

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AXON ENTERPRISE, INC.,  
Petitioner,

v.

DIGITAL ALLY, INC.,  
Patent Owner.

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Case IPR2017-00375  
Patent 8,781,292 B1

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

KAUFFMAN, *Administrative Patent Judge*.

DECISION  
Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

## I. INTRODUCTION

### A. OVERVIEW

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

### B. RELATED PROCEEDINGS

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

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

<sup>2</sup> We caution Petitioner that in future briefing strict attention should be given to the mandated word count certification. *See* 37 C.F.R. §§ 42.24(a), (d). Petitioner’s certification states that the Petition “has a total of 13,912 words.” Pet. 75. Petitioner, however, fails to use normal spacing in the Petition for numerous citations in order to reduce the word count. For example, Petitioner did not place spaces in many of its citations such as in “(Ex.1008, ¶22).” Pet. 3; *see also* The Blue Book, Twentieth Ed., Rule 3.3; *Pi-Net Int’l, Inc. v. JPMorgan Chase & Co.*, 600 F. App’x 774, 775 (Fed. Cir. 2015) (determining deletion of required spacing circumvents rule on word count). The Board expects the use of ordinary spacing in phrases and citations in submitted documents. *See Google Inc. v. Makor Issues & Rights Ltd.*, Case No. IPR2016-01535, slip op. at 7 (PTAB, Dec. 1, 2016) (Paper 8) (“Excessive wording in figures, drawings or images, deleting spacing between words, or using excessive acronyms or abbreviations for word phrases, in order to bypass the rules on word count, are not reasonable.”). Parties and their counsel ought to give strict attention to the related rule especially as it requires an attorney certification and we will consider appropriate sanctions for violation. *See* 37 C.F.R. § 42.11.

*Ally, Inc. v. Enforcement Video, LLC d/b/a Watchguard Video*, Case No. 2:16-cv-02349-JTM-JPO, each pending in the United States District Court for the District of Kansas (“the related litigation”) (Ex. 1007, ¶ 26). Pet. 2; Prelim. Resp. 1.

The ’292 patent was subject to *ex parte* reexamination, and a Reexamination Certificate was issued on January 14, 2016. Ex. 1001, 17–22.<sup>3</sup>

The ’292 patent is also the subject of IPR2017-00376 filed concurrently with the Petition at hand. There, Petitioner challenges claims 1, 8, 12, 18, 20, 21, 26, 28, 30, 32, 36, 38, 39, 42, 45, 47, 48, 50, 51, 54, 57, and 59.

The ’292 patent is a continuation of U.S. Patent No. 9,253,452 B2 (“the ’452 patent”).<sup>4</sup> The ’452 patent is the subject of IPR2017-00515 and IPR2017-00775, both of which were filed by Petitioner.

## II. THE CLAIMED SUBJECT MATTER

### A. INTRODUCTION

#### 1. *Background*

As a description of related art, the ’292 patent describes that recording device management systems are used to coordinate recording devices to capture multiple recordings of an event. Ex. 1001, 1:28–31. For example, a user could press a button on a control board to start multiple video cameras.

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<sup>3</sup> We reference Petitioner’s exhibits in a slightly different format. For example, Petitioner labels a page of Exhibit 1001 as “1001-017,” and we reference that page as “1001, 17.”

<sup>4</sup> A copy of the ’452 patent is filed as Exhibit 1002.

*Id.* at 1:31–35. Such systems did little if anything to react to inputs from electronic devices, to make decisions based on statuses of electronic devices, or to corroborate the recorded data from distinct devices. *Id.* at 1:33–39.

Also as background, the '292 patent describes that law enforcement often used recording devices to record evidence. *Id.* at 1:40–42. These devices often used different cues to start recording, or required manual operation. *Id.* at 1:40–49. Known drawbacks of such systems included lack of corroboration or other forensic verification, and time to correlate this evidence. *Id.* at 4:49–57.

