

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROOFPOINT, INC. AND
ARMORIZE TECHNOLOGIES, INC.
Petitioner

v.

FINJAN, INC.
Patent Owner

Case: IPR2016-00937
U.S. Patent No. 8,141,154

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

Pursuant to 35 U.S.C. § 317(a), Petitioner and Patent Owner jointly request termination of this *inter partes* review (IPR) proceeding, IPR2016-00937, which is directed to U.S. Patent No. 8,141,154. The parties are also concurrently filing separate motions to terminate three other IPR proceedings involving Petitioner and Patent Owner, namely: IPR2016-00966, which is directed to U.S. Patent No. 7,647,633, as well as IPR2016-00967 and -00970, which are both directed to U.S. Patent No. 8,225,408.¹

Termination of this proceeding is appropriate as the parties have settled their dispute and entered into a written Settlement Agreement on June 3, 2016, a true copy of which has been submitted as Exhibit 1041. Pursuant to the Settlement Agreement, the parties have agreed to terminate all of the above-identified IPRs, as well as dismiss the related district court litigation. There are no other pending proceedings between the parties.

On June 9, 2016, Petitioner advised the Board that the parties had reached a settlement, and sought authorization to file joint motions to terminate these proceedings. The Board authorized the filing of such motions on June 14, 2016.

¹ The petitions for all of the identified proceedings were accompanied by joinder motions. The parties respectfully request that the Board also dismiss these joinder motions as moot.

In accordance with the Board's June 14th email, the parties are also filing separate requests for the Settlement Agreement to be treated as confidential business information and kept separate from the files of the challenged patents pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Settlement Agreement has been filed in PRPS under the designation of "Parties and Board Only."

The applicable statute, 35 U.S.C. § 317(a), provides that an IPR proceeding "shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." In this case, the Board has not yet determined whether trial will be instituted. Thus, the Board has not yet reached any decision on the merits of the proceeding.² Accordingly, termination at this early juncture promotes efficiency, conserves Board resources, and minimizes unnecessary costs.

In view of the foregoing, the parties jointly and respectfully request that the instant IPR proceeding be terminated.

² The Board recently instituted trial in each of the underlying IPR proceedings filed by different petitioners to which these proceedings sought to be joined, namely IPR2015-01979 (to which joinder was sought in the instant proceeding), as well as IPR2015-01974, IPR2015-02001 and IPR2016-00157. Thus, the Board has also not yet decided the merits of any of these underlying IPR proceedings.

Date: June 16, 2016

Respectfully submitted,

By: /Joseph J. Richetti/
Joseph J. Richetti (Reg. No. 47,024)
BRYAN CAVE LLP
1290 Avenue of the Americas
New York, NY 10104
General Tel: (212) 541-2000
Fax: (212) 541-4630
Email: joe.richetti@bryancave.com

*Attorneys for Petitioner – Proofpoint, Inc.
and Armorize Technologies, Inc.*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74 was served electronically via e-mail on June 16, 2016, in its entirety on the following:

Counsel for Patent Owner

James Hannah
Michael Lee
Kramer Levin Naftalis & Frankel LLP
990 Marsh Road
Menlo Park, CA 94025
jhannah@kramerlevin.com
mhlee@kramerlevin.com
svdocketing@kramerlevin.com

Jeffrey H. Price
Shannon Hedvat
Kramer Levin Naftalis & Frankel LLP
1177 Avenue of the Americas
New York, NY 10036
jprice@kramerlevin.com
shedvat@kramerlevin.com

Michael Kim
Finjan Inc.
2000 University Ave., Ste. 600
E. Palo Alto, CA 9430
mkim@finjan.com

Counsel for Petitioners in IPR2015-01979:

Orion Armon
Brian Eutermoser
COOLEY LLP
380 Interlocken Crescent, Suite 900
Broomfield, Colorado 80021
oarmon@cooley.com
beutermoser@cooley.com
zpatdcdocketing@cooley.com

Jennifer Volk-Fortier
COOLEY LLP
One Freedom Square
Reston Town Center
11951 Freedom Drive
Reston, Virginia 2019
jvolkfortier@cooley.com
zpatdcdocketing@cooley.com

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.