

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Prime Focus Creative Services Canada Inc.,
Petitioners,

v.

Legend3D, Inc.,
Patent Owner.

Case No. IPR2016-01243

Patent No. 7,907,793

PATENT OWNER'S MOTION TO AMEND

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TABLE OF EXHIBITS

Exhibit No.	Description
1001	U.S. Pat. No. 7,907,793 (“the ’793 Patent” or the “patent-at-issue”)
1003	U.S. Pat. No. 7,181,081 (“the ’081 Patent”)
1004	U.S. Pat. No. 7,333,670 (“the ’670 Patent”)
1005	U.S. Pub. No. 2009/0219383 (“Passmore”)
1006	U.S. Pat. No. 7,573,475 (“Sullivan”)
2022	U.S. Patent No. 4,925,294 (“Geshwind”)
2024	Declaration of Carlos Vasquez
2025	US Pat. No. 6,141,433 (“Moed”)
2026	US Pat. No. 5,940,528 (“Tanaka”)

I. Introduction

Petitioner's challenge improperly uses two parent filings of the '793 Patent (patent-at-issue) as alleged prior art, namely: US Pat. No. 7,181,081 ("the '081 Patent") and US Pat. No. 7,333,670 ("the '670 Patent"). Petitioner relies on each of these parent filings in combination with US Pat. No. 7,573, 475 ("Sullivan") and/or US Pat. App. No. 12/241,992 ("Passmore") to support each ground of its invalidity challenge. *See* Petition, p 3-4 (Paper 1). If the Board finds that the claims of the '793 Patent are sufficiently supported by – and therefore properly claim priority to – one or more of these parent filings, Petitioner's challenge becomes groundless.

Though Patent Owner contends the original claims in the '793 Patent are adequately supported by the parent filings (further explained in the Patent Owner's Response filed concurrently herewith), in the event the Board holds a different view, Patent Owner moves on a contingent basis to amend original claims 1, 8-13, and 20 to ensure the claims find clear support in the '081 Patent and the '670 Patent (thereby making it improper to use either as prior art to the '793 Patent). In such event, Patent Owner further moves, on a contingent basis, to cancel original claims 2-7 and 14-19.

The amendments presented in this motion squarely address each ground in Petitioner's challenge, and further satisfy the requirements of 37 C.F.R. § 42.121.

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