UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner

v.

FINJAN, INC.,
Patent Owner

Patent No. 8,141,154

Inter Partes Review No. IPR2016-00151

PETITIONER'S REPLY BRIEF ON REMAND

la-1411894

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I. INTRODUCTION

In its Response on Remand ("Response," Paper 61), Patent Owner ("Finjan") tries to convince the Board to disregard the substance of Petitioner's arguments. As discussed below, however, the Board can and should consider Petitioner's arguments on the merits. When those arguments are fully considered, claims 9 and 12 should be found unpatentable as obvious in light of Ross and Calder.

II. PETITIONER IS NOT ESTOPPED UNDER § 315(e)(1) BECAUSE THERE IS NO FINAL WRITTEN DECISION WITH RESPECT TO CLAIMS 9 AND 12.

Finjan first argues that Petitioner is estopped from making the very arguments that the Federal Circuit remanded this case for the Board to consider. Finjan's argument is contrary to the express provisions of 35 U.S.C. § 315(e)(1), and is not supported by any relevant authority. Claims 9 and 12 have no final written decisions issued against them, and thus Petitioner is not estopped from maintaining a proceeding before this Board with respect to those claims.

Under § 315(e)(1) (emphasis added), a "petitioner in an *inter partes* review of a claim in a patent under this chapter that results in a final written decision under section 318(a). . . may not request or maintain a proceeding before the Office *with respect to that claim* on any ground that the petitioner raised or reasonably could have raised during that *inter partes* review." Thus, the estoppel provisions of § 315 apply on a claim-by-claim basis. *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d

1044, 1052 (Fed. Cir. 2017) ("the relevant IPR estoppel statute, § 315(e)(1) . . . applies on a claim-by-claim basis. . . . There is no IPR estoppel with respect to a claim as to which no final written decision results"). If, and only if, there is a final written decision issued as to a particular claim, are the provisions of § 315(e)(1) triggered.

Despite the unambiguous text of § 315(e)(1), Finjan argues that "in the situation where a FWD confirms the patentability of an independent claim, estoppel should attach to every claim depending from the patentable base claim." (Patent Owner's Response at 4.) This interpretation of § 315(e)(1) is not supported by the text of the statute or any authority. Finjan cites only to *SynQor, Inc. v. Artesyn Technologies, Inc.*, but in that case the Federal Circuit exercised its discretion on appeal not to consider certain dependent claims. *SynQor, Inc. v. Artesyn Techs., Inc.*, 709 F.3d 1365, 1375 (Fed. Cir. 2013). *SynQor* accordingly does not address estoppel. Under § 315(e)(1), Petitioner is not estopped from challenging the validity of claims 9 and 12 of the '154 patent.

III. THE BOARD SHOULD ADDRESS PETITIONER'S ARGUMENTS WITH RESPECT TO CLAIMS 9 AND 12.

The Board's original written decision addressed claims 1-8, 10 and 11, but did not address challenged claims 9 and 12. As a result, the Federal Circuit vacated and "remand[ed] to allow the Board to issue a Final Written Decision consistent with *SAS*

[*SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018)]." *Palo Alto Networks, Inc. v. Finjan, Inc.*, 752 F. App'x 1017, 2018 WL 6040843, at *3 (Fed, Cir. Nov. 19, 2018). Finjan nonetheless argues now that the Board on remand need not consider the patentability of claims 9 and 12, because those claims depend from claims that the Board found patentable in its original final decision. (Patent Owner's Response at 6-7.) Contrary to the Finjan's argument, the Board can and should address petitioner's arguments as to claims 9 and 12, as doing so will fully comply with the remand from the Federal Circuit in this case.

The Board's decision in this case as to the patentability of claims 1-8, 10 and 11 has not yet been reviewed by the Federal Circuit. If the Federal Circuit ultimately concludes that those claims should have been held unpatentable in this case, then the patentability of claims 9 and 12 will still need to be resolved. The Board can and should resolve that issue now. The recent case of *MaxLinear Inc., v. CF Crespe LLC*, 880 F.3d 1373 (Fed. Cir. 2018), is a good example of the risk of avoiding resolution of these dependent claims now. In that case, the Board did not independently address arguments concerning the patentability of certain dependent claims, relying on the fact that those claims depended from claims that had been found patentable over the prior art references. (*Id*. at 1375-76.) However, in a parallel proceeding, the independent claims were found to be unpatentable. As a result, the Federal Circuit

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