UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC., and
FORTINET, INC.,
Petitioner,

v.

LIONRA TECHNOLOGIES LTD.,
Patent Owner

Case No. IPR2024-00099
U.S. Patent No. 7,685,436

JOINT MOTION TO TERMINATE PETITIONER FORTINET, INC. FROM *INTER PARTES* REVIEW PROCEEDINGS PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R § 42.72

Petitioner's Exhibit List

Exhibit #	*Description*
1001	U.S. Patent No. 7,685,436 ("the '436 Patent")
1002	Select portions of prosecution history of the '436 ("File History")
1003	Declaration of Petitioner's Expert Dr. Crovella ("Crovella")
1004	U.S. 2003/0074473 ("Pham")
1005	U.S. 7,424,744 ("Wu")
1006	U.S. 7,996,670 ("Krishna")
1007	U.S. 6,279,113 ("Vaidya")
1008	U.S. Patent Publication 2002/0073316 ("Collins")
1009	U.S. 7,181,017 ("Nagel")
1010	US 2004/0039928A1 ("Elbe")
1011	Related Patents
1012	Not used
1013	Not used
1014	Docket Control Order, *Lionra Technologies Limited v. Fortinet, Inc.*, Case No. 2:22-cv-00322 (E.D. Tex.) Document 55-1
1015	U.S. Patent Publication 2003/0145225A1 ("Bruton")
1016	Deposition of Eric Cole, PhD
1017	Supplemental Declaration of Dr. Mark Crovella
1018	Settlement and License Agreement - Confidential
1019	Petitioners Trial Demonstratives
1020	Settlement and License Agreement – Confidential
1021	Settlement and License Agreement – Confidential

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, and the Board's authorization provided on September 23, 2024, Petitioner Fortinet, Inc. ("Fortinet" or "Petitioner") and Patent Owner Lionra Technologies, Ltd. ("Lionra Technologies" or "Patent Owner") (collectively, the "Parties") hereby provide notice that they have reached a settlement agreement and jointly request termination of petitioner Fortinet, Inc. as a petitioner in IPR2023-00673, IPR2023-00703, IPR2024-00099 and IPR2024-00158 challenging U.S. Patent Nos. 7,685,436 ("the '436 Patent") and 8,566,612 ("the '612 Patent").

I. Termination Is Appropriate

The basis for this Joint Motion is the settlement of all disputes between Fortinet and Lionra Technologies relating to the '436 Patent and the '612 Patent. Pursuant to that settlement, the Parties have also entered into a mutual release. An *inter partes* review 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 proceedings before the request for termination is filed. 37 U.S.C. § 317(a). Further, "no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner." *See id*.

In August 2022, Patent Owner filed suit in district court against Petitioner asserting patent infringement based on the '436 Patent and the '612 Patent. *Lionra*

Technologies Limited v. Fortinet, Inc. No. 2:22-cv-00322 (E.D. Tex.) (filed Aug. 19, 2022).

On May 9, 2024 Joinder was granted with respect to Petitioners Palo Alto Networks and Fortinet in both IPR2023-00673 and IPR2023-00703. (IPR2024-00099 and IPR2024-00158 respectively).

The settlement agreement requires the dismissal of Fortinet as a party in IPR2023-00673, IPR2023-00703, IPR2024-00099 and IPR2024-00158.

II. Legal Standard

35 U.S.C. § 317(a) provides that "[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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." 37 C.F.R. § 42.72 similarly provides that "[t]he Board may terminate a trial without rendering a final written decision, where appropriate . . . pursuant to a joint request under 35 U.S.C. § 317(a)." The Trial Practice Guide also observes that "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding" and that the Board "expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

III. Agreement in Writing Submitted to the Board

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Parties' settlement agreement is being submitted as Exhibit 1021. The settlement agreement is in writing and constitutes the Parties' entire understanding and agreement. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), in a separate paper filed concurrently herewith, the Parties jointly request that the settlement agreement be treated as business confidential information and be kept separate from the underlying patent file.

IV. Conclusion

Termination of the proceeding is a just and fair resolution. The Parties agree that neither Fortinet nor Lionra Technologies will be prejudiced by the termination of the IPRs with respect to Petitioner Fortinet. Finally, the Parties will benefit from preserving resources that would otherwise be expended if this motion is denied. For at least the foregoing reasons, the Parties respectfully request that the Board terminate Inter Partes Reviews IPR2023-00673, IPR2023-00703 IPR2024-00099 and IPR2024-00158 with respect to Fortinet.

Respectfully submitted,

Dated: October 1, 2024

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CERTIFICATE OF SERVICE

I hereby certify that on October 1, 2024, a copy of Petitioner's Joint Motion to Terminate Proceedings was served by filing this document through the PTAC's System as well as delivering a copy via electronic mail upon the following:

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