

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

IPR2016-01243

U.S. Patent No. 7,907,793

PETITIONER'S REQUEST FOR REHEARING

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
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I. BACKGROUND

On pages 16 through 18, the Petition argued reasons that a person of ordinary skill would have to combine the prior art '081 and/or '670 Patents with prior art Sullivan and also separately with prior art Passmore. These reasons were supported by evidence within the prior art and also the expert testimony of Dr. David Forsyth. Paper 1 at p. 16-18; Ex. 1009 ¶¶ 45-46, 48-49.

In its Preliminary Response, Patent Owner did not challenge the proffered reasons to combine or evidence in support thereof. Rather, Patent Owner argued only that the reasons to combine were moot because they relied on references that Patent Owner asserted were not prior art. Paper 12 at p. 27.

The Board instituted IPR on multiple grounds that combined Sullivan with the '081 Patent and/or '670 Patent. Paper 14 at p. 16. After noting the Petition's arguments regarding reasons to combine and Patent Owner's non-response to these reasons, the Institution Decision held that there was a reasonable likelihood that the challenged claims were obvious over the Sullivan combinations. *Id.* at p. 11-14.

In its Response, Patent Owner never disputed the reasons to combine or evidence in support thereof. *See* Paper 36. Nor did the Patent Owner's expert dispute the reasons to combine. *See* Exs. 2024 and 1040. The only new evidence on the issue was introduced when Patent Owner asked Petitioner's expert, Dr. Forsyth, a handful of questions related to reasons to combine, and Dr. Forsyth

responded with answers that were fully supported by evidence in the record. *See* Ex. 2018 at 24:10-34:22. In short, Patent Owner never introduced any evidence or argument disputing the combinability of Sullivan or Dr. Forsyth’s conclusions.

At the oral hearing, the Board did not ask any questions regarding reasons to combine, nor did Petitioner present any argument specifically directed to reasons to combine. *See* Paper 53. Patent Owner did not appear at the oral hearing and therefore did not make any argument regarding reasons to combine. *Id.* at p. 2. Thus, by the end of the trial on the merits, no evidence in the record disputed Dr. Forsyth’s findings regarding the combinability of Sullivan, and neither Patent Owner nor the Board had never disputed the combinability of Sullivan.

In its Final Written Decision, the Board held that the Petition established sufficient reasons to combine Passmore with the ‘081 and/or ‘670 Patents, especially since Patent Owner did “not address Petitioner’s arguments or evidence regarding...rationale for the combination.” *See* Paper 54 at p. 28-29. However, the Board held that Petitioner had not carried its burden regarding reasons to combine Sullivan, even though the reasons to combine Sullivan relied on *uncontroverted* evidence. *See id.* at p. 42-45. The Board based its holding regarding the Sullivan combination in part on testimonial evidence that had never been cited or discussed by anyone. *Id.* at 44 (*citing* Ex. 2021 at 31:12-15).

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