

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

Before LYNNE E. PETTIGREW, CARL M. DEFRANCO, and
KAMRAN JIVANI, *Administrative Patent Judges*.

JIVANI, *Administrative Patent Judge*.

Conduct of the Proceeding
37 C.F.R. § 42.5

A. INTRODUCTION

On January 17, 2017, an initial conference call was conducted between respective counsel for the parties and Judges Pettigrew and Jivani. Prime Focus Creative Services Canada, Inc. (“Petitioner”) was represented by Mr. Joshua Glucoft. Legend3D, Inc. (“Patent Owner”) was represented by Mr. Joseph Mayo and Ms. Danna Cotman. The general purpose of the call was to resolve the parties’ dispute regarding Due Dates 1 and 2 set forth in the Scheduling Order (Paper 15), and discuss the parties’ requests for authorization to file several motions contemplated by the parties and identified in their Joint List of Proposed Motions (Paper 21) (“Joint List”).

B. SCHEDULING ORDER

Patent Owner sought an extension of Due Date 1 by three weeks. Petitioner opposed this extension, preferring the schedule remain unchanged, and offered an alternative counter proposal to extend Due Dates 1 and 2 each by 3 weeks. After significant negotiations, the parties agreed to extend Due Date 1 by one and half weeks and Due Date 2 by one week. The parties subsequently filed on January 17, 2017 a joint stipulation extending Due Date 1 from March 16, 2017 to March 27, 2017 and Due Date 2 from June 16, 2017 to June 23, 2017.

C. STATUS OF RELATED PROCEEDINGS AND SETTLEMENT NEGOTIATIONS

The parties identify the following related litigation: *Prime Focus Creative Services Canada Inc. v. Legend3D, Inc.*, Central District of California, Case No. 2:15-cv-2340-MWF-PLA, filed on April 21, 2016. Pet. 1. During the conference, we directed the parties to submit a brief statement

summarizing the status of this related proceeding as well as the status of any settlement negotiations between them no later than January 31, 2017. On January 19, 2017, the parties filed a Joint Notice (Paper 21) stating the parties do not have any settlement discussions scheduled and that the Central District of California litigation is stayed pending conclusion of the instant *inter partes* review as well as IPR2016-00806, instituted on claims 1–18 of U.S. Patent No. 8,922,628. Joint Notice 2–3.

D. REQUESTS FOR AUTHORIZATION OF MOTIONS

1. Generally

The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b).¹ A party desiring to file a motion should request a conference to obtain authorization to file the motion after first conducting a meet and confer with the opposing party.

2. Petitioner’s Proposed Motion to Submit Supplemental Information

Petitioner seeks authorization to file a motion to submit “supplemental information,” namely a corrected declaration of David Forsyth, Ph.D. Joint List 2. Petitioner’s proposed motion arises from the following events.

In support of its June 21, 2016 Petition, Petitioner contemporaneously filed a declaration made by Dr. Forsyth (Ex. 1009). On September 23, 2016, Patent Owner filed a Preliminary Response (Paper 12). We instituted trial in this matter on December 20, 2016. Paper 14 (“Dec.”). On January 5, 2017, pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner objected to Dr. Forsyth’s

¹ Discussion of some motions for which prior authorization is not required may be found in the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,762–63 (Aug. 14, 2012).

declaration because it was not made under oath or affirmed under penalty of perjury. Paper 18, 2.

During the conference, Patent Owner stated that Petitioner timely served on Patent Owner a corrected declaration of Dr. Forsyth, which constitutes supplemental evidence pursuant to 37 C.F.R. § 42.64(b)(2). Petitioner represented the corrected declaration contains no substantive changes to the original declaration beyond containing a signature affirmed under penalty of perjury. Patent Owner does not dispute this characterization, but nevertheless opposes Petitioner's proposed motion to submit this corrected declaration because it is not properly characterized as "supplemental information."

We agree with Patent Owner that the corrected declaration of Dr. Forsyth constitutes supplemental evidence under 37 C.F.R. § 42.64(b)(2) and not supplemental information pursuant to 37 C.F.R. § 42.123. Supplemental information is generally information Petitioner intends to use to support an argument on the merits. By contrast, supplemental evidence is served in response to an objection to the admissibility of evidence. Supplemental evidence is normally served on the objecting party, and may be filed only with an opposition to a motion to exclude the objected to evidence. *See GoPro, Inc. v. Contour IP Holding LLC*, Case IPR2015-01078 (PTAB Apr. 7, 2016) (Paper 40); *Handi Quilter, Inc. v. Bernina Int'l AG*, Case IPR2013-00364 (PTAB Jun. 12, 2014) (Paper 30).

Accordingly, we do not authorize this motion. Given the facts of this specific case, however, we authorize and direct Petitioner to file the corrected declaration of Dr. Forsyth no later than five business days from the date of this Order. This declaration shall be titled "CORRECTED

DECLARATION of David Forsyth, Ph.D.,” bear exhibit number 1009, and not contain substantive changes to the original declaration beyond containing a signature of Dr. Forsyth affirmed under penalty of perjury.

3. *Petitioner’s Proposed Motion for Sanctions under 37 C.F.R. § 42.12(b)*

Petitioner seeks authorization to file a motion for sanctions on the basis “that the Patent Owner has made certain misrepresentations to the Board in its Preliminary Response.” Joint List 1. Petitioner stated during the conference that this motion is ripe because Petitioner may be required to prepare and defend its witness Dr. Forsyth during deposition on Patent Owner’s proposed construction of the term “depth parameter,” which Petitioner asserts is inconsistent with Patent Owner’s prior statements. Patent Owner opposes this proposed motion. After each party presented its positions with respect to this proposed motion, we took this matter under advisement.

Having considered the parties’ arguments, we are not persuaded this motion is warranted at this time. The sanctions Petitioner seeks would preclude Patent Owner from asserting its priority claim—a matter central to our determination to institute this trial. *See* Dec. 6–10. Although we are mindful that Petitioner may be required to prepare and defend its witness Dr. Forsyth during deposition on Patent Owner’s proposed construction of the term “depth parameter,” we are not persuaded that this burden outweighs the significant burden to the parties of extensive motions practice on these weighty allegations. In essence, Petitioner’s motion would accelerate this trial to bring about a final decision on patentability without the benefit of the

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