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Paper 10
Entered: September 8, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYMANTEC CORP.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-00919
Patent 8,141,154 B2

Before THOMAS L. GIANNETTI, MIRIAM L. QUINN, and PATRICK M. BOUCHER *Administrative Patent Judges.*

QUINN, *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)

I. INTRODUCTION

Symantec Corp. ("Petitioner" or "Symantec") filed a Petition (Paper 3, "Pet.") requesting an *inter partes* review of claims 1–8, 10, and 11 ("the challenged claims") of U.S. Patent No. 8,141,154 B2 (Ex. 1001, "the '154 patent"), and concurrently filed a Motion for Joinder (Paper 2, "Mot."). The Motion for Joinder seeks to join this proceeding with *Palo Alto Networks, Inc. v. Finjan, Inc.*, Case IPR2015-01979 ("the PAN IPR"). Mot. 1. Patent Owner filed a waiver of the Preliminary Response, and does not oppose the Motion for Joinder. Paper 8. For the reasons described below, we institute an *inter partes* review of claims 1–8, 10, and 11 of the '154 patent, and grant Petitioner's Motion for Joinder.

II. INSTITUTION OF *INTER PARTES* REVIEW

On March 21, 2016, we instituted a trial in IPR2015-01979 on the following alleged grounds of unpatentability based on obviousness:

1) Claims 1–5 over Khazan[1] and Sirer[2]; and

2) Claims 6–8, 10, and 11 over Khazan, Sirer, and Ben-Natan.[3]

PAN IPR, slip. op. at 15 (PTAB March 29, 2016) (Paper 8). Upon review of the Petition here, we note that the Petition is substantially identical to the Petition in the PAN IPR. The Petition in this proceeding asserts the same grounds as those on which we instituted review in the PAN IPR. Pet. 1, 4–5. Petitioner further relies on the same declaration of Dr. Aviel Rubin, and

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[1] Patent Application Pub. No. US 2005/0108562 A1 ("Khazan").

[2] Sirer et al., *Design and Implementation of a Distributed Virtual machine for Networked Computers* (1999) ("Sirer").

[3] U.S. Patent No. 7,437,362 B1 ("Ben-Natan").

same arguments and supporting evidence presented in the PAN IPR. Pet. 4; Mot. 3.

In view of the identity of the challenge in the instant Petition and in the petition in the PAN IPR, and in light of Patent Owner's waiver of its Preliminary Response, we institute *inter partes* review in this proceeding on the same grounds, and for the same reasons, regarding claims 1–8, 10, and 11, on which we instituted *inter partes* review in the PAN IPR.

III. GRANT OF MOTION 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 parties 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, https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-e2e-frequently-asked-questions.

Petitioner asserts it has grounds for standing because, in accordance with 35 U.S.C. § 315(c), Petitioner filed a motion for joinder concurrently with the Petition and not later than one month after institution of the PAN

IPR. Mot. 1. Patent Owner does not oppose Petitioner's motion for joinder. Paper 8. We find that the Motion is timely.

We also find that Petitioner has met its burden of showing that joinder is appropriate. The Petition here is substantially identical to the Petition in the PAN IPR. Mot. 3–4. The evidence also is identical, including the reliance on the same declaration of Dr. Aviel Rubin. *Id.*

Petitioner further has shown that the trial schedule will not be affected by joinder. Mot. 4–5. No changes in the schedule are anticipated or necessary, and the limited participation, if at all, of Petitioner 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 arrangement promotes the just and efficient administration of the ongoing trial and the interests of Petitioner and Patent Owner.

IV. ORDER

In view of the foregoing, it is

ORDERED that IPR2016-00919 is hereby instituted as to claims 1–8, 10, and 11 on the following grounds:

(1) claims 1–5 as unpatentable under 35 U.S.C. § 103(a) over Khazan and Sirer; and

(2) claims 6–8, 10, and 11 as unpatentable under 35 U.S.C. § 103(a) over Khazan, Sirer, and Ben-Natan;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2015-01979 is *granted*;

FURTHER ORDERED that the grounds on which trial in IPR2015-01979 was instituted are unchanged and no other grounds are included in the joined proceeding;

FURTHER ORDERED that the Scheduling Order entered in IPR2015-01979 (Paper 9) and schedule changes agreed-to by the parties in IPR2015-01979 (pursuant to the Scheduling Order) shall govern the schedule of the joined proceeding;

FURTHER ORDERED that, throughout the joined proceeding, all filings in IPR2015-01979 will be consolidated and no filing by Petitioner Symantec alone will be allowed without prior authorization by the Board;

FURTHER ORDERED that a copy of this Decision will be entered into the record of IPR2015-01979;

FURTHER ORDERED that IPR2016-00919 is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceeding are to be made in IPR2015-01979; and

FURTHER ORDERED that the case caption in IPR2015-01979 shall be changed to reflect joinder with this proceeding in accordance with the attached example.

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