

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MASTERIMAGE 3D, INC. and  
MASTERIMAGE 3D ASIA, LLC,  
Petitioner,

v.

REALD INC.,  
Patent Owner.

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Case IPR2015-00040  
Patent 8,220,934 B2

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Before JAMESON LEE, JAMES B. ARPIN, and  
BART A. GERSTENBLITH, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER  
Conduct of Proceedings  
*37 C.F.R. § 42.5*

## Introduction

Since December 2015, Patent Owner filed two papers titled “Patent Owner’s Supplemental Mandatory Notice Pursuant to 37 C.F.R. § 42.8,” one on December 19, 2015 (Paper 76), and one on January 11, 2016 (Paper 79). Filed with the first is a “copy” of a public version of a “Notice Regarding Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bonding” (Exhibit 2045) issued by Administrative Law Judge Essex in a related proceeding before the United States International Trade Commission.<sup>1</sup> Filed with the second is a “full copy” of Judge Essex’s “Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond” (Exhibit 2046). In response to the first submission, Petitioner filed its own “Petitioner’s Supplemental Mandatory Notice Pursuant to 37 C.F.R. § 42.8” (Paper 78) on December 22, 2015, identifying and discussing the Initial Determination. In connection with these filings, Patent Owner filed updated exhibit lists on December 19, 2015, and January 11, 2016. Papers 77, 80.

## Discussion

Patent Owner has misused the filing of a Mandatory Notice under 37 C.F.R. § 42.8(b)(2) with regard to related matters by specifically highlighting and discussing the substantive contents of Judge Essex’s Initial Determination. The first filing of that nature, on December 19, 2015,

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<sup>1</sup> The related proceeding is *In the Matter of Certain Three-Dimensional Cinema Systems and Components Thereof*, Inv. No. 337-TA-939, and one of the involved patents is U.S. Patent No. 8,220,934.

triggered Petitioner to engage in the same on December 22, 2015.<sup>2</sup> An appropriate notice simply would have noted that Judge Essex had issued an Initial Determination in the related proceeding involving U.S. Patent No. 8,220,934. Patent Owner should not have turned the Mandatory Notice into a briefing opportunity to advocate the conclusion it urges in the matters pending before the Board. And the Notice of, and copy of, the Initial Determination should not have been filed without prior Board authorization.

#### Order

It is

ORDERED that Patent Owner's Supplemental Mandatory Notices (Papers 76 and 79), updated exhibit lists (Papers 77 and 80), and Exhibits 2045 and 2046 constitute unauthorized papers and are expunged;

FURTHER ORDERED that Petitioner's Supplemental Mandatory Notice (Paper 78) constitutes an unauthorized paper and is expunged; and

FURTHER ORDERED that a joint conference call is scheduled for January 20, 2016, at 1:00 PM ET, to discuss the matter of mandatory notices as they pertain to a related proceeding (a dial-in number with a passcode will be provided to the parties by the Board's administrative staff prior to that time).

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<sup>2</sup> Petitioner questioned the propriety of Patent Owner's submission. Paper 78.

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