

UNITED STATES PATENT AND TRADEMARK OFFICE

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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

Patent 7,907,793 B1

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**PATENT OWNER'S AND PETITIONER'S JOINT NOTICE  
REGARDING STATUS OF THE RELATED UNITED STATES  
DISTRICT COURT CASE AND SETTLEMENT DISCUSSIONS**

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

On January 17, 2017, 12:00 PM Eastern Time an Initial Conference Call in this proceeding was held 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") (together, the "Parties") provide the following Joint Statement Regarding the Status of the Related United States District Court, Central District of California ("USDC"), Case Number 2:15-cv-02340-MWF-PLA and Settlement Discussions as ordered by the Patent Trial and Appeal Board (PTAB) during the Initial Conference Call.

**United States District Court, Central District of California Case**

**Summary (and related actions)**

A complaint was filed by Prime Focus on March 30, 2015, as to U.S. Patent No. 8,922,628 ("the '628 Patent"): *Prime Focus Creative Services Canada, Inc. v. Legend3D, Inc.*, United States District Court, Central District of California, Case Number 2:15-cv-02340-MWF-PLA. On March 28, 2016, Legend3D filed a petition for *inter partes* review of the '628 Patent (IPR2016-00806), which was instituted as to all claims (claims 1-18) on September 19, 2016.

On April 21, 2016, Legend3D timely filed its Answer and Counter Claim asserting infringement of U.S. Patent No. 7,907,793 ("the '793

Patent”). On April 22, 2016, Legend3D further requested leave to file a supplemental counterclaim on U.S. Patent No. 9,286,941 (“the ‘941 Patent”). The Court denied the request for leave to file a supplemental counterclaim without prejudice. Prime Focus filed a petition for *inter partes* review of the ‘793 Patent on June 21, 2016, which matured into the present proceeding (IPR2016-1243). Prime Focus then filed a petition for *inter partes* review of eighteen of the thirty (30) claims of the ‘941 Patent on July 26, 2016, (IPR2016-01491), and an institution decision in that proceeding is expected by Feb 13, 2017.

On October 17, 2016, the Court stayed the proceedings as to claims and defenses related to the ‘628 Patent.

On September 14, 2016, the Court stayed the proceedings as to the ‘793 Patent, pending the decision in IPR2016-01243. The parties stipulated to agree to continue the stay after the PTAB instituted proceedings on December 20, 2016; the Court entered that stipulation on January 13, 2017.

### **Settlement Discussions**

To date the parties have not had settlement discussions. The parties previously indicated to the Court that alternative dispute resolution was contemplated to occur after the completion of discovery. Discovery was stayed as a result of the IPR proceedings and remains stayed at this time.

The parties currently do not have any settlement discussions scheduled.

Dated: January 19, 2017

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

Pursuant to 37 Code of Federal Regulations § 42.6, the undersigned certifies that on January 19, 2017, a copy of the foregoing document was served by ELECTRONIC MAIL, as agreed to by the parties and on counsel of record identified below, and that this document was filed with the Patent Trial and Appeal Board via the PTAB End-to-End System.

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