

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 and ROBERT L. KINDER,
Administrative Patent Judges.

KINDER, *Administrative Patent Judge.*

ORDER

*Staying 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 January 27, 2017, the Board held a telephonic conference to discuss the timing of the reissue application in relation to this *inter partes* review proceeding (“IPR”). Counsel for both parties and Judges Giannetti and Kinder attended the conference. After reviewing the record in this IPR and in the ’366 reissue application, we determine that, under the circumstances, it is appropriate to stay examination of the ’366 reissue application.

II. DISCUSSION

The Director has authority to stay a reissue proceeding pursuant to 35 U.S.C. § 315(d), which provides:

(d) **MULTIPLE PROCEEDINGS.**— Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an *inter partes* review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the *inter partes* review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

Further, pursuant to 37 C.F.R. § 42.122(a), the Board may enter an order to effect a stay:

(a) *Multiple Proceedings.* Where another matter involving the patent is before the Office, the Board may during the pendency of the *inter partes* review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter.

See also 37 C.F.R. § 42.3(a) (permitting the Board to exercise exclusive jurisdiction within the Office over an involved application and patent during the proceeding).

The claims in the '366 reissue application are nearly identical to certain claims pending before the Board in Patent Owner's Motion to Amend (Paper 29). Indeed, during the conference call, counsel for Patent Owner agreed the claims had "a good amount of overlap." The reissue claims have not been examined, and no Office action has been entered.

Petitioner requests that the Board stay examination of the reissue application pending the completion or termination of this *inter partes* review proceeding.

Patent Owner opposes the stay and requests that examination of the reissue application proceed. During the conference call, Patent Owner argued that the potential for conflict is minimal because the estimated time for the first office action was listed on the USPTO web site as 25 months. Also, Patent Owner expressed concern that after this proceeding concludes, it will then have to wait another 25 months for the first office action in the reissue application.

We have determined that staying examination of the '366 reissue application is in the interest of justice. Conducting examination of the '366 reissue application concurrently with this IPR would duplicate efforts within the Office and could potentially result in inconsistencies between the proceedings. Indeed, as Patent Owner agrees, the proposed claims in the '366 reissue application are nearly the same as those pending before the Board. Should examination of the '366 reissue application begin, the Office may take action on those claims that could be inconsistent with

determinations of the Board. Patent Owner's main concern seems to be the possibility of delay and having to wait another 25 months after conclusion of this proceeding. Patent Owner's concern is entirely speculative at this stage. Reissue applications are considered "special" under PTO examining procedures to be acted upon by the examiner in advance of other applications. Manual of Patent Examining Procedure (MPEP) § 1442; 37 C.F.R. § 1.176. Regardless, the potential for conflicting results and duplication of effort outweigh Patent Owner's timing concerns.

Based upon the facts in this proceeding and in the '366 reissue application, we conclude it is in the interest of justice to stay examination of the '366 reissue application pending the completion or termination of this proceeding.

ORDER

Accordingly, it is

ORDERED that examination of reissue application 15/394,366, filed December 29, 2016, is stayed by the Board, pursuant to 35 U.S.C. § 315(d), and 37 C.F.R. §§ 42.3(a), 42.122(a), pending the completion or termination of this *inter partes* review proceeding;

FURTHER ORDERED that this stay tolls all time periods for filing further papers in reissue application 15/394,366, and no further papers shall be filed in that application while this stay remains in place; and

FURTHER ORDERED that all time periods in reissue application 15/394,366 will be restarted upon lifting of the stay.

IPR2016-00806
Patent 8,922,628 B2

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