

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SIG SAUER INC.,
Petitioner,

v.

LONE STAR FUTURE WEAPONS, INC.,
Patent Owner.

IPR2025-00410
Patent 8,919,238 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

DECISION

Granting Patent Owner's Request for Discretionary Denial and Denying
Institution of *Inter Partes* Review

Lone Star Future Weapons, Inc. (“Patent Owner”) filed a request for discretionary denial (Paper 8, “DD Req.”) in the above-captioned case, and SIG Sauer Inc. (“Petitioner”) filed an opposition (Paper 10, “DD Opp.”).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in this proceeding. This determination is based on the totality of the evidence and arguments the parties have presented.

U.S. Patent No. 8,919,238 B2 issued over 10 years ago, and Petitioner subsequently developed a competing product without challenging this patent. DD Req. 28–29. Additionally, Petitioner filed its Petition after Patent Owner filed a trade secret misappropriation suit against Petitioner in district court, which did not involve the challenged patent. *Id.* at 1; *see* Ex. 2001. Petitioner subsequently filed a counterclaim in the district court action seeking a declaratory judgment of non-infringement of the ’238 patent. DD Opp. 35; Ex. 2004, 16–26.

These circumstances favor discretionary denial. In particular, based on the age of the patent and the timing of Petitioner’s challenge, Patent Owner’s settled expectations weigh in favor of discretionary denial. *See Dabico Airport Solutions Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (Acting Director Stewart June 18, 2025). In addition, the parties are engaged in related litigation, and there is a persuasive argument that the filing of the Petition may be inappropriate here. *See* DD Req. 29–30.

Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petition is denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

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ORDERED that Patent Owner's request for discretionary denial is *granted*; and

FURTHER ORDERED that the Petition is *denied*, and no trial is instituted.

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