

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*.

DECISION
Granting Joint Motion to Terminate
37 C.F.R. §§ 42.5(a), 42.71(a)

IPR2016-01243
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Petitioner and Patent Owner have filed, with our prior authorization, a Joint Motion to Terminate Proceedings (“Motion” or “Mot.,” Paper 59) based on a settlement that resolves the parties’ disputes regarding the patent at issue in this proceeding, namely U.S. Patent No. 7,907,793 B1, as well as its continuation-in-part U.S. Patent No. 9,286,941 B2. Mot. 2. The parties concurrently filed a true copy of a Settlement and License Agreement (“Settlement Agreement,” Exhibits 1041 and 2028), which resolves the parties’ disputes with respect to IPR2016-01243 and IPR2018-00803 (collectively, the “IPR Proceedings”). Ex. 1041, 1 (Recitals); Ex. 2028, 1 (Recitals). In the Settlement Agreement, the parties also resolved their district court case, *Prime Focus Creative Services Canada Inc. v. Legend3D, Inc.*, Case No. 2:15-cv-02340-MWF-PLA (C.D. Cal.). *Id.* Pursuant to the Settlement Agreement, the parties have filed motions to dismiss that lawsuit and to terminate the IPR Proceedings. Mot. 2. The Parties also certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination the IPR Proceedings. *Id.*

In addition to the Motion, Petitioner and Patent Owner have filed a Joint Request to File Settlement Agreement as Business Confidential Information Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. (“Request,” Paper 60). The parties request therein that the Settlement Agreement be treated as business confidential information and be kept separate from the underlying files, as provided in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (“A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application.”). Request 2.

We issued a Final Written Decision in this proceeding on December 18, 2017 (Paper 54). On January 16, 2018, Petitioner filed a Request for Rehearing (Paper 55). Under the circumstances present here, we determine that a decision on the Request for Rehearing is unnecessary and that it is appropriate to terminate this proceeding at this time. *See* 37 C.F.R. §§ 42.5(a), 42.71(a). This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

ORDER

Accordingly, it is

ORDERED that the Joint Motion to Terminate Proceedings Pursuant to 35 U.S.C. § 317(a) (Paper 59) is *granted*;

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 (Paper 60) is *granted*;

FURTHER ORDERED that the Settlement Agreement (Exhibits 1041 and 2028) shall be treated as business confidential information, be designated “Parties and Board Only,” and be kept separate from the files of the involved U.S. Patent No. 7,907,793 B1.

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