

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROTECT ANIMALS WITH SATELLITES, LLC,
Petitioner,

v.

ONPOINT SYSTEMS, LLC,
Patent Owner.

IPR2022-01139 (Patent 9,924,314 B2)
IPR2022-01141 (Patent 9,922,522 B2)¹

Before LYNNE H. BROWNE, DANIEL J. GALLIGAN, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

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

¹ This Order is entered into each case. The parties are not authorized to use this joint heading and filing style in their papers.

I. INTRODUCTION

Protect Animals with Satellites, LLC (“Petitioner”) filed petitions seeking *inter partes* review of and challenging the patentability of claims 1–12 of U.S. Patent No. 9,924,314 B2 (“the ’314 patent”) and claims 1–18 of U.S. Patent No. 9,924,314 B2 (“the ’522 patent”). IPR2022-01139 (“1139 IPR”), Paper 1; IPR2022-01141 (“1141 IPR”), Paper 1. On December 9, 2022, we instituted trial in these proceedings. 1139 IPR, Paper 11; 1141 IPR, Paper 9.

On March 10, 2023, OnPoint Systems, LLC (“Patent Owner”) filed a Patent Owner’s Response in each proceeding. 1139 IPR, Paper 15; 1141 IPR, Paper 13. In the respective Responses, Patent Owner notifies the Board that Patent Owner has disclaimed claims 1–12 (all of the challenged claims) of the ’314 patent and claims 1–18 (all of the challenged claims) of the ’522 patent. 1139 IPR, Paper 15, 1–2; 1141 IPR, Paper 13, 1–2.

II. 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;

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(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 disclaimers (1139 IPR, Ex. 2003; 1141 IPR, Ex. 2003), which authorize payment of the required fee, and the Office's public records. We conclude that a disclaimer of all of the challenged claims of the '314 and '522 patents pursuant to 35 U.S.C. § 253(a) has been recorded in the Office as of March 10, 2023.

Accordingly, we construe the disclaimers as requests for adverse judgment, and we enter judgment against Patent Owner with respect to all of the challenged claims of the '314 and '522 patents.

III. ORDER

It is ORDERED that adverse judgment is *entered* under 37 C.F.R. § 42.73(b) against Patent Owner.

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FOR PETITIONER:

Gregory S. Bishop

Haden Marrs

TROUTMAN PEPPER HAMILTON SANDERS LLP

gregory.bishop@troutman.com

haden.marrs@troutman.com

FOR PATENT OWNER:

Monté T. Squire

Patrick D. McPherson

Paul H. Belnap

DUANE MORRIS, LLP

mtsquire@duanemorris.com

pdmcperson@duanemorris.com

phbelnap@duanemorris.com

Steven G. Saunders

NUTTER, McCLENNEN & FISH, LLP

ssaunders@nutter.com