

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-00151¹
U.S. Patent No. 8,141,154

**PATENT OWNER'S BRIEF CONCERNING
PETITIONER ESTOPPEL UNDER 35 U.S.C. § 315(e)(1)**

¹ Case IPR2016-01071 has been joined with this proceeding.

Pursuant to the Board's October 20, 2016 Order on the Conduct of the Proceeding, Patent Owner Finjan, Inc. ("Patent Owner") submits this brief concerning the potential impact of petitioner estoppel under 35 U.S.C. § 315(e)(1) on the captioned proceedings. IPR2016-00151, Paper 24.

I. INTRODUCTION

These two cases are among *six* filed by Palo Alto Networks, Inc. ("Petitioner" or "PAN") and others against the claims of U.S. Patent. No. 8,141,154 (the "'154 Patent"). The Board should terminate or stay the latter-filed case as moot. Petitioner estoppel precludes PAN from continuing to maintain the later-filed case after the Board issues the Final Written Determination in the first case because Petitioner cannot maintain a proceeding with respect to any ground that Petitioner raised or reasonably could have raised. Petitioner could have raised the grounds of the latter Petition in its earlier Petition because it learned of the same art through a related Petition that it joined. Allowing the second case to continue to proceed will, therefore, needlessly waste the resource of the Board and the parties, as the second case will be terminated prior to the issuance of a Final Written Decision.

II. SUMMARY OF THE FACTS

Entities accused of infringement have filed six petitions against the '154 Patent. Symantec Corp. ("Symantec") filed IPR2015-01547, which the Board

denied, and IPR2016-01071 and IPR2016-00919, which the Board joined to these proceedings. Proofpoint, Inc. and Armorize Technologies, Inc. filed IPR2016-00937, which terminated on June 24, 2016. IPR2016-00937, Paper 10.

Petitioner filed IPR2015-01979 and IPR2016-00151, which both are directed to claims 1-8, 10, and 11 of the '154 Patent, but are neither consolidated nor joined with the other. Case IPR2015-01979, filed by Petitioner on September 25, 2015, was instituted on March 21, 2016, and is scheduled for oral argument on December 15, 2016, with the Final Written Decision due by March 21, 2017. IPR2015-01979, Paper 9. Case IPR2016-00151, filed by Petitioner on November 5, 2015, was instituted on April 20, 2016, and is scheduled for oral argument on January 24, 2017, with the Final Written Decision due by April 20, 2017. IPR2016-00151, Paper 11.

III. THE IPR2016-00151 CASE IS MOOT UNDER 35 U.S.C. § 315(E)(1)

Petitioner estoppel renders moot the IPR2016-00151 case. Petitioner will be estopped from maintaining that proceeding upon the issuance of a Final Written Decision in Case No. IPR2015-01979, which involves the same '154 Patent (and the same claims).

The grounds raised in the IPR2016-00151 Petition “reasonably could have been raised” in the IPR2015-01979 Petition, as confirmed by the fact that Petitioner filed that petition a little over a month after filing its first petition. This

mandates dismissal of the second proceeding after the Board issues a Final Written Decision in the first:

The 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), or the real party in interest or privy of the petitioner, 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.

35 U.S.C. § 315(e)(1) (emphasis added). “Maintain” means to cause (something) to exist or continue without changing.” Merriam-Webster’s Learner’s Dictionary. Thus, the plain language of the statute is that the petition should not continue once petitioner estoppel attaches.

Petitioner readily could have raised in the first IPR2015-01979 Petition the additional references asserted in the latter IPR2016-00151 Petition. The Board has held that § 315(e)(1) applies to any “prior art which a skilled researcher conducting a diligent search reasonably could have been expected to discover.” *See Praxair Distribution, Inc. v. Ino Therapeutics LLC*, Case IPR2016-00781, Decision Denying Institution of *Inter Partes* Review, Paper 10 at 7 (PTAB Aug. 25, 2016) (citing 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl)). Here, the Ross and Calder references cited in the latter Petition were cited by Symantec in its July 3, 2015, Petition and, thus, were readily available to Petitioner

without conducting any prior art searching when it filed its first Petition. *See* IPR2015-01547, Exhibits 1002, 1003. Indeed, on November 5, 2015, just days after it filed the earlier IPR2015-01979 petition, Petitioner filed a Motion to Join the Symantec petition, specifically referencing the Ross and Calder references.

Pursuant to 35 U.S.C. § 316(a)(11), the Board will be required to issue a Final Written Decision in Case No. IPR2015-01979 by March 21, 2017. IPR2015-01979, Paper 9. Accordingly, by no later than March 21, 2017, the estoppel provision of 35 U.S.C. § 315(e)(1) will ripen and prevent Petitioner from maintaining Case No. IPR2016-00151. *See, e.g., Kofax, Inc. v. Uniloc USA, Inc.*, Case IPR2015-01207, Decision on Motion to Terminate *Inter Partes* Review, Paper 22 at 8, 11–12 (PTAB June 2, 2016) (terminating an *inter partes* review due to petitioner estoppel when a petitioner “had an opportunity to raise the grounds in [an] earlier proceeding” that ended in a Final Written Decision).

IV. THE BOARD SHOULD TERMINATE OR STAY THE SECOND PROCEEDING

The Board should terminate or stay the IPR2016-00151 case. Patent Owner recognizes that the issue of petitioner estoppel is not yet ripe because no Final Written Decision has issued yet in Case No. IPR2015-01979. However, because estoppel will require dismissal of the IPR2016-00151 case once a Final Written Decision issues in the earlier case, Patent Owner requests that the Board consider

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