

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 IPR2016-01491
Patent 9,286,941 B2

Before MICHAEL R. ZECHER, 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)

A. INTRODUCTION

On February 23, 2017, an initial conference call was conducted between respective counsel for the parties and Judges Zecher and Jivani. Prime Focus Creative Services Canada, Inc. (“Petitioner” or “Prime Focus”) was represented by Mr. Joshua Glucoft. Legend3D, Inc. (“Patent Owner” or “Legend3D”) was represented by Ms. Danna Cotman and Mr. Joseph Mayo. The general purpose of the conference was to discuss the parties’ requests for authorization to file several motions contemplated by the parties and identified in their Joint Statement of Proposed Motions (Paper 18) (“Joint List”).

B. REQUESTS FOR AUTHORIZATION OF MOTIONS

1. Generally

The parties are reminded that, except as otherwise provided in the Rules, our authorization is required before filing a motion. 37 C.F.R. § 42.20(b).¹ A party desiring to file a motion should request a conference call to obtain authorization to file the motion after first conducting a meet and confer with the opposing party.

2. Petitioner’s Proposed Motion to File Corrected Declaration

Petitioner seeks authorization to file a motion to “substitute a corrected declaration of Dr. David Forsyth (Ex. 1012) that is substantively identical to the original but includes a signature of Dr. Forsyth affirmed under penalty of perjury.” Joint List 6. Petitioner’s proposed motion arises from the following events.

¹ Discussion of some motions for which prior authorization is not required may be found in the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,762–63 (Aug. 14, 2012).

In support of its Petition filed on July 26, 2016, Petitioner contemporaneously filed a declaration made by Dr. David Forsyth. Ex. 1012. On November 11, 2016, Patent Owner filed a Preliminary Response. Paper 10. We instituted trial on February 6, 2017. Paper 13 (“Dec. on Inst.”). On February 16, 2017 and pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner objected to Dr. Forsyth’s declaration because it was not made under oath or affirmed under penalty of perjury. Paper 17, 4.

This matter is substantially similar to the objections raised in cases IPR2016-01243 and IPR2016-00806, both of which involve the same parties in this matter. In both cases, Prime Focus filed declarations of Dr. Forsyth that were not made under oath or affirmed under penalty of perjury. *See* IPR2016-01243, Paper 24; IPR2016-00806, Paper 37. In separate Orders on January 30, 2017, and February 2, 2017, respectively, other panels of this Board allowed Prime Focus to file corrected declarations of Dr. Forsyth that contained no “substantive changes to the original declaration beyond containing a signature of Dr. Forsyth affirmed under penalty of perjury.” IPR2016-01243, Paper 24, 8; IPR2016-00806, Paper 37, 2.

During the conference in the instant case, Petitioner stated that, after other panels of this Board allowed correction of the declarations in cases IPR2016-01243 and IPR2016-00806, the parties discussed Petitioner’s desire to correct the declaration in this case, but chose not to raise immediately the issue with this panel and instead chose to seek jointly an initial conference call addressing all proposed motions.

Patent Owner stated during the conference that it opposes Petitioner’s proposed motion because of the prejudice Patent Owner would experience by the substitution, namely the cost of defending this *inter partes* review.

Patent Owner's allegation of prejudice is premised upon an assertion that Dr. Forsyth's declaration serves as the evidentiary basis of our Decision instituting the current trial. Patent Owner stated that its opposition would urge, therefore, that we strike Dr. Forsyth's declaration, vacate our Decision for want of supporting evidence, and thereby require Petitioner to bring a new petition on U.S. Patent No. 9,286,941 B2 (the "'941 patent"). Petitioner replied that Patent Owner's allegation of prejudice is unfounded because our Decision is not predicated solely on Dr. Forsyth's declaration. Petitioner further asserted that vacating our Decision and requiring a new petition on the '941 patent would be inefficient and wasteful of resources.

We are not persuaded by Patent Owner's allegation of prejudice. Our Decision to institute this trial weighed the totality of record evidence, as indicated by our analysis and the citations therein, in order to determine whether Petitioner had established a reasonable likelihood that it would prevail in its challenges to at least one claim. *See generally* Dec. on Inst. To the extent we relied in part upon Dr. Forsyth's declaration, Petitioner's proposed correction would not change the substance of the testimony. Further, Patent Owner's proposal of requiring Petitioner to bring a new petition on the '941 patent is contrary to our policy set forth in our Rules to "secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b).

