

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FIREEYE, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2017-00157
U.S. Patent No. 8,225,408

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR
JOINDER UNDER 37 C.F.R. § 42.23(b)**

On October 28, 2016, FireEye, Inc., (“Petitioner” or “FireEye”) submitted a petition (“Petition”) to institute an *inter partes* review (“IPR”) challenging claims 1-2, 8-9, 11, 23–28, and 29-34 of U.S. Patent No. 8,225,408 (“the ‘408 Patent”). The Petition was filed concurrently with a Motion for Joinder indicating that it seeks to join a “petition” filed by Blue Coat Systems, Inc. (“Blue Coat”), in Case No. IPR2016-01441. *See* Petition at 1; Motion for Joinder, *FireEye, Inc., v. Finjan, Inc.*, Paper No. 3 (“Joinder Motion”). Finjan, Inc., (“Patent Owner” or “Finjan”) requests that Petitioner’s Joinder Motion be denied because 35 U.S.C. § 315(c) only permits joinder of a party to an *inter partes* review “[i]f the Director institutes an inter partes review.” Because no institution decision has been entered in Case No. IPR2016-01441, Petitioner’s Motion for Joinder is improper and should be denied.

FireEye argues that “Joinder may be requested no later than one month after the institution date of an *inter partes* review for which joinder is requested.” Joinder Motion at 5 (citing 37 C.F.R. § 42.122). Petitioner’s reliance on 37 C.F.R. § 42.122 is misplaced because Petitioner disregards the fact that it seeks to join a case for which *inter partes* review proceedings have not been initiated (IPR2016-01441), which is contrary to the law. The law is clear that joinder cannot be appropriate where no “decision granting institution has been entered in the inter partes review for which joinder is requested.” *See Linear Tech. Corp. v. In-Depth*

Test LLC, Case No. IPR2015-01994, Paper No. 7 at 4 (P.T.A.B. Oct. 20, 2015) (“It is clear from both the statute and the rule that a request for joinder is appropriate only if a decision granting institution has been entered in the *inter partes* review for which joinder is requested.”).

Indeed, 35 U.S.C. § 315(c) dictates that the Director may only join a party to an *inter partes* review proceeding *after* the proceeding has been instituted:

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.

35 U.S.C. § 315(c) (emphasis added). The conditional phrase highlighted above leaves no doubt that a motion for joinder is only appropriate when the case to be joined is an instituted *inter partes* review proceeding. Similarly, the Patent Rules provide that any request for joinder must be filed within one month of the institution date of the *inter partes* review to be joined:

Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any **inter partes review for which joinder is**

requested. The time period set forth in §42.101(b) shall not apply when the petition is accompanied by a request for joinder.

37 C.F.R. § 42.122(b) (emphasis added). That is, a request for joinder is a request to join an **inter partes review**, which only exists after the Board's institution decision. *In re Cuozzo Speed Technologies, LLC*, 793 F. 3d 1268, 1272 (Fed. Cir. 2015) ("IPRs proceed in two phases. In the first phase, the PTO determines whether to institute IPR. In the second phase, the Board conducts the IPR proceeding and issues a final decision.")(citations omitted).

In addition, Ground 1 should not be instituted because (a) it is not a ground in the original petition (IPR2016-01441), and (b) FireEye is statutorily barred from filing an *inter partes* petition under 35 U.S.C. § 315(b). Blue Coat failed to challenge the independent claims in IPR2016-01441, which is required under 35 U.S.C. § 312(a)(3), as such the petition should fail. Indeed, the Board has already requested additional briefing on Blue Coat's failure to include independent claims in another *inter partes* petition (IPR2016-01443). As such, FireEye cannot attempt to fix Blue Coat's IPR2016-01441 petition by filing a joinder petition adding additional grounds, particularly, when both Blue Coat and FireEye are statutorily barred from filing new petitions under 35 U.S.C. § 315(b).

For at least the foregoing reasons, Patent Owner respectfully requests that the Board deny Petitioner's improper Joinder Motion.

Patent Owner's Opposition to Petitioner's Motion for Joinder
IPR2017-00157 (U.S. Patent No. 8, 225,408)

Respectfully submitted,

Dated: November 15, 2016

/James Hannah/

James Hannah (Reg. No. 56,369)
Michael Lee (Reg. No. 63,941)
Kramer Levin Naftalis & Frankel LLP
990 Marsh Road
Menlo Park, CA 94025
Tel: 650.752.1700 Fax: 650.752.1800

Jeffrey H. Price (Reg. No. 69,141)
Shannon Hedvat (Reg. No. 68,147)
Kramer Levin Naftalis & Frankel LLP
1177 Avenue of the Americas
New York, NY 10036
Tel: 212.715.7502 Fax: 212.715.8302

Michael Kim (Reg. No. 40,450)
Finjan Inc.
2000 University Ave., Ste. 600
E. Palo Alto, CA 94303
Tel: 650.397.9567

(Case No. IPR2017-00157)

Attorneys for Patent Owner

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.