

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FIREEYE, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2017-00155
Patent 8,079,086 B2

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

BOUCHER, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review and
Dismissing Motion for Joinder
37 C.F.R. §§ 42.108, 42.122

On October 28, 2016, FireEye, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1, 4–6, 9, 12–14, 17, 24, 35, 37, and 42 of U.S. Patent No. 8,079,086 B2 (Ex. 1001, “the ’086 patent”). Petitioner concurrently filed a Motion for Joinder with *Blue Coat Systems, Inc. v. Finjan, Inc.*, IPR2016-01444 (“the *Blue Coat* proceeding” or “*Blue Coat*”). Paper 3 (“Mot.”). Finjan, Inc. (“Patent Owner”) filed an Opposition to the Motion for Joinder (Paper 7) and a Preliminary Response (Paper 8) to the Petition. We deny the Petition and dismiss the Motion for Joinder, without prejudice.

I. BACKGROUND

A. *The ’086 Patent*

The ’086 patent discloses systems and methods capable of protecting personal computers and other network-accessible devices from “harmful, undesirable, suspicious or other ‘malicious’ operations that might otherwise be effectuated by remotely operable code.” Ex. 1001, col. 2, ll. 30–35.

B. *Illustrative Claim*

Independent claim 1 is illustrative of the claims at issue and is reproduced below.

1. A computer-based method, comprising the steps of:
 - receiving an incoming Downloadable;
 - deriving security profile data for the Downloadable, including a list of suspicious computer operations that may be attempted by the Downloadable;
 - appending a representation of the Downloadable security profile data to the Downloadable, to generate an appended Downloadable; and

transmitting the appended Downloadable to a destination computer.

Id. at col. 20, l. 60–col. 21, l. 2.

B. References

Petitioner relies on the following references. Pet. 7–12.

Morton Swimmer, Baudouin Le Charlier, and Abdelaziz Mounji, *Dynamic Detection and Classification of Computer Viruses Using General Behaviour Patterns*, PROC. FIFTH INT’L VIRUS BULL. CONF. 75 (Virus Bulletin Ltd. 1995) (Ex. 1003) (“Swimmer”).

George C. Necula, *Proof-Carrying Code*, PROC. 24TH ACM SIGPLAN-SIGACT SYMP. ON PRINCIPLES OF PROGRAMMING LANGUAGES 106 (ACM 1997) (Ex. 1004) (“Necula”).

M. Douglas McIlroy, *Virology 101*, 2 COMP. SYS. 173 (1989) (Ex. 1005) (“McIlroy”).

Ari Luotonen and Kevin Altis, *World-Wide Web proxies*, 27 COMP. NETWORKS AND ISDN SYS. 147 (1994) (Ex. 1006) (“Luotonen”).

C. Asserted Grounds of Unpatentability

Petitioner challenges claims 1, 4–6, 9, 12–14, 17, 24, 35, 37, and 42 under 35 U.S.C. § 103(a) over the following combinations of references.

Pet. 14.

References	Claims
Swimmer and Necula	1, 5, 9, 13, 17, 24, and 42
Swimmer, Necula, and McIlroy	4 and 12
Swimmer, Necula, and Luotonen	6, 14, 35, and 37

D. Related Proceedings

1. District Court Proceedings

Both parties identify the following district court proceedings as involving the '086 patent: *Finjan, Inc. v. ESET LLC et al.* No. 3:16-cv-03731 (N.D. Cal.); and *Finjan, Inc. v. Blue Coat Systems, Inc.*, 5:15-cv-03295 (N.D. Cal.). Pet. 13; Paper 5, 1. Petitioner additionally identifies the following district court proceedings as involving the '086 patent: *Finjan, Inc. v. Proofpoint, Inc. et al.*, No. 3:13-cv-05808 (N.D. Cal.); and *Finjan, Inc. v. FireEye, Inc.*, 4:13-cv-03133 (N.D. Cal.). Pet. 13.

2. Reexamination Proceeding

Patent Owner identifies the following reexamination proceeding as involving the '086 patent: Control No. 90/013,654. Paper 5, 1.

3. Inter Partes Review

A petition for *inter partes* review of the '086 patent was filed in the *Blue Coat* proceeding. Although that petition was denied, a timely-filed request for rehearing of the denial is currently pending before the Board. *Blue Coat*, Papers 9, 10.

II. ANALYSIS

A. Statutory Time Bar

Patent Owner has asserted the '086 patent against a number of defendants, including Petitioner, who acknowledges that “[i]n 2013, Patent Owner filed a complaint asserting the '086 patent against [Petitioner].” Mot. 2. Relevant to this proceeding, Petitioner was served with the

complaint for infringement of the '086 patent on July 11, 2013, more than a year before the October 28, 2016, filing of the instant Petition. Ex. 2050.

“An *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b); *see also* 37 C.F.R. § 42.101(b) (mirroring statutory language in regulation defining who may file a petition for *inter partes* review). Accordingly, the Petition is statutorily barred.

B. Motion for Joinder

Section 315(b) provides an exception to the statutory bar for a request for joinder: “The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).” Nevertheless, there must be an instituted proceeding to join: “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 . . . that the Director . . . determines warrants the institution of an *inter partes* review under section 314.” 35 U.S.C. § 315(c) (emphasis added).

Petitioner’s filing of the Petition and Motion for Joinder, before the Board reached a decision on institution of an *inter partes* review in the *Blue Coat* proceeding, is premature. The exception to the statutory bar against the Petition, which would allow consideration of the Petition and Motion for Joinder on their merits, will apply only if the request for rehearing in the *Blue Coat* proceeding is granted and an *inter partes* review is instituted in that proceeding. Because we are mandated statutorily to take action on the Petition in this proceeding by May 3, 2017, we deny the Petition as

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