

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 OBJECTIONS TO EVIDENCE
PURSUANT TO 37 CFR § 42.64**

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

I. INTRODUCTION

Pursuant to 37 Code of Federal Regulations (“CFR”) § 42.64(b)(1), Patent Owner Legend3D, Inc. (“Patentee” or “LEGEND3D”) hereby submits the following Objections to Evidence in relation to the below filings by Petitioner Prime Focus Creative Services Canada Inc., (“Petitioner”) in connection with this *inter partes* review (“IPR”). For these purposes, the Federal Rules of Evidence (“FRE”) are applicable hereto. (37 CFR § 42.62(a))

II. OBJECTIONS TO EVIDENCE

Prime Focus Exhibit 1009 (Corrected Declaration of Dr. David Forsyth)

PREFACE AND OBJECTION: Patentee previously objected to the first iteration of this exhibit (Paper 18) based on the fact that the subject exhibit, *upon which the institution decision was based*, was not under oath or affirmation or penalty of perjury as required by law. (FRE, Rule 603; 28 United States Code (“USC”) § 1746; and 37 CFR §§ 1.68, 42.2, 42.53(a), 42.61(a) [*“Evidence that is not taken, sought, or filed in accordance with this subpart is not admissible.”*]), 42.62(a), 42.63(a), *Coalition for Affordable Drugs IX, LLC v. Bristol-Myers Squibb Company*, Case No. IPR01723, at p. 6, fn. 5, (PTAB February 22, 2016) (Paper 10)) The aforesaid “declaration” was 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]; *Apple, Inc. v. DSS Tech.*

Mgmt., Inc., Case IPR2015-00369, at 8 (PTAB Aug. 12, 2015) (Paper 14) [expert declaration merely repeating assertion(s) in petition entitled to little or no weight].), and, accordingly, the subject petition was unsupported by any evidence and this defect should have been fatal to the petition.

Under analogous circumstances, institution of review has been denied notwithstanding a motion to submit a corrected exhibit. (*Zhongshan Broad Ocean Motor Co, Ltd., et al. v. Nidec Motor Corp.*, Case No. IPR2014-01121, at 9-12 (PTAB Jan. 21, 2015) (Paper 20)) Notably, no motion was made by Petitioner (via 37 CFR §§ 42.20-42.22, or otherwise) for leave to file a corrected declaration or to suspend the Rules applicable to this proceeding under 37 CFR § 1.83. In the present instance, and as expressly recognized by the Board’s order in this proceeding (Paper 20, pp. 2-4), Petitioner moved only to submit “supplemental information” as distinct from “supplemental evidence” (which this is) that is governed by a different process (see 37 CFR § 42.64(b)(2)) and Petitioner failed to demonstrate any clerical or typographical error.

To be sure, the “corrected” portion of the exhibit was simply not in existence at the time of the original filing—and it was not omitted due to correctable error because no such showing was made by Petitioner—and as such there was no legal basis to correct any clerical error. (*Ford Motor Co. v. U.S.* (Fed. Cir. 1998) 157 F.3d 849, 860) As with *Zhongshan*, any purported “mistake” resulted from a

failure to include a legal prerequisite to admissibility at all until attention was later drawn to the error by Patentee since the “corrected” portion was clearly created after the fact given the same is acknowledged to be “*supplemental evidence.*”

Consequently, Patentee objects to Petitioner being allowed to even file a supposedly “corrected” declaration since the form of the document when first presented prevented it from being given any substantive consideration in the same way as any other inadmissible evidence should not be considered and constitutes a lack of threshold proof required by 35 USC § 314(a). The faulty institution of review based thereupon was error to the extent of rendering the proceeding *void* (see *VanderMolen v. Stetson* (D.C. Cir. 1977) 571 F.2d 617, 624, citing *Vitarelli v. Seaton* (1959) 359 U.S. 535; *Service v. Dulles* (1957) 354 U.S. 363; *Accardi v. Shaughnessy* (1954) 347 U.S. 260) and allowing correction only compounds the error to Patentee’s prejudice by forcing its participation in a nullity.

Of course, an IPR proceeding as a formal administrative adjudication is subject to the Administrative Procedures Act (“APA”). (See *SAS Institute, Inc. v. ComplementSoft, LLC* (Fed. Cir. 2016) 825 F.3d 1341, 1351) Under the APA, an agency **must** follow its own regulations, and the failure to do so is a due process violation. (*Stainback v. Mabus* (D. D.C. 2009) 671 F.Supp.2d 126, 138, and cases cited therein including without limitation *Frizelle v. Slater* (D.C. Cir. 1997) 111 F.3d 172, and *VanderMolen v. Stetson* (D.C. Cir. 1977) 571 F.2d 617, 626-628)

Additionally, as an administrative procedure, the agency is subject to oversight by a reviewing court for compliance with its own procedures. (5 USC § 706(2); see also *Cuozzo Speed Technologies, LLC v. Lee* (2016) 579 U.S. ___; 136 S.Ct. 2131, 2141-2142) Agency actions contrary to constitutional rights (such as due process), acts in excess of statutory jurisdiction, or that are arbitrary or capricious are properly reviewable under 35 USC § 319 and the APA notwithstanding 35 USC § 314(d). (*Id.* at 1242)

Because the institution decision was not actually based on any evidence in compliance with the PTAB's own rules (*ante*), the institution decision at issue using this exhibit as a predicate is also an improper advisory opinion. (*In re Dien* (CCPA 1982) 680 F.2d 151, 154-155)

Moreover, the subject declaration is (still) unsigned. (37 CFR §§ 1.4, 1.68 [“subscribed”], 42.2 [“*Affidavit*” defined])

Furthermore, the subject exhibit fails to comply with both 37 CFR § 42.6(e)(4)(ii) in that there is no transmittal letter or certificate of service, and 37 CFR § 42.63(e) in that no current exhibit list was served or filed therewith.

Again, Patentee moves and will move to exclude and/or strike the subject “declaration” as not in compliance with the law, and neither correction nor supplementation will cure these fundamental defects.

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