Trials@uspto.gov
571-272-7822

Paper No. 8
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUE COAT SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-00890
Patent 8,677,494 B2

Before JAMES B. ARPIN, ZHENYU YANG, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *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)

I. INTRODUCTION

Blue Coat Systems, Inc. ("Blue Coat" or "Petitioner") filed a Petition for *inter partes* review of claims 1, 2, 5, 6, 10, 11, 14, and 15 of U.S. Patent No. 8,677,494 B2 (Ex. 1001, "the '494 patent"). Paper 2 ("Pet."). Concurrently with its Petition, Blue Coat filed a Motion for Joinder with *Symantec Corp. v. Finjan, Inc.*, Case IPR2015-01892 ("the Symantec 1892 IPR"). Paper 3 ("Mot.). Finjan, Inc. ("Patent Owner") filed a Waiver of Its Preliminary Response and Statement of Non-Opposition to Motion for Joinder. Paper 7 ("Waiver").

For the reasons explained below, we institute an *inter partes* review of claims 1, 2, 5, 6, 10, 11, 14, and 15 of the '494 patent and grant Blue Coat's Motion for Joinder.

II. RELATED PROCEEDINGS

The Parties report that the '494 patent has been asserted in *Finjan, Inc. v. Sophos, Inc.*, 3:14-cv-01197 (N.D. Cal.) (filed Mar. 14, 2014); *Finjan, Inc. v. Symantec Corp.*, 3:14-cv-02998 (N.D. Cal.) (filed June 30, 2014); *Finjan, Inc. v. Palo Alto Networks, Inc.*, 3:14-cv-04908 (N.D. Cal.) (filed Nov. 4, 2014), and *Finjan, Inc. v. Blue Coat Systems, Inc.*, 5:15-cv-03295 (N.D. Cal.) (filed July 15, 2015). Pet. 1; Paper 6, 1. Although not reported by the Parties, we understand that the '494 patent was also asserted previously in *Finjan, Inc. v. Websense, Inc.*, 5:14-cv-01353 (N.D. Cal.) (filed Mar. 24, 2014).

The '494 patent has previously been challenged in *Sophos, Inc. v. Finjan, Inc.*, Case IPR2015-01022 ("Sophos IPR"); *Symantec Corp. v. Finjan, Inc.*, Case IPR2015-01897 ("Symantec 1897 IPR"); and *Palo Alto*

Networks, Inc. v. Finjan, Inc., Case IPR2016-00159 ("PAN IPR"), as well as in the Symantec 1892 IPR. Pet. 1; Paper 6, 1–2. Blue Coat has also filed two additional petitions challenging certain claims of the '494 patent. *Blue Coat Systems, Inc. v. Finjan, Inc.*, Case IPR2016-01174 (Paper 2); *Blue Coat Systems, Inc. v. Finjan, Inc.*, Case IPR2016-01443 (Paper 2).

In the Symantec 1892 IPR, we instituted *inter partes* review of claims 1, 2, 5, 6, 10, 11, 14, and 15 of the '494 patent under 35 U.S.C. § 103(a) as unpatentable over Morton Swimmer et al., *Dynamic Detection and Classification of Computer Viruses Using General Behaviour Patterns*, Virus Bull. Conf. 75 (Sept. 1995) ("Swimmer"). *See Symantec Corp. v. Finjan, Inc.*, Case IPR2015-01892, slip op. at 34 (PTAB Mar. 18, 2016) (Paper 9) ("Symantec 1892 Dec."). We denied institution of *inter partes* review in the Finjan IPR and the Symantec 1897 IPR. IPR2015-01022 (PTAB Sept. 24, 2015) (Paper 7); IPR2015-01897 (PTAB Feb. 26, 2016) (Paper 7). In the PAN IPR, we instituted *inter partes* review of claims 1, 2, 6, 10, 11, and 15 of the '494 patent under 35 U.S.C. § 103(a) as unpatentable over Swimmer, and claims 3–5 and 12–14 of the '494 patent under 35 U.S.C. § 103(a) as unpatentable over the combination of Swimmer and David M. Martin, Jr. et al., *Blocking Java Applets at the Firewall*, Proc. 1997 Symp. on Network & Distributed Sys. Sec. (1997). *See* IPR2016-00159, slip op. at 34 (PTAB May 13, 2016) (Paper 8).

III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same ground of unpatentability as that on which we instituted review in the Symantec 1892 IPR. *Compare* Pet. 4, *with* Symantec 1982 Dec. 34. Indeed, as Blue Coat

notes, the Petition filed in this proceeding is "narrowly tailored to the ground of unpatentability that is the subject of the Symantec [1892] IPR, with a single ground of unpatentability that is substantially identical to the instituted ground of the Symantec [1892] IPR, including the same analysis of the prior art and expert testimony." Mot. 1. Blue Coat further asserts that "[t]he petitions do not differ in any substantive way, other than the removal of grounds on which institution was not granted." *Id.* at 6.

For the same reasons set forth in our institution decision in the Symantec 1892 IPR, we determine that the information presented in Blue Coat's Petition shows a reasonable likelihood that Blue Coat would prevail in showing that claims 1, 2, 5, 6, 10, 11, 14, and 15 of the '494 patent are unpatentable over Swimmer. *See* Symantec 1892 Dec. 12–23. Accordingly, we institute an *inter partes* review on that same ground in this case.

IV. GRANT OF MOTION FOR JOINDER

The Petition and Motion for Joinder in this proceeding were filed on April 14, 2016, and the Petition was accorded that same filing date. *See* Paper 4. Thus, Blue Coat's Motion for Joinder is timely because joinder was requested no later than one month after the institution date of the Symantec 1892 IPR, i.e., March 18, 2016. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); Mot. 4.

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

> 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.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

The Petition in this case asserts the same ground of unpatentability on which we instituted review in the Symantec 1892 IPR. *See* Mot. 1–5; Pet. 3–4, 11–23; Symantec 1892 Dec. 34. Blue Coat also relies on the same prior art analysis and expert testimony submitted by Symantec Corp. ("Symantec") in the Symantec 1892 IPR. *See* Mot. 1, 3, 4, 6. Indeed, the Petition is nearly identical to the petition filed by Symantec with respect to the grounds on which review was instituted in the Symantec 1892 IPR. *Compare* Pet. 11–23, *with Symantec Corp. v. Finjan, Inc.*, Case IPR2015-01892, Paper 1 at 12–25. Thus, this *inter partes* review does not present any ground or matter not already at issue in the Symantec 1892 IPR.

If joinder is granted, Blue Coat "anticipates participating in the proceeding in a limited capacity," absent termination of Symantec as a party. Mot. 1, 6. In particular, Blue Coat agrees that, to the extent that it does participate in the joined proceeding, it "will coordinate with Symantec to consolidate any filings, manage questioning at depositions, manage presentations at the hearing, ensure that briefing and discovery occur within the time normally allotted, and avoid redundancies." *Id.* at 1–2. Blue Coat also states that, "if the proceedings are joined and absent termination of

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