

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

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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

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