

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MISSION INTEGRATED TECHNOLOGIES, LLC
Petitioner

v.

JOSHUA CLEMENTE
Patent Owner

IPR2023-01285
Patent 11,174,677

Before BARRY L. GROSSMAN, MATTHEW S. MEYERS,
and ARTHUR M. PESLAK, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

SECOND ORDER TO SHOW CAUSE
37 C.F.R. § 42.5

Petitioner, Mission Integrated Technologies, LLC (“MIT” or “Petitioner”) filed a Petition in this proceeding on August 7, 2023, challenging all the claims of Patent No. 11,174,677 B2 (the ’677 patent). *See* Paper 1 (“Pet.”).

We issued an Order to Show Cause to clarify issues regarding the Power of Attorney filed by Petitioner. Paper 8. That issue remains unresolved.¹ Petitioner’s response, however, raises an additional issue concerning ownership of the ’677 patent. We issue this Second Order to Show Cause to clarify Petitioner’s claim that it is owner of the patent.

A patent owner is precluded from filing a petition for an *inter partes* review. 35 U.S.C. § 311(a) (“a person who is *not the owner* of a patent may file with the Office a petition to institute an inter partes review of the patent.” (emphasis added)). In naming MIT as the Petitioner in this proceeding, Petitioner is representing to the Patent and Trademark Office and to this Board that Petitioner MIT is *not* the owner of the ’677 patent. 37 C.F.R. § 42.11(c). In a related proceeding in Federal Court, however, Petitioner is representing to the Court that MIT *is the owner* of the ’677 patent. *See* Ex. 3003, 27 (Amended Complaint seeking, in the Prayer for Relief, an injunction requiring “transfer to MIT all rights to, ownership in, and access to all of MIT’s intellectual property, . . . including but not limited to the ARES [’677] patent”). MIT can’t be both a petitioner in an *inter partes* review, claiming it is *not* the patent owner, and a plaintiff in Federal

¹ Before counsel can file papers on behalf of MIT, there must be on file a Power of Attorney (“POA”) authorizing counsel’s representation of MIT. Counsel’s prior declaration filed in this case recognized that the existing POA in this case was defective because it named an individual, not MIT, as the party counsel represented. *See, e.g.*, Ex. 1043 ¶¶ 4, 8, 9, 15.

Court, claiming it is the patent owner.

There are no assignments of ownership recorded in the Patent and Trademark Office concerning the '677 patent. The '677 patent does not identify an assignee. *See* Ex. 1001. Joshua Clemente is listed as the sole applicant for the patent and the sole inventor. *Id.*, codes [71], [72]. We are aware, however, of a signed Assignment Agreement between the named inventor in the '677 patent and MIT. *See* Ex. 3002, 343–349² (signed “Intellectual Property Assignment Agreement,” “entered into as of the 21st day of June 2022 ([‘]Effective Date’), by and between Joshua Clemente” and MIT).

Therefore, when the Petition in this proceeding was filed by MIT, MIT believed it was the owner of the '677 patent. MIT still believes it is the owner and is seeking judicial enforcement of that belief. Accordingly, based on MIT’s claims in Federal court, MIT should show cause, including supporting authority, establishing why this Petition should not be dismissed under 35 U.S.C. § 311(a) based on the circumstances discussed in this Order.

² Ex. 3002 is a 349-page document that is a copy of a Virginia state court complaint and supporting exhibits, including Exhibits A–J, which now has been removed to Federal court and is now pending in the Eastern District of Virginia, as case No. 1:23-cv-01608. *See* Ex. 3004, ¶ 1 (“A copy of that [349-page Virginia state court] complaint and its supporting exhibits is attached as Exhibit 1.”). The pages of Exhibit 3002 are sequentially numbered (1–349) in the header added by the Federal court. For Exhibit 3002, we cite to these page numbers for the exhibits or to paragraph numbers for the complaint.

I. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, MIT, through its properly appointed counsel, shall file on or before January 30, 2024, a paper not to exceed three (3) pages stating why MIT, which claims in a related Federal Court proceeding it is the owner of the '677 patent, is entitled to file this Petition in light of 35 U.S.C. § 311(a) precluding a patent owner from challenging the owned patent; and

FURTHER ORDERED that, Patent Owner, may, but is not required to, file a response on or before February 2, 2024, not to exceed three (3) pages responding to papers filed by MIT pursuant to this Order.

IPR2023-01285
Patent 11,174,677 B2

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