## 2. *The '292 Patent*

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

Figure 1 follows:

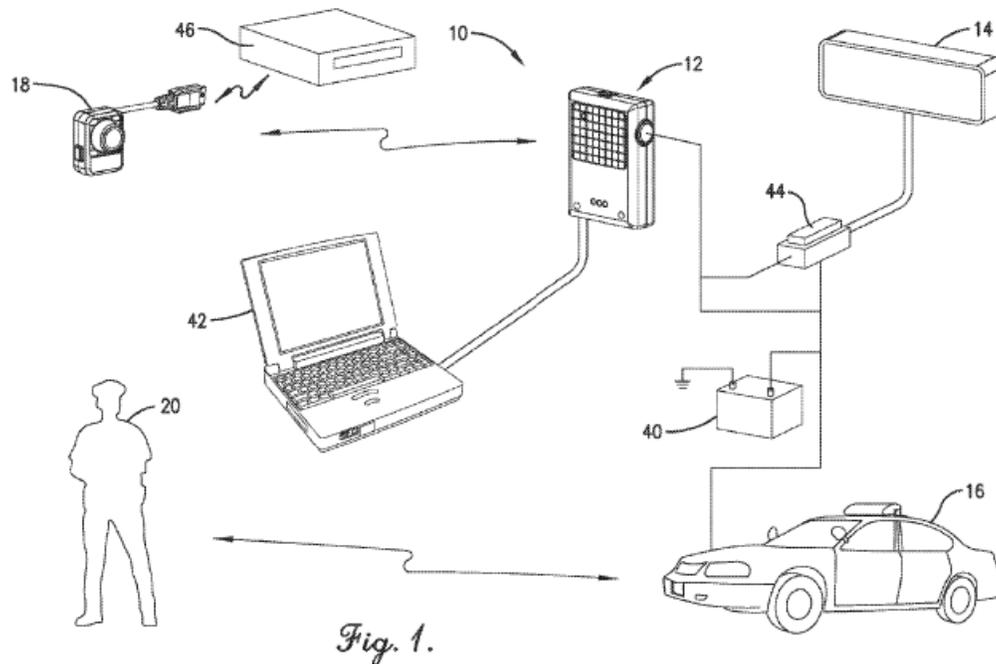


Figure 1 is a schematic plan view of a multiple recording device management system. *Id.* at 2:32–37. System 10 includes intermediate vehicle video recording device 14 mounted in police vehicle 16 and personal video recording device 18 carried by police officer 20, each wirelessly synced to recording device manager 12. *Id.* at 3:21–30. Multiple personal recording devices 18 can be synced with manager 12. *Id.* at 3:46–48, 4:30–34. When recording device manager 12 receives a signal that a first recording device (*e.g.*, personal recording device 18) has begun recording, either due to an instruction to record or a triggering event, recording device manager 12 signals a second recording device (*e.g.*, vehicle recording device 14) to record.<sup>5</sup> *Id.* at 4:39–53.

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<sup>5</sup> Either recording device (14, 18) may be considered the first or second recording device. *See generally* Ex. 1001, 4:27–53.

B. ILLUSTRATIVE CLAIM

Claims 1, 18, 36, and 48 are independent. Claim 1 is illustrative and follows:<sup>6</sup>

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

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

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

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

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

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

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

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

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

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<sup>6</sup> We identify portions of the claim with added bracketed letters because the parties reference the claim in this manner. *See, e.g.*, Pet. 32; PO Resp. 22.

recorded by the first recording device is different than the second set of record data recorded by the second recording device,

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

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

Ex. 1001, 18 (claim 1 in reexamination certificate).

#### C. APPLICABLE STANDARD

In an *inter partes* review, the Board interprets claim terms in an unexpired patent according to the broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation approach).

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

D. SPECIFIC CLAIM TERMS

1. “record” and “recording device” (All Claims)

Each of the independent claims includes various forms of the word “record,” and each recites a first and a second “recording device.” We construe these terms together because the meanings are interrelated.

Petitioner contends that “recording device” as claimed amounts to a “device [means] for recording” and is a means-plus-function limitation under 35 U.S.C. § 112(f). Pet. 20. Petitioner goes on to identify the portions of the Specification that describe the structure corresponding to the claimed function. *Id.* at 21 (citing Ex. 1001, 3:40–48, 11:13–19, 11:43–63).