Accordingly, given the facts of this specific case, and because correction of the declaration was timely sought, we authorize and direct Petitioner to file the corrected declaration of Dr. Forsyth no later than five business days from the date of this Order. This declaration shall be titled "CORRECTED DECLARATION of David Forsyth, Ph.D.," bear Exhibit

No. 1012, and not contain substantive changes to the original declaration beyond containing a signature of Dr. Forsyth affirmed under penalty of perjury. We exercise our discretion under 37 C.F.R. § 42.5(b) to allow Petitioner to file this declaration without any supporting motion.

3. Patent Owner's Proposed Opposition to Prime Focus's Request for Rehearing

Patent Owner seeks authorization to file an opposition to Petitioner's Request for Rehearing, but only if "the board is inclined to give merit to Petitioner's Request." Joint List at 1. During the conference, Patent Owner stated that this proposed opposition seeks an opportunity to be heard on the issues raised in Petitioner's Request.

We are mindful of Patent Owner's desire to be heard in the event that Petitioner's Request for Rehearing persuades us to institute trial on claims 1, 3–5, 11–13, 16, 19, and 24. Our rules, however, specifically provide for such an opportunity to be heard in the form of Patent Owner's Response. 37 C.F.R. § 42.120(a) ("A patent owner response is filed as an opposition."). Accordingly, we do not authorize the filing of this proposed opposition to Patent Owner's Request for Rehearing.

4. Patent Owner's Proposed Contingent Motion to Amend Claims Pursuant to 37 C.F.R. § 42.121

Patent Owner indicates that it may file a contingent motion to amend. Joint List at 2. During the conference, we reminded Patent Owner that, pursuant to the Scheduling Order, Patent Owner must confer with us at least ten (10) business days prior to DUE DATE 1 before filing any such motion to amend. Paper 14, 4.

5. Patent Owner's Proposed Motion to File a Certificate of Correction

Patent Owner seeks authorization to file a motion to submit a certificate of correction “*but only if the Institution Decision is not vacated.*” Joint List at 2. Patent Owner clarified during the conference call that it seeks to amend one of two descriptions of Figure 65 contained in the Specification of the '941 patent and cited in our Decision on Institution.

Correction is authorized under 35 U.S.C § 255 where “a mistake [is] of a clerical or typographical nature, or of minor character” and “the correction does not involve such changes in the patent as would constitute new matter or would require re-examination.” “A mistake is not considered to be of the ‘minor’ character required for the issuance of a Certificate of Correction if the requested change would materially affect the scope or meaning of the patent.” Manual of Patent Examining Procedure § 1481. Here, given Patent Owner’s representation that it seeks to amend a portion of the Specification specifically because of our reliance on that portion, we are not persuaded Patent Owner’s proposed correction would be of “minor character” and would not constitute new matter or require reexamination. Accordingly, we do not authorize this proposed motion.

6. Patent Owner's Proposed Motion to File New Evidence of Record as Supplemental Information or Otherwise, and Patent Owner's Proposed Motion for Reciprocity to File New Evidence of Record or Suspend Rules

Through two separate requests, Patent Owner seeks authorization to move this panel to (i) take judicial notice of briefing filed in Case IPR2016-01243 wherein Petitioner allegedly admits “that several ancestors of the '941 patent . . . require a computer to automatically reshape masks”; and (ii) allow entry of four demonstratives comparing patents related to the '941

patent. Joint List at 3–4. As to (i), we are aware of the briefing in Case IPR2016-01243 and thus “judicial notice” is not required. As to (ii), Patent Owner fails to articulate any persuasive reason why these exhibits should be permitted to be entered into the record at this stage of the proceeding. Accordingly, we do not authorize these proposed motions.

ORDER

It is

ORDERED that Petitioner is authorized to file a corrected declaration of Dr. Forsyth no later than five business days from the date of this Order. This declaration shall be titled “CORRECTED DECLARATION of David Forsyth, Ph.D.,” bear Exhibit No. 1009, and not contain substantive changes to the original declaration beyond containing a signature of Dr. Forsyth affirmed under penalty of perjury.

FURTHER ORDERED that no other motions are authorized.

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