

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 REPLY IN SUPPORT OF ITS MOTION TO AMEND

TABLE OF CONTENTS

	Page
I. Introduction.....	1
II. Prime’s Speculations of Inequitable Conduct Cannot Form the Basis for Denying Legend’s Motion to Amend	1
III. The Amended Claims Do Not Constitute Double Patenting.....	1
IV. Legend Adequately Analyzed the Prior Art of Record, and Satisfied its Duty of Candor to the Board.....	3
V. The Amended Claims are Distinct Over the Prior Art Prime Relies Upon in Its Opposition	4
A. The Amended Claims are Distinct over Burt, Irani 96, Irani 98 Odone, Szeliski, and Nielsen, Alone or in Combination With One Another	5
VI. Conclusion	7

TABLE OF AUTHORITIES

	Page(s)
<u>Cases</u>	
<i>Ex parte Davis</i>	
80 USPQ 448 (Bd. App. 1948).....	2
<i>In re Gray</i>	
53 F.2d 520, 11 USPQ 255 (CCPA 1931).....	2
<i>Idle Free Systems, Inc. v. Bergstrom Inc.</i>	
Case IPR2012-00027	3, 4
<u>Statutes</u>	
35 U.S. Code section 103.....	6
<u>Other Authorities</u>	
U.S. Patent No. 4,984,072.....	4, 5, 6

I. Introduction

Patent Owner submits this Reply to Petitioner's Opposition ("Opposition," Paper 44) to Patent Owner's Motion to Amend ("Motion," Paper 41).

II. Prime's Speculations of Inequitable Conduct Cannot Form the Basis for Denying Legend's Motion to Amend

Prime asserts that Legend is perpetuating inequitable conduct by representing to the Board that the '793 patent can claim priority to its parents. (Opposition, Paper 44 at 1.) Prime's argument improperly treats as a foregone conclusion that Legend intended to deceive the Patent Office when it failed to identify the Passmore application in an IDS during prosecution of the '793 patent. But no such intent has been established, not in this proceeding nor in any other. Indeed, Prime's arguments amount to mere speculation and conjecture. Prime's request requires the Board to just take their word for it, and deny Legend's Motion because somehow Legend's continued claim for priority to the parent applications perpetuates an unproven inequitable conduct claim. Prime's request is unavailing and should be rejected.

III. The Amended Claims Do Not Constitute Double Patenting

Petitioner argues that because color "by definition consists of hue, saturation, and luminance," that the instant amendment clarifying that the "depth parameter" is saturation or luminance (or both) somehow constitutes double

patenting over the “color parameter” limitation claimed in the ’081 and ’670 parent patents. (Opposition, Paper 44 at 1-2.)

But Prime’s new position contradicts its own Petition. Prime already took the position in its Petition that “a color parameter relates to the visible hue of an object.” (Petition, Paper 1 at 10.) But “hue” is not a “depth parameter” the amended ’793 claims are concerned with. Instead, the amended claims specifically exclude “hue” (as well as many other parameters) from the “depth parameter” limitation. The claims do this by using “consists of” as the operative transitional phrase in this limitation, such that “depth parameter” is limited to saturation or luminance or both. (*See* Motion, Paper 41 at 2; *see also In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931) (the transitional phrase “consisting of” excludes any element, step, or ingredient not specified in the claim); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) (“consisting of” defined as “closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith”). Even if Prime hadn’t already taken a position in conflict with its current view, the amended claims’ focus on saturation and luminance, for purposes of depth specifically, is clearly a patentable distinction over the claims as set forth in the ’081 and ’670 patents. Legend thus contends that the amended claims do not constitute double patenting as Prime suggests.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.