Patent Owner counters that a “recording device” as claimed is not a means-plus-function term, and means “a device that captures and stores data for future retrieval.” Prelim. Resp. 13–17. Patent Owner’s interpretation relies on the related interpretation that “record” as claimed means to “store captured data for future retrieval.” Prelim. Resp. 14 (incorporating Patent Owner’s discussion of “record” as claimed at Prelim. Resp. 12).

a) *Storing Captured Data for Future Retrieval*

Patent Owner’s interpretation is undermined by the language of the claims. Independent claim 1 does not recite that either “recording device” stores captured data for future retrieval. Rather, independent claim 1 recites that the first set of record data “is recorded on a first computer-readable medium associated with the first recording device.”<sup>7</sup> Claim 1 does not recite that the recording device “includes” a computer readable medium. Rather, claim 1 recites that the recording device is “associated with” the computer-

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<sup>7</sup> See limitation 1[E].

readable medium, indicating that the computer readable medium need not be a part of the recording device. This interpretation is supported by the Specification, which describes that recording devices 14 and 18 may or may not include memory (a device to store captured data for future retrieval).<sup>8</sup> *See* Ex. 1001, 11:64–12:2. The remaining independent challenged claims (18, 36, 48) are similar. The associated computer-readable medium may store captured data for future retrieval instead of the recording device itself. Consequently, we disagree with Patent Owner’s assertion that a recording device as claimed must “store captured data for future retrieval.”

*b) Application of § 112(f)*

The standard for determining if §112(f) applies is whether a person of ordinary skill in the art understood the term to have a sufficiently definite meaning as the name for structure. *See Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015). Here, neither party provides convincing argument or evidence related to this issue. Despite the lack of this information, we make a preliminary determination.

The presumption is that §112(f) does not apply because the claim term at issue (“recording device”) does not use the word “means.” This presumption is overcome if the claim term fails to recite sufficiently definite structure, or recites function without reciting sufficient structure for performing that function. *Williamson*, 792 F.3d at 1349.

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<sup>8</sup> The Specification does not contain a lexicographical definition that would require either recording device to include memory (a device to store data for future retrieval).

In the context of the challenged claims, the term “device” does not provide any indication of structure because it sets forth the same black box recitation of structure for providing the function of “recording” as if the term “means” had been used. *See generally Williamson*, 792 F.3d at 1349 (noting that the term “device” is a nonce word, that is, a generic term tantamount to using the word “means”); *see also* Pet. 20 (noting that “device” is a nonce word). Thus, the recited “recording device” equates to a “recording means” or “means for recording.”

The claims specify that each recording device includes an input (*e.g.*, the first recording device includes a first input) that receives the record data that is recorded on an associated computer-readable medium. This high-level description does not inform the structural character of the “recording device.”

In light of the limited record before us, we preliminarily determine that the presumption is rebutted, and the claim term “recording device” invokes § 112(f).

The function of this limitation is “recording,” and the corresponding structure is cameras, audio recorders, thermal imagers, security cameras, radios, seismic sensors, radar and LIDAR scanners, chemical analyzers, and their equivalents. *See* Pet. 21; Ex. 1003 ¶ 118; Ex. 1001, 1:40–42, 3:40–46, 11:13–19, 11:43–45.

Alternatively, if § 112(f) does not apply, we determine a “recording device” as claimed is not limited to a device that captures and stores data for future retrieval as Patent Owner asserts, because the associated computer-readable medium performs that function.

2. “*recording device manager*” (Claims 1 and 36)

Independent claims 1 and 36 are each directed to a “recording device manager.”

Petitioner contends that a “recording device manager” as claimed is a means-plus-function limitation under 35 U.S.C. § 112(f). Pet. 22–24. Petitioner contends that the claimed function is “managing the synced recording devices by receiving communication signals from the first recording device, and transmitting communication signals to the second recording device in response to receiving the first communications.” *Id.* at 22. Petitioner identifies the portions of the Specification that describe the corresponding structure for performing the claimed function. *Id.* at 23 (citing Ex. 1001, 8:31–45, 9:37–10:6, 10:23–46).

Patent Owner counters that the term at issue does not invoke § 112(f) because claims 1 and 36 do not use the term “means” and Petitioner has not overcome the presumption that the limitation is not a means-plus-function limitation. Prelim. Resp. 18–19.

Here neither party provides convincing argument or evidence regarding whether a person of ordinary skill in the art understood the contested term to have a sufficiently definite meaning as the name for structure. *See Williamson*, 792 F.3d at 1348. Our preliminary interpretation is based on the record to this point.

The presumption is that § 112(f) does not apply because the claim term at issue (“recording device manager”) does not use the word “means.” This presumption is overcome if the claim term fails to recite sufficiently definite structure, or recites function without reciting sufficient structure for performing that function. *Williamson*, 792 F.3d at 1349.

