonable likelihood of prevailing to show that any of the combinations presented in Ground 5 renders the claim obvious, and Petitioner's Ground 5 should fail.

F. Woodman (Ground 6)

Petitioner's Ground 6 relies on US D702,474²² ("Woodman"), which discloses a design for a camera housing. EX1019, 1. Woodman's camera

²² US D734,799, which is a continuation of US D702,474, was cited by the Examiner during prosecution of the '435 patent. EX1001, (56).

housing, as shown in the following annotated image, comprises various features, including a top closure and a fixture.



Pet., 31 (annotated).

Petitioner has not demonstrated a reasonable likelihood of prevailing to show that any of the combinations presented in Ground 6 renders the claimed design obvious, for the following reasons.

- Petitioner fails to consider the visual appearance of Woodman’s camera housing as a whole and has instead focused exclusively on general design concepts.**

Petitioner argues that camera housing design in Woodman shows a “‘box-like’ design” with the following features listed on pages 32-33 of the Petition.

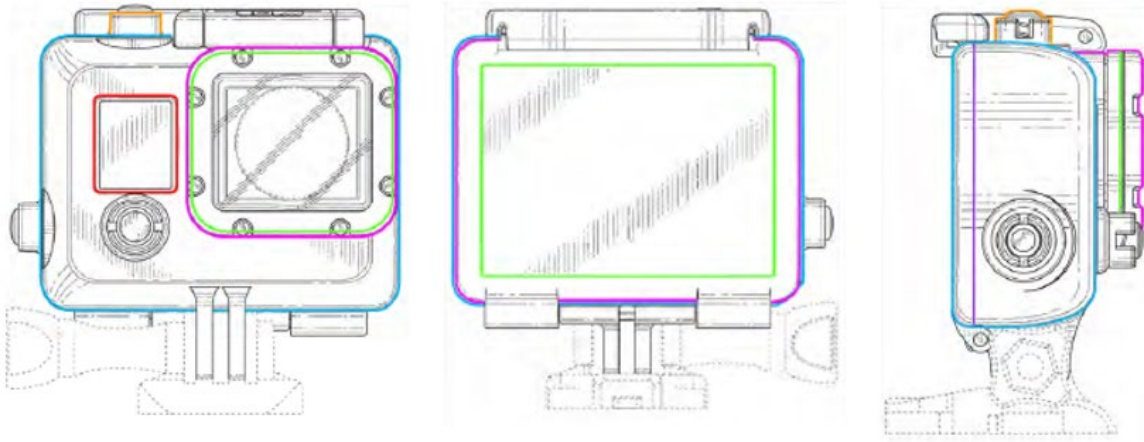
- “a roughly rectangular body”

- “a rectangular lens cover extending outward from the front of the body and showing a line”
- “a rectangle for a display at the front that is flush^[23] with its front face, and a rectangle for a display that occupies a large part of the back”
- “buttons/access elements at the top and left side”

Petitioner is describing features of Woodman’s camera housing, but in reality, the housing is much more than what Petitioner describes.

