

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUE COAT SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-00955
Case IPR2016-00956
Patent 8,225,408 B2¹

Before THOMAS L. GIANNETTI, MIRIAM L. QUINN, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108
37 C.F.R. § 42.122(b)

¹ We consolidate the proceedings under 35 U.S.C. § 314(d) and join with IPR2015-02001 and IPR2016-00157, which have also been consolidated.

On April 27, 2016, Blue Coat Systems, Inc. (“Petitioner”) filed (1) a Petition (IPR2016-00955, Paper 2 (“955 Petition” or “Pet. 955”)) to institute an *inter partes* review of claims 1, 9, 22, 23, 29, and 35 of U.S. Patent No. 8,225,408 B2 (“the ’408 patent”); and (2) a Petition (IPR2016-00956, Paper 2 (“956 Petition” or “Pet. 956”)) to institute an *inter partes* review of claims 3–7, 12–16, and 18–21 of the ’408 patent. Concurrent with filing its Petition in IPR2015-00955, Petitioner filed a Motion for Joinder of IPR2016-00955 (IPR2016-00955, Paper 3, “955 Motion” or “Mot. 955”) with *Palo Alto Networks, Inc. v. Finjan, Inc.*, Cases IPR2015-02001 and IPR2016-00157 (“the consolidated PAN IPRs”), which is a consolidated proceeding instituted on March 29, 2016. On August 1, 2016, Petitioner filed a Motion for Joinder of IPR2016-00956 (IPR2016-00956, Paper 12, “956 Motion” or “Mot. 956”) with the consolidated PAN IPRs. The 955 Motion is timely but the 956 Motion is untimely. 37 C.F.R. § 42.122(b). Patent Owner filed waivers of its Preliminary Responses in both IPR2016-00955 (Paper 10) and IPR2016-00956 (Paper 11).

We institute *inter partes* review in both proceedings, consolidate the proceedings, and join with the consolidated PAN IPRs. We excuse the untimeliness of the 956 Motion.

I. INSTITUTION OF *INTER PARTES* REVIEW

The 955 Petition asserts the same grounds as those asserted in the petition filed in IPR2015-02001. *See* Pet. 955, 4. Upon review of the 955 Petition, we note that it substantially duplicates, almost word-for-word, the

petition filed in IPR2015-02001. *See* Mot. 955, 1 (“ . . . narrowly tailored to the grounds of unpatentability that are the subject of IPR2015-02001, . . . including the same analysis of the prior art and expert testimony”).

Similarly, the 956 Petition asserts the same grounds as those asserted in the petition filed in IPR2016-00157 in substantially duplicative fashion. *See* Pet. 956, 4, Mot. 956, 1. The cited art is (Exhibits 1003–1005 are the same in both proceedings):

Chandnani	US 7,636,945 B2	Dec. 22, 2009	Ex. 1003
Kolawa	US 5,860,011	Jan. 12, 1999	Ex. 1004
Walls	US 7,284,274 B1	Oct. 16, 2007	Ex. 1005
Huang	US 6,968,539 B1	Nov. 22, 2005	Ex. 1062 of IPR2016-00956

Petitioner’s challenges of independent claims 1, 9, 22, 23, 29, and 35 in IPR2016-00955, and challenges of dependent claims 3–7, 12–16, and 18–21 in IPR2016-00956, as obvious under 35 U.S.C. § 103(a), are summarized in the following table. Pet. 955, 4; Pet. 956, 4.

References	Claims Challenged
Chandnani and Kolawa	1, 3–5, 9, 12–16, 18, 19, 22, 23, 29, and 35
Chandnani, Kolawa, and Walls	1, 3–5, 9, 12–16, 18, 19, 22, 23, 29, and 35
Chandnani, Kolawa, and Huang	6, 7, 20, and 21
Chandnani, Kolawa, Walls, and Huang	6, 7, 20, and 21

In view of the identity of the challenges between the instant Petitions and those considered in the consolidated PAN IPRs, and in light of Patent Owner’s waiver of its Preliminary Responses, we institute *inter partes*

reviews in these proceedings on the same grounds instituted in the consolidated PAN IPRs, and consolidate the proceedings under 35 U.S.C. § 315(d). In subsequent briefing (subject to the limits described below), the parties shall file consolidated briefs that collectively address the issues in both proceedings, subject to the usual page limits.

II. MOTIONS FOR JOINDER

Joinder in *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

(c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. See Frequently Asked Question H5, <http://www.uspto.gov/patentsapplication-process/appealing-patentdecisions/trials/patent-reviewprocessing-system-prps-0>.

The 955 Motion was filed less than one month after institution of the consolidated PAN IPRs, but the 956 Motion was filed outside that time

window, making the 956 Motion untimely. 37 C.F.R. § 42.122(b). Nevertheless, within the one-month window, Petitioner indicated its intention to file the 956 Motion concurrently with the 956 Petition. Pet. 956, 2 (“Petitioner has filed herewith a motion to join the Consolidated PAN IPRs”); *see* Mot. 956, 1 (assertion that “[t]his Motion for Joinder . . . is submitted within one month of the date on which the Consolidate PAN IPRs were instituted” suggests original intention to file with the 956 Petition). Patent Owner does not oppose joinder in either proceeding and acknowledges that Petitioner’s failure to file timely the 956 Motion “appears to be a clerical error.” IPR2016-00956, Paper 11, 1. Under the circumstances, and although Petitioner has not filed a motion to have the untimely filing accepted, we excuse the delay in filing the 956 Motion. *See* 42.5(c)(1) (authorizing the Board to modify default times by order, subject to statutory restrictions).

Petitioner shows sufficiently that joinder is appropriate. The Petitions are substantially identical and rely on the same evidence, including the same declaration testimony by Dr. Aviel D. Rubin. Ex. 1002 (both proceedings). Petitioner further shows that the trial schedule will not be affected by joinder. Mot. 955, 6–7; Mot. 956, 6–7. No changes in the schedule are anticipated or necessary, and Petitioner’s limited participation, if at all, will not impact the timeline of the ongoing trial. We limit Petitioner’s participation in the joined proceeding such that Petitioner shall require prior authorization from the Board before filing *any* further paper. This

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.