

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: IPR2016-00970
U.S. Patent No. 8,225,408

**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, IPR2016-00970, which is directed to U.S. Patent No. 8,225,408. The parties are also concurrently filing separate motions to terminate three other IPR proceedings involving Petitioner and Patent Owner, namely: IPR2016-00937, which is directed to U.S. Patent No. 8,141,154, IPR2016-00966, which is directed to U.S. Patent No. 7,647,633, as well as IPR2016-00967, which is also 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 1065. 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 IPR2016-00157 (to which joinder was sought in the instant proceeding), as well as IPR2015-01974, IPR2015-01979 and IPR2015-02001. 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/
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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:

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