

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASKELADDEN LLC,
Petitioner,

v.

DEKEL SHILOH,
Patent Owner.

IPR2020-01415
Patent 8,112,405 B2

Before NABEEL U. KHAN, STEVEN M. AMUNDSON, and
RUSSELL E. CASS, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

JUDGMENT

Granting Request for Adverse Judgment After Institution of Trial
37 C.F.R. § 42.73(b)

On August 7, 2020, Askeladden LLC (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–19 in U.S. Patent No. 8,112,405 B2 (Ex. 1001, “the ’405 patent”) under 35 U.S.C. §§ 311–319. Paper 3 (“Pet.”). Petitioner served a copy of the Petition and the supporting exhibits on the correspondent of record for the ’405 patent. Pet. Cert. of Service.

According to PTO records, Red Dragon Innovations, LLC assigned the ’405 patent to Lightwire, LLC (“Lightwire”) on February 19, 2019, and Cotman IP submitted that assignment to the PTO for recording. *See* Ex. 3001. According to PTO records, Lightwire owned the ’405 patent as of August 7, 2020. *See* Exs. 3001–3002.

The Board’s rules require that a patent owner file mandatory notices “within 21 days of service of the petition.” 37 C.F.R. § 42.8(a)(2). Accordingly, Lightwire should have filed the required mandatory notices on or before August 28, 2020, but did not do so.

On September 8, 2020, a Board paralegal requested that Petitioner’s counsel serve courtesy copies of the Petition and the supporting exhibits on Lightwire. Paper 5, 2.

On September 11, 2020, Petitioner’s counsel served courtesy copies of the Petition and the supporting exhibits on Lightwire by sending the copies to Lightwire at Cotman IP’s address. Paper 5, 3.

According to PTO records, Lightwire assigned the ’405 patent to Dekel Shiloh on October 6, 2020, and Cotman IP submitted that assignment to the PTO for recording. *See* Ex. 3002. The ’405 patent identifies Mr. Shiloh as the sole inventor. Ex. 1001, code (76).

On February 3, 2021, we instituted an *inter partes* review of claims 1–19 in the ’405 patent after determining that “Petitioner has shown there is a reasonable likelihood that it would prevail with respect to at least one of the challenged claims.” Paper 6, 2. We also issued a Scheduling Order. Paper 7.

On March 11, 2021, Mr. Shiloh called a Board paralegal to inquire about participating in this proceeding.

On March 12, 2021, a Board paralegal responded to Mr. Shiloh’s inquiry by email and informed him that, to participate in this proceeding, he should (1) immediately file mandatory notices according to 37 C.F.R. § 42.8(b) and (2) file a Response to the Petition by the date set in the Scheduling Order (Paper 7), i.e., April 29, 2021. Ex. 3003.

Mr. Shiloh (“Patent Owner”) did not file mandatory notices according to 37 C.F.R. § 42.8(b) or a Response to the Petition.

On January 6, 2022, we issued an Order to Show Cause as to why adverse judgment should not be entered against Patent Owner in view of his failure to file mandatory notices. Paper 8. The Order explained that the Board’s rules provide that “[a] party may request adverse judgment against itself at any time during a proceeding” and that “[a]ctions construed to be a request for adverse judgment include . . . [a]bandonment of the contest.” *Id.* at 3 (quoting 37 C.F.R. § 42.73(b)). The Order also explained that “[f]ailure to participate in a proceeding, such as failure to file mandatory notices according to 37 C.F.R. § 42.8(b), may be considered abandonment of the contest and result in adverse judgment against a patent owner under 37 C.F.R. § 42.73(b).” *Id.* (citing *Cellpak, Inc. v. Mambate USA Inc.*, IPR2021-00007, Paper 4 at 2 (PTAB Mar. 23, 2021)). The Order gave

Patent Owner ten business days to show cause why adverse judgment should not be entered against him. *Id.* at 4.

More than ten business days have elapsed since the Order to Show Cause was entered. *See* Paper 8, 1. Patent Owner has filed no response to the Order. Nor has Patent Owner filed mandatory notices or any other paper in this proceeding.

In view of Patent Owner's failure to file mandatory notices or any other paper in this proceeding, we determine that Patent Owner has abandoned the contest. According to 37 C.F.R. § 42.73(b)(4), we construe Patent Owner's abandonment of the contest as a request for adverse judgment. Under these circumstances, we determine that entry of judgment against Patent Owner is appropriate.

ORDER

Accordingly, it is

ORDERED that adverse judgment is entered against Patent Owner under 37 C.F.R. § 42.73(b) with respect to claims 1–19 in the '405 patent; and

FURTHER ORDERED that this proceeding is terminated.

IPR2020-01415
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