

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HENROB LTD.,
Petitioner,

v.

NEWFREY LLC,
Patent Owner.

IPR2019-00269
Patent 9,803,675 B2

Before CARL M. DeFRANCO, SCOTT C. MOORE, and
ERIC C. JESCHKE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

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

I. INTRODUCTION

Henrob Ltd. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–12 of U.S. Patent 9,803,675 B2 (the “’675 Patent”). Paper 1 (“Petition”). Newfrey LLC (“Patent Owner”) declined to file a preliminary response. On May 16, 2019, we instituted an *inter partes* review as to all challenged claims. Paper 6.

After institution, Patent Owner filed a Non-Contingent Motion to Amend and Request for Preliminary Guidance. Paper 11 (“Motion to Amend”). Petitioner filed a Response to the Motion to Amend (Paper 18), and we issued Preliminary Guidance regarding the Motion to Amend (Paper 19). Patent Owner subsequently filed a Motion to Withdraw its Motion to Amend (Paper 21), which we granted (*see* Paper 23). Accordingly, the claims now at issue in this proceeding are the same ones challenged in the Petition—original claims 1–12 of the ’675 Patent.

On December 12, 2019, Patent Owner filed an Unopposed Request for Adverse Judgment, asking the Board “to cancel claims 1–12 of U.S. Patent No. 9,803,675 . . . and enter adverse judgment against Patent Owner.” Paper 24 (“Request for Adverse Judgment”).¹ In this filing, Patent Owner represented that “Petitioner does not oppose Patent Owner’s request for adverse judgment.” *Id.*

II. DISCUSSION

Under 37 C.F.R. § 42.73(b), “[a] party may request judgment against itself at any time during a proceeding.” As permitted by this Rule, Patent Owner has explicitly asked the Board to enter adverse judgment cancelling

¹ We authorized this filing in our December 9, 2019, Order (Paper 20).

claims 1–12 of the '675 Patent. Paper 24. Claims 1–12 are the only claims at issue in this proceeding. *See* Paper 1.

III. CONCLUSION

Having reviewed Patent Owner's Motion for Adverse Judgment, we determine that entry of judgment against Patent Owner cancelling claims 1–12 of the '675 Patent is appropriate. Thus, we grant the Motion for Adverse Judgment pursuant to 37 C.F.R. § 42.73(b). This constitutes a final written decision pursuant to 35 U.S.C. § 318(a) cancelling claims 1–12 of the '675 Patent.

IV. ORDER

Accordingly, it is

ORDERED that adverse judgment is entered against Patent Owner pursuant to 37 C.F.R. § 42.73;

FURTHER ORDERED that claims 1–12 of the '675 Patent are cancelled; and

FURTHER ORDERED that this constitutes a Final Written Decision under 35 U.S.C. § 318(a);

FURTHER ORDERED that Patent Owner shall file a notice and copy of this judgment in the files of any proceeding or action involving the '675 patent; and

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.73(d)(3), Patent Owner is precluded from taking any action inconsistent with this judgment, including obtaining or maintaining any patent claim that is not patentably distinct from the cancelled claims in this proceeding.

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