

PATENT ASSIGNMENT COVER SHEET

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SUBMISSION TYPE:	RESUBMISSION
NATURE OF CONVEYANCE:	CORRECTION BY DECLARATION OF INCORRECT PATENT NO. 8036827 RECORDED AT REEL AND FRAME NO 038695, 0100-0103.
RESUBMIT DOCUMENT ID:	504370180

CONVEYING PARTY DATA

Name	Execution Date
DOUBLESHOT, INC.	09/21/2007

RECEIVING PARTY DATA

Name:	DOUBLESHOT, INC.
Street Address:	1200 VALLEY HOUSE DRIVE
Internal Address:	SUITE 190
City:	ROHNERT PARK
State/Country:	CALIFORNIA
Postal Code:	94928

PROPERTY NUMBERS Total: 1

Property Type	Number
Patent Number:	8036827

CORRESPONDENCE DATA

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Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.

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NAME OF SUBMITTER:	CHRISTOPHER T. HOLLAND
SIGNATURE:	/Christopher T. Holland/
DATE SIGNED:	06/05/2017

Total Attachments: 10source=Petition 8036827#page1.tif
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CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8	
I hereby certify that this correspondence is being transmitted to the USPTO electronically via EPAS on June 5, 2017.	
/Christopher T. Holland/ [name]	June 5, 2017 Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent Number : 8,036,827
First Named Inventor : Alan Shulman
Issue Date : October 22, 2011
Title : Cognitive Change Detection System

**PETITION TO CORRECT AND REMOVE IMPROPERLY FILED AND RECORDED
ASSIGNMENT FILED AND RECORDED BY ANOTHER PERSON AGAINST OWNER'S
PATENT (MPEP § 323.01(c) [R-07.2015])**

U.S. Patent and Trademark Office
Assignment Services Division

Dear Sir/Madam:

Doubleshot, Inc. ("Doubleshot"), the sole, true, and correct owner of U.S. Patent Number 8,036,827 ("the '827 Patent"), hereby petitions to correct and remove an "assignment" improperly filed and recorded by William E. Knight ("Knight") against the '827 Patent without Doubleshot's permission or knowledge (**Reel 038695, Frame 0100-0103**).

This petition is made under Manual of Patent Examining Procedure ("MPEP") § 323.01(c) [R-07.2015], which provides, in pertinent part:

When the owner of an application or registration discovers that another party has improperly recorded an assignment or name change against the owner's application or patent, the owner must correct the error by having a corrected cover sheet filed with the Assignment Services Division.

* * *

Specifically, the owner should submit the following to the Assignment Services Division:

(A) a completed cover sheet identifying the application or patent against which the assignment was improperly recorded;

(B) an affidavit or declaration (1) identifying itself as the correct owner, (2) stating that the previously recorded document was submitted with erroneous information, and (3) providing the reel and frame number of the previously recorded document; and

(C) the required fee (37 CFR 3.41) for each application or patent to be corrected.

Pursuant to MPEP § 323.01(c), Doubleshot is submitting along with this Petition: (1) a completed cover sheet as required; and (2) the Declaration of Alan Shulman (“Shulman Decl.”), the Founder of Doubleshot. Because this Petition and related papers are being submitted electronically, no fee is required under 37 C.F.R. § 3.41.

Also included in this Petition are a summary of the relevant factual circumstances surrounding the proper chain of title of the ‘827 Patent and the erroneous recordation by Knight and a discussion of legal authorities supporting the relief sought in the Petition.

Brief Factual Background

On September 21, 2007, Doubleshot recorded with the U.S. Patent and Trademark Office (“PTO”) a “New Assignment” for the parent patent (U.S. Patent No. 7,571,051) to the ‘827 Patent (Reel 019862, Frame 0698-99), conveying the parent patent and all children to Doubleshot by way of a written patent assignment. Schulman Decl. ¶ 3, Ex. A.

