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Paper No. 33
Date Entered: March 16, 2017

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.*

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

A conference call in the above proceeding was held on March 13, 2017, among 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, Mr. Daniel N. Yannuzzi, and Mr. Trevor J. Quist. The call was requested by Patent Owner to discuss certain claim amendments it may submit in a motion to amend.

Patent Owner indicated that it intended to propose one substitute claim for each of independent claims 1, 13, and 20 of the challenged patent, and one substitute claim for each challenged claim depending from claims 1 and 13 to update the dependencies in the dependent claims. Patent Owner is reminded that each proposed, substitute claim must be given a new claim number beginning sequentially from the last numbered claim of the challenged patent. Further, any claim not subject to review will continue to exist in its original form following review of the challenged claims (i.e., dependent from and incorporating the limitations of an original parent claim and any intervening claims, even if the parent claim is determined to be unpatentable and a substitute claim added).

Generally, consideration of a motion to amend is contingent on our determining that the claim for which the substitute claim is proposed is unpatentable. Entry of proposed amendments is not automatic; Patent Owner must demonstrate the patentability of the proposed substitute claims. *See* 37 C.F.R. § 42.20(c). This includes demonstrating that the proposed substitute claims are supported by the written description of the application upon which the substitute claims rely, addressing the patentability of the proposed substitute claims over the prior art of record and other prior art

known to Patent Owner, and accounting for the basic knowledge and skill set possessed by a person of ordinary skill in the art even without reliance on any particular item of prior art. *See* 37 C.F.R. § 42.121(b). For further guidance on a motion to amend, we direct the parties to the following decisions: (1) *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027 (PTAB June 11, 2013) (Paper 26) (informative) ("*Idle Free*"); (2) *Corning Optical Commc'n RF, LLC, v. PPC Broadband, Inc.*, Case IPR2014-00441 (PTAB Oct. 20, 2014) (Paper 19); and (3) *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040, slip op. 3 (PTAB July 15, 2015) (Paper 42) (precedential) ("*MasterImage*").

Patent Owner is reminded that it bears the burden of showing, on a claim by claim basis, "patentable distinction over the prior art of record and also prior art known to the patent owner." *Idle Free* at 7. *MasterImage* includes the following explanation of what is meant by "prior art of record" in *Idle Free*:

> a. any material art in the prosecution history of the patent;
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> b. any material art of record in the current proceeding, including art asserted in grounds on which the Board did not institute review; and
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> c. any material art of record in any other proceeding before the Office involving the patent.

MasterImage at 2. *MasterImage* also explains that "prior art known to the patent owner" should be understood as "no more than the material prior art that Patent Owner makes of record in the current proceeding pursuant to its duty of candor and good faith to the Office under 37 C.F.R. § 42.11, in light of a Motion to Amend." *Id.* at 3.

ORDER

It is, therefore,

ORDERED that Patent Owner has satisfied the requirement of conferring with the Board prior to filing a motion to amend under 37 C.F.R. § 42.121(a).

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