When identifying the corresponding structure, Petitioner notes that the Specification describes that the recording device manger includes a controller having a receiver and transmitter, and further asserts that the device manager generates signals and receives information. Pet. 23. While acknowledging these features in the Specification, Petitioner does not address that each of these features is recited in claims 1 and 36. Consequently, Petitioner has failed to persuade us that the claim term fails to recite definite structure or recites function without reciting sufficient structure for performing that function.

We preliminarily determine that a “recording device manager” as claimed is not a means-plus-function limitation.

3. *“communicatively coupled” (Claims 1, 36, and 48)*

Independent claims 1 and 36 each recite that the first and second recording devices are “communicatively coupled” to the recording device manager. Claim 48 recites that certain other devices are “communicatively coupled.”

Petitioner contends that the ’292 patent uses the term “communicatively coupled” to mean “synced,” and requires “a communication path between devices.” Pet. 19–20 (citing to Patent Owner’s assertion in the related litigation regarding a communication path).

Patent Owner counters that Petitioner’s interpretation is of little use because Petitioner does not define “synced.” Prelim. Resp. 21. Patent Owner asserts that the plain and ordinary meaning of the term should be used, but does not specify that meaning. *Id.* Further, Patent Owner does not address the contention that “communicatively coupled” as claimed requires a communication path between devices.

The '292 patent describes that vehicle recording device 14 is “communicatively coupled (i.e., synced)” to recording device manager 12. Ex. 1001, 3:27–28, Fig. 1; *see also Abbott Labs. v. Novopharm Ltd.*, 323 F.3d 1324, 1330 (Fed. Cir. 2003) (determining that use of the term “i.e.” can provide a lexicographical definition).<sup>9</sup> We discern nothing in the '292 patent that is inconsistent with synced meaning that there is a communication path between devices. We preliminarily interpret “communicatively coupled” to mean “synced” in that there is a communication path between the devices.

#### 4. *Other Terms*

Petitioner addresses other terms<sup>10</sup> and Patent Owner counters that the plain and ordinary meaning should apply, but does not specify those meanings. *See* Pet. 21–22, 24–25; Prelim. Resp. 21–22. Our Decision here does not necessitate explicitly construing those other terms at this time.

#### E. CLAIM CONSTRUCTION IS AN OPEN ISSUE

Our claim interpretations are preliminary. During trial, the parties may address our interpretations above or the interpretation of any other claim term necessary for proper resolution of this case. Should the parties seek to further address the application of § 112(f) to the terms “recording device” or “recording device manager,” we ask that they include argument

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<sup>9</sup> If the intrinsic evidence supports another meaning, we ask that the parties address it. *See Pfizer, Inc. v. Teva Pharm., USA, Inc.*, 429 F.3d 1364, 1372–1373 (Fed. Cir. 2005) (noting that claim interpretation must be made in the context of the entire patent).

<sup>10</sup> Those terms are: “input” (All Claims), “insures” (All Claims), and “metadata” (Claims 21, 38, 39, 42, 51, 54).

and evidence regarding whether a person of ordinary skill in the art would have understood those terms to have a sufficiently definite meaning as the name for structure. The parties should also address any related findings made in district court or any other proceeding related to these terms.

### III. PATENTABILITY

#### A. EVIDENCE AND ASSERTED GROUND OF UNPATENTABILITY

Petitioner asserts that the challenged claims are unpatentable under 35 U.S.C. § 103(a) over Pierce<sup>11</sup> and 20/20-W.<sup>12</sup> Pet. 26–71; *see also* Pet. 5–15 (regarding the scope and content of the prior art); 17–18 (regarding the level of skill in the art).

Petitioner relies upon the Declaration of Henry Houh, Ph.D. Ex. 1003; *see also* Ex. 1004 (Curriculum Vitae). Petitioner provides the original file history of the '292 patent (Ex. 1005), as well as the Reexamination File History (Ex. 1006).

#### B. LEVEL OF SKILL IN THE ART

The parties are largely in agreement regarding the level of skill in the art. For example, each asserts a person of ordinary skill would have had at least a bachelor's degree in electrical engineering or a related field. Pet. 17;

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<sup>11</sup> U.S. 2005/0083404, published Apr. 21, 2005 (Ex. 1014).

<sup>12</sup> Raytheon JPS Communications, Raytheon Model 20/20-W, Raytheon 20/20 VISION, Digital In-Car Video Systems, White Paper WP-8002-11 (Ex. 1015). *See also* Exhibit 1016 regarding public availability of Exhibit 1015.