Subsequently, on May 13, 2016, Knight recorded with the PTO a “New Assignment” against several of Doubleshot’s patent assets, including the ‘827 Patent (Reel 038695, Frame 0100-0103) (“the Recording”), without Doubleshot’s knowledge or consent. *Id.* ¶ 5, Ex. B. In the cover sheet accompanying the Recording, Knight described the nature of the alleged conveyance to Knight as a “Judgment,” and stated that the execution date of the conveyance was November 24, 2010. Knight also attached to the cover sheet a November 24, 2010 “Order to Set Aside Dismissal and Entry of Judgment” entered in the state court litigation *William E. Knight v. Doubleshot, Inc.*, SCV-241748, Superior Court of California, County of Sonoma (“the Judgment”). *Id.* ¶ 7. No other document – such as a written assignment from Doubleshot – was included with the Recording (nor does any such document, in fact, exist). *Id.*

By way of background, the Judgment that Knight attached to the Recording arose from a business dispute between Knight and Doubleshot, which did not in any way pertain to the '827 Patent or any of Doubleshot's other patent assets. *Id.* ¶ 8. That litigation exclusively involved state court claims that were resolved by a settlement between the parties, whereby Doubleshot stipulated to entry of judgment against it "in the amount of seven hundred thousand dollars (\$700,000.00)." *Id.* Ex. B. That money amount was the sole recovery provided for in the Judgment, which makes absolutely no mention of the '827 Patent or any other Doubleshot patent asset.

To be clear, Doubleshot and its founder Mr. Shulman continue to dispute the merits of the state court litigation, which took place while Mr. Shulman was coping with his significant other's terminal illness. Due to those personal circumstances, as well as inadequate representation by counsel, Mr. Shulman did not fully appreciate the implications of the litigation and/or the settlement, and was taken completely off-guard by Mr. Knight's furtive recording of the Judgment, which has clouded the title of several of Doubleshot's patent assets.

Importantly, at no point did the Court in the *Knight v. Doubleshot* litigation ever order that any Doubleshot patent asset, such as the '827 Patent, be sold to satisfy the Judgment, nor did the Court ever appoint a receiver to liquidate any Doubleshot patent asset to satisfy the Judgment. *Id.* ¶ 9. Indeed, Knight never sought such relief with the Court, and Doubleshot never offered or agreed to transfer ownership of its patent assets. *Id.* Put simply, neither the Court nor Doubleshot has taken any action involving or impacting the ownership of the '827 Patent or the other Doubleshot patent assets. Thus, Doubleshot has been, and continues to be, the sole owner of the '827 Patent. *Id.* ¶ 10.

Furthermore, to the best of Doubleshot's knowledge, Knight has never perfected a security interest in the '827 Patent or in any other Doubleshot patent asset under Article 9 of the Uniform Commercial Code ("UCC"), as adopted in California (*see* Cal. Com. Code § 9106). *Id.* ¶ 9. Indeed, in discussions with Shulman, Knight's attorney recognized that Knight would need a security interest or a court order to obtain any interest in the Doubleshot patent assets. *Id.*

As explained further below, Knight's Recording and the related Judgment do not fall under any of the categories of documents specified in 37 C.F.R § 3.11 as being recordable with the PTO. Thus, the Recording was improper and in error and should be removed from the record under MPEP § 323.01.¹

Relevant Legal Authorities and Argument

The Code of Federal Regulations provides that certain documents relating to ownership and/or interests in patents and patent applications are recordable with the PTO. Specifically, 37 C.F.R § 3.11 ("Rule 3.11") provides, in pertinent part:

(a) Assignments of applications, patents, and registrations, and other documents relating to interests in patent applications and patents, accompanied by completed cover sheets as specified in § 3.28 and § 3.31, will be recorded in the Office. Other documents, accompanied by completed cover sheets as specified in § 3.28 and § 3.31, affecting title to applications, patents, or registrations, will be recorded as provided in this part or at the discretion of the Director.

Thus, under the plain language of Rule 3.11, recordable documents are limited to: (1) assignments or other documents relating to interest in patents and patent applications; and (2) documents affecting title to patents and patent applications. In this case, the Judgment attached to Knight's Recording does not fall within either of those categories of documents, and thus should have never been filed or recorded.

First, the Judgment is clearly not an assignment or other document relating to an interest in the '827 Patent. The Patent Act is very clear that "[a]pplications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing." 35 U.S.C. § 261 (emphasis added). The Judgment is not a written instrument conveying any ownership right or interest in the '827 Patent. In particular, the Judgment does not mention the '827 Patent, is not signed by Doubleshot, and does not otherwise specify that the '827 Patent is being assigned to Knight.

¹In view of the ongoing and contentious dispute between the parties, Doubleshot has not secured Knight's agreement to file corrective papers.

