

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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Record of Oral Hearing  
Held: March 26, 2019

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

Case IPR2016-00151  
Patent 8,141,154

APPEARANCES:

ON BEHALF OF THE PETITIONER:

MATTHEW I. KREEGER, ESQ.  
SHOUVIK BISWAS, ESQ.  
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ON BEHALF OF THE PATENT OWNER:

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The above-entitled matter came on for hearing on Tuesday, March 26, 2019, commencing at 9:59 a.m., at the U.S. Patent and Trademark Office, Texas Regional Office, 207 S. Houston Street, Dallas, Texas 75202.

PROCEEDINGS

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JUDGE QUINN: We're on the record. This is the oral argument for Palo Alto Networks versus Finjan, Inc., Case No. IPR2016-151 regarding Patent No. 8,141,154. With me are judges Tom Giannetti and Patrick Boucher and myself, Miriam Quinn. And this hearing is -- will proceed for 20 minutes for each side to present argument. Petitioner will begin and can reserve time for rebuttal. Patent Owner will also be able to reserve time for rebuttal.

And instructions: No objections will be allowed to be interjected in each other's arguments. Because this hearing is telephonic and audio quality is of utmost importance, please mute all of your phones, computers, and anything that dings or has bells so that we don't have interruptions in the audio. Also, whenever speaking, you must identify yourself so the court reporter can attribute the statements to the appropriate person.

Who do we have for Petitioner at this time?

MR. KREEGER: Hello, Your Honor. This is Matthew Kreeger from Morrison and Foerster, appearing for Petitioner. With me on the phone is Shouvik Biswas.

MR. BISWAS: Good morning, Your Honor.

JUDGE QUINN: Good morning. Thank you.

And counsel for Patent Owner, would you please state your appearance.

MR. PRICE: Yes, Your Honor. Jeffrey Price for Patent

1 Owner, Finjan.

2 JUDGE QUINN: Anybody else with you, Mr. Price?

3 MR. PRICE: No. It's just me today.

4 JUDGE QUINN: Okay. Thank you.

5 All right. Let's begin with Petitioner. As I say, you  
6 have 20 minutes. How much would you like to reserve for rebuttal?

7 MR. KREEGER: I'd like to reserve five minutes, please,  
8 Your Honor.

9 JUDGE QUINN: Okay. You may proceed.

10 MR. KREEGER: Thank you. May it please the board, I do  
11 represent -- this is Matthew Kreeger, and I represent Palo Alto  
12 Networks, the Petitioner in this case. I want to begin with the  
13 procedural issues that were raised by Finjan. First of all, as to  
14 estoppel, Palo Alto Networks is not estopped in this case. The  
15 estoppel statute is clear and unambiguous. Estoppel operates on a  
16 claim-by-claim basis, and in this case, there has never been a  
17 final written decision as to claims 9 and 12. In fact, that's the  
18 entire point of the remand from the federal circuit, so that the  
19 board can enter a final written decision after those claims, and  
20 therefore, just as a matter of statute, there's no estoppel.

21 Now, Finjan argues that, in final written decision as to  
22 independent claims, applies to dependent claims, but they have no  
23 support for that in any case law or in the statute and actually  
24 would render the remand order a nullity in this case.

25 Also, I'd like to point out that Finjan argues in its  
26 sur-reply that the board should terminate Palo Alto Networks as a

1 party in this matter or somehow foreclose it from participating in  
2 this remand proceeding, and that would be both contrary to the  
3 remand order and basically without basis because there is no  
4 estoppel here.

5 JUDGE QUINN: Well, there is, Mr. Kreeger, the question  
6 that, procedurally, we are on a remand, but the final written  
7 decision, as it stands, has been vacated, so we would need to  
8 enter another final written decision in this case. And as I see  
9 the issue that Patent Owner has framed for us, the issuance of a  
10 final written decision would necessarily have to include all of  
11 the claims that were challenged by Petitioner in the '151 case.

12 And so by understanding that claims 9 and 12 are the  
13 scope of the remand, we still have to issue a final written  
14 decision on all the other claims that are potentially estopped.  
15 So what we do about that?

16 MR. KREEGER: Well, it's our position that Palo Alto  
17 Networks is not maintaining this proceeding at this point. The  
18 federal circuit remanded the case. And just as a case on appeal  
19 is not being maintained for the PTAB, at this point, the board  
20 should comply with the remand order and not consider Palo Alto  
21 Networks as maintaining the case.

22 But in any event, we're not asking you to revisit the  
23 issues or the decision that you entered with respect to the  
24 independent claims. We're expecting the board to reissue that  
25 portion of its decision in unchanged form.

26 As to claims 9 and 12, we're asking that the board go

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