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Filed on behalf of: Blue Coat Systems, Inc.
By: Michael T. Rosato (mrosato@wsgr.com)
Andrew S. Brown (asbrown@wsgr.com)
WILSON SONSINI GOODRICH & ROSATI
701 FIFTH AVENUE, SUITE 5100
SEATTLE, WA 98104-7036

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUE COAT SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Patent No. 8,677,494

MOTION FOR JOINDER

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I. Statement of the Precise Relief Requested

Blue Coat Systems, Inc. (“Blue Coat”) submits, concurrently with this motion, a petition for *inter partes* review (“Petition”) of claims 1, 2, 5, 6, 10, 11, 14, and 15 of U.S. Patent No. 8,677,494 (“the ’494 patent”), which is assigned to Finjan, Inc. (“Patent Owner”). Blue Coat respectfully requests that this proceeding be joined, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), with a pending *inter partes* review initiated by Palo Alto Networks, Inc. (“PAN”), IPR2016-00159 (“PAN IPR”), which was instituted on May 13, 2016.

Blue Coat’s request for joinder is timely, because it is submitted within one month of the date on which the PAN IPR was instituted. The Petition is also narrowly tailored to the grounds of unpatentability that are the subject of the PAN IPR, with grounds that are substantively identical to the instituted grounds of the PAN IPR, including the same analysis of the prior art and expert testimony. In addition, joinder is appropriate because it will efficiently resolve the patentability of the challenged claims of the ’494 patent, without prejudicing the parties to the PAN IPR. Indeed, absent termination of PAN as a party to the proceeding, Blue Coat is willing to take a “backseat” role to PAN, in which it would not file any separate papers without consultation with PAN and prior authorization from the Board.

Blue Coat has conferred with counsel for PAN regarding the subject of this motion. PAN has indicated that it does not oppose joinder.

II. Background

Patent Owner has asserted the '494 patent against a number of defendants, including Blue Coat. On July 15, 2015, Patent Owner filed a complaint asserting the '494 patent against Blue Coat. *See* Case No. 5:15-cv-3295 (N.D. Cal. filed July 15, 2015).

On November 6, 2015, PAN filed a petition for *inter partes* review challenging certain claims of the '494 patent. The Board instituted the PAN IPR on May 13, 2016 based on two grounds: (1) claims 1-2, 6, 10-11, and 15 are rendered obvious by *Dynamic Detection and Classification of Computer Viruses Using General Behaviour Patterns*, by Morton Swimmer, and (2) claims 3-5 and 12-14 are rendered obvious by Swimmer in view of *Blocking Java Applets at the Firewall*, by David Martin.

III. Argument

A. Legal Standard

The Board has authority to join as a party to an instituted *inter partes* review one who properly files a petition for *inter partes* review. 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of institution of any *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). In deciding whether

to grant a motion for joinder, the Board considers several factors including: (1) the reasons why joinder is appropriate; (2) whether the party to be joined has presented any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See, e.g., Hyundai Motor Co. v. Am. Vehicular Sciences LLC*, IPR2014-01543, Paper No. 11 at 3 (Oct. 24, 2014); *Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (Aug. 13, 2014) (quoting *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013)).

B. Blue Coat's Motion for Joinder is Timely

Joinder may be requested no later than one month after the institution date of an *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). Here, because the Board instituted the PAN IPR on May 13, 2016, less than one month before the filing of this motion, this motion for joinder is timely.

C. The Relevant Factors Weigh in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder. As discussed below, granting joinder will not enlarge the scope of the PAN IPR and will not negatively impact the PAN IPR schedule, but a decision denying joinder could prejudice Blue Coat. Thus, joinder is appropriate and warranted.

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