Second, the Judgment does not affect Doubleshot's title in the '827 Patent. Again, the Court in *Knight v. Doubleshot* never ordered the sale of the '827 Patent or otherwise took any action affecting title to the patent, such as by appointing a receiver to liquidate Doubleshot's patent assets to satisfy the Judgment. The Judgment simply provides for recovery of a monetary amount, without ordering how that amount is to be satisfied. Also, to Doubleshot's knowledge, Knight has never secured an interest in the '827 Patent under California's UCC relating to the Judgment. Thus, the Judgment has no impact whatsoever on Doubleshot's title in the '827 Patent.²

In conclusion, the chain of title for '827 Patent should not be considered altered by Knight's incorrect Recording because Doubleshot continues to be the sole owner of the '827 Patent. For these reasons, Doubleshot respectfully requests that the PTO remove Knight's improper Recording (Reel 038695, Frame 0100-0103) in its entirety from the record under MPEP § 323.01.

If any further information or response is required, we would kindly request the opportunity to discuss this Petition with you by telephone before a final decision is made. The undersigned attorney may be reached at (415) 200-4981.

Respectfully submitted,

Date: June 5, 2017

 /Christopher T. Holland/
Christopher T. Holland
Registration No. 36,551

HOLLAND LAW LLP
220 MONTGOMERY STREET, SUITE 800
SAN FRANCISCO, CA 94104

² Even if the Judgment could somehow be considered a security interest in the '827 Patent, the Judgment never should have been recorded as an "assignment" under Rule 3.11, as it improperly was. *See In re Cybernetic Servs., Inc.*, 252 F.3d 1039, 1052 (9th Cir. 2001) ("a security interest in a patent that does not involve a transfer of the rights of ownership is a 'mere license' and is not an 'assignment, grant or conveyance' within the meaning of 35 U.S.C. § 261"). Thus, on that basis alone the Recording and Judgment should be expunged from the PTO record.

U.S. Patent No. 8,036,827
Petition to Correct and Remove Improperly Filed and Recorded Assignment

P: 415-200-4981
F: 415-200-4989
CHolland@HollandLawLLP.com

DECLARATION OF ALAN SHULMAN

I, Alan Shulman, declare as follows:

1. I am the Founder of Doubleshot, Inc. (“Doubleshot”), and have held that position at all relevant times discussed herein. I make this declaration of my own personal knowledge and, if called as a witness, I could and would testify competently to the matters stated herein.

2. Doubleshot is the true, correct, and sole owner of the following U.S. patents/patent applications (“the Doubleshot Patent Assets”):

- 12/267,455
- 7,386,394
- 7,571,051
- 7,907,150
- 8,000,895
- 8,036,827
- 8,169,445
- 8,295,644
- 8,662,707
- 8,704,845
- 9,488,471

3. In particular, each of the Doubleshot Patent Assets has been assigned to Doubleshot by the named inventor(s). Those assignments were recorded with the U.S. Patent and Trademark Office (“PTO”) as follows:

Patent/Patent Application	Date of Recording	Reel/Frame
12/267,455	1/23/09	022150/0761-66
7,386,394	9/21/07	019862/0693-94
7,571,051	9/21/07	019862/0698-99
7,907,150	9/11/07	019812/0001-02
8,000,895	9/21/07 (recorded in parent patent 7,386,394)	019862/0693-94
8,036,827	9/21/07 (recorded in parent patent 7,571,051)	019862/0698-99
8,169,445	11/11/08	021818/0846-47
8,295,644	9/21/07 (recorded in parent application 10/914,375)	019862/0704-05

Patent/Patent Application	Date of Recording	Reel/Frame
8,662,707	11/11/08	021818/0722-24
8,704,845	11/11/08 (recorded in parent patent 8,169,445)	021818/0846-47
9,488,471	12/16/08	021990/0106-08

4. True and correct copies of those recording are attached collectively as Exhibit A.

5. Subsequently, on May 13, 2016, William E. Knight (“Knight”) recorded with the PTO a “New Assignment” against all the Doubleshot Patent Assets identified herein (Reel 038695, Frame 0100-0103) (“the Recording”), without Doubleshot’s knowledge or consent. A true and correct copy of Knight’s Recording is attached as Exhibit B.

6. Because Knight’s Recording is not an “assignment” or other document relating to or affecting title in Doubleshot Patent Assets, the Recording was submitted with erroneous information and should be removed from the record.

