

Filed on behalf of Petitioner
By: Joseph J. Richetti
Kevin E. Paganini
Bryan Cave LLP
1290 Avenue of the Americas
New York, NY 10104
Tel: (212) 541-2000
Fax: (212) 541-4630

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROOFPOINT, INC. AND
ARMORIZE TECHNOLOGIES, INC.
Petitioner

v.

FINJAN, INC.
Patent Owner

Case: To Be Assigned
U.S. Patent No. 8,141,154

**MOTION FOR JOINDER UNDER
35 U.S.C. 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)
TO *INTER PARTES* REVIEW OF IPR2015-01979**

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Proofpoint, Inc. and Armorize Technologies, Inc (“Petitioner”) respectfully submits this Motion for Joinder, together with a petition (the “Proofpoint Petition”) for *Inter Partes* Review of U.S. Patent No. 8,141,154 (the “‘154 patent”) filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review filed by Palo Alto Networks, Inc. (“PAN”) in *Palo Alto Networks, Inc. v. Finjan, Inc.*, IPR2015-01979 (the “PAN IPR”), which was instituted on March 21, 2016 and concerns the same ‘154 patent. Petitioner timely filed the Proofpoint Petition and this motion within one month of the institution of the PAN IPR. 37 C.F.R. § 42.122(b).

Joinder will efficiently resolve the challenges to the ‘154 patent in the PAN IPR, and will neither impact the substantive issues or schedule in that proceeding, nor prejudice the parties in the PAN IPR. The Proofpoint Petition raises the same grounds of unpatentability for which the PAN IPR was instituted, challenges the same claims, and relies on the same prior art, arguments and evidence¹ presented in

¹ Petitioner is also submitting the declaration of Sylvia Hall-Ellis and corresponding exhibits as filed in IPR2015-01547 as additional evidence that the Sierer reference on which the Board instituted review in the PAN IPR is a prior art printed

PAN's petition for *inter partes* review. Indeed, in an effort to avoid multiplication of issues before the Board, the Proofpoint Petition duplicates the challenges presented on the instituted grounds in the PAN IPR and it relies on the same supporting expert declaration of Dr. Aviel Rubin submitted by PAN in support of its petition. In addition, Petitioner explicitly agrees to consolidated discovery and briefing as described below, and is willing to accept a limited role with PAN's counsel acting as the lead counsel as long as PAN remains in the proceeding.² Accordingly, Petitioner submits that joinder is appropriate because it will not prejudice the parties or impact the substantive issues and schedule in the PAN IPR, while efficiently resolving in a single proceeding the question of the '154 patent's validity based on the instituted grounds of the PAN IPR.

publication. *Palo Alto Networks, Inc. v. Finjan, Inc.*, IPR2015-01979, paper 8 at 15.

² Petitioner notes that on April 19, 2016, Symantec Corp. also filed a motion requesting joinder to the PAN IPR (IPR2016-00919). In the event that Symantec's motion for joinder is granted, Petitioner agrees to the same procedures for simplified briefing and discovery discussed herein and, in the event that PAN settles with Patent Owner, Petitioner agrees to work with Symantec to determine which counsel will replace PAN's counsel as the lead counsel in the proceedings.

II. STATEMENT OF MATERIAL FACTS

1. The '154 patent is entitled "System and method for inspecting dynamically generated executable code" and lists David Gruzman and Yuval Ben-Itzhak as inventors. The '154 patent issued on March 20, 2012. Finjan, Inc. (the "Patent Owner") is believed to have all rights, title, and interest in '154 patent.

2. On December 16, 2013, Patent Owner filed a civil action asserting the '154 patent, along with other patents, against Proofpoint, Inc. and Armorize Technologies, Inc. in Civil Action No. 3:13-cv-05808. On April 12, 2016 the district court granted Petitioner's motion for summary judgment as to non-infringement of the '154 patent. A jury trial on the remaining patents is currently scheduled for June 13, 2016.

3. On November 4, 2014, Patent Owner filed a civil action asserting the '154 patent, along with other patents, against PAN in Civil Action No. 3:14-cv-04908.

4. On September 25, 2015, PAN filed a petition for *inter partes* review requesting cancellation of claims 1-8, 10, and 11 of the '154 patent (the "PAN Petition"), which was subsequently assigned Case No. IPR2015-01979.

5. On March 21, 2016, the Board instituted *inter partes* review in Case No. IPR2015-01979, finding that a reasonable likelihood existed that the PAN Petition would prevail in showing the unpatentability of claims 1-8, 10, and 11 of the

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