Prelim. Resp. 10–11. Additionally, each asserts that person would have had two years of experience. Pet. 17–18; Prelim. Resp. 10–11.

The parties’ proposed level of skill differs in two minor respects. First, Patent Owner more specifically refers to the experience as “experience designing,” while Petitioner refers to “experience” in an industrial or educational setting without mention of designing. Prelim. Resp. 10–11. Given that experience in an industrial or educational setting could include experience designing, this distinction is not significant. Second, Patent Owner asserts that such person would have had “a working knowledge of computing devices and their associated hardware (including recording devices and systems for communicatively coupling a central control system with recording devices) and software.” *Id.* Petitioner does not explicitly mention such working knowledge, but the educational and experience requirements asserted by Petitioner are consistent with the working knowledge asserted by Patent Owner.

Based on our review of the record to this point, to include the prior art references, a person of ordinary skill would have had at least a bachelor’s degree in electrical engineering or a related field. That person would have had two years of experience in an industrial or educational setting, to include design experience. Given this education level and experience, that person would have had a working knowledge of computing devices and associated hardware and software.

If during this proceeding the parties provide additional argument and evidence related to the level of skill in the art, it should focus on how that level impacts the obviousness analysis. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966); *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir.

2001) (The “level of skill in the art is a prism or lens through which a judge, jury, or the Board views the prior art and the claimed invention.”); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991) (“The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.”).

C. OBVIOUSNESS OVER PIERCE AND 20/20-W

Petitioner contends that the challenged claims would have been obvious over Pierce and 20/20-W. Pet. 26–71. Patent Owner presents a single set of arguments against the challenged claims. *See* Prelim. Resp. 25. Our analysis focuses on claim 1.

1. *Introduction to the References*

Pierce discloses a vehicle mounted data acquisition and display system and method of recording referred to as the ICOP 20/20. Pet. 26; Ex. 1014 ¶¶ 2, 18, Fig. 4a (“ICOP 20/20” in top left corner of the device). Pierce’s system includes a data acquisition and display system apparatus 10 that includes a number of cameras 62 (e.g., first camera 62a, second camera 62b). Ex. 1014 ¶¶ 35, 52, Figs. 1–3. The system includes central unit 30 housing controller 31 that is programmable to coordinate operation of system 10. *Id.* at ¶ 39.

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

2. *Petitioner's Contentions*

*I[A], [B]*

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

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

Petitioner contends that Pierce discloses a multiple recording device management system. Pet. 32–33. Petitioner contends the Pierce discloses a recording device manager (central unit 30 housing controller 31) including at least one receiver and at least one transmitter (communication connections, ports, or jacks 54 that receive data and transmit control signals). *Id.* at 32–35.

*I[C]–[E]*

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

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

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

Petitioner contends that Pierce discloses a first recording device (wireless microphone 68b) communicatively coupled with the recording device manager (central unit 30). Pet. 39–41.

Petitioner contends that Pierce's receiver (jack 54) is configured to receive a first communication signal from the first recording device

(wireless microphone 68b) indicating that device received an instruction initiated by a first law enforcement officer to record a first set of record data related to an event (*e.g.*, when RECORD button 72a or HELP button 72b are depressed).<sup>13</sup> Pet. 41–42. To the extent that Pierce does not disclose this limitation, Petitioner contends that 20/20-W discloses recording from three audio sources by default, and in view of this, it would have been obvious to modify Pierce to automatically trigger video and audio recording when the HELP button is depressed in order to record critical data. *Id.* at 42.

Petitioner contends that Pierce’s first recording device (wireless microphone 68b) includes a first input for receiving the first set of record data, and contends that the received first set of record data is recorded on a first computer-readable medium (recording media 44 of controller 31) associated with the first recording device. Pet. 43.

*I[F]*

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

Petitioner contends that Pierce discloses a second recording device (*e.g.*, car-mounted internal microphone 68a, car-mounted video cameras 62, or radar and LIDAR speed guns 77) communicatively coupled with the recording device manager (central unit 30). Pet. 44–46.

*I[G]*

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

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<sup>13</sup> Petitioner mistakenly refers to the HELP button as 72a (Pet. 41), but subsequently correctly identifies it as 72b (Pet. 42).

