

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MITEK SYSTEMS, INC.,
Petitioner,

v.

ROTHSCHILD MOBILE IMAGING INNOVATIONS, LLC,
Patent Owner.

Case IPR2015-00624
Patent 7,456,872 B2

Before JAMESON LEE, DAVID C. McKONE, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

JUDGMENT AND FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

BACKGROUND

On August 6, 2015, the Board instituted *inter partes* review of claims 27, 28, 38, and 39 of U.S. Patent No. 7,456,872 B2 (“the ’872 patent”). Paper 7. In a conference call on November 23, 2015, counsel for Patent Owner Rothschild Mobile Imaging Innovations, LLC, informed the Board that Patent Owner had decided not to contest the challenge of the claims for which trial was instituted in this proceeding, and we informed Patent Owner that it should file a request for adverse judgment. *See* Paper 21, 2. Counsel for Petitioner Mitek Systems, Inc., indicated that Petitioner would not oppose Patent Owner’s filing of such a request. *Id.* Following the conference call, Patent Owner on November 30, 2015, filed a Request to Terminate Proceeding (Paper 22), stating that, “[b]ecause Patent Owner does not intend to respond to the Petition with respect to the four claims under review, and it is willing to abandon those claims as a result, Patent Owner seeks termination of this proceeding.” Paper 22, 2. On December 3, 2015, Patent Owner supplemented its Request to Terminate by filing a Request for Adverse Judgment (Paper 23), stating that, “[b]ecause Patent Owner does not intend to respond to the Petition with respect to the four claims under review, and it is willing to abandon those claims as a result, Patent Owner seeks an[] adverse judgment in this proceeding.” Paper 23, 2.

DISCUSSION

A party may request entry of adverse judgment against itself at any time during a proceeding. *See* 37 C.F.R. § 42.73(b). Here, in view of Patent Owner’s explicit request for adverse judgment, entry of judgment adverse to

Patent Owner and cancellation of claims 27, 28, 38, and 39 of the '872 patent are appropriate. Further, because “[a] judgment . . . disposes of all issues that were, or by motion reasonably could have been, raised and decided,” 37 C.F. R. § 42.73(a), we dismiss Patent Owner’s co-pending Request to Terminate Proceeding as moot.

ORDER

Accordingly, it is

ORDERED that Patent Owner’s Request for Adverse Judgment is GRANTED;

FURTHER ORDERED that judgment is entered against Patent Owner with respect to claims 27, 28, 38, and 39 of the '872 patent;

FURTHER ORDERED that claims 27, 28, 38, and 39 of the '872 patent are *unpatentable*, and a certificate canceling those claims shall issue in due course;

FURTHER ORDERED that Patent Owner’s Request to Terminate Proceeding is DISMISSED as moot; and

FURTHER ORDERED that this decision and entry of adverse judgment constitutes a final written decision under 35 U.S.C. § 318(a).

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