

Case PGR2019-00058
U.S. Patent No. 10,214,664

Filed on behalf of: Patent Owner

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHIELDMARK, INC.
Petitioner,

v.

CLIFFORD A. LOWE
Patent Owner.

Case PGR2019-00058

U.S. Patent No.10,214,664

Before PAULA CONN, *Trial Paralegal*

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
ACCEPT THE LATE FILING OF ITS REHEARING REQUEST**

In support of its motion for leave to accept late filing of its Rehearing Request, originally due April 8, 2020, Counsel for Petitioner argues that: the person experienced in filing documents with the Board was absent from Counsel's office on April 8, 2020, the office being closed due to the COVID-19 outbreak; Counsel for Petitioner personally undertook the task and believed he had properly filed the Rehearing Request; and Patent Owner will not be prejudiced by grant of leave because Counsel for Petitioner served Counsel for Patent Owner at that time. The undersigned Counsel for Patent Owner respectfully disagrees.

Because of the COVID-19 outbreak, requests for rehearings in AIA trial proceedings due between March 27, 2020 and April 30, 2020 were to be considered timely if filed within 30 days of the original due date and accompanied by a statement that the delay in filing was due to the COVID-19 outbreak. The 30-day extension was intended to grant forbearance as to the *timeliness of a filing*—that is, a delay in filing due to the COVID-19 outbreak—not simply an *error in filing*, as occurred here. In the event the COVID-19 outbreak prevented or interfered with a filing before the Board, Petitioner was to contact the PTAB for an extension of time. On April 8, 2020, Counsel for Petitioner received a filing receipt for a Rehearing Request stating, in capital letters, “THERE WERE NO DOCUMENTS SUBMITTED WITH THIS REQUEST.” Yet, 35 days passed with no attempt by Petitioner to contact the PTAB. Therefore, what is relevant to

Petitioner's request that the PTAB accept its late filing is whether, in view of Petitioner's *filing error*, (a) good cause exists for leave, or (b) the interests of justice demand it. Neither applies here.

COVID-19 may have played a part in Counsel for Petitioner's office being closed on April 8, 2020 with the person experienced in filing documents with the Board being absent from the office that day. However, COVID-19 does not explain why this particular Counsel for Petitioner, and not one of the two other Counsel of record for Petitioner—one from a separate law firm—undertook the filing of Rehearing Request on April 8, 2020; why Counsel waited until the “eleventh hour” to file the Rehearing Request; whether Counsel reviewed the filing process, which is detailed on the PTAB website, including a step for checking to assure a filing is successful; whether Counsel did or did not call the “Help” number on the PTAB website for assistance; why Counsel did not read the filing receipt stating in capital letters, “THERE WERE NO DOCUMENTS SUBMITTED WITH THIS REQUEST;” or why Co-Counsel did not read the filing receipt and inform him of the need for remedial action. These unanswered questions demonstrate Petitioner's *filing error* was an error and not the result of the COVID-19 outbreak—and the absence of good cause to excuse the *filing error*.

Petitioner had over 30 days in which to review its April 8, 2020 Rehearing Request filing. Had it been reviewed before May 8, 2020, believing, as argued, that

the COVID-19 outbreak necessitated its late filing, Counsel for Petitioner could have timely refiled with the omitted document and such Statement. If, in fact, the COVID-19 outbreak prevented or interfered with filing, which is expressly denied for the reasons stated above, Counsel for Petitioner had over 30 days in which to contact the PTAB for an extension of time. Yet, it was not reviewed—further demonstrating the absence of good cause. Instead, a Supervisory Paralegal contacted Petitioner on May 13, 2020 to advise of the *filing error*.

That Patent Owner had been served a copy of Petitioner’s Rehearing Request is simply irrelevant to the issue of whether Petitioner’s *filing error* is excusable for good cause. As to “the interests of justice,” it is the *Patent Owner* who is prejudiced by the further delay. As acknowledged by Counsel for Petitioner, the parties are in litigation and that litigation is *suspended during these proceedings*. Litigation matters (though not jury trials) are proceeding before district courts for the Northern District of Ohio; they are not suspended because of COVID-19. Nor does further delay serve the purpose of time restraints on preliminary AIA proceedings—to expedite return to litigation should an AIA post-grant review petition be denied and proceedings not instituted. That purpose is furthered served here by denying late filing, without prejudice to Petitioner, who can fully argue its invalidity position before the court.

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Dated: June 2, 2020

Respectfully submitted,

/Ray L. Weber/

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