

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUE COAT SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-00479
Patent 6,965,968 B1

Before JAMES B. ARPIN, ZHENYU YANG, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. BACKGROUND

Blue Coat Systems, Inc. (“Petitioner”) filed a Petition (Paper 3, “Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–38 of Patent No. US 6,965,968 B1 to Touboul (Ex. 1001, “the ’968 patent”). Pet. 8.

Finjan, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

Concurrently with the Petition, Petitioner filed a Motion for Joinder. Paper 4 (“Joinder Motion.”). The Joinder Motion seeks to join this proceeding with *Palo Alto Networks, Inc. v. Finjan, Inc.*, Case IPR2016-00150 (“’150 IPR”). Joinder Motion 1. Petitioner states that the Petition here “in fact is practically a copy” of the ’150 IPR petition with respect to the proposed grounds of unpatentability. *Id.* In particular, Petitioner states that

The Petition does not present any new ground of unpatentability. As mentioned above, the Petition presents only the grounds raised in Palo Alto Networks’ petition, and is based on the same prior art analysis and expert testimony submitted by Palo Alto Networks. The petitions do not differ in any substantive way.

Id. at 5. Patent Owner opposes the Joinder Motion in its Preliminary Response. Prelim. Resp. 12–19.

At the time Petitioner filed its Petition and Motion for Joinder, the Board had not yet decided whether to institute an *inter partes* review of the ’968 patent in the ’150 IPR. On May 15, 2016, however, we entered a Decision in the ’150 IPR denying the Petition as to all challenges. ’150 IPR, Paper 11 (“Institution Decision”). We determined that, applying the standard set forth in 35 U.S.C. § 314(a), the petitioner in that proceeding, Palo Alto Networks, Inc., had failed to demonstrate a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim of the ’968 patent. *Id.* at 33. Palo Alto Networks, Inc. did not file a request for rehearing in the ’150 IPR.

Patent Owner asserts that the Petition should be dismissed because it is “unquestionably” time-barred under the provisions of 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b). Prelim. Resp. 11. Patent Owner also contends that the Petition should be denied for substantially the same reasons as the petition in the

'150 IPR. *See id.* at 33–60; *cf.* '150 IPR, Paper 7, 26–56. For the reasons that follow, we determine that the Joinder Motion should be dismissed as moot and the Petition for *inter partes* review should be denied.

II. DISMISSAL OF MOTION FOR JOINDER

Because we denied the petition in IPR2016-00150, and we did not institute *inter partes* review in that case, Petitioner's Joinder Motion is dismissed as moot. 35 U.S.C. § 315(c).¹

III. DENIAL OF *INTER PARTES* REVIEW

A. *Time Bar Under 35 U.S.C. § 315(b)*

Petitioner acknowledges that a complaint alleging infringement of the '968 patent was served on Petitioner more than a year before the filing date of the Petition. Pet. 9. Under 35 U.S.C. § 315(b), that is a bar to the institution of *inter partes* review unless Petitioner's request for joinder is granted. *See id.* (“[H]owever, a motion to joinder has been filed to join the *inter partes* review requested in the '150 petition not later than 1 month after institution in accordance with 37 U.S.C. § 315(c).”). Because we dismiss the Joinder Motion (*see supra* Section II), we conclude that the Petition should be denied as time-barred under § 315(b).

B. *Denial on the Same Grounds as the '150 IPR*

Petitioner states that it relies on the same references and expert testimony as the petition denied in the '150 IPR. *See* Joinder Motion 4 (“[The Petition] also relies on the same prior art analysis and expert testimony submitted by Palo Alto Networks. Indeed, the Petition is virtually identical with respect to the grounds

¹ Patent Owner filed its Preliminary Response in IPR2016-00479 before we issued our Institution Decision denying institution of *inter partes* review in IPR2016-00150.

raised in Palo Alto Networks’ petition, and does not include any grounds not raised in Palo Alto Networks’ petition.”); *supra* Section I (quoting Joinder Motion 5). Thus, Petitioner challenges claims 1–38 of the ’968 patent on the same grounds (Pet. 8) as those asserted in the ’150 IPR, namely,

Ground	References and Document	Challenged Claims
35 U.S.C. § 103(a)	Coss and Zuk	1–3, 5–8, 12–17, 20, 21, 23–27, 29, and 32–36
35 U.S.C. § 103(a)	Coss, Zuk, and Check Point	9–11
35 U.S.C. § 103(a)	Coss, Zuk, and Ke	4, 18, 19, and 28
35 U.S.C. § 103(a)	Coss, Zuk, and Ganesan	22, 30, 31, 37, and 38

’150 IPR, Paper 11, 8; *see* ’150 IPR, Paper 2, 5, 8. In view of our determination that the Petition is time-barred under 35 U.S.C. § 315(b), however, we do not need to decide the separate grounds for denial urged by Patent Owner. *See* Prelim Resp. 19–60.

IV. ORDER

It is, therefore,

ORDERED that the Motion for Joinder is *dismissed* as moot; and

FURTHER ORDERED that the Petition is *denied* as to all challenged claims as untimely filed, and no trial is instituted.

Case IPR2016-00479
Patent 6,965,968 B1

For PETITIONER:

Michael T. Rosato
Andrew S. Brown
WILSON SONSINI GOODRICH & ROSATI
mrosato@wsgr.com
asbrown@wsgr.com

For PATENT OWNER:

James Hannah
Jeffrey H. Price
KRAMER LEVIN NAFTALIS & FRANKEL LLP
jhannah@kramerlevin.com
jprice@kramerlevin.com

Michael Kim
FINJAN, INC.
mkim@finjan.com