7. Specifically, in the “assignment” cover sheet accompanying the Recording, Knight described the nature of the alleged conveyance to Knight as a “Judgment,” and stated that the execution date of the conveyance was November 24, 2010. Knight also attached a November 24, 2010 “Order to Set Aside Dismissal and Entry of Judgment” entered in the state court litigation *William E. Knight v. Doubleshot, Inc.*, SCV-241748, Superior Court of California, County of Sonoma (“the Judgment”). Knight did not include a written assignment with the Recording because no such document exists: Doubleshot never assigned any interest in any of the Doubleshot Patent Assets to Knight.

8. To clarify, the Judgment that Knight attached to the Recording arose from a business dispute between Knight and Doubleshot, which did not pertain to any of the Doubleshot Patent Assets. That litigation exclusively involved state court claims that were resolved by a settlement between the parties, whereby Doubleshot stipulated to entry of judgment against it “in the amount of seven hundred thousand dollars (\$700,000.00).” Exhibit B. That money amount was the sole recovery provided for in the Judgment, which makes absolutely no mention of any Doubleshot Patent Asset.

9. At no point did the Court in the *Knight v. Doubleshot* litigation ever order that any Doubleshot Patent Asset be sold to satisfy the Judgment, nor did the Court ever appoint a receiver to liquidate any Doubleshot Patent Asset to satisfy the Judgment. In fact, Knight never

sought such relief with the Court, and Doubleshot never offered or agreed to transfer ownership of any patent asset. Put simply, neither the Court nor Doubleshot has taken any action involving or impacting the ownership of, or creating an interest in, any of the Doubleshot Patent Assets. Also, to the best of Doubleshot's knowledge, Knight has never perfected a security interest in any Doubleshot Patent Asset under California's version of the Uniform Commercial Code. In fact, in discussions with Shulman, Knight's attorney recognized that Knight would need a security interest or a court order to obtain any interest in the Doubleshot patent assets.

10. Therefore, Doubleshot has been, and continues to be, the sole owner of the Doubleshot Patent Assets identified herein.

11. Moreover, the chain of title for the Doubleshot Patent Assets should not be considered altered by Knight's incorrect Recording.

12. On May 17, 2017, counsel for Doubleshot sent a letter to Mr. Knight's attorney, requesting that Mr. Knight remove the improperly recorded assignments (Reel 038695, Frame 0100-0103) against the Doubleshot Patent Assets identified herein. To date, Doubleshot has received no response to that letter. Nor does it appear from the USPTO records that any correction has been made.

I declare under the penalty of perjury under the laws of the State of California and the United States that the foregoing is true and correct.

Executed on this second day of June, 2017 in San Francisco, California.



/ALAN SHULMAN/



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

May 25, 2017

PTAS

CHRISTOPHER T. HOLLAND
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504370180

United States Patent and Trademark Office
Notice of Non-Recordation of an Assignment Document

The enclosed document has been examined and found non-recordable by the Assignment Recordation Branch of the U.S. Patent and Trademark Office. The reason(s) for non-recordation are stated below:

1. Nature of conveyance should stated: Correction by declaration of erroneously application number (insert number) on reel/frame (insert reel/frame number). Please send back only declaration other pages are not necessary.

Documents being resubmitted for recordation must reflect the corrected information to be recorded, the Document ID number referenced above and all pages from this submitted document. The original date of filing of this assignment document will be maintained if resubmitted with the appropriate correction(s) by **Tuesday, July 25, 2017**, as outlined under 37 CFR 3.51. The resubmitted document must include a stamp with the official date of receipt under 37 CFR 3. Applicants may use the certified procedures under 37 CFR 1.8 or 1.10 for resubmission of the returned papers if they desire to have the benefit of the date of deposit in the United States Postal Service.

To file the resubmission electronically, navigate to the EPAS website at <http://epas.uspto.gov>, click the Start Resubmission button and enter the following information:

Document ID: 504370180

Access Code: 5QS524S1SN0CGW0

To file the resubmission in paper, send documents to: U.S. Patent and Trademark Office, Mail Stop: Assignment Recordation Branch, P.O. BOX 1450, Alexandria, VA 22313. If you have any questions regarding this notice, you may contact the Assignment Recordation Branch at 571-272-3350.

LAZENA MARTIN
ASSIGNMENT RECORDATION BRANCH
PUBLIC RECORDS DIVISION