

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITBIT, INC.
Petitioner,

v.

SMART WEARABLE TECHNOLOGIES INC.,
Patent Owner.

Case IPR2018-00252
Patent 6,997,882 B1

Before PATRICK R. SCANLON and ZHENYU YANG,
Administrative Patent Judges.

YANG, *Administrative Patent Judge.*

ORDER

Denying Patent Owner's Request for Adverse Judgment without Prejudice
37 C.F.R. § 42.73 (b)

INTRODUCTION

Fitbit, Inc. filed a Petition, requesting an *inter partes* review of claims 8–10 of U.S. Patent No. 6,997,882 B1. Paper 2. After we instituted the review (*see* Paper 7), Smart Wearable Technologies Inc. (“Patent Owner”) filed a Disclaimer of Challenged Claims, which we construe as a request for adverse judgment. Paper 11. The request, in its entirety, reads as follows: “Pursuant to 37 C.F.R. § 42.73(b)(2), Patent Owner Smart Wearable Technologies Inc. hereby disclaims claims 8 – 10 of U.S. Patent No. 6,997,882. No claims remain at issue for trial. Patent Owner requests entry of adverse judgment in IPR2018-00252.” *Id.* We deny Patent Owner’s request for adverse judgment without prejudice.

“A party may request judgment against itself at any time during a proceeding.” 37 C.F.R. § 42.73(b). Actions construed to be a request for adverse judgment include “disclaimer of a claim such that the party has no remaining claim in the trial.” *Id.* § 42.73(b)(2). In an *inter partes* review, “[t]he patent owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent.” *Id.* § 42.107(e). Under the statute,

A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

35 U.S.C. § 253(a).

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In the request, Patent Owner has not shown that it has complied with 35 U.S.C. § 253(a) or 37 C.F.R. § 1.321(a). Thus, we deny Patent Owner's request for adverse judgment. Patent Owner may, if it so wishes, file a renewed request for adverse judgment after filing a proper statutory disclaimer with the Office. Patent Owner is reminded that the Board does not process such statutory disclaimer.

ORDER

Accordingly, it is

ORDERED that Patent Owner's request for adverse judgment is denied without prejudice; and

FURTHER ORDERED that Patent Owner is authorized to file a renewed request for adverse judgment after filing a proper statutory disclaimer in compliance with 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a).

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