

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PALO ALTO NETWORKS, INC.,  
Petitioner,

v.

FINJAN, INC.,  
Patent Owner.

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Case IPR2016-00151  
Patent 8,141,154

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Before, THOMAS L. GIANNETTI, MIRIAM L. QUINN, and  
PATRICK M. BOUCHER, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

We issued a Final Written Decision in this proceeding on March 14, 2017. Paper 51. In that Decision we determined that Petitioner had not shown by a preponderance of the evidence that challenged claims 1–8, 10, and 11 of the '154 patent are unpatentable. *Id.* The Decision, however, did not address challenged dependent claims 9 and 12 because we denied institution of those claims. Paper 10. Petitioner appealed the Final Written Decision. *See* Paper 54. On April 24, 2018, and while that appeal was pending, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018). The Federal Circuit, pursuant to Petitioner's request, remanded this proceeding to the Board to address the non-instituted claims set forth in the Petition. *See* Ex. 3001.

#### ORDER

We modify the institution decision to include review of dependent claims 9 and 12 of the '154 patent on the grounds set forth in the petition.

IPR2016-00151  
Patent 8,141,154

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