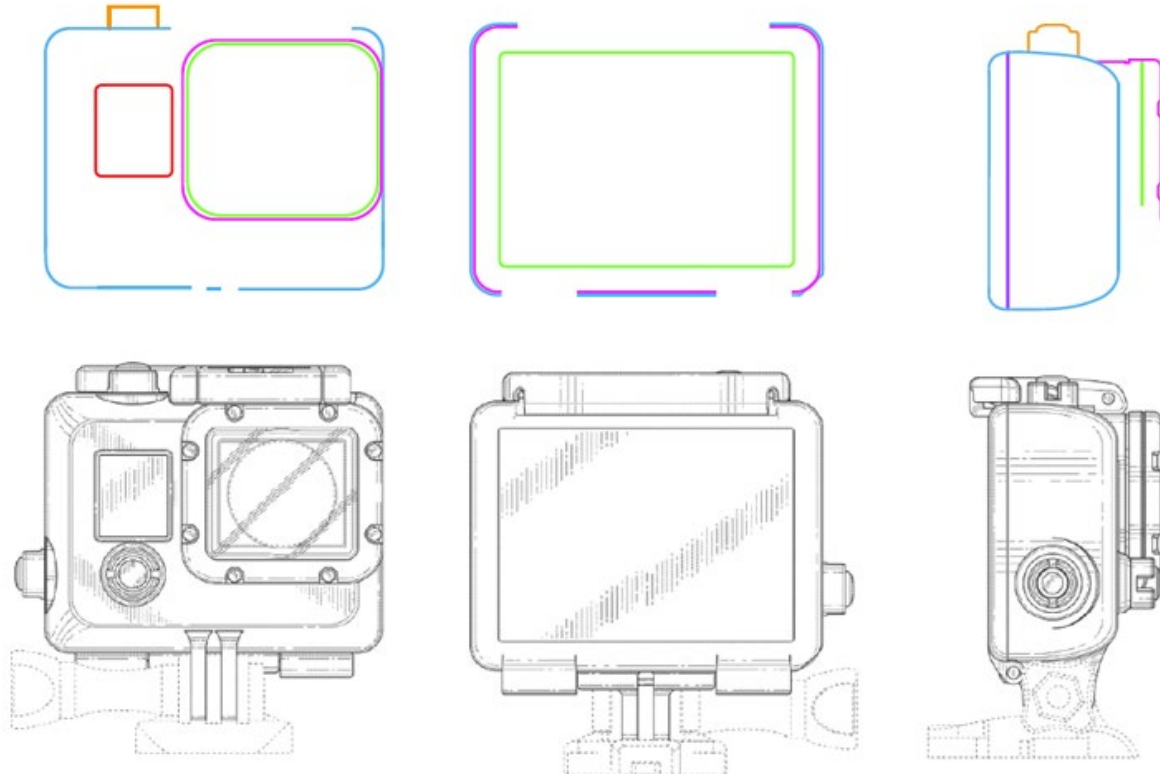
To try to draw attention away from the appearance of the actual Woodman camera housing, Petitioner provides colored annotated images from Woodman, some of which are reproduced below.

²³ Petitioner incorrectly states the rectangle is flush with the body. As shown in at least figure 1 of Woodman, the rectangle is surrounded by a protruding bezel on the front surface. EX1019, 2.



Pet., 113, 114, 116.

But these images, and the corresponding discussion of them, are inconsistent with and misrepresent the overall visual appearance of the camera housing disclosed by Woodman. Shown below are the same images with the annotations separated from the images. As is clear, the appearance of the camera housing disclosed by Woodman is significantly different from Petitioner's simplified shapes, which factor out or ignore many significant features of the housing.

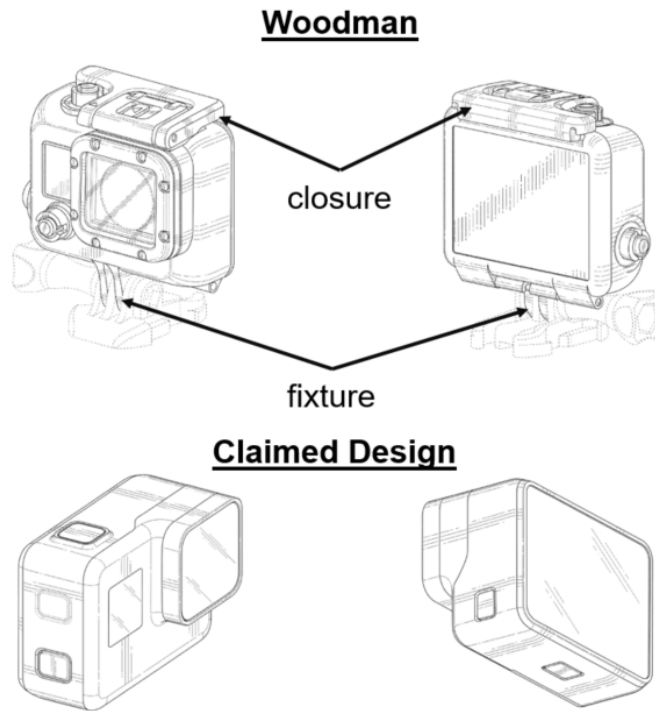


Pet., 113, 114, 116 (separated).

The proper comparison for analysis under the *Graham* factors should be of the drawings from Woodman to the claimed design, and not of the dissociated lines and shapes created by Petitioner. A proper obviousness challenge cannot be based on “the visual impressions of selected, separate features of the prior art designs to the [claimed] designs” it must be based on “the visual impression of the designs as a whole.” *Harvey*, 12 F.3d at 1065.

When comparing the actual drawings from Woodman to the color-annotated, superimposed shapes, it is clear the camera housing of Woodman looks nothing like Petitioner’s color-annotated shapes or the claimed design.

For example, at least the closure and the fixture are not present in Petitioner's color-annotated shapes or the claimed design, both of which contribute to the overall ornamental appearance of Woodman.



