

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUE COAT SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-00498
Patent 6,154,844

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

BOUDREAU, *Administrative Patent Judge*.

DECISION
Dismissal of the Petition
35 U.S.C. § 317; 37 C.F.R. §§ 42.5(a), 42.71(a)

On January 25, 2016, Blue Coat Systems, Inc. (“Petitioner”) filed a Petition (Paper 3, “Pet.”) to institute an *inter partes* review of claims 1, 7, 11, 15, 16, 41, and 43 of U.S. Patent No. 6,154,844 to Touboul et al. (Ex. 1001, “the ’844 patent”). Pet. 1. Concurrently with the Petition, Petitioner filed a Motion for Joinder (Paper 4, “Joinder Mot.”), seeking to join this proceeding with *Symantec Corp. v. Finjan, Inc.*, Case IPR2015-01894 (“’1894 IPR”). Petitioner states that the Petition here “in fact is a practical copy” of Symantec’s petition in the ’1894 IPR with respect to the proposed grounds of unpatentability, including the same analysis of the prior art and expert testimony. Joinder Mot. 1. 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 Symantec’s petition, and is based on the same prior art analysis and expert testimony submitted by Symantec. The petitions do not differ in any substantive way.

Id. at 6.

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 ’844 patent in the ’1894 IPR. On March 11, 2016, however, we entered a Decision in the ’1894 IPR denying the Petition as to all challenges. ’1894 IPR, Paper 7 (“Institution Decision”). We determined that, applying the standard set forth in 35 U.S.C. § 314(a), the petitioner in that proceeding, Symantec Corp., had failed to demonstrate a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim of the ’844 patent. *Id.* at 33. Symantec did not file a request for rehearing in the ’1894 IPR.

On June 9, 2016, in view of the denial of institution in the ’1894 IPR, and pursuant to our authorization, Petitioner filed a Motion to Dismiss

Petition (Paper 9, “Dismiss Mot.”), requesting dismissal of the Petition and Motion for Joinder. Dismiss Mot. 1. Petitioner indicates that Patent Owner, Finjan, Inc., does not oppose this request. *Id.*

Under the present circumstances, we determine that it is appropriate to dismiss the Petition and the Motion for Joinder. *See* 37 C.F.R. §§ 42.5(a), 42.71(a). We note that Petitioner acknowledges that a complaint alleging infringement of the ’844 patent was served on Petitioner more than a year before the filing date of the Petition. Pet. 2–3. 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.* Because institution was denied in the ’1894 IPR, however, the Motion for Joinder necessarily would have been denied as moot (*see* 35 U.S.C. § 315(c)), and the Petition necessarily would have been denied as time-barred under § 315(b) in the absence of Petitioner’s request.

Accordingly, it is

ORDERED that the Motion to Dismiss Petition (Paper 9) is *granted*;

FURTHER ORDERED that the Petition (Paper 3) is *dismissed* as to all challenged claims; and

FURTHER ORDERED that the Motion for Joinder (Paper 4) is *dismissed*.

IPR2016-00498
Patent 6,154,844

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