

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZSCALER, INC.,
Petitioner,

v.

SYMANTEC CORPORATION,
Patent Owner.

Case IPR2018-00136
Case IPR2018-00137
Patent 7,203,959 B2¹

Before NEIL T. POWELL, DANIEL N. FISHMAN, and
STACEY G. WHITE, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*

ORDER

Dismissing the Proceedings
35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.5, 42.71(a)

On April 18, 2018, Petitioner filed substantively identical, authorized, unopposed, motions to dismiss in each of the above-identified cases.

¹ Because resolution of issues set forth in this order involves both of the above-identified cases, we exercise our discretion to issue a single order to be entered in each case.

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IPR2018-00136 Paper 8 (“Unopposed Motion to Dismiss IPR2018-00136 Pre-Institution”) and IPR2018-00137 Paper 8 (“Unopposed Motion to Dismiss IPR2018-00137 Pre-Institution”) (individually or collectively referred to herein as “Mot.”). The motions aver that Patent Owner does not oppose the motions.

Petitions in the above-identified cases were filed October 30, 2017. Patent Owner filed its Preliminary Response in IPR2018-00136 on February 9, 2018 and filed its Preliminary Response in IPR2018-00137 on February 14, 2018. The Board’s decisions on institution in these cases are, therefore, due in the near future (May 9, 2018 for IPR2018-00136 and May 14, 2018 for IPR2018-00137). Although preliminary review of both cases had commenced, the Board had not yet reached a decision regarding institution in either of the above-identified cases.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, if the settlement agreement includes all parties. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

In the motions, Petitioner indicates that, although litigation between the parties is on-going relating to a number of patents, the District Court dismissed with prejudice the litigation claims relating to the ’959 patent (the subject of the Petitions in both above-identified cases). Mot. 1. Petitioner further indicates that there is no settlement agreement between the parties

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“however, there is no pending dispute between Petitioner and Patent Owner in the related litigation” related to the ’959 patent (at issue in both above-identified cases before the Board). *Id.* at 2. Therefore, Petitioner requests dismissal and termination of the above-identified cases “to preserve both the Board’s and the parties’ resources, and to achieve an efficient and inexpensive resolution to this proceeding.” *Id.*

Despite the expenditure of some resources by the Board on initial review of both above-identified cases, under these circumstances, we are persuaded that it is appropriate to terminate these proceedings with respect to both Petitioner and Patent Owner.

Accordingly, it is

ORDERED that Petitioner’s Unopposed Motion to Dismiss IPR2018-00136 Pre-Institution is *granted*;

FURTHER ORDERED that Petitioner’s Unopposed Motion to Dismiss IPR2018-00137 Pre-Institution is *granted*;

FURTHER ORDERED that the proceeding in IPR2018-00136 is *terminated* with respect to both Petitioner and Patent Owner; and

FURTHER ORDERED that the proceeding in IPR2018-00137 is *terminated* with respect to both Petitioner and Patent Owner.

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