

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

IPR2019-01611
Patent 8,079,086 B1

Before PATRICK M. BOUCHER, CHARLES J. BOUDREAU, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

Unified Patents, Inc. (“Petitioner”) filed a Petition 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, and 37 of U.S. Patent No. 8,079,086 B1 (Ex. 1001, “the ’086 patent”). Paper 1 (“Pet.”). Finjan, Inc. (“Patent Owner”) filed a

Preliminary Response.¹ Paper 10 (“Prelim. Resp.”). Pursuant to our authorization, Paper 6, Petitioner filed a Reply to address real-party-in-interest and privy arguments raised in the Preliminary Response. Paper 15.²

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); *Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“the PTO is permitted, but never compelled, to institute an IPR proceeding”). For the reasons set forth below, we exercise our discretion under 35 U.S.C. § 314(a) to deny institution of an *inter partes* review of the challenged claims of the ’086 patent.

I. BACKGROUND

A. The ’086 Patent

The ’086 patent is directed to 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, 2:30–35. The ’086 patent incorporates a number of other patents and patent applications by reference, including U.S. Patent No. 6,092,194 (Ex. 1012, “the ’194 patent”). *Id.* at 1:8–35. Figure 3 of the ’194 patent is reproduced below.

¹ We previously granted Patent Owner’s request for an extension of the deadline for filing its Preliminary Response to January 21, 2020. Paper 6. We subsequently further extended that deadline to January 23, 2020, in response to an email request in which Patent Owner represented that Petitioner did not oppose the request. Ex. 3001.

² We cite herein to publicly available, redacted versions of the Preliminary Response and Reply. This Decision does not rely on the unredacted versions, filed respectively as Papers 9 and 14.

