UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Symantec Corp.,
Petitioner

v.

Finjan, Inc.
Patent Owner

U.S. Patent No. 8,141,154
Filing Date: June 14, 2010
Issue Date: March 20, 2012

Title: System and Method for Inspecting
Dynamically Generated Executable Code

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IPR2016-00919

PETITIONER'S MOTION FOR JOINDER

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I.   INTRODUCTION

Petitioner Symantec Corp. ("Petitioner" or "Symantec") moves to join its concurrently filed petition for *inter partes* review involving U.S. Patent No. 8,141,154 (the '154 patent) with the *inter partes* review requested by the Palo Alto Networks, Inc. ("PAN") against the same patent, *Palo Alto Networks, Inc. v. Finjan, Inc.*, IPR2015-01979 (the "PAN IPR"). The Board instituted trial in that proceeding on March 21, 2016. Symantec seeks to join as a party to the PAN IPR, and thus, has presented patentability challenges that are identical to PAN's.

The Symantec petition is timely filed under 35 U.S.C. § 315(c), as it is filed within one month of the date that the PAN IPR was instituted. *See* IPR2015-01979, Paper 8 at 1. As the statute provides and the Board has explained, the one-year filing window specified in § 315(b) and § 42.101(b) "shall not apply to a request for joinder under subsection (c)." 35 U.S.C. § 315(b); *Dell Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper 17 at 4-5 (granting joinder beyond the one-year window); *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15 at 4-5 (same); 37 C.F.R. § 42.122(b) (the "time period set forth in §42.101(b) shall not apply when the petition is accompanied by a request for joinder.").

Joinder is appropriate because of the similarity between the Symantec petition and the PAN IPR. The Symantec petition relies on the *exact same*

grounds as those instituted by the Board in the PAN IPR. Other factors relevant to

joinder favor granting this motion, including that: (i) the same schedule for various

proceedings can be adopted, (ii) Symantec is not advancing any new expert

testimony, and thus, discovery will not be impacted by joinder, and (iii) joinder

will not materially affect the range of issues needing to be addressed by the Board

and by the parties in the joined proceedings. *See Kyocera Corp. v. Softview LLC*,

IPR2013-00004, Paper No. 15 at 4 (Apr. 24, 2013). Moreover, Symantec is

involved in other proceedings involving the '154 patent and has an interest in

ensuring the Board does not resolve an issue in this proceeding that would impact

those other proceedings. Because these factors support joining these proceedings,

Symantec requests the Board to grant this motion for joinder.

II.   RELEVANT FACTS

Finjan has alleged infringement of the '154 patent against Symantec and

other entities in numerous lawsuits.

On June 30, 2014, Finjan filed suit against Symantec, asserting infringement

of one or more claims of the '154 patent in *Finjan, Inc. v. Symantec Corp.*, 3:14-

cv-02998 (N.D. Cal.).   The '154 patent has also been asserted in *Finjan, Inc. v.

Palo Alto Networks, Inc.*, No. 3-14-cv-04908 (N.D. Cal.); *Finjan, Inc. v. Websense,

Inc.*, No. 5-14-cv-01353 (N.D. Cal.); *Finjan, Inc. v. Websense, Inc.*, No. 5-13-cv-

04398 (N.D. Cal.); *Finjan, Inc. v. Sophos, Inc.*, No. 3-14-cv-01197 (N.D. Cal.);

and *Finjan, Inc. v. Proofpoint, Inc.*, No. 3-13-cv-05808 (N.D. Cal.).

III. ARGUMENT

Joinder with the Symantec IPR is justified because each factor identified by

the Board as supporting joinder is met. For example, the Board has explained that

a motion for joinder should: (1) explain the 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.

Kyocera Corp. v. Softview LLC, IPR2013-00004, Paper 15 at 4 (representative

order). Each of these factors is addressed below, and, when considered together,

strongly support granting this motion for joinder.

A.   Joinder Is Appropriate

Joinder between the instant petition and the PAN IPR is appropriate because

they involve the same patent, the same art, the same expert declaration, and the

same arguments and legal rationales. Symantec's proposed grounds of invalidity

are *identical* to PAN's.

Permitting joinder will not prejudice PAN or Finjan. Symantec raises no

issues that are not already before the Board, and consequently, joinder would not

affect the timing of the PAN IPR nor the content of any of Finjan's responses.

Moreover, PAN is amenable to coordinating with Symantec and, as such, neither PAN nor Finjan will suffer any additional costs or burdens in preparing motions and arguments.

The denial of joinder, however, will prejudice Symantec. Absent joinder, Symantec would be unable to participate in the *inter partes* review proceeding related to the '154 patent. Symantec is involved in other proceedings involving the '154 patent, specifically, *Finjan, Inc. v. Symantec Corp.*, 3:14-cv-02998 (N.D. Cal.). Granting joinder would allow Symantec to ensure the Board does not resolve an issue in this proceeding that would impact that proceedings.

Accordingly, because of the instant petition is substantively identical to the PAN IPR, and to avoid prejudice to Symantec, joinder is appropriate.

B.   No New Grounds of Unpatentability in the Symantec Petitions

Symantec's petition proposes institution of trial on the same grounds that were instituted by the Board in the PAN IPR, and Symantec relies on the same exhibits and expert testimony included in the PAN IPR. Accordingly, Symantec proposes no new grounds of unpatentability.

C.   No Impact on the Trial Schedule of Costs of the Proceeding

Granting this motion for joinder will have no impact on the trial schedule because Symantec does not raise any issues that are not already before the Board. Finjan does not need to specifically address any issues raised by Symantec, and

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