**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| In re *Inter Partes* Review of: | ) |
| U.S. Patent No. 7,907,793 | ) |
| Issued: March 15, 2011 | ) |
| Application No.: 12/542,498 | ) |
| Filing Date: 8/17/2009 | ) |
| Priority Date: 5/4/2001 | ) |

For: IMAGE SEQUENCE DEPTH ENHANCEMENT SYSTEM AND METHOD

*Filed via Patent Trial Appeal Board End-to-End (PTAB-E2E) system*

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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Prime Focus Creative Services Canada Inc.,

Petitioner

v.

Legend3D, Inc.,

Patent Owner

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Case IPR2016-01243

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**PATENT OWNER LEGEND3D, INC.'S REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. § 42.71(c)**

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Pursuant to 37 Code of Federal Regulations ("CFR") § 42.71(c), Patent Owner Legend3D, Inc., ("Patentee"), hereby submits the following Request for Rehearing in response to the Decision for Institution of *Inter Partes* Review of U.S. Patent No. 7,907,793 (the " '793 Patent").

## I. STATEMENT OF PRECISE RELIEF REQUESTED

The Board ordered review based on all grounds of unpatentability of claims 1-20 of the '793 Patent. Patentee requests reconsideration of the Decision to Institute on claims 1-20, at least because (1) the Decision is based on an unsworn and unsigned expert declaration that is not evidence, (2) relies on an incorrect version of a critical claim term that is not in accordance with Petitioner's definition, (3) overlooks inherency compliance, *even using Petitioner's own claim construction*, and (4) is based incorrectly on a lack of written description argument as well as lack of inherency argument, both created by the PTAB on behalf of Petitioner. Patentee requests that the Decision to institute be vacated.

## II. LEGAL STANDARDS

A request for rehearing "must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or reply." (37 CFR § 42.71 (d)). "When rehearing a decision on petition, the panel will review the decision for an abuse of discretion." (37 CFR § 42.7 1(c)) "An abuse of discretion

occurs where the decision (1) is clearly unreasonable, arbitrary, or fanciful ["**R1**"]; (2) is based on an erroneous conclusion of law ["**R2**"]; (3) rests on clearly erroneous fact findings ["**R3**"]; or (4) involves a record that contains no evidence on which the Board could rationally base its decision. ["**R4**"]" (*Stevens v. Tamai* (Fed. Cir. 2004) 366 F.3d 1325, 1329, quoting *Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wash*. (Fed. Cir. 2003) 334 F.3d 1264, 1266-67) (**R1-R4** added.[1])

## III. BASIS FOR RELIEF REQUESTED

The PTAB asserts that Petitioner relies on the '081 and '067 patents as teaching or suggesting every limitation of claims 1, 13 and 20 except "depth parameter" (Decision, pp. 6-7). Thus, the entire institution decision boils down to whether Patentee's own '081 and '670 patents inherently support a claim of priority for "depth parameter" from the '793 Patent.

### A. Petitioner's Expert did not sign his Decl. under penalty of perjury, so the Decl. is not evidence

The Decision is based on material that is not evidence in the case as Petitioner's purported expert declaration of David Forsyth is not under oath or affirmation or penalty of perjury as required by law. (Federal Rules of Evidence Rule 603; 28 United States Code § 1746; and 37 CFR §§ 1.68, 42.2, 42.53(a), 42.63(a), *Coalition for Affordable Drugs IX, LLC v. Bristol-Myers Squibb*

[1] All emphasizing herein is added unless otherwise noted.

*Company*, Case No. IPR01723, at p. 6, fn. 5, (PTAB February 22, 2016) (Paper 10)) The supposed declaration is also unsigned and unsubscribed. (*Ibid.*) The aforesaid "declaration" is therefore not evidence. (See, e.g., *Gemtron Corp. v. Saint-Gobain Corp.* (Fed. Cir. 2009) 572 F.3d 1371, 1380 [unsworn attorney argument is not evidence]) The Decision to institute should accordingly be vacated based on lack of evidence (**R4**).

### B. The PTAB instituted based on an incorrect version of the Petitioner's construction of depth parameter

The Decision is based on an incorrect version of Petitioner's construction of depth parameter. Although the Decision quotes Petitioner's construction properly (at p. 8, first full paragraph), the PTAB then proceeds to base its decision on a faulty construction thereof (at p. 9, first full paragraph):

> … Dr. Forsyth attests that "**depth parameter**" relates to the **distance** of an object from a camera, … On the record … not entitled to a priority date …

The PTAB relied on "…'depth parameter' relates to the **distance** of an object from a camera", yet Petitioner's construction is "relates to the ***perceived* distance** of an object from the camera" (Pet., p. 10:5-8 [emphasis added]).

This distinction is critical since Patentee has provided extensive arguments that the color parameters taught in the '081 Patent (**H**ue, **S**aturation, **L**uminance) may be used as depth parameters (**S**aturation, **L**uminance) that alter the ***perceived* distance** of an object from the camera (Response pp. 2-15), even if there is no

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