

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BLUE COAT SYSTEMS, INC.,  
Petitioner,

v.

FINJAN, INC.,  
Patent Owner.

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Case IPR2016-00492  
Patent No. 6,804,780

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

GIANNETTI, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
*37 C.F.R. § 42.108*

## I. BACKGROUND

Blue Coat Systems, Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–18 of U.S. Patent No. 6,804,780 (“the ’780 patent”). Paper 3 (“Pet.”). Finjan, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 10 (“Prelim. Resp.”).

Concurrently with the Petition, Petitioner filed a Motion for Joinder. Paper 4 (“Joinder Motion.”). The Joinder Motion seeks to join this proceeding with *Palo Alto Networks, Inc. v. Finjan, Inc.*, Case IPR2015-00165 (“’165 IPR”). Joinder Motion 1. Petitioner states that the Petition here is “practically a copy” of the ’165 IPR petition, “including the same analysis of the prior art and expert testimony.” *Id.* Patent Owner opposes the Joinder Motion in its Preliminary Response. Prelim. Resp. 10–12.

At the time Petitioner filed its Petition and Motion for Joinder, the Board had not yet decided whether to institute *inter partes* review of the ’780 patent in the ’165 IPR. On April 21, 2016, however, we entered a Decision in the ’165 IPR denying the Petition as to all challenges. ’165 IPR, Paper 7 (“Institution Decision”). We determined that applying the standard set forth in 35 U.S.C. § 314(a), the petitioner in that proceeding, Palo Alto Networks, Inc., had failed to demonstrate a reasonable likelihood that it would prevail with respect to at least one challenged claim of the ’780 patent. *Id.* at 20.

Patent Owner asserts that the Petition should be dismissed because it is “unquestionably” time-barred under the provisions of 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b). Prelim. Resp. 1. Patent Owner also contends that the Petition should be denied for the same reasons as the petition in the ’165 IPR was denied. *Id.* at 2. Patent Owner also contends the joinder

motion should be denied because of the Board's denial of institution in the '165 IPR. *Id.* For the reasons that follow, we determine that the Joinder Motion should be dismissed as moot and the Petition for *inter partes* review denied.

## II. DISMISSAL OF MOTION FOR JOINDER

Because the petition in IPR2016-00165 was denied and *inter partes* review was not instituted, Petitioner's Joinder Motion is dismissed as moot. 35 U.S.C. § 315(c).

## III. DENIAL OF *INTER PARTES* REVIEW

### A. *Time Bar Under 35 U.S.C. § 315(b)*

Petitioner admits that a complaint alleging infringement of the '780 patent was served on Petitioner more than a year before the filing date of the Petition. Pet. 5. Under 35 U.S.C. § 315(b), that is a bar to the institution of *inter partes* review unless Petitioner's request for joinder is granted. *See id.*, final sentence. Because we conclude *supra* that the joinder motion is dismissed, we conclude also that the Petition should be denied as time-barred under § 315(b).

### B. *Denial on the Same Grounds as the '165 IPR*

Petitioner states that it relies on the same references and expert testimony as the petition denied in the '165 IPR. *See supra.* Thus, Petitioner challenges claims 1–18 of the '780 patent on the same grounds (Pet. 5) as those asserted in the '165 IPR, namely, obviousness under 35 U.S.C. § 103(a) over Rubin and Waldo. Pet. 5.

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In view of our determination that the Petition is time-barred under 35 U.S.C. § 315(b), however, we do not need to decide this separate ground for denial urged by Patent Owner.

#### IV. ORDER

It is, therefore,

ORDERED that the Motion for Joinder is *dismissed* as moot;

FURTHER ORDERED that the Petition is *denied* as to all challenged claims and no trial is instituted.

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PETITIONER:

Michael T. Rosato

Andrew S. Brown

WILSON SONSINI GOODRICH & ROSATI

mrosato@wsgr.com

asbrown@wsgr.com

PATENT OWNER:

James Hannah

Jeffrey H. Price

KRAMER LEVIN NAFTALIS & FRANKEL LLP

jhannah@kramerlevin.com

jprice@kramerlevin.com

Michael Kim

Finjan, Inc.

mkim@finjan.com