Pet., 31 (annotated); EX1001, FIGs. 1, 2.

Petitioner's attempt to ignore these features of the camera housing in Woodman is improper. A design's overall visual impression is impacted by all its features. Ignoring features when evaluating the design improperly changes that overall visual impression. When evaluating obviousness, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention. *See W.L. Gore & Assoc., Inc.*, 721 F.2d at 1550-51.

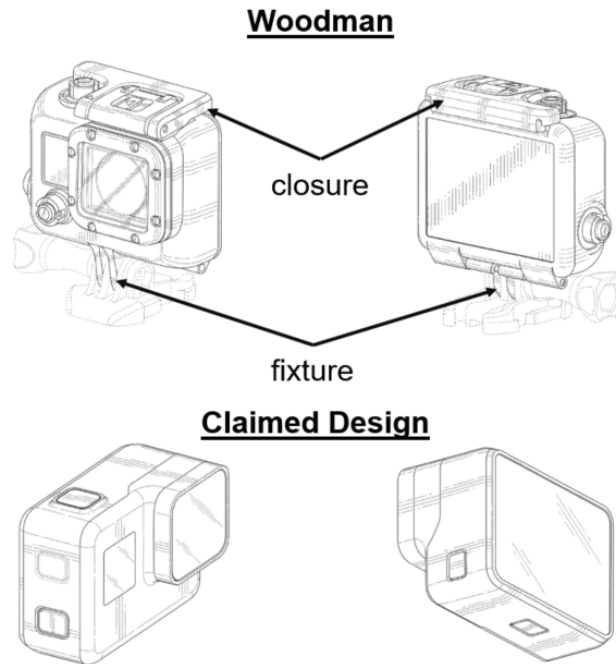
By focusing solely on the color-annotated shapes, Petitioner is making a false comparison between Woodman and the claimed design under the first *Graham* factor. Petitioner is not comparing the claimed design to “something in existence,” but rather to a collection of separate design concepts allegedly present in the cited reference. This is improper. *See Masimo*, IPR2023-00831, Paper 9 at 33.

Petitioner fails to consider the visual appearance of Woodman as a whole and instead focuses exclusively on general design concepts. For at least this reason, Petitioner fails to properly apply the first factor in the *Graham* analysis. Without properly applying the first factor, Petitioner cannot establish that Woodman, alone or in combination with one or more secondary references, teaches or suggests a camera having the same overall visual appearance as the claimed design.

2. Petitioner ignores differences between Woodman and the claimed design.

By focusing on discrete design elements of the camera housing of Woodman, Petitioner fails to account for differences between Woodman’s camera housing and the claimed design. Petitioner therefore fails to evaluate Woodman’s camera housing and the claimed design in terms of overall visual appearance. This failure is fatal to the Petition.

A simple visual comparison of Woodman and the claimed design makes clear there are numerous differences between the two. But Petitioner does not even mention many of them, including the closure and the fixture.



Pet., 31 (annotated); EX1001, FIGs. 1, 2.

Rather than address the effect that these differences have on the overall visual appearance of Woodman and the claimed design, Petitioner and Mr. Bressler summarily conclude that the two have an overall appearance that is similar. This is fatal to Petitioner's Ground 6 for at least the following reasons.

First, conclusory statements that differences are insubstantial cannot support a valid obviousness challenge. *See Xerox Corp.*, IPR2022-00624, Paper 9 at 15-16. When assessing the presence of the closure on the rear

view of Woodman, Mr. Bressler agrees the camera housing is different from what is claimed “due to its design having extra pieces at the top and the bottom,” but summarily dismisses “the presence of these extra pieces as insubstantial because the rectangles still occupy a large part of the back of the design, and the body still has a roughly rectangular shape.” EX1002, ¶189. This statement about the insubstantial effect of prominent design features is not supported by any evidence or meaningful analysis of the designs.

Second, by failing to take into account the differences, Petitioner fails to evaluate Woodman and the claimed design in terms of their overall visual appearances. To support a valid obviousness ground, a petitioner must adequately address all differences. *See LKQ*, 102 F.4th at 1299. It is legal error to focus solely on similarities, as Petitioner does here. *See W.L. Gore & Assoc.*, 721 F.2d at 1550-51 (the totality of a reference’s teachings must be considered).

