

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHIELDMARK, INC.
Petitioner,

v.

CLIFFORD A. LOWE
Patent Owner.

PGR2019-00058
Patent 10,214,664 B2

Before CHRISTOPHER L. CRUMBLEY, JO-ANNE M. KOKOSKI, and
SHELDON M. McGEE, *Administrative Patent Judges*.

McGEE, *Administrative Patent Judge*.

DECISION

Granting Petitioner's Motion to Accept Late-filing of Request for Rehearing

37 C.F.R. § 42.5(c)

Denying Petitioner's Request on Rehearing of Institution Decision

37 C.F.R. § 42.71(d)

I. INTRODUCTION

ShieldMark, Inc. (“Petitioner”) filed a Petition for post-grant review of claims 1–6, 10–16, and 20–22 of U.S. Patent No. 10,214,664 B2 (Ex. 1001, “the ’664 patent”). Paper 2 (“Pet.”). Clifford A. Lowe (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 7. Upon consideration of the Petition and the Preliminary Response, we determined that Petitioner had failed to demonstrate that it is more likely than not that the ’664 patent is eligible for post-grant review, and denied institution of trial. Paper 8 (“Dec.” or “Decision”).

On April 8, 2020, the Board’s electronic filing system, PTABE2E, sent an email to the parties stating that a Request for Rehearing had been filed in this proceeding. The email also indicated, in all capital letters, “THERE WERE NO DOCUMENTS SUBMITTED WITH THIS REQUEST.” Paper 9, 2; Ex. 3001.

On May 13, 2020, the Board sent an email to the parties requesting clarification as to whether Petitioner intended to file a request for rehearing. The parties requested a call with the Board and we held that call on May 19, 2020. Paper 9. During the call, Petitioner explained the circumstances surrounding its mistaken belief that it timely filed a rehearing request, and how it served Patent Owner with such a request on April 8, 2020. Patent Owner confirmed that it was so served. Based on the circumstances presented in the call, we authorized Petitioner to file a motion to accept the late filing of the request for rehearing that was served on Patent Owner on April 8, 2020. *Id.* at 3. We authorized Patent Owner to file an opposition. *Id.*

Petitioner filed its motion (Paper 10, “Mot.”), along with a copy of the request that was purportedly served on Patent Owner (Ex. 1020), and Patent Owner filed its opposition (Paper 12, “Opp.”).

After considering these papers, we determine it would be in the interests of justice to accept Petitioner’s late-filed rehearing request. However, based on our consideration of the merits of the Request for Rehearing, we are not persuaded that we misapprehended or overlooked any issues of law or fact that would necessitate modification of our Decision.

II. ANALYSIS

Petitioner’s Motion to Accept Late-Filed Rehearing Request

In its motion, Petitioner states that its office was closed on April 8, 2020 due to the COVID-19 outbreak, and that the individual who “was experienced in filing documents with the Board . . . was unavailable to file the document.” Req. 1. As a result, according to Petitioner, “the undersigned attorney filed the Rehearing Request and believed it was properly filed on April 8, 2020,” and also served a copy on Patent Owner. *Id.* Petitioner states it “believed the reference to ‘no documents submitted’ with the request in the receipt meant that no exhibits were included with the Rehearing Request,” and “did not realize that there was an issue with the filing until it received an email from the Board on May 13, 2020.” *Id.* at 2.

Based on these circumstances, Petitioner asserts that good cause exists for us to grant its motion because its late filing “was simply an honest mistake resulting from Petitioner’s counsel’s office closure due to the Covid-19 outbreak,” and was not a circumstance of Petitioner’s own making. *Id.* Petitioner also asserts that it is in the interests of justice to grant

its motion and consider its request. *Id.* at 3. Specifically, Petitioner asserts that Patent Owner would not be prejudiced by our consideration of its request, and further states that an extension of the deadline for filing its rehearing request is warranted by the CARES Act extension of deadlines. *Id.*

Patent Owner avers that Petitioner's actions amount to filing error and the extensions provided by the CARES Act do not apply to filing errors, but rather to the timeliness of a filing, i.e., "a delay in filing due to the COVID-19 outbreak." Opp. 1. According to Patent Owner, the current circumstances do not meet the good cause or interests of justice standards. *Id.* at 2. Specifically, Patent Owner states that COVID-19 may have played a role in Petitioner's counsel's office closure, but that does not excuse a filing error because 1) other counsel could have filed the request, 2) counsel could have filed the request sooner, 3) counsel could have reviewed the filing process detailed on the PTAB website and/or requested technical assistance from PTAB, and 4) counsel and co-counsel failed to read the filing receipt status regarding no documents being submitted. *Id.*

Patent Owner further avers that it would be prejudiced by a delay in this proceeding in view of the pending litigation that is suspended while this case is active before us, and argues such delay does not "serve the purpose of time restraints on preliminary AIA proceedings—to expedite return to litigation should an AIA post-grant review be denied and proceedings not instituted." *Id.* at 3.

Under 37 C.F.R. § 42.5(c)(3), "[a] late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice." We agree with Petitioner that it

would be in the interests of justice to consider the merits of its rehearing request.

The CARES Act Notice¹ cited by Petitioner provides that certain filings due between March 27, 2020 and April 30, 2020 will be considered timely if filed on or before June 1, 2020. Ex. 1024, 2. To qualify for such an extension, the filing must be accompanied by a statement that the delay in filing was due to the COVID-19 outbreak. *Id.* One such delay “due to the COVID-19 outbreak” includes a circumstance where a petitioner was affected by an office closure that materially interfered with timely filing. *Id.* at 2–3. The circumstances surrounding Petitioner’s counsel’s office closure fall within the scope of the relief afforded by the CARES Act Notice because, due to the closure, the individual familiar with the PTABE2E filing system was not present at counsel’s office to ensure the request was properly uploaded. Based on the facts and circumstances presented, including the lack of significant prejudice to Patent Owner, we determine it would be in the interests of justice to deem Petitioner’s Request for Rehearing to be timely filed and now consider its merits.

Petitioner’s Request for Rehearing

A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.

¹ Available at <https://www.uspto.gov/sites/default/files/documents/Patents-Notice-CARES-Act-2020-04.pdf>

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