

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRIME FOCUS CREATIVE SERVICES CANADA INC.,

Petitioner,

v.

LEGEND3D, INC.,

Patent Owner

Case IPR2016-01243

Patent 7,907,793 B1

**PATENT OWNER'S AND PETITIONER'S JOINT LIST OF
PROPOSED MOTIONS**

Mail Stop Patent Board
Patent Trial and Appeal Board
P.O. Box 1450
Alexandria, VA 22313-1450

In preparation for the January 17, 2017, 12:00 PM Eastern Time initial conference call scheduled in this proceeding, and pursuant to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48765-66 (August 14, 2012), Patent Owner Legend3D, Inc. ("Legend3D") and Petitioner Prime Focus Creative Services Canada Inc. ("Prime Focus") provide the following list of motions each respective party is currently considering filing. This list is provided without prejudice to either party's right to seek authorization to file additional motions or to decide not to file motions listed.

Motions Proposed by Petitioner Prime Focus

I. Motion for Sanctions under 37 C.F.R. § 42.12(b)

Per Prime Focus's email to the Board on January 6, 2016, Prime Focus contends that the Patent Owner has made certain misrepresentations to the Board in its Preliminary Response. Specifically, in light of at least representations made by Patent Owner to the USPTO during the original prosecution of the challenged patent as well as statements made by Patent Owner to the District Court in parallel litigation, Prime Focus contends that Patent Owner has misrepresented the meaning of the term "depth parameter" in order to try to preserve the claim of priority from the challenged '793 Patent to U.S. Patent Nos. 7,181,081 and 7,333,670.

Prime Focus seeks an order that: (a) holds that none of the claims in the challenged '793 Patent can claim priority to the '081 or '670 Patents; and (b) precludes Patent Owner from arguing that any claim related to 2D-to-3D conversion within a continuation or CIP of the challenged '793 Patent can claim priority to the '081 or '670 Patents.

Prime Focus has conferred with Patent Owner about this issue but the parties were unable to reach agreement.

II. Motion to Submit Supplemental Information

Patent Owner objected to Prime Focus's expert's declaration as "not under oath or affirmation or penalty of perjury." Paper 18 at p. 2 (Jan. 5, 2017). In response, Prime Focus timely served on Patent Owner supplemental evidence in the form of an additional declaration from Prime Focus's expert, Dr. Forsyth, to address the alleged deficiency. As Patent Owner's objection goes to the admissibility of the original declaration, Prime Focus believes that its additional declaration is properly handled as supplemental evidence. However, in an abundance of caution in the event that the Board understands Patent Owner's objection to operate in a different manner, Petitioner seeks authorization to file the additional declaration as supplemental information.

The parties have met and conferred about this issue.

Motions Proposed by Patent Owner Legend3D

1. Motion to Submit Supplemental Information Pursuant to 37 Code of Federal Regulations (“CFR”) § 42.123. Legend3D Requests authorization to file a Motion to Submit Supplemental Information that is relevant to a claim for which the trial has been instituted. Specifically, Legend3D seeks to submit the following supplemental information:

- (1) *Maleficent* Up Close Video from Prime Focus’s website;
- (2) A research paper from December 2005 entitled “*Converting 2D to 3D: A Survey*” by Qingqing Wei, Delf University of Technology, the Netherlands (previously submitted by Patent Owner in IPR2015-01350 as Exhibit 1014);
- (3) 1995 book entitled “*Perception of Space and Motion*”, Chapter 3: “*Perceiving layout and knowing distances: The integration, relative potency, and contextual use of different information about depth*” by Cutting & Vishton; and
- (4) 1991 section on “*How to Reinforce Perception of Depth in Single Two-Dimensional Pictures*” by Shojiro Nagata from the book entitled “*Pictorial communication in Virtual and Real Environments*”.

The above Supplemental Information is relevant to a claim for which trial has been instituted per 37 CFR § 42.123(a).

2. Contingent Motion to Amend Claims pursuant to CFR §

42.121. Legend3D may wish to file a motion to amend claims. Legend3D's motion to amend would be contingent upon the PTAB's decision. Legend3D would request that its motion only be considered if the PTAB chooses to invalidate any of the claims in the 7,907,793 B1 Patent.

3. Motion for Additional Discovery pursuant to 37 CFR §

42.51(b)(2). Legend3D believes additional discovery is warranted in relation to factual assertions advanced by either party in the proceeding. Specifically, Legend3D seeks to depose Richard Baker, an employee of Prime Focus (Sn. Stereo Supervisor), who appears and narrates a portion of the *Maleficent Up Close Video* (above). Legend3D asserts that this Additional Discovery is warranted because it directly relates to the issues of Saturation and Luminance being used as depth parameters to affect depth, and the *Graham* secondary consideration of nonobviousness copying factor.

4. Motion for Sanctions for Misrepresentations by Petitioner.

Legend3D may seek to file a Motion for Sanctions pursuant to either 37 CFR § 42.11 or § 42.12 for certain improper conduct amounting to misrepresentations made by Petitioner to the Board in this proceeding.

First, Petitioner's assertions that counsel for Legend3D has made various unspecified "misrepresentations" for advancing a legal argument is,

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