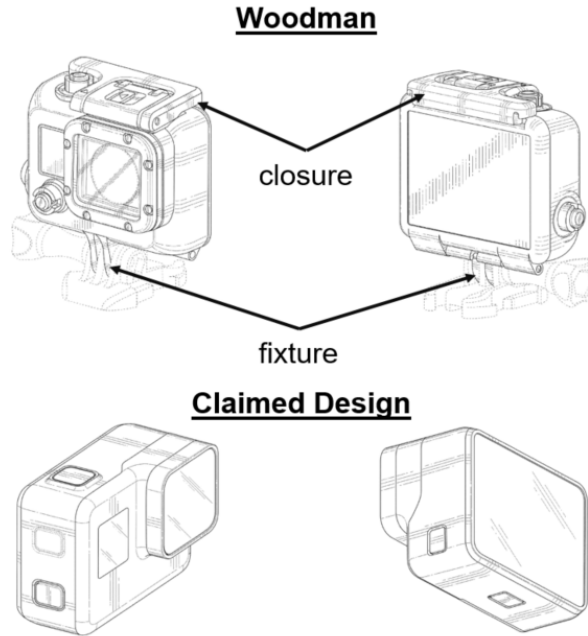
Without adequately considering and addressing at least the above-noted differences, it is not possible for Petitioner to establish that the Woodman camera housing in combination with Huang or Heo, results in *the same* camera design as claimed.

3. Petitioner's combination of Woodman with secondary references does not result in the claimed design.

Petitioner admits Woodman's camera housing alone does not render the claimed design obvious. Pet. 113-126. To fill the gaps, Petitioner relies on Huang/Heo.²⁴ In particular, Petitioner relies on Huang or Heo to make buttons rectangular (Pet., 116-119, 121-123), and to add rectangles to the right side and bottom of Woodman (Pet., 120-121, 124-126).

Yet, as discussed above in Section V.F.2 and illustrated below, these are not the only differences between the claimed design and Woodman.

²⁴ When modifying Woodman, Petitioner repeatedly refers to "Huang/Heo" as disclosing various features. It is unclear whether Petitioner relies on Huang alone, Heo alone, or a combination of Huang and Heo to modify Woodman. But in either case, Patent Owner does not concede that Huang or Heo disclose features similar to those claimed.



Pet., 31; EX1001, FIGs. 1, 2

As a result of Petitioner ignoring at least the above-noted differences between the claimed design and Woodman, even if there were motivation to combine Woodman with Petitioner's cited secondary references, the claimed design would not result. That is because at least these same differences would still be present in the hypothetical combination design.

The *Graham* factors require that *all* differences between the designs be evaluated when assessing whether the prior art renders a claimed design obvious. See *LKQ*, 102 F.4th at 1299.

Beyond impermissible hindsight based on knowledge of the claimed design, Petitioner does not provide any record-supported reasons for modifying the camera housing of Woodman to remove or change the closure

and fixture in view of Huang/Heo to arrive at the claimed design. Without any record-supported reasons to make these changes, it is not possible for Petitioner to establish that the camera housing in combination with Huang/Heo results in *the same* camera design as claimed.

Moreover, Mr. Bressler’s conclusory arguments for motivation to modify Woodman to include additional rectangles because doing so would “compliment an overall visual impression of a rectangular ‘box-like’ design” (EX1002, ¶201) fail to meaningfully consider how these changes would be incorporated into Woodman. Mere compatibility of the references is not sufficient. *Personal Web Techs.*, 848 F.3d at 993 (it is not enough to show that “a skilled artisan, once presented with the two references, would have understood that they could be combined”).

Petitioner’s modifications are nothing more than unsupported modifications based on impermissible hindsight gleaned from the ’435 patent must be avoided. *LKQ*, 102 F.4th at 1300. An analysis focused on assembling design concepts from the prior art in isolation to arrive at the claimed design is improper hindsight. *See Premier Gem*, IPR2016-00434, Paper 9 at 16–17.

* * *

For at least these reasons, Petitioner has not demonstrated a reasonable likelihood of prevailing to show that any of the combinations presented in Ground 6 renders the claim obvious, and Petitioner's Ground 6 should fail.

VI. CONCLUSION

The Petition fails to show a reasonable likelihood that the challenged claim is unpatentable as obvious in view of the cited art and, therefore, the Board should deny institution.

Respectfully submitted,

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/Tracy Durkin/

Tracy-Gene G. Durkin
Registration No. 32,831
Attorney for Patent Owner

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CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

1. This Patent Owner Preliminary Response complies with the type-volume limitation of 14,000 words, comprising 13,644 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

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Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER PRELIMINARY
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