

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EARLY WARNING SERVICES, LLC, and
SAMSUNG ELECTRONICS CO., LTD.,

Petitioner,

v.

WEPAY GLOBAL PAYMENTS LLC,

Patent Owner.

PGR2022-00031

PGR2022-00045

Patent D930,702 S

Before GRACE KARAFFA OBERMANN, SCOTT A. DANIELS,
and MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

Per curiam.

FINAL WRITTEN DECISION

Adverse Judgment Based on Disclaimer

37 C.F.R. § 42.73(b)

Alternatively,

Determining Sole Challenged Claim Unpatentable

35 U.S.C. § 328(a)

I. INTRODUCTION

a. Background

On October 7, 2022, based on the information advanced in the Petition filed by Early Warning Services, LLC (“EWS”) and the Preliminary Response filed by Wepay Global Payments LLC (“Patent Owner”), we instituted a post-grant review of the sole design claim of U.S. Patent No. D930,702 S (“the ’702 patent”). *See* Paper 1 (Petition or “Pet.”); Paper 9 (Preliminary Response); Paper 22 (Institution Decision); Ex. 1001 (the ’702 patent). On December 20, 2022, we granted a motion for joinder filed by Samsung Electronics Co., LTD (“Samsung”). *See* Paper 28. We refer to EWS and Samsung collectively as “Petitioner.”

We instituted post-grant review based on the grounds of invalidity asserted in the Petition, as shown in the following chart.

Claim Challenged	35 U.S.C. §¹	Reference(s)
1	102	Reddy ²
1	103	Reddy
1	103	Reddy, SGQR ³

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103, effective March 16, 2013. Given that the application from which the ’702 patent issued was filed after this date, the current versions of §§ 102 and 103 apply.

² U.S. Patent Appl. Pub. No. 2018/0260806 A1, issued Sept. 17, 2018 (Ex. 1004).

³ Screenshots of YouTube video, “SGQR—Singapore Quick Response Code,” <https://www.youtube.com/watch?v=1VmJm9imBp4> (Ex. 1005). Petitioner asserts a publication date of September 16, 2018. Pet. 25.

Claim Challenged	35 U.S.C. § ¹	Reference(s)
1	102	GrabPay ⁴
1	103	Digital Debit Video, ⁵ Digital Debit Patent ⁶

Pet. 11.⁷ In this Final Written Decision, we grant Petitioner’s motion for adverse judgment (Paper 30) as supported by a supplement authorized by the Board (Paper 32; Ex. 1103). In addition, we find that Petitioner has shown by a preponderance of the evidence that the challenged design claim is unpatentable based on the grounds asserted in the Petition.

Patent Owner did not file a response to Petitioner’s motion for adverse judgment within the time provided by the Board. *See* Ex. 1103 (setting February 8, 2023, as the due date for a response). Petitioner, however, directs us to information that “Wepay Global Payments LCC waives any opposition to the petitioner’s motion for Adverse” Judgment. Ex. 1105; *see* Paper 32, 2 (quoting Ex. 3002, 3 (indicating that “Wepay Global Payments LLC requests . . . Adverse Judgment under 37 C.F.R. Section 42.73(b) and immediate termination of this action”)).

⁴ Screenshots of YouTube video, “GrabPay Standalone,” <https://www.youtube.com/watch?v=bc84snlxTRc> (Ex. 1006). Petitioner asserts a publication date of March 20, 2020. Pet. 32.

⁵ Screenshots of YouTube video, “Digital Debit App Preview,” <https://www.youtube.com/watch?v=tDqvQFJB8GA> (Ex. 1007). Petitioner asserts a publication date of November 20, 2017. Pet. 39.

⁶ U.S. Patent No. D857,054 S, issued August 20, 2019 (Ex. 1008).

⁷ Although the Petition sets forth four numbered grounds, two distinct grounds are embedded within Petitioner’s second-numbered ground. *See* Pet. 11 (asserting, in the second-numbered ground, obviousness over Reddy “alone or in view of” SGQR).

b. Real Parties-in-Interest

EWS identifies itself as “the only real party in interest.” Pet. 7. EWS further identifies, as customers of EWS, “Bank of America, N.A., JPMorgan Chase Bank, N.A., and PNC Bank, N.A.” *Id.*

Samsung “identifies Samsung Electronics Co., Ltd. and Samsung Electronics America Inc. as real parties-in-interest.” Paper 28, 3 (citing PGR2022-00045 (“PGR045”), Paper 9 at 2 (Samsung’s petition in PGR045)).

