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

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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 contents that the amended claims do not constitute double patenting as Prime suggests.

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