

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EARLY WARNING SERVICES, LLC,

Petitioner,

v.

FINTECH INNOVATION ASSOCIATES LLC,

Patent Owner.

PGR2022-00046

Patent D945,453 S

Before KEN B. BARRETT, BART A. GERSTENBLITH, and
ROBERT L. KINDER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

JUDGMENT

Granting Request for Adverse Judgment After
Institution of Trial
37 C.F.R. § 42.73(b)

On February 6, 2023, Early Warning Services, LLC (“Petitioner”) sought leave to file a motion for adverse judgment against Patent Owner. Ex. 3005. Petitioner states that, on February 2, 2023, Fintech Innovation Associates LLC (“Patent Owner”) paid the requisite fee for a statutory disclaimer Patent Owner filed on October 10, 2022. *Id.*; *see also* Ex. 3002 (statutory disclaimer), Ex. 3006 (electronic patent application fee transmittal). As discussed below, the statutory disclaimer (Ex. 3002) disclaims the sole claim of U.S. Patent No. D945,453 S (“the ’453 patent”) (Ex. 1001).

Because a statutory disclaimer of the sole claim in a proceeding is construed as a request by a patent owner for adverse judgment against itself pursuant to 37 C.F.R. § 42.73(b), we determine that there is no need for a motion for adverse judgment, and, therefore, we deny Petitioner’s request for leave to file a motion. Additionally, for the same reasons, we enter adverse judgment against Patent Owner.

BACKGROUND

On October 10, 2022, Patent Owner filed a statutory disclaimer disclaiming the claim of the ’453 patent. Ex. 3002. The statutory disclaimer was not accompanied by the required fee, as we noted in an Order issued on November 15, 2022. Paper 13 at 4. *See also* 37 C.F.R. § 1.321(a) (“The disclaimer, to be recorded in the Patent and Trademark Office, must: (4) Be accompanied by the fee set forth in [37 C.F.R.] § 1.20(d).”).

On January 5, 2023, the Board instituted post grant review of the claim of the ’453 patent. Paper 16.

As noted above, Petitioner, by email, requests leave to file a motion for adverse judgment against Patent Owner based on the statutory

disclaimer. Ex. 3005. Petitioner informs the Board that on February 2, 2023, Patent Owner paid the fee for filing a statutory disclaimer, and Petitioner states that “the entire scope of the ‘453 patent has now been properly disclaimed.” Exs. 3005, 3006. On February 6, 2023, Patent Owner responded to Petitioner’s email with the following statement: “Patent owner FIA supports.” Ex. 3005.

DISCUSSION

A party may request judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). Actions construed as a request for entry of adverse judgment include “[c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial.” *Id.*

A disclaimer is “considered as part of the original patent” as of the date on which it is “recorded” in the Office. 35 U.S.C. § 253(a). For a disclaimer to be “recorded” in the Office, the document filed by the patent owner must:

- (1) Be signed by the patentee, or an attorney or agent of record;
- (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
- (3) State the present extent of patentee’s ownership interest in the patent; and
- (4) Be accompanied by the fee set forth in [37 C.F.R.] § 1.20(d).

37 C.F.R. § 1.321(a). “[N]othing in the statutes or regulations requires any action by the [Patent Office] for a disclaimer to be ‘recorded.’” *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998).

We have reviewed Patent Owner's signed disclaimer (Ex. 3002), the electronic patent application fee transmittal submitted on February 2, 2023 (Ex. 3006), and the Office's public records. Patent Owner's payment of the requisite fee in order to perfect the disclaimer is confirmation that Patent Owner desires to disclaim the sole claim involved in this proceeding. We conclude that a disclaimer of the claim of the '453 patent pursuant to 35 U.S.C. § 253(a) has been recorded in the Office as of February 2, 2023.

Accordingly, we construe this disclaimer as a request for adverse judgment, and we enter judgment against Patent Owner with respect to the claim of the '453 patent.

ORDER

It is

ORDERED that adverse judgment is *entered* under 37 C.F.R. § 42.73(b) against Patent Owner and the challenged claim of the '453 patent is *cancelled*.

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Patent D945,453 S

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