

Filed: January 30, 2024

**UNITED STATES PATENT AND TRADEMARK
OFFICE**

**BEFORE THE PATENT TRIAL AND APPEAL
BOARD**

MISSION INTEGRATED
TECHNOLOGIES, LLC
Petitioner

v.

JOSHUA CLEMENTE,
Patent Owner

Case No.: IPR2023-01285
Patent 11,174,677

RESPONSE TO SECOND ORDER TO SHOW CAUSE
37 C.F.R. § 42.5(c)

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EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 11,174,677 (“the ‘677 patent”)
1002	File History of the ‘677 patent
1003	U.S. Provisional Application No. 62/770,022 claiming benefit for the ‘677 patent
1004	Declaration of Fahmi Alubbad (“Alubbad”)
1005	Paid invoice to Genovese Productions, LLC by Mission Integrated Technologies (“MIT”) for a video shoot of MIT’s Articulated Rapid Entry System (“ARES”) in July 2017
1006	MIT’s <i>Technical Offer</i> to the Kingdom of Saudi Arabia for two Armored Assault Vehicles with ARES by MIT dated June 12, 2017
1007	<i>ARES PROMO 6</i> (“the ARES 6 video”) posted on YouTube on October 11, 2017
1008	Screenshot of search on YouTube that yields the ARES 6 video (Ex. 1007)
1009	Screenshot of current YouTube webpage that features the ARES 6 video (Ex. 1007)
1010	Screenshots taken from the ARES 6 video (Ex. 1007) with red annotations added
1011	Screenshot of the Inventor and Patent Owner (“Joshua Clemente”) of the ‘677 patent featured in the ARES 6 video (Ex. 1007)
1012	Screenshot of MIT’s homepage of October 22, 2017, taken from the Internet Archive using the Wayback Machine
1013	Screenshot of MIT’s homepage of November 30, 2018, taken from the Internet Archive using the Wayback Machine
1014	MIT’s ARES Marketing Brochure created on October 31, 2017 (“the Oct. 2017 brochure”) with red annotations added
1015	True and Correct copy of document properties for the Oct. 2017 brochure (Ex. 1014)

Exhibit No.	Description
1016	True and Correct copy of MIT's President's ("Tim Clemente") email dated November 8, 2017, sending the Oct. 2017 brochure (Ex. 1014) to a potential client
1017	Screenshot of webpage showing MIT's exhibition site at Milipol Paris 2017 ("Milipol 2017")
1018	Screenshot of a Milipol 2017 Exhibition webpage showing that MIT was an Exhibitor at Milipol 2017
1019	<i>ARES Elevated Tactics System</i> ("the Elevated ARES video") posted on YouTube on November 13, 2018
1020	<i>Curriculum Vitae</i> of Matthew Hayduk
1021	Declaration of Matthew Hayduk ("Hayduk")
1022	Screenshot of search on YouTube that yields the Elevated ARES video (Ex. 1019)
1023	Screenshot of current YouTube webpage that features the Elevated ARES video (Ex. 1019)
1024	Screenshots taken from the Elevated ARES video (Ex. 1019) with red annotations added
1025	MIT's initial Operating Agreement and Written Statement of Organization ("Initial Agreement") dated October 7, 2013
1026	Written Consent of the Member of MIT dated December 15, 2023, in which Tim Clemente was fired as MIT's President by Alubbad
1027	Email dated December 18, 2023, by Tim Clemente confirming receipt of Written Consent of the Member of MIT removing Tim Clemente as President of MIT
1028	MIT Contract with Miami-Dade County, Florida dated August 31, 2021, for an ARES Tactical Assault System signed by Alubbad
1029	Email chain, dated June 8-9, 2023, between Miami-Dade Police Department and Alubbad for extending a warranty of ARES Tactical Assault System sold to Miami-Dade County (Ex. 1028)
1030	Letter dated November 15, 2023, from the US Department of State addressed to Alubbad as CEO of MIT providing MIT with a register for International Traffic in Arms Regulations (ITAR)

