

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOME DEPOT U.S.A., INC.,
Petitioner,

v.

RAVENWHITE SECURITY, INC. and SECURITY TECHNOLOGY, LLC,¹
Patent Owner.

IPR2024-01316 (Patent 10,594,823 B1)
IPR2024-01420 (Patent 11,562,402 B2)²

Before ST. JOHN COURTENAY, III, MICHAEL R. ZECHER, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5(a)

¹ According to the assignment records kept at the U.S. Patent and Trademark Office, RavenWhite Security, Inc. is the Patent Owner of U.S. Patent No. 10,594,823 B1, whereas Security Technology, LLC is the Patent Owner of U.S. Patent No. 11,562,402 B2.

² This Order addresses the same issue for these two proceedings. We, therefore, exercise our discretion to issue one Order to be filed in each proceeding. The parties, however, are not authorized to use this style heading in any subsequent papers.

IPR2024-01316 (Patent 10,594,823 B1)

IPR2024-01420 (Patent 11,562,402 B2)

I. DISCUSSION

A conference call in these two proceedings was held on December 6, 2024, among counsel for Petitioner, Home Depot U.S.A. Inc. (“Home Depot”), counsel for the exclusive licensee of the two involved patents, RavenWhite Licensing LLC (“RavenWhite”), and Judges Zecher, Ippolito, and Courtenay. The purpose of the call was to discuss Home Depot’s opposed request for authorization to file a motion to strike the mandatory notices filed by RavenWhite in each of these two proceedings. IPR2024-01316, Ex. 3001; IPR2024-01420, Ex. 3001. No court reporter was present during the conference call.

In the mandatory notices filed in IPR2024-01316, RavenWhite represents that the Patent Owner of U.S. Patent No. 10,594,823 B1 is RavenWhite Security, Inc., and RavenWhite is the exclusive licensee and real party in interest. IPR2024-01316, Paper 5, 1. In the mandatory notices filed in IPR2024-01420, RavenWhite represents that the Patent Owner of U.S. Patent No. 11,562,402 B2 is Security Technology, LLC, and RavenWhite is the exclusive licensee and real party in interest. IPR2024-01420, Paper 5, 1.

During the conference call, Home Depot asserted that RavenWhite is not an exclusive licensee with “all substantial rights” to the two involved patents, and that there is no regulatory support that allows a purported exclusive licensee of a challenged patent to file mandatory notices.

In response, RavenWhite asserted that it is an exclusive licensee with “all substantial rights” to the two involved patents, including the right to defend each involved patent in an *inter partes* review proceeding. Upon inquiry from the panel, RavenWhite appeared amenable to submitting evidence to

support its assertion under seal. Home Depot requested that should RavenWhite present evidence to support its assertion, Home Depot should get an opportunity to address the submitted evidence in the form of a reply.

After a brief deliberation, we determined that we would benefit from briefing that is narrowly tailored to clarify the dispute between Home Depot and RavenWhite regarding whether RavenWhite is an exclusive licensee with “all substantial rights” to the two involved patents, including the right to participate in an *inter partes* review proceeding. As such, we authorized Home Depot to file Motions to Strike RavenWhite’s mandatory notices that are each limited to five (5) pages. Home Depot’s Motions to Strike are due no later than Friday, December 13th, 2024. We also authorized RavenWhite to file Oppositions to Home Depot’s Motions to Strike that are each limited to five (5) pages. RavenWhite’s Oppositions are due no later than Friday, December 20th, 2024. We also authorized the parties to submit additional supporting evidence with either the Motions to Strike or the Oppositions.

To the extent any document is submitted under seal, a corresponding motion to seal should be filed concurrently pursuant to 37 C.F.R. § 42.14. If a motion to seal is to be filed before entry of a protective order, a jointly proposed protective order shall be filed as an exhibit with the motion. *See* 37 C.F.R. § 42.54; Consolidated Trial Practice Guide³ at 19–20. We encourage the parties to adopt the Board’s default protective order if they conclude that a protective order is necessary. *See* Consolidated Trial Practice Guide at 107–122 (App. B, Protective Order Guidelines and Default Protective Order). If the parties choose to propose a protective order deviating from the default protective order, they must (1) submit the

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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proposed protective order jointly along with a marked-up comparison of the proposed and default protective orders showing the differences between the two; and (2) explain why good cause exists to deviate from the default protective order.

During the conference call, we did not authorize Home Depot to file replies to RavenWhite's Oppositions. In the event RavenWhite files supporting evidence with its Oppositions and Home Depot wishes to respond to RavenWhite's submission of evidence, we direct Home Depot to send an email to Trials@uspto.gov requesting authorization to file replies to the Oppositions. No substantive arguments should be included in such an email.

II. ORDER

Accordingly, it is hereby:

ORDERED that Home Depot is authorized to file a Motion to Strike RavenWhite's mandatory notices, along with any supporting evidence, in each of these two proceedings;

FURTHER ORDERED that the Motion to Strike shall be no more than five (5) pages and shall be filed no later than Friday, December 13th, 2024;

FURTHER ORDERED that RavenWhite is authorized to file an Opposition to Home Depot's Motion to Strike, along with any supporting evidence, in each of these two proceedings;

FURTHER ORDERED that the Opposition to the Motion to Strike shall be no more than five (5) pages and shall be filed no later than Friday, December 20th, 2024; and

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FURTHER ORDERED that, to the extent any document is submitted under seal, a corresponding motion to seal, along with a jointly proposed protective order, shall be filed concurrently pursuant to 37 C.F.R. §§ 42.14, 42.54, and Consolidated Trial Practice Guide.

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