

Filed on behalf of Petitioner
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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

IPR2016-00966
U.S. Patent No. 7,647,633

**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 IPR2015-01974**

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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. 7,647,633 (the “‘633 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.*, IPR2015-01974 (the “PAN IPR”), which was instituted on March 29, 2016 and concerns the same ‘633 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 ‘633 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 evidence presented in 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. In addition, Petitioner explicitly agrees to consolidated dis-

covery 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.¹ 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 '633 patent's validity based on the instituted grounds of the PAN IPR.

II. STATEMENT OF MATERIAL FACTS

1. The '633 patent is entitled "Malicious mobile code runtime monitoring system and methods" and lists Yigal Mordechai Edery *et al.* as inventors. The '633 patent issued on January 12, 2010. Finjan, Inc. (the "Patent Owner") is believed to have all rights, title, and interest in '633 patent.

2. On December 16, 2013, Patent Owner filed a civil action asserting the '633 patent, along with other patents, against Proofpoint, Inc. and Armorize Tech-

¹ Petitioner notes that on January 20, 2016, Blue Coat Systems, Inc. ("Blue Coat") also filed a motion requesting joinder to the PAN IPR (IPR2016-00480). In the event that Blue Coat'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 Blue Coat to determine which counsel will replace PAN's counsel as the lead counsel in the proceedings.

nologies, Inc. in Civil Action No. 3:13-cv-05808. A jury trial concerning the ‘633 patent as well as other patents is currently scheduled for June 13, 2016.

3. On November 4, 2014, Patent Owner filed a civil action asserting the ‘633 patent, along with other patents, against PAN in Civil Action No. 3:14-cv-04908.

4. On September 30, 2015, PAN filed a petition for *inter partes* review requesting cancellation of claims 1–4, 6–8, 13, 14, 19, 28, and 34 of the ‘633 patent (the “PAN Petition”), which was subsequently assigned Case No. IPR2015-01974.

5. On January 20, 2016, Blue Coat filed a petition and motion for joinder to join IPR2015-01974. Blue Coat’s petition has been assigned Case No. IPR2016-00480 (the “Blue Coat IPR”). Like Proofpoint, Blue Coat submits that its petition is “virtually identical with respect to the grounds raised in Palo Alto Networks’ petition.” *Blue Coat Systems, Inc. v. Finjan, Inc.*, IPR2015-00480, paper 4 at 4 (PTAB January 20, 2016). No decision has been rendered in the Blue Coat IPR.

6. On March 29, 2016, the Board instituted *inter partes* review in Case No. IPR2015-01974, finding that a reasonable likelihood existed that the PAN Petition would prevail in showing the unpatentability of claims 14 and 19 of the ‘633 patent.

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