Patent Owner identifies Wepay Global Payments LLC as “the real party in interest” and sole owner of the ’702 patent. Paper 11, 1 (Patent Owner’s Mandatory Notices).

c. Related Matters

The parties identify ten district court actions as related to this proceeding and involving the ’702 patent, namely: (1) *Wepay Global Payments LLC v. Amazon.com, Inc.*, No. 1:2022-cv-01061 (N.D. Ill.); (2) *Wepay Global Payments LLC v. Apple Inc.*, No. 6:2022-cv-00223 (W.D. Tex.) (dismissed); (3) *Wepay Global Payments LLC v. Bank of America, N.A.*, 1:2022-cv-00105 (N.D. Ill.); (4) *Wepay Global Payments LLC v. JPMorgan Chase Bank, N.A.*, 1:2022-cv-00103 (N.D. Ill.); (5) *Wepay Global Payments LLC v. McDonald’s Corporation*, 1:2022-cv-01064 (N.D. Ill.); (6) *Wepay Global Payments LLC v. PayPal, Inc.*, 6:2021-cv-01094 (W.D. Tex.); (7) *Wepay Global Payments LLC v. PNC Bank, N.A.*, 1:2021-cv-05052 (N.D. Ill.); (8) *Wepay Global Payments LLC v. Samsung Electronics Co., Ltd. et al.*, 6:2021-cv-01095 (W.D. Tex.); (9) *Wepay Global Payments LLC v. Tesla, Inc.*, 6:2022-cv-00224 (W.D. Tex.); and

(10) *Wepay Global Payments LLC v. Wal-Mart Stores, Inc.*, 1:2022-cv-01062 (N.D. Ill.) (dismissed). Pet. 8–9; Paper 9, 2–3 (citing PGR045, Paper 8 at 3–4); Paper 11, 1–2.

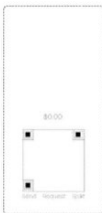
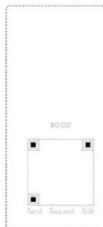
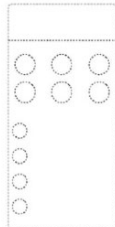
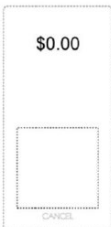
Samsung identifies two additional district court actions as related to this proceeding and involving the ’702 patent, namely: (1) *Wepay Global Payments LLC v. PNC Bank, N.A.*, 2:22-cv-00592 (W.D. Pa.); and (2) *Wepay Global Payments LLC v. Wells Fargo Bank, N.A.*, 6:22-cv-00363 (W.D. Tex.). Paper 9, 2–3 (citing PGR045, Paper 8 at 3–4).

II. DISCUSSION

We organize our discussion into two sections, addressing first Petitioner’s motion for adverse judgment (Papers 30, 32), then deciding, in addition, the merits of Petitioner’s challenges.

a. Adverse Judgment Based on Disclaimer

The ’702 patent includes five figures that describe two embodiments of a graphical user interface (“GUI”) design. We reproduce those figures and embodiments in the chart below.

'702 Patent		
First Embodiment		
		
	FIG. 1	+ FIG. 2
Second Embodiment		
		
	FIG. 3	FIG. 4
		
	FIG. 5	

Paper 32, 1. The above chart reproduces and identifies Figures 1 and 2 from the '702 patent as the first embodiment of the invention and Figures 3, 4, and 5 as the second embodiment of the invention.

On October 5, 2022, Patent Owner filed a statutory disclaimer of the first embodiment, including Figures 1 and 2. Ex. 1106; Paper 32, 2. On January 26, 2023, Patent Owner filed a statutory disclaimer of the second embodiment, including Figures 3, 4, and 5. Ex. 1107; Paper 32, 2. Patent Owner successfully paid the statutory disclaimer fees in connection with both disclaimers. Ex. 1106, 4; Ex. 1107, 4; Paper 32, 2–3.

Based on the information presented, we find that Patent Owner, by disclaiming all figures and embodiments described in the '702 patent, has disclaimed the entire scope of the sole design claim at issue, such that no challenged claim remains in this proceeding. Specifically, in that regard, the '702 patent claims and describes two embodiments, where the first embodiment is depicted in Figures 1 and 2, and the second embodiment is depicted in Figures 3, 4, and 5. Ex. 1001, code (57). The statutory disclaimers, taken together, disclaim both embodiments and all five figures set forth in the '702 patent. Exs. 1106, 1107. Accordingly, we determine that adverse judgment against Patent Owner based on the disclaimers is warranted. 37 C.F.R. §§ 42.73(b)(1), 42.73(b)(2); Paper 32, 3.⁸

To the extent reasonable minds could differ as to whether Patent Owner intends to disclaim the full scope of the subject matter of the sole design claim at issue, we determine, in addition, that Petitioner has shown by

⁸ We do not reach the additional bases for adverse judgment advanced by Petitioner. *See generally* Paper 30.

a preponderance of the evidence that the challenged claim is unpatentable. In the next section, we explain our reasoning for that alternative determination.

b. Final Written Decision on the Merits

In our Institution Decision, we determined that Petitioner had shown that, more likely than not, it would prevail at trial in showing that the sole design patent claim is unpatentable in view of Reddy. Paper 22. Patent Owner has not substantively participated in the trial phase of this proceeding. For example, Patent Owner did not file a response to the Petition within the time provided or object to any evidence advanced in the Petition. *See* Paper 30, 2. Patent Owner did not respond to two requests to designate replacement counsel, or arrange a teleconference with the Board, after discharging its original counsel. Paper 26, 5; Paper 29, 3. Furthermore, Patent Owner did not respond to Petitioner’s motion for adverse judgment within the time set by the Board. Ex. 1103 (setting February 8, 2023, as the due date for a response). Accordingly, we agree with Petitioner that “the evidentiary record for this proceeding is closed.” Paper 30, 2; *see* Paper 22, 15 (providing notice that any arguments made by Patent Owner in the Preliminary Response would not be considered if not advanced during the trial phase of the proceeding).