Exhibit No.	Description
1031	Email chain from Tim Clemente to Alubbad dated May 29, 2018, regarding a reminder for renewal of ITAR
1032	Work for Hire Agreement between MIT and Adept Inc. signed by Alubbad as Managing Member of MIT dated November 28, 2022
1033	Employment Agreement with MIT and Kevin Burnett signed by Alubbad with MIT's seal on January 10, 2023
1034	Statement of Work Agreement between MIT and Retiina, LLC for ARES Control System Development Project signed by Alubbad as Managing Member of MIT dated June 3, 2021, with MIT's seal
1035	Work for Hire Agreement between MIT and Retiina, LLC for command, control and communication software for ARES signed by Alubbad as Principle of MIT dated June 3, 2021, with MIT's seal
1036	Work for Hire Agreement between MIT and Wulco, Inc. for the integration of ARES system onto trucks signed by Alubbad as Managing Member of MIT dated March 2, 2022, with MIT's seal
1037	Appointment of Noel Matchett as Empowered Official for MIT as required by ITAR administered by the US Depart. of State signed by Alubbad as CEO and Owner's Rep dated May 2, 2022, with MIT seal
1038	Special Written Consent of Members of MIT dated July 12, 2022 signed by Tim Clemente, indicating one of MIT's patents was erroneously record listing Joshua Clemente as sole inventor (annotate in yellow)
1039	Email chain of August 8, 2023 between Thomas Brown and his secretary Tarteasha Williams and Andrew Melick regarding defective POA filed with the IPR and a telephone call placed with the PTAB
1040	IPR2023-01285-Payment Receipt Notice dated August 7, 2023
1041	IPR2023-01285-Patent Review Petition Filing Receipt dated August 7, 2023
1042	Second Declaration of Fahmi Alubbad
1043	Declaration of Thomas E. Brown
1044	Consultant Agreement between IT and Keith Billiot signed by Alubbad as Managing Member of MIT dated May 7, 2022

Exhibit No.	Description
1045	Letter dated November 8, 2021, from the US Department of State addressed to Alubbad as Chief Executive Officer of MIT providing MIT with a register code as a manufacturer and exporter for International Traffic in Arms Regulations (ITAR)
1046	Letter dated June 8, 2020, from the US Department of State addressed to Alubbad as Chief Executive Officer of MIT providing MIT with a register code as a manufacturer and exporter for International Traffic in Arms Regulations (ITAR)
1047	Export License, (License Number 050712040) issued on January 24, 2020 from the U.S. State Department providing MIT with approval to export its ARES system to the Presidency of State Security Kingdom of Saudi Arabia with Alubbad as Applicant
1048	Email from Alubbad dated June 8, 2023, to Kallman Worldwide, Inc. attaching an Application for Pavilion Space at Milipol, Paris 2023 and indicating that payment of \$31,075 was mailed in the form of a MIT check
1049	Milipol Exhibit Application attached to Email (Ex. 1048) showing Alubbad as the party to receive the \$31,075 Invoice
1050	2023.11.24 - J. Clemente Answer and Counterclaim (w exhibits)
1051	2024.01.03 - Amended Complaint
1052	2024.01.17 - Josh's Answer to Amended Complaint & Counterclaim
1053	2023.12.13 - Answer to Counterclaim

I. INTRODUCTION

Petitioner, MIT, initiated this proceeding on August 7, 2023 challenging all claims in the '677 patent. On October 16, 2023, F2E Holdings, LLC (suing derivatively on behalf of MIT) filed suit against Joshua Clemente seeking, *inter alia*, to have the ownership of the '677 patent transferred from Joshua Clemente to MIT. Ex. 3004.¹ On January 25, 2024, the PTAB issued a Second Order to Show Cause, 37 C.F.R. § 42.5(c), “to clarify [MIT’s] claim that it is the owner of the patent.” Paper 12 at 2.

