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 No. 8,141,154

PATENT OWNER'S RESPONSE ON REMAND

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On January 23, 2019, the Board modified its original "institution decision to include review of dependent claims 9 and 12 of the '154 patent." Paper 55 at 2. Pursuant to the Remand Briefing Schedule, Petitioner filed its Institution Response Brief on February 13, 2019. Paper 56 at 5; Paper 60. Patent Owner's Response is being timely filed by March 6, 2019. *Id.*

I. INTRODUCTION

Petitioner is estopped under 35 U.S.C. § 315(e)(1) from further participation in this proceeding. Each independent claim of the '154 Patent was the subject of a Final Written Decision in IPR2015-01979, which was filed by Petitioner. *See Palo Alto Networks, Inc., v. Finjan, Inc.*, IPR2015-01979, Paper 62.

II. THIS PROCEEDING SHOULD BE TERMINATED BECAUSE PETITIONER IS ESTOPPED UNDER 35 U.S.C. § 315(E)(1)

Petitioner filed petitions for *inter partes* review challenging claims of the '154 Patent in Case Nos. IPR2015-01979 and IPR2016-00151. On March 15, 2017, the Board issued Final Written Decisions ("FWD") in both cases confirming the patentability of claims 1–8, 10, and 11. Although the Federal Circuit vacated the Board's FWD in this case, it affirmed the Board's decision in IPR2015-01979. *See Palo Alto Networks, Inc., v. Finjan, Inc.*, 2017-2314, 2018 WL 6040843, at *6 (Fed. Cir. Nov. 19, 2018).

By the plain terms of 35 U.S.C. § 315(e)(1), Petitioner cannot "maintain a proceeding before the Office with respect to [claims 1–8, 10 and 11] on any ground

that the petitioner raised or reasonably could have raised during that *inter partes* review." 35 U.S.C. § 315(e)(1). There should be no question that Petitioner could have raised the grounds asserted in IPR2016-00151 in IPR2015-01979 given that the two petitions were filed a little over a month apart. Moreover, Petitioner's Brief on Estoppel in this case (Paper 30) made no attempt to demonstrate that it could not "have raised" the grounds presented in IPR2016-00151 in its earlier-filed petition. Accordingly, it should not be in dispute that Petitioner is estopped from maintaining the instant proceeding with respect to claims 1–8, 10, and 11.

The fact that Petitioner is estopped from maintaining this proceeding with respect to claims 1-8, 10, and 11 means that this proceeding should be dismissed pursuant to 35 U.S.C. § 315(e)(1) for at least the reasons discussed below.

A. The Proceeding Should Be Terminated Because Estoppel Attaches to Non-Challenged Dependent Claims

Petitioner is estopped from maintaining a challenge to claims 1–12 of the '154 Patent because the Board's Final Written Decision confirming the patentability of each independent claim of the '154 Patent in IPR2015-01979 also confirms the patentability of every dependent claim, including claims 9 and 12. *SynQor, Inc. v. Artesyn Techs., Inc.*, 709 F.3d 1365, 1375 (Fed. Cir. 2013)("This court need not consider Defendants' arguments that certain dependent claim limitations would have been obvious where the base claim has not been proven invalid.")(citation omitted). Thus, whether or not Petitioner challenged claims 9

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