

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-00151
Patent 8,141,154

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

QUINN, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding—Remand Briefing Schedule
37 C.F.R. § 42.5

On January 22, 2019, the panel held a conference call with counsel for Palo Alto Networks, Inc. (“Petitioner”) and Finjan, Inc. (“Patent Owner”) to discuss the procedure and schedule on remand. The parties agreed to a schedule that allows Petitioner to initiate the briefing by filing, within three weeks of the call, a Petitioner’s Institution Response Brief. Patent Owner would have the opportunity to respond to Petitioner’s Brief, within three weeks of Petitioner’s filing. In particular, Patent Owner indicated that it may wish to raise an argument under 35 U.S.C. § 315(e)(1). We also discussed further rounds of reply and sur-reply papers with deadlines in one-week intervals. Petitioner also expressed a potential request for a hearing; while Patent Owner expressed that a hearing was not necessary given the narrow issues on remand. Nevertheless, if the Board sets a date for a telephonic hearing, both parties stated they would present argument. Based on the discussion with the parties, and the issues presented on remand, we hereby set the following schedule (see DUE DATE APPENDIX) and instructions.

ORDER

1. DUE DATE 1: Petitioner is authorized to file an Institution Response Brief of no more than ten pages to address the Board’s discussion in the institution decision of the newly-added claims: claims 9 and 12 of the ’154 patent. Petitioner’s Institution Response Brief is for identifying matters that Petitioner believes the Board misapprehended or overlooked, or otherwise erred in its institution decision discussing the newly-added claims. Petitioner should not direct its arguments to issues that were decided in the Final Written

Decision, as those issues were fully briefed before the Board and in the Federal Circuit. Petitioner is not permitted to introduce new evidence in its Institution Response Brief. Finally, we note that Petitioner retains the burden to prove unpatentability of the previously non-instituted claims by a preponderance of the evidence, and that burden is unchanged even if Patent Owner waives supplemental briefing on the newly-added claims. *See* 35 U.S.C. § 316(e).

2. DUE DATE 2: Patent Owner is authorized, but is not required, to file a Response to Petitioner’s Institution Response Brief, of no more than ten pages. The Response should address only arguments that are presented in Petitioner’s Brief as to why the institution decision was in error or issues that address *non-substantive* reasons why the proceeding should be terminated. Patent Owner shall not introduce new evidence without authorization by the Board.

3. DUE DATE 3: If Patent Owner determines that it desires to file supporting evidence with its Response or raise substantive arguments not responsive to Petitioner’s Brief, Patent Owner shall meet and confer with Petitioner and arrange a telephone conference with the Board by no later than this date.

4. DUE DATE 4: Petitioner is authorized, but not required, to file a Reply, of no more than seven pages. “A reply may only respond to arguments raised in the corresponding opposition or patent owner response.” 37 C.F.R. § 42.23(b). Petitioner may not submit new evidence or argument in its Reply absent express authorization from the Board.

5. DUE DATE 5: Patent Owner is authorized, but not required to file, a Sur-reply, of no more than seven pages. The sur-reply may only respond to arguments raised in the reply. Patent Owner may not submit new evidence with the sur-reply.
6. DUE DATE 6: Either party may request oral argument, which would proceed as a telephonic hearing.
7. DUE DATE 7: Oral argument (if requested).

DUE DATE APPENDIX

DUE DATE 1	February 13, 2019
Petitioner's Institution Response Brief	
DUE DATE 2	March 6, 2019
Patent Owner's Response	
DUE DATE 3	February 18, 2019
Conference Call Request	
DUE DATE 4	March 13, 2019
Petitioner's Reply	
DUE DATE 5	March 20, 2019
Patent Owner's Sur-reply	
DUE DATE 6	March 20, 2019
Request for oral argument	
DUE DATE 6	March 26, 2019
Oral argument (if requested)	

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