

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
Patent 8,141,154 B2

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

QUINN, *Administrative Patent Judge*.

ORDER

Granting Joint Motion to Terminate as to Symantec Corp.
37 C.F.R. § 42.74

¹ In Case IPR2016-01071, Symantec Corp. filed, and we granted, a request to join this proceeding as petitioner. Paper 11. Pursuant to this Order, Symantec Corp. is dismissed.

Joint Petitioner, Symantec Corp. (“Symantec”), and Patent Owner, Finjan, Inc. (“Finjan”), jointly move to terminate the instant *inter partes* review with respect to Symantec in light of the settlement that resolves their dispute regarding U.S. Patent No. 8,141,154 B2. Paper 57. Symantec and Finjan also filed a true copy of their written settlement agreement in connection with the termination as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Ex. 2044. Pursuant to 37 C.F.R. § 42.74(c), the parties further filed a joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent. Paper 58.

For the reasons set forth below, the Joint Motion to Terminate with respect to Symantec, and the Joint Request to File Settlement Agreement as Business Confidential Information are *granted*.

Under the Leahy-Smith America Invents Act, settlement between the parties to a proceeding is encouraged. Notably, 35 U.S.C. § 317(a), in part, provides the following (emphasis added):

(a) IN GENERAL.—An inter partes review instituted under this chapter 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. If the inter partes review is terminated with respect to a petitioner under this section, *no estoppel under section 315(e) shall attach to the petitioner*, or to the real party in interest or privy of the petitioner, on the basis of that petitioner’s institution of that inter partes review.

Here, although the instant *inter partes* review was completed and we issued a Final Written Decision, the proceeding is on remand from the Federal Circuit, and that Final Written Decision has been vacated. Upon review of the procedural posture of this proceeding and the facts before us,

we determine that it is appropriate to terminate this proceeding with respect to Symantec. The proceeding, however, will not be terminated with respect to Palo Alto Networks, Inc. and Finjan.

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate, with respect to Symantec, is *granted*;

FURTHER ORDERED that this review is terminated with respect to Symantec only; but this review continues to proceed with Finjan and the remaining Petitioner;

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information and to keep such settlement agreement separate from the patent file, and to make it available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*.

IPR2016-00151
Patent 8,141,154 B2

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