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Paper No. 79
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LEGEND3D, INC.,
Petitioner,

v.

PRIME FOCUS CREATIVE SERVICES CANADA INC.,
Patent Owner.

Case IPR2016-00806
Patent No. 8,922,628 B2

Before THOMAS L. GIANNETTI, MATTHEW R. CLEMENTS, and ROBERT L. KINDER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge.*

ORDER
Lifting Stay of Examination of Reissue Application No. 15/394,366
35 U.S.C. § 315(d) and 37 C.F.R. §§ 42.3, 42.122

I. INTRODUCTION

On December 29, 2016, Prime Focus Creative Services Canada Inc. ("Patent Owner") filed application 15/394,366 ("the '366 reissue application") to reissue U.S. Patent No. 8,922,628 B2 ("the '628 patent). Paper 32, 2 (Revised Mandatory Notices). On February 2, 2017, the Board issued an order staying the examination of the '366 reissue application pending the outcome of this *inter partes* review. Paper 38. In that Order, we determined the potential for duplications of efforts warranted a stay. *Id.* at 3.

On September 18, 2017, the Board rendered a Final Written Decision determining that claims 1–18 of the '628 patent are unpatentable and also denying Patent Owner's Motion to Amend on the basis that proposed claims 19–36 are unpatentable under 35 U.S.C. § 103(a) over Sullivan,[1] Tam '868,[2] and Tam '711.[3] Paper 73, 46–47. The time for either party to seek rehearing or appeal of the panel's Final Written Decision has passed.

Patent Owner filed a Motion to Lift Stay of Reissue Application No. 15/394,336 (Paper 75) on October 19, 2017, Petitioner filed an Opposition (Paper 77) on October 30, 2017, and Patent Owner filed a Reply (Paper 78) on November 2, 2017. For the reasons set forth below, we grant Patent Owner's request and lift the stay of Reissue Application No. 15/394,336.

[1] U.S. Patent No. 7,573,475.
[2] U.S. Patent No. 8,488,868.
[3] U.S. Patent No. 8,213,711.

II. DISCUSSION

We first note that Petitioner requested that the Board stay examination of the reissue application pending the completion or termination of this *inter partes* review proceeding. *See* Paper 38, 4. Because we have issued a Final Written Decision (Paper 73), and no appeal has been filed, we consider the proceeding completed.

Patent Owner contends that "the Board routinely lifts the stay on parallel Patent Office proceedings, especially where the claims at issue in the parallel proceeding differ from those at issue in the corresponding IPR." Paper 75, 2. Patent Owner states that the "second preliminary amendment will present claims that Patent Owner believes are patentably distinct from the original patent claims." *Id.*

Petitioner opposes Patent Owner's request to lift the stay because this proceeding is not complete. Paper 77, 1–3. Petitioner's argument is now moot, however, because Patent Owner did not appeal by the November 20 deadline, and Patent Owner also indicated no appeal would be filed. Thus, this proceeding is complete. *See id.* at 3 ("the Board should continue the stay at least until Patent Owner's appeal has been exhausted, or the deadline to file a notice of such appeal passes without Patent Owner filing the same").

Petitioner also argues the reissue application has been "[i]nfected by [Patent Owner's] [m]isrepresentations and should therefore be [t]erminated." Paper 77, 3–9. Petitioner alleges that Patent Owner has made misrepresentations to the Office in order to obtain "a broadening amendment it knew without a doubt it was not entitled to claim." *Id.*

In Reply, Patent Owner contends that lifting the stay now is the appropriate course and that "[i]t would be unprecedented and contrary to the

Rules for the Board to undertake the analysis that [Petitioner] requests." Paper 78, 3.

Patent Owner has established persuasively that lifting the stay of the pending reissue application is the proper course. Because this *inter partes* review is now complete, there is no longer concern about duplicate efforts within the Office and inconsistencies between the proceedings. It is therefore appropriate to lift the stay of examination of the reissue application. The Office is capable of examining the issues raised by Petitioner if and when they arise during the reissue proceeding. Pursuant to the duty of candor (37 C.F.R. § 1.56), Patent Owner must present to the Office the complete record of this proceeding, as well as the record in IPR2015-01350, and the Office will examine the reissue application in light of the complete record before it. *See, e.g.*, *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1360 (Fed. Cir. 2017) ("[e]xtending the prosecution disclaimer doctrine to IPR proceedings").

Considering that this proceeding is now complete, and based upon the facts before us, we conclude it is in the interest of justice to lift the stay of the examination of the '366 reissue application.

ORDER

Accordingly, it is

ORDERED that the stay of examination of Reissue Application No. 15/394,366 is hereby lifted;

FURTHER ORDERED that all time periods in Reissue Application No. 15/394,366 are now restarted.

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