

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2015-01979
Patent 8,141,154

**DECLARATION OF S.H. MICHAEL KIM IN SUPPORT OF PATENT
OWNER'S RESPONSE PURSUANT TO 37 C.F.R. § 42.120**

I, S.H. Michael Kim, make the following declaration under penalty of perjury:

1. I make this Declaration based upon my own personal knowledge, information, belief, and I would and could competently testify to the matters set forth herein if called upon to do so.

2. I am currently the Senior Director, Intellectual Property (IP) Counsel of Finjan Holdings, Inc. I have been IP counsel since March 2015. The assignee of U.S. Patent No. 8,141,154 (“the ‘154 Patent”) under *inter partes* review is Finjan Inc. (“Finjan”), a wholly owned-subsidiary of Finjan Holdings, Inc. The ‘154 Patent issued on March 20, 2012.

3. As part of my responsibilities, I oversee the enforcement, prosecution, and post-grant proceedings of patents assigned to Finjan in district courts and before the U.S. Patent & Trademark Office (“PTO”). I am familiar with Finjan’s licensing practices and also assist in the licensing of Finjan’s world-wide patent portfolio.

4. Finjan was founded in 1997. It has invested over 65 million dollars in developing patented technology related to proactive content behavior inspection. Such investment contributed to Finjan being awarded 27 U.S. issued patents and 27 issued foreign patents. To date, Finjan has licensed its technology in the industry receiving over \$155 million dollars in royalty payments.

5. Finjan's successful licensing program includes Microsoft, M86, Trustwave, Intel/McAfee, Webroot, F-Secure, Websense, Inc. ("Websense"), Proofpoint, Inc. ("Proofpoint"), Armorize Technologies, Inc. ("Armorize") and Avast Software ("Avast"). Several of the SEC filings that reflect some of these licenses are Patent Owner Exhibits 2020-2025.

6. Finjan's successful licensing program was bolstered with the issuance of the '154 Patent on March 20, 2012. Since the issuance of the '154 Patent, Finjan has entered into seven licenses.

7. On December 7, 2012, Finjan and Intel settled a pending patent infringement litigation brought by Finjan against McAfee which was newly acquired by Intel. The parties entered a license agreement under which Intel can at least use, make, sell, offer to sell, import or export the inventions of Finjan patents as of the effective date of the agreement, November 6, 2012. On July 30, 2012, Finjan and Webroot Inc. settled a pending patent infringement brought by Finjan against Webroot. The parties entered a license agreement under which Webroot can at least use, make, sell, offer to sell, import or export the inventions of Finjan patents as of the effective date of the agreement, July 30, 2012.

8. On April 7, 2015, a license agreement was entered into with F-Secure in order to at least use, make, sell, offer to sell, import or export the inventions of the '154 Patent and other Finjan patents. On November 15, 2015, a license

agreement was entered into with Avast in order to at least use, make, sell, offer to sell, import or export the inventions of the Finjan patents, including the '154 Patent. On December 30, 2015, Finjan entered into another license agreement with a large network security computer company in order to at least use, make, sell, offer to sell, import or export the inventions to the '154 Patent and other Finjan patents.

9. On September 23, 2013, Finjan asserted infringement of the '154 Patent against Websense and that its products embodied inventions of the '154 Patent. *Finjan v. Websense, Inc.*, 13-CV-04398-BLF (N.D. Cal.) (that case was later combined with another case asserting another patent against Websense). On September 24, 2014, the parties settled and Websense entered into a license agreement in order to at least use, make, sell, offer to sell, import or export the inventions of the '154 Patent and other Finjan patents.

10. In a different litigation (*Finjan v. Proofpoint and Armorize*, 13-CV-05805-HSG (N.D. Cal.)), Finjan settled with Proofpoint and Armorize. As part of the settlement, Proofpoint and Armorize entered into a license agreement to at least use, make, sell, offer to sell, import or export the inventions of the '154 Patent and other Finjan patents.

11. The licensees of the '154 Patent are competitors in the computer network security field with Finjan or Finjan's licensees.

12. Attached to the Patent Owner's Response are Exhibits 2026 and 2027, which are Gartner Magic Quadrant reports that show competitors within the computer network security field.

13. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the patent and any inter partes decision issuing thereon.

Print Name

Signature

Date

S.H. Michael Kim



July 12, 2016