

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PALO ALTO NETWORKS, INC.,  
Petitioner,

v.

FINJAN, INC.,  
Patent Owner.

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Case IPR2016-00151  
Patent 8,141,154

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**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-subsubsidiary 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 and in ensuring that Finjan complies with any ongoing obligations under its licenses.

4. As part of my responsibilities, and in preparing for this Declaration, I reviewed Finjan’s business records, maintained in the ordinary course of Finjan’s regular business activities, including documentation of and relating to the following:

- a. Finjan's research and development efforts since its founding in 1997;
- b. Finjan's entire patent portfolio including its 27 U.S. issued patents and 27 foreign issued patents;
- c. Finjan's license agreements including the seven licenses that have been entered into after the issuance of the '154 Patent; and
- d. Finjan's SEC filings (including those available at Exhibits 2020-2025) which include information regarding Finjan's successful licensing program (discussed more herein); these filings were made at the time that they were filed based on information from Finjan's officers, were signed and confirmed by Finjan's officers, and are regularly made and maintained in the ordinary course of Finjan's regular business activities; and
- e. Gartner Magic Quadrant reports (including those available at Exhibits 2026 and 2027) which show competitors within the computer network security field.

5. 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.

6. 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.

7. 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.

8. 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.

9. 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.

10. 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.

11. 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.

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

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