Petitioner contends that when Pierce's HELP button is depressed, the first recording device (wireless microphone 68b) and the second recording device (car-mounted internal microphone 68a, car-mounted video cameras 62, or radar and LIDAR speed guns 77) all begin recording data. Pet. 46. In light of this, Petitioner asserts that Pierce's receiver (jack 54 of central unit 30) is configured to transmit a second communication signal to the second recording device (car-mounted internal microphone 68a, car-mounted video cameras 62, or radar and LIDAR speed guns 77) instructing the second recording device to begin recording a second set of record data related to an event. *Id.*

Alternatively, Petitioner contends that 20/20-W's internal microphone actively records whenever the system is in record mode, and thus Pierce, as modified by 20/20-W, transmits a second communication signal to internal microphone 68a, to speed measuring apparatus 77, and to camera 62a. Pet. 46–47. Petitioner contends that it would have been obvious to modify Pierce's system in view of the 20/20-W Publication “in order to trigger the internal microphone 68a to begin recording in response to activation of the wireless microphone 68b.”<sup>14</sup> Pet. 36 (citing Ex. 1003 ¶¶ 175–177, 237, 238). Further, according to Petitioner, it would have been obvious to trigger other data recorders, such as Pierce's camera 62 to begin recording in response to activation of the wireless microphone 68b. *Id.* (citing Ex. 1003, ¶¶ 177–179, 237, 238). Petitioner contends this would allow Pierce to record and store data from underutilized data recorders for a more complete

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<sup>14</sup> Petitioner quotes claim 1 as requiring “transmitting the second signal in response to receiving the first communication signal.” Pet. 36. This appears to be an incorrect quotation of clause 1[K].

evidentiary record. Pet. 38. Petitioner further contends that the proposed modification would not require undue experimentation<sup>15</sup> and is nothing more than combining “prior art elements according to known methods to yield predictable results” and/or the “[u]se of known technique[s] to improve similar devices (methods, or products) in the same way.” *Id.* (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417–22 (2007)); Ex.1003 ¶ 177).

As a second alternative, Petitioner contends that to the extent that Pierce alone, and Pierce as modified by 20/20-W, do not disclose this limitation it would have been obvious. Pet. 47–48. Specifically, according to Petitioner, the modification was obvious to try as one of a finite number of predictable solutions, was predictable and would not have required undue experimentation, and was the use of a known technique to improve a similar device in the same way. *Id.*

The three versions discussed above can be summarized as contentions that this limitation is shown by: (1) Pierce alone, (2) Pierce and 20/20-W, and (3) an obvious variant of Pierce.

*1[H]*

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

Petitioner contends that Pierce’s second recording device (device car-mounted internal microphone 68a, car-mounted video cameras 62, or radar

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<sup>15</sup> We note that ordinarily “undue experimentation” is a concern under 35 U.S.C. § 112(a) while a “reasonable expectation of success” is a concern in an obviousness analysis.

and LIDAR speed guns 77) includes an input for receiving the second set of record data, and that data is recorded on a second computer readable medium associated with the second recording device. Pet. 49–50. Petitioner contends that 20/20-W discloses that audio from interior and remote transmitting microphones record on separate channels. *Id.* at 50. Thus, according to Petitioner, Pierce alone or as modified by 20/20-W discloses that the second recording device includes a second input for receiving the second set of record data, and wherein the received second set of record data is recorded on a second computer-readable medium associated with the second recording device. *Id.*

1[I]

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

Petitioner contends that Pierce’s first recording device (microphone 68b) is different from the second recording device (car-mounted internal microphone 68a, car-mounted video cameras 62, or speed measuring apparatus 77) so that the data recorded by each is different. Pet. 50–51.

1[J]

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

Petitioner contends that Pierce discloses that when either the HELP button (on microphone 68a) or the RECORD button is depressed, sound data is transmitted to the controller and recorded onto the recording media. Pet. 51. Petitioner contends that Pierce alone or Pierce as modified by 20/20-W discloses that an activation signal or second communication signal is sent from controller 31 to microphone 68a to begin recording. Pet. 51–52. Petitioner contends that Pierce alone or as modified in view of 20/20-W discloses an activation signal or second communication signal can be sent from controller 31 to cameras 62a, 62b and speed measuring apparatus 77 instructing these devices to begin recording. *Id.* at 52.

In light of this, Petitioner contends that Pierce alone or in combination with 20/20-W discloses that a second communication signal that is transmitted to the second recording device (microphone 68a or speed measuring apparatus 77) in response to the first communication signal being received by controller 31 via port 54. *Id.* at 52–53.

