

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUE COAT SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-01441
Patent 8,225,408 B2

Before JAMES B. ARPIN, PATRICK M. BOUCHER, and
ZHENYU YANG, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5

A conference call was held on December 12, 2016, among representatives of the parties and Judges Arpin, Boucher, and Yang. The call was requested by Petitioner to seek authorization to file a Reply to Patent Owner's Preliminary Response addressing three issues raised by the Preliminary Response: (1) that the Petition is procedurally barred under 35 U.S.C. §§ 312, 315(e)(1), and 325(d) by an earlier joinder petition; (2) that the Petition fails to identify all real parties in interest under 35 U.S.C. § 312(b); and (3) that Patent Owner submitted testimonial evidence from another proceeding without submitting corresponding contrary cross-examination testimony. We deny the request with respect to the second and third issues, but authorize the filing of a Reply and Sur-reply addressing the estoppel aspects of the first issue. *See* 37 C.F.R. § 42.23 (governing the content of replies).

During the call, we also noted Patent Owner's argument in its Preliminary Response that Petitioner has not paid full fees to support its challenge of dependent claims. Under 37 C.F.R. §§ 42.15(a)(3) and (a)(4), fees are due for "unchallenged claims from which a challenged claim depends." Because the deficiency may have resulted from an error by the Office in confirming the required fees, we advised Petitioner to contact Trials@uspto.gov regarding the nature of the deficiency and Petitioner's ability now to correct it. If such contact does not resolve the issue, the parties further are authorized to address the impact of the fee deficiency in the Reply and Sur-reply.

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In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file, by December 16, 2016, a Reply to the Preliminary Response, limited to five pages, that responds to the Preliminary Response's estoppel arguments and, if appropriate, to the fee-deficiency arguments; and

FURTHER ORDERED that Patent Owner is authorized to file, by December 21, 2016, a Sur-reply, limited to five pages, that responds to Petitioner's arguments in the Reply.

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