II. MIT SEEKS TO BECOME THE OWNER OF THE '677 PATENT, BUT IT IS NOT CURRENTLY THE OWNER OF THE PATENT

The PTAB misapprehends what the parties are contending in Case No. 1:23-cv-01608, which is currently pending in the Alexandria Division of the U.S. District Court for the Eastern District of Virginia (the “Federal Case”). Joshua Clemente is the only named inventor on the '677 Patent. There are no assignments of ownership recorded in the PTO concerning the '677 patent. Joshua Clemente, purporting to be the patent owner, is *presently suing MIT for infringing the '677 patent in the Federal Court Case*. Ex. 1050 at pages 17, 18. In the Federal Case, MIT seeks (“*inter alia*”) either to invalidate the '677 patent or to have the ownership of the '677 patent transferred to it.

¹ Joshua Clemente removed the case to federal court (Ex. 3004) and asserted a counterclaim against MIT for patent infringement. (Exs. 1050, 1052). Thereafter, MIT filed an amended complaint converting the Federal Case from a derivative action on behalf of MIT to a direct action by MIT. Ex. 1051).

Ex. (1053) (answer to counterclaim). MIT is not, however, contending that it is the current “owner” of the ’677 patent. Rather, MIT seeks to have the ownership of the patent transferred to MIT. Ex. 3002 at 28 (highlighting supplied):

- F. An injunction against Josh (a) requiring Josh to transfer to MIT all rights to, ownership in, and access to all of MIT’s intellectual property, trade secrets, and other confidential business information, including but not limited to the ARES patent; (b) requiring Josh to return to MIT all of MIT’s intellectual property, trade

In its Second Order to Show Cause, the PTAB focused on and raised concerns about what it characterized as a “signed Assignment Agreement between the named inventor in the ’677 patent and MIT.” Paper 12 at 3. However, in the Federal Case, MIT alleges that the purported Assignment Agreement referenced by the PTAB is invalid and did not, in fact, effectively assign ownership of the ’677 patent to MIT. That is the case for at least two reasons. First, as MIT alleges in the Federal Case, Joshua Clemente materially altered the terms of the Assignment Agreement that was presented to him by MIT. Second, as MIT also alleges, MIT’s controlling member—F2E Holdings LLC—never authorized Timothy Clemente to sign the Assignment Agreement that had been materially altered by Joshua Clemente. Accordingly, it is MIT’s position that the Assignment Agreement signed by Joshua and Timothy Clemente is invalid. Ex. 3002 at 19 (¶¶ 98-104 entitled “False Representations of Patent Assignment”). Moreover, Joshua Clemente has filed a counterclaim against MIT in the

Federal Case for infringement of the '677 patent. Thus, no party in the Federal Case is contending that the Assignment Agreement is valid. Therefore, MIT is not currently the owner of the '677 patent and is a proper party to bring this proceeding.

III. THE PTAB SHOULD STAY THIS PROCEEDING PENDING RESOLUTION OF THE FEDERAL COURT CASE.

Given that patent owners cannot initiate IPR proceedings, and there is a challenge to the ownership of the '677 patent currently underway in the Federal Case, it is appropriate to consider whether to stay this proceeding pending the outcome of the Federal Case. The Alexandria Division of the Eastern District of Virginia is the fastest federal court in the United States. The limited period for discovery permitted in that court is already underway. The Federal Case is, thus, almost certain to be resolved by Judge Brinkema within six months. Therefore, MIT respectfully suggests that these proceedings be stayed pending the outcome of the Federal Case. Rulings or verdicts in that case concerning the ownership and validity of the patent will provide guidance as to whether these proceeding should continue.

Respectfully submitted,

/Thomas E. Brown/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that, undersigned hereby certifies that, pursuant to 37 CFR §§ 42.6(e) and 42.105(a), a copy of this Response to RESPONSE TO SECOND ORDER TO SHOW CAUSE 37 C.F.R. § 42.5(c) is being deposited on January 30, 2024, with FedEx Express (a commercial overnight delivery service), for overnight delivery, to the Patent Owner, Pro se, in a box addressed to:

Joshua F. Clemente
2006 Vista Ln APT B.
Austin, TX 78703

January 30, 2024

/Thomas E. Brown/

Thomas E. Brown
WHDA, LLP