*1[K]*

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

Petitioner contends that microphone 68b is configured to be carried by a law enforcement officer. Pet. 53.

### *3. Patent Owner's Arguments*

Patent Owner makes five contentions in support of the argument that the proposed ground of unpatentability does not disclose the second communication signal. Prelim. Resp. 22–23.

*a) expert*

Patent Owner argues that Petitioner's expert, Dr. Houh, admits that the proposed combination may not disclose the second communication signal. Prelim. Resp. 22–23.

To the extent that Patent Owner is suggesting that Dr. Houh concedes that the proposed combination does not disclose the second communication signal, we disagree. Dr. Houh opines that Pierce alone or as modified by the 20/20-W publication, “may not provide an express disclosure of the entire function of the ‘recording device manager.’” Ex. 1003 ¶ 178. Dr. Houh then elaborates on an alternative contention regarding the limitation at issue. *Id.* Expression of an alternative contention is not an admission that the proposed combination does not disclose the limitation at issue.

*b) Pierce*

Patent Owner contends that Pierce does not disclose the claimed second communication signal. Prelim. Resp. 25–36. In support, Patent Owner contends that Pierce's devices (wireless microphone 68b, car-mounted internal microphone 68a, car-mounted video cameras 62, and radar and LIDAR speed guns 77) do not capture and store data for future retrieval and therefore are not recording devices as claimed. *Id.* at 13–17, 25–26. This assertion implicitly relies on Patent Owner's claim interpretation that a recording device stores captured data for future retrieval. As explained in our claim construction above, a recording device as claimed need not store captured data for future retrieval. Accordingly, Patent Owner's argument is not persuasive because it is not commensurate in scope with claim 1 as properly construed.

Patent Owner contends that the signal alleged to be a second communication signal as claimed is activated in response to operator input, not in response to receipt of a first communication signal. Prelim. Resp. 26–27. In particular, Patent Owner notes that Pierce’s interface 40 includes an “INT MIC” button for activating the internal microphone. *Id.* (citing Ex. 1014, Fig. 4a).

This contention is not responsive to the ground of unpatentability articulated by Petitioner. Petitioner does not rely on activation of the “INT MIC” button of user interface 40 of central unit 30. *See* Ex. 1014 ¶¶ 44, Fig. 4a. Rather, as detailed above, Petitioner asserts that when the HELP button 72a<sup>16</sup> of microphone 68a (first recording device) is activated, a second recording device (image sensor of camera 62a, audio transducer of microphone 68a, or radar or LIDAR sensor of speed measuring apparatus 77) is activated. Pet. 46 (citing Ex. 1014 ¶¶ 68, 84; Ex. 1003 ¶¶ 152, 172). In other words, Petitioner contends that the transmitter of the recording device manager (central unit 30 having a controller 31) transmits a second communication signal (the distress call from HELP button 72b) to the second recording device (car-mounted internal microphone 68a, car-mounted video cameras 62, or radar and LIDAR speed guns 77) instructing the second recording device to begin recording a second set of record data.

Patent Owner contends that Pierce does not teach that the controller sends a second communication signal to any input device in response to activation of the HELP button. Prelim. Resp. 28–29. In particular, Patent

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<sup>16</sup> Petitioner explains, and Patent owner does not contest, that HELP button 72a referred to in paragraph 68 of Pierce is the same as the CALL button referred to in paragraph 84. *See* Pet. 41; Ex. 1003 ¶¶ 152, 172.

Owner emphasizes that various input devices such as cameras 62a and 62b are already recording when the HELP button is activated so that a signal to those devices to begin recording is not needed. *Id.* (citing Ex. 1014 ¶ 84). For the reasons that follow, Patent Owner's argument is not persuasive.