We have reviewed the evidence and arguments presented in the Petition as well as our preliminary findings of fact and conclusions of law as set forth in the Institution Decision. *See generally* Pet.; Paper 22. For the reasons set forth in our Institution Decision and based on a review of all the evidence of record, we find that Petitioner has proven by a preponderance of

the evidence that the subject matter of the sole claim of the '702 patent is anticipated by, or obvious over, the disclosure of Reddy. Paper 22, 10–14.

In particular, we find that Reddy discloses a design having substantially the same overall appearance as the claimed design, as shown in Petitioner’s comparison illustration reproduced below.

'702 Patent Ex. 1001	an image of this:  followed by an image of this: 
Reddy Ex. 1004	an image of this:  followed by an image of this: 

Paper 22, 10 (citing Pet. 63). The above illustration compares the claimed design in the upper half to Reddy’s design in the lower half. Both designs include an image of a Three Square Arrangement⁹ followed by an image of “a \$0.00 in practically identical style and font.” *Id.* at 10–11 (quoting Pet. 64).

We determine that Petitioner proves by a preponderance of the evidence, moreover, “that ‘the overall visual effect of the claimed design,’ when compared to ‘the design disclosed in Reddy[,] would be substantially the same to an ordinary observer.’” *Id.* at 11 (alteration in original) (citation omitted); Pet. 64–67 (and evidence cited therein). Based on the full trial record, we agree with Petitioner and find that “there is no material difference

⁹ We adopt Petitioner’s convention and refer to the first image of the claimed design as the Three Square Arrangement.

between Reddy and the claimed design such that Reddy anticipates the challenged claim.” Paper 22, 11; Pet. 67–69.

To the extent “any ‘slightly different spacing of the squares,’ as between the claimed and prior art designs,” is not *de minimus*, we find “that the ordinary designer would have modified Reddy’s design to mirror the claimed design” in order “to increase the amount of data” contained in the code. Paper 22, 13 (quoting Pet. 72 (citing Ex. 1002 ¶ 97)). The ordinary designer, considering Reddy alone, “would find the claimed ‘design as a whole has substantially the same overall visual appearance as the Reddy design,’ as so modified.” *Id.* (quoting Pet. 73 (citing Ex. 1002 ¶ 99)). Based on the full trial record, we determine that Reddy renders the challenged claim unpatentable as obvious.

In our Institution Decision, we stated that disputed issues of fact surround the other grounds of invalidity asserted in the Petition, when considered in view of arguments made by Patent Owner in the Preliminary Response (Paper 9). Paper 22, 14. However, we expressly notified Patent Owner that “any issue not raised in a timely-filed response to the Petition, or as permitted in another manner during trial, even if asserted by Patent Owner in the Preliminary Response or discussed in this Decision,” would be deemed forfeited. Paper 22, 15. No arguments or issues have been made of record by Patent Owner.

We conclude that Patent Owner has forfeited any arguments opposing the information advanced in the Petition with respect to the other asserted grounds of invalidity. We adopt the reasoning set forth in the Petition with respect to those grounds. *See* Pet. 23–45 (arguments and evidence directed to

publication and accessibility of SGQR, GrabPay, Digital Debit Video, and Digital Debit Patent), 73–88 (arguments and evidence directed to the grounds that assert SGQR, GrabPay, Digital Debit Video, and Digital Debit Patent). On this record, Petitioner demonstrates by a preponderance of the evidence that the subject matter of the challenged claim would have been obvious based on the other grounds asserted in the Petition. *Id.*

III. CONCLUSION

We determine that the statutory disclaimers are effective to disclaim the sole design claim of the '702 patent. Exs. 1106, 1107.

In addition, we determine that Petitioner has shown by a preponderance of the evidence that the sole design claim of the '702 patent is unpatentable, as summarized in the following chart.¹⁰

Claim	35 U.S.C. §	Reference(s)	Claim Shown Unpatentable	Claim Not Shown Unpatentable
1	102	Reddy	1	
1	103	Reddy	1	
1	103	Reddy, SGQR	1	
1	102	GrabPay	1	

¹⁰ We draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). We remind Patent Owner of its continuing obligation to notify the Board of any related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

Claim	35 U.S.C. §	Reference(s)	Claim Shown Unpatentable	Claim Not Shown Unpatentable
1	103	Digital Debit Video, Digital Debit Patent	1	
Overall Outcome			1	

IV. ORDER

It is

ORDERED that adverse judgment under 37 C.F.R. § 42.73(b) is *entered* against Patent Owner and the challenged claim of the '702 patent is *cancelled*;

FURTHER ORDERED that, alternatively, Petitioner has shown by a preponderance of the evidence that the sole design claim of the '702 patent is unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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