

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPECIAL TACTICAL SERVICES, LLC,
Petitioner,

v.

MARK E. HAGEDORN and CONNIE L. HAGEDORN,
Patent Owner.

Case IPR2019-00240
Patent 10,006,735 B1

Before LINDA E. HORNER, HYUN J. JUNG, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding
37 C.F.R. § 42.5

Dismissing the Petition
35 U.S.C. § 311(c) and 37 C.F.R. § 42.102

On November 9, 2018, Special Tactical Services, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting institution of an *inter partes* review of claims 1–20 of U.S. Patent No. 10,006,735 B1 (Ex. 1007, “the ’735 patent”).

On December 17, 2018, a conference call was held between Ms. Shestul and Mr. Saliba, counsel for Petitioner; Mr. Fugett, counsel for Mark E. Hagedorn and Connie L. Hagedorn (collectively, “Patent Owner”); and Judges Horner, Jung, and Hoskins. Patent Owner requested the conference to seek dismissal of the Petition with prejudice and to seek authorization to file a motion for sanctions. During the conference, Petitioner agreed that the Petition was prematurely filed in view of 35 U.S.C. § 311. Patent Owner described what it believed were actions by Petitioner that warranted dismissal of the Petition with prejudice and sanctions in the form of reimbursement of attorney’s fees. Upon questioning by the Board, Patent Owner agreed that there was no basis in the relevant statute and rules that required the Petition to be dismissed with prejudice and that past cases where the Board has imposed sanctions would indicate Petitioner’s actions in filing the instant Petition do not show conclusively that sanctions should be imposed in this case.

In view of the parties’ representations and the circumstances of this case, we deny Patent Owner’s request for authorization to file a motion for sanctions.

Turning to the Petition, pursuant to 35 U.S.C. § 311(c)(1) and 37 C.F.R. § 42.102, a petition for *inter partes* review must be filed after the date that is nine months after the date of the grant of the patent for patents

described in § 3(n)(1) of the AIA.¹ *See* 35 U.S.C. § 311(c)(1); 37 C.F.R. § 42.102(a)(1). Section 3(n)(1) of the AIA describes what patents will be subject to the “first-inventor-to-file” provisions of the AIA. *See* AIA § 3, 125 Stat. at 285. Under § 3(n)(1), the first-inventor to file provisions take effect 18 months following the passage of the AIA. *See* AIA § 3(n)(1), 125 Stat. at 293. Section 3(n)(1) further provides the first-inventor-to-file provisions:

shall apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time—

(A) a claim to a claimed invention that has an effective filing date as defined in Section 100(i) of title 35, United States Code, that is on or after the effective date described in this paragraph; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

AIA § 3(n)(1), 125 Stat. at 293.

The AIA passed on September 16, 2011. *See* 125 Stat. 284. The effective date under § 3(n)(1) is 18 months after the date of passage—i.e., March 16, 2013.

The ’735 patent was filed on June 2, 2017 and is a continuation of an application filed on February 28, 2017. Ex. 1007, [22], [63], 1:6–8; *see also* Pet. 11 (indicating the same). The ’735 patent, thus, has an effective filing date that is after March 16, 2013, and therefore, it is a patent described in § 3(n)(1) of the AIA.

¹ Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”).

Applying 35 U.S.C. § 311(c)(1) and 37 C.F.R. § 42.102, a petition challenging the '735 patent must be filed after the date that is nine months after the date of the grant of the '735 patent. The '735 patent was granted on June 26, 2018 (Ex. 1007, at [45]), and any petition for *inter partes* review, thus, must be filed after March 26, 2019. Petitioner, however, prematurely filed the Petition on November 9, 2018.

In view of the foregoing, it is hereby,

ORDERED that the Petition is *dismissed without prejudice*; and

FURTHER ORDERED that Patent Owner's request for authorization to file a motion for sanctions is *denied*.

PETITIONER:

Inna S. Shestul
ishestul@hotmail.com

Melvin Kraus
ANTONELLI, TERRY, STAUT & KRAUS LLP
mkraus@antonelli.com

Raja N. Saliba
Grant S. Shackelford
SUGHRUE MION, PLLC
rsaliba@sughrue.com
gshackelford@sughrue.com

PATENT OWNER:

Eric B. Fugett
Mark A. Pitchford
PITCHFORD FUGETT, PLLC
eric@pf-legal.com
andy@pf-legal.com