

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZSCALER, INC.,

Petitioner,

v.

SYMANTEC CORPORATION,

Patent Owner.

Case IPR2018-00929

Patent 6,285,658

**JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C § 317 AND 37
C.F.R. §§ 42.72 AND 42.74**

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board’s authorization of February 4, 2019, Petitioner ZSCALER, INC., (“Petitioner” or “ZSCALER”) and Patent Owner SYMANTEC CORPORATION (“Patent Owner” or “Symantec”) (collectively, the “Parties”) jointly move to terminate the present *inter partes* review proceeding in light of the Parties’ agreement to terminate this proceeding.

The Parties have reached an agreement to file a motion to terminate this *inter partes* review. The Parties are concurrently filing a true and correct copy of their written Agreement in connection with this matter as required by statute as Exhibit 1019. The parties certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding.

I. Legal Standard

An *inter partes* review 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.” 35 U.S.C. § 317(a). A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings

currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper No. 26, at *2 (P.T.A.B. July 28, 2014).

II. Brief Explanation as to Why Termination is Appropriate

Termination of the present IPR is appropriate as the Board has not yet decided the merits of the proceeding, the subject patent has been dismissed, with prejudice, from the litigation between the Parties, and the parties have agreed that it is appropriate to terminate this proceeding. “Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement.” *Oracle Corp. v. Cmty. United IP, LLC*, CBM2013-00015, Paper 13 (July 25, 2013) (citing Patent Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)).

Terminating this proceeding promotes the Congressional goal to establish a more efficient and streamlined patent system that, *inter alia*, limits unnecessary and counterproductive litigation costs. *See* Patent Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). In view of the dismissal, with prejudice, of the subject patent from the litigation between the Parties, the absence of any other pending litigation involving this patent, or any public interest or other factors militating against termination, termination of this proceeding is justified.

III. Related Proceedings

With respect to the second, third, and fourth *Heartland Training* requirements, the Parties identify the following litigation and proceedings currently before the Office involving the Parties. There are no parties in these related litigations and proceedings besides the Parties to this proceeding.

| Case Name | Case No. | Court | Filed |
|--|---------------|--|----------------|
| <i>Symantec Corporation and Symantec Limited v. Zscaler, Inc.</i> | 3:17-cv-04414 | United States District Court for the Northern District of California | August 3, 2017 |
| <i>Symantec Corporation and Symantec Limited v. Zscaler, Inc.</i> (transferred to USDC, N.D.Ca, 3:17-cv-04414) | 1:17-cv-00806 | United States District Court for the District of Delaware | June 22, 2017 |

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|--|---------------|--|-------------------|
| <i>Symantec Corporation v. Zscaler, Inc.</i> | 3:17-cv-04426 | United States District Court for the Northern District of California | August 4, 2017 |
| <i>Symantec Corporation v. Zscaler, Inc.</i> (transferred to USDC, N. D. Ca. 3:17-cv-004426) | 1:16-cv-01176 | United States District Court for the District of Delaware | December 12, 2016 |

The '658 Patent was asserted in the first-listed action above (ND Cal. Case 4414, previously D. Del. Case 806). On December 13, 2018, Symantec dismissed its claims based on the '658 Patent, with prejudice. *Symantec Corp. and Symantec Ltd. v. Zscaler, Inc.*, 17-cv-04414 (N.D. Cal.), STIPULATION AND ORDER re 148 STIPULATED REQUEST AND [PROPOSED] ORDER DISMISSING SYMANTEC'S CLAIMS AS TO U.S. PATENT NOS. 6,285,658; 7,360,249; AND 9,525,696 WITH PREJUDICE. D.I. 151. The '658 Patent is not at issue in the other actions listed above, nor in any other currently pending action.

The Parties also provide the following list of other PTAB proceedings between

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