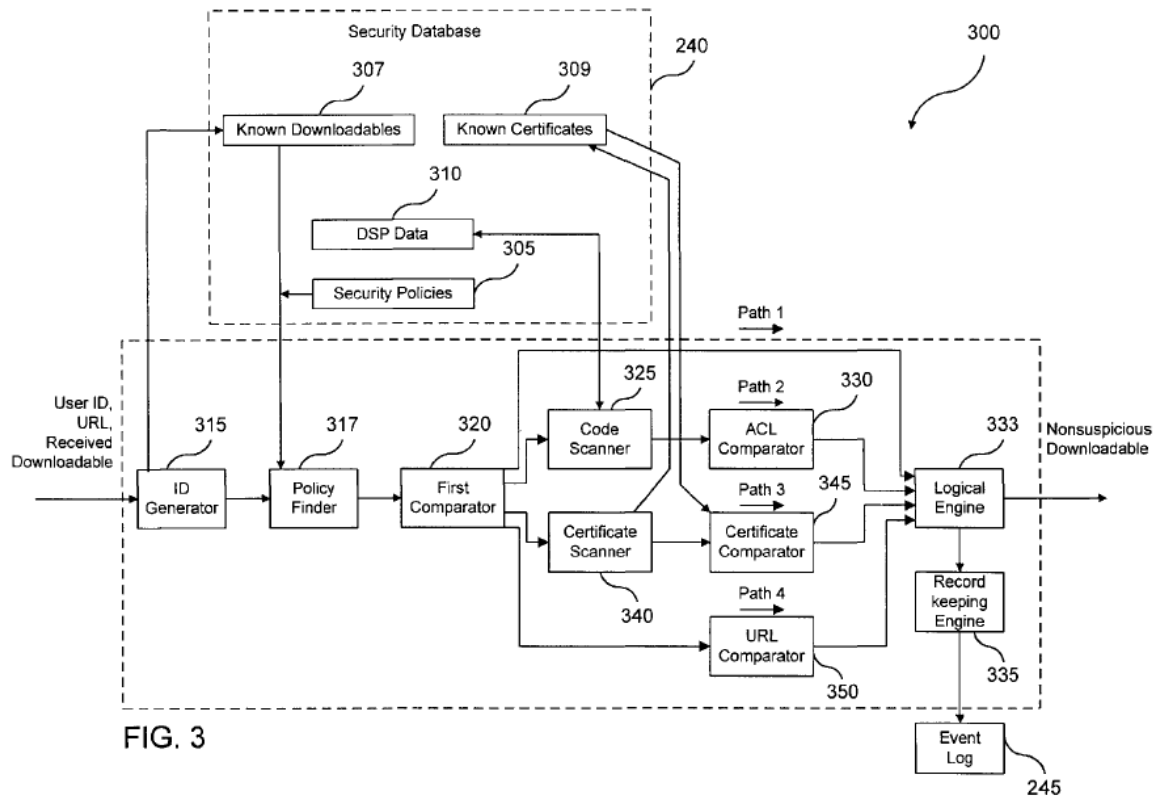


Figure 3 is a block diagram that illustrates a security program (lower dashed box) and security database 240 (upper dashed box). Ex. 1012, 3:62–63. The security program operates in conjunction with security database 240, “which includes security policies 305, known Downloadables 307, known Certificates 309 and Downloadable Security Profile (DSP) data 310 corresponding to the known Downloadables 307.” *Id.* at 4:14–18.

Security policies 305, which include policies specific to particular users and generic policies for determining whether to block an incoming Downloadable, “may identify specific Downloadables to block, specific Downloadables to allow, or necessary criteria for allowing an unknown Downloadable.” *Id.* at 4:18–24. DSP data 310 “includes the list of all potentially hostile or suspicious computer operations that may be attempted

by each known Downloadable 307, and may also include the respective arguments of these operations.” *Id.* at 4:33–37.

B. Illustrative Claim

Independent claim 1 of the ’086 patent is illustrative of the challenged claims:

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.

Ex. 1001, 20:60–21:2.

C. Evidence

Petitioner relies on the following references. Pet. 4–5, 11–14.

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”).

In addition, Petitioner relies on a Declaration by Azer Bestavros, Ph.D. Ex. 1002.

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1, 4–6, 9, 12–14, 17, 24, 35, and 37 on the following grounds. Pet. 5–6.

Claims Challenged	35 U.S.C. §³	References
1, 5, 9, 13, 17, 24	103(a)	Swimmer, Necula
4, 12	103(a)	Swimmer, Necula, McIlroy
6, 14, 35, 37	103(a)	Swimmer, Necula, Luotonen

E. Real Parties in Interest

The parties identify only themselves as real parties in interest. Pet. 1; Paper 3, 1. Patent Owner disputes Petitioner’s identification, and contends that various additional entities “should have been ‘named a real party in interest’ or privy of [Petitioner].” Prelim. Resp. 5 (citing *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018)). We do not reach this dispute.

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended various provisions of 35 U.S.C. Because the ’086 patent was filed before March 16, 2013 (the effective date of the relevant amendment), the pre-AIA versions of those provisions apply.

F. Related Matters

Both parties identify the following district court litigation as involving the '086 patent: (1) *Finjan, Inc. v. Fortinet Inc.*, No. 3:18-cv-06555 (N.D. Cal.); (2) *Finjan, Inc. v. Rapid7, Inc.*, No. 1:18-cv-01519 (D. Del.); (3) *Finjan, Inc. v. Check Point Software Technologies, Inc.*, No. 3:18-cv-02621 (N.D. Cal.); and (4) *Finjan, Inc. v. ESET, LLC*, No. 3:17-cv-00183 (S.D. Cal.). Pet. 1; Paper 3, 1. Petitioner additionally identifies the following district court litigation as involving the '086 patent: (1) *Finjan, Inc. v. AVG Technologies CZ, s.r.o.*, No. 5:17-cv-00283 (N.D. Cal.); (2) *Finjan, Inc. v. ESET, LLC*, No. 3:16-cv-03731 (N.D. Cