

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

U.S.A. DAWGS, INC.,
Requester

v.

Patent of CROCS, INC.,
Patent Owner

Appeal 2019-004306
Reexamination Control 95/002,100
Patent D517,789
Technology Center 2900

RAE LYNN P. GUEST, *Administrative Patent Judge*.

DECISION EXPUNGING IMPROPER SUBMISSION IN *INTER PARTES*
REEXAMINATION

This is a Decision finding the submission entitled “REQUEST TO CHANGE THE REAL PARTY IN INTEREST FROM THIRD PARTY REQUESTOR U.S.A. DAWGS, INC. TO MOJAVE DESERT HOLDINGS, LLC IN INTER PARTES REEXAMINATION/HEARING OF SCOTT SEAMANS” filed on July 18, 2019, to be an improper submission in accordance with 37 C.F.R. § 1.905. The improper submission, and

accompanying documents, will be expunged in accordance with 37 C.F.R. § 41.7(a).

This is also an Order dismissing “PATENT OWNER’S MOTION FOR PERMISSION TO FILE OPPOSITION TO MOJAVE DESERT HOLDINGS, LLC’S REQUEST TO CHANGE THE REAL PARTY IN INTEREST FROM THIRD PARTY REQUESTOR U.S.A. DAWGS, INC. TO MOJAVE DESERT HOLDINGS, LLC IN INTER PARTES REEXAMINATION/HEARING OF SCOTT SEAMANS,” filed August 5, 2019 (Petition). Because motions practice is not applicable to an *inter partes* reexamination, the motion is being treated as a petition. Patent Owner included an opposition with the petition, which is premature, because the filing of an opposition has not been authorized. Patent Owner’s petition is dismissed as moot in view of the expungement of the improper submission.

FINDINGS

1. Third Party Requester, U.S.A. DAWGS, Inc., filed a request for *inter partes* reexamination of U.S. Patent No. D517,789, on August 24, 2012, which was assigned Control No. 95/002,100.
2. On November 19, 2012, reexamination was ordered.
3. On April 29, 2013, a non-final Office action was mailed.
4. Prosecution continued and on August 9, 2017, a Right of Appeal Notice (RAN) was mailed.
5. Patent Owner filed a Notice of Appeal on September 8, 2017.
6. Patent Owner filed an Appellant’s Brief on November 8, 2017.

7. Requester filed a Respondent's Brief on December 8, 2017.
8. On November 28, 2018, an Examiner's Answer was mailed.
9. Patent Owner filed a Rebuttal Brief on December 27, 2018, and a Request for Oral Hearing on January 28, 2019.
10. On May 14, 2019, an Appeal Docketing Notice was mailed.
11. On June 28, 2019, a Notice of Hearing was mailed, which scheduled the oral hearing for August 26, 2019.
12. Patent Owner filed a confirmation of attendance at the oral hearing on July 18, 2019.
13. Mojave Desert Holdings, LLC filed its submission on July 18, 2019.
14. Patent Owner filed the petition on August 5, 2019, accompanied by an opposition to the submission.

DISCUSSION

The submission of July 18, 2019, is filed on behalf of Mojave Desert Holdings, LLC, a Nevada limited liability company ("Mojave"). The submission is accompanied by a Revocation of Power of Attorney with a New Power of Attorney and Change of Correspondence Address for Third Party Requester; a Request for Oral Hearing and payment of a Request for Oral Hearing Fee; a confirmation of attendance at the oral hearing of August 2019; and a Certificate of Service.¹ Most of the submissions of July 18, 2019, are signed by "Matt Berkowitz, Reg. No. 57,215, Counsel for Mojave

¹ The submission refers to a Declaration of David Bloom, which does not appear to have been included with the submission.

Desert Holdings, LLC.” The revocation of power of attorney document is signed by “James Mann, Owner - Mojave Desert Holdings LLC.”

The submissions of Mojave assert that Mojave is a real party in interest in the instant *inter partes* reexamination proceeding, and propose that Mojave assume the role of Third Party Requester. The purported basis for the assertions are a Chapter 11 bankruptcy auction, in which all tangible and intangible assets of U.S.A. Dawgs, Inc. were transferred to U.S.A. Dawgs Holdings, LLC, a Delaware limited liability company. It is stated that Mojave subsequently purchased such assets from U.S.A. Dawgs Holdings, LLC. However, the submissions are insufficient to establish Mojave as a real party in interest and/or Requester in the instant *inter partes* reexamination proceeding, because the initial transfer of assets from U.S.A. Dawgs, Inc. to U.S.A. Dawgs Holdings, LLC, a Delaware limited liability company, appears to be silent about any rights with regard to the instant *inter partes* reexamination proceeding. *See Agilent Technologies, Inc. v. Waters Technologies Corp.*, 811 F.3d 1326, 1334 (Fed. Cir. 2016).

RELEVANT AUTHORITY

37 C.F.R. § 11.18 provides:

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed or inserted by such practitioner, in compliance with § 1.4(d) or § 2.193(a) of this chapter.

(b) By presenting to the Office or hearing officer in a disciplinary proceeding (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious, or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001 and any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;

(ii) The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of—

- (1) Striking the offending paper;
- (2) Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;
- (3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;
- (4) Affecting the weight given to the offending paper; or
- (5) Terminating the proceedings in the Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action.

37 C.F.R. § 1.905 provides:

Unless specifically provided for, no submissions on behalf of any third parties other than third party requesters as defined in 35 U.S.C. 100(e) will be considered unless such submissions are in accordance with § 1.915 or entered in the patent file prior to the date of the order

for reexamination pursuant to § 1.931. Submissions by third parties, other than third party requesters, filed after the date of the order for reexamination pursuant to § 1.931, must meet the requirements of § 1.501 and will be treated in accordance with § 1.902. Submissions which do not meet the requirements of § 1.501 will be returned.

37 C.F.R. § 1.939(a) provides:

If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

37 C.F.R. § 41.7(a) provides:

The Board may expunge any paper directed to a Board proceeding, or filed while an application or patent is under the jurisdiction of the Board, that is not authorized under this part or in a Board order, or that is filed contrary to a Board order.

37 C.F.R. § 41.8(a) provides:

In an appeal brief (§§ 41.37, 41.67, or 41.68) or at the initiation of a contested case (§ 41.101), and within 20 days of any change during the proceeding, a party must identify:

- (1) Its real party-in-interest, and
- (2) Each judicial or administrative proceeding that could affect, or be affected by, the Board proceeding.

37 C.F.R. § 41.66 provides:

- (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so)

such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

(c) The examiner will consider both the appellant's and respondent's briefs and may prepare an examiner's answer under § 41.69.

(d) Any appellant may file a rebuttal brief under § 41.71 within one month of the date of the examiner's answer. The time for filing a rebuttal brief or an amended rebuttal brief may not be extended.

(e) No further submission will be considered and any such submission will be treated in accordance with § 1.939 of this title.

ANALYSIS

The submission of July 18, 2019, is before the Board for consideration. In accordance with 37 C.F.R. § 41.8(a), in an appeal brief (§§ 41.67, or 41.68), and **within 20 days of any change during the proceeding, a party must identify "Its real party-in-interest"** (emphasis added). The submissions of July 18, 2019, were filed on behalf of Mojave. However, Mojave is not the third party requester of the instant *inter partes* reexamination, nor is Mojave the Patent Owner. Because Mojave is not a party to the instant *inter partes* reexamination proceeding, Mojave does not have standing to update the real party-in-interest in the proceeding pursuant to § 41.8(a). Also, the submission does not appear to be filed within 20 days of the change, therefore even if it were proper, it is not filed timely.

In accordance with 37 C.F.R. § 1.905, unless specifically provided for, no submissions on behalf of any third parties other than third party requesters as defined in 35 U.S.C. 100(e) will be considered unless such submissions are in accordance with § 1.915 or entered in the patent file prior to the date of the order for reexamination pursuant to § 1.931. Submissions by third parties, other than third party requesters, filed after the date of the order for reexamination pursuant to § 1.931, must meet the requirements of § 1.501 and will be treated in accordance with § 1.902. Submissions which do not meet the requirements of § 1.501 will be returned.

It is undisputed that U.S.A. Dawgs, Inc. requested this *inter partes* reexamination, and therefore U.S.A. Dawgs, Inc. is the Third Party Requester by definition. U.S.A. Dawgs, Inc. is identified as the real party in interest in the request for *inter partes* reexamination, as well as in Requester's respondent's brief. Because all briefing has been completed, any further participation by Requester in this *inter partes* reexamination proceeding is limited to presentation of arguments at the oral hearing. Because the Requester is the only third party allowed to respond pursuant to 37 C.F.R. § 1.905, the Requester U.S.A. Dawgs, Inc. is the only respondent allowed to participate in the oral hearing. Mojave is not the Requester of the instant *inter partes* reexamination, and therefore Mojave does not have standing to act as the respondent at the oral hearing of August 26, 2019, and will **not** be permitted to participate in the oral hearing.

The submissions filed July 18, 2019, on behalf of Mojave are improper pursuant to 37 C.F.R. § 1.905, and will be expunged in accordance

Appeal 2019-004306
Reexamination Control 95/002,100
Patent D517,789

with 37 C.F.R. § 41.7(a), by being closed in the Office's Image File Wrapper (IFW) system with the mailing of this Decision.

Practitioner representing Mojave is reminded that when presenting any paper to the Office, Practitioner must adhere to the provisions of 37 C.F.R. § 11.18(b).

DECISION

In view of the foregoing, the submissions of July 18, 2019, filed on behalf of Mojave are EXPUNGED.

Patent Owner's petition is DISMISSED, and the opposition is unauthorized pursuant to 37 C.F.R. § 1.939(a) and will not be considered.

The oral hearing will be conducted with Patent Owner on August 26, 2019.

It is noted that oral hearings in *inter partes* reexaminations are open to the public, but the public may not participate in such hearings.

Patent Owner:
WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

Third Party Requester:
USA DAWGS, INC.
4120 WEST WINDMILL LANE, UNIT 106
LAS VEGAS, NV 89117