Pierce discloses that in some constructions of the device (i.e., some embodiments) data is continuously recorded (e.g., video from cameras 62a, 62b and sound data from microphones 68a, 68b), and this data is recorded over until EVENT recording is triggered such as by activation of HELP button 72a. Ex. 1014 ¶ 86; *see also* ¶¶ 58, 61 (describing the cameras and microphones). When this occurs, recording media 44 saves the previously recorded data (up to 1 minute) and continues to record and save that data until an operator presses STOP. *Id.* Regarding this embodiment, Patent Owner is right that data is already being recorded and for that reason no signal to begin recording need be sent to an input device (e.g., microphones 68a, 68b). However, the disclosure that data may alternatively be continuously recorded indicates that there is an embodiment that is not recording when EVENT recording is triggered (such as by activation of HELP button 72a). In this embodiment, a signal to input devices (e.g., microphones 68 or cameras 62) would be necessary. Consequently, we are persuaded by Petitioner's contention that in Pierce's system, when an officer activates the HELP button 72a of the first recording device (second microphone 68a), the controller causes the second recording device (image sensor of camera 62a, audio transducer of microphone 68a, or radar/LIDAR sensor of speed measuring apparatus 77) to begin recording data. *See* Pet. 46.

Patent Owner goes on to repeat the contention that Petitioner's expert, Dr. Houh, recognizes that Pierce does not disclose a second communication signal as claimed, and further contends that Dr. Houh's testimony does not add to the Petition. Prelim. Resp. 30–36. As detailed above, Dr. Houh presents an alternative contention and does not concede that Pierce fails to disclose a second communication signal. Further, Patent Owner's attacks on Dr. Houh's testimony are based on the same incomplete interpretation of Pierce discussed above.

*c) 20/20-W*

Patent Owner contends that 20/20-W does not disclose the claimed second communication signal. Prelim. Resp. 36–46. In general, Patent Owner's contention parallels that against Pierce for this limitation. Specifically, Patent Owner contends that a signal to the input devices would not be needed because the input devices are already recording; however, 20/20-W expressly discloses that activation of the Officer help button activates video and audio recordings "if not previously activated." Ex. 1015, 17 (¶ 2.10, third bullet).

*d) Rationale*

Patent Owner contends that Petitioner's rationale for modifying Pierce in view of 20/20-W is inadequate.<sup>17</sup> Prelim. Resp. 46–49. In particular, Patent Owner contends that Petitioner's reasoning and that of Petitioner's expert is conclusory. Further, according to Patent Owner, Petitioner

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<sup>17</sup> This rationale applies to modifications of Pierce in view of 20/20-W and not to the versions of this ground of unpatentability based on Pierce without modification or an obvious variant of Pierce.

explains the result of the combination rather than a reason for making the combination. *Id.*

As detailed above, Petitioner asserts that the proposed modifications of Pierce are nothing more than combining prior art elements according to known methods to yield predictable results and/or use of a known technique to improve similar devices in the same way. Pet. 38. Petitioner explains that by activating more recorders as taught by 20/20-W, the modified device has the advantage of producing a more complete evidentiary record. *Id.*; *see also* Ex. 1014 ¶¶ 4–6 (describing that the 20/20-W apparatus utilizes underutilized recording devices and produces a record that might increase deterrence of crime). Patent Owner’s contentions do not address Petitioner’s reasoning. At this stage of the proceeding, we are persuaded that Petitioner has provided a sufficient rationale for the proposed combination.

#### 4. *Conclusion*

Petitioner has demonstrated a reasonable likelihood of prevailing in establishing that claim 1 is obvious over: (1) Pierce without modification, (2) Pierce and 20/20-W.<sup>18</sup>

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<sup>18</sup> As detailed above, Petitioner contends that if Pierce alone, and Pierce combined with 20/20-W do not disclose a second communication signal, it would have been an obvious variant. Pet. 47–48. Given that, as detailed above, we determine that Petitioner has demonstrated sufficiently that Pierce alone, or Pierce as modified by 20/20-W, discloses a second communication signal as claimed, the contingency for assertion of this alternative has not been met. Consequently, this alternative is not part of this proceeding going forward.

Patent Owner does not present additional argument with regard to the remaining challenged claims. We have reviewed Petitioner's ground of unpatentability and underlying evidence against these claims. On the record before us, Petitioner has demonstrated a reasonable likelihood of prevailing in the contention that these claims are unpatentable.

#### IV. ORDER

Accordingly, it is

ORDERED that *inter partes* review is instituted with respect to claims 1, 3, 8, 18, 20, 21, 24, 26, 27, 29–31, 36, 38, 39, 42, 43, 45, 46, 48, 50, 51, 54, 55, 57, and 58 as unpatentable under 35 U.S.C. § 103(b) as obvious over Pierce alone and under 35 U.S.C. § 103(b) as obvious over Pierce and 20/20-W.

FURTHER ORDERED that no other ground of unpatentability is authorized for this *inter partes* review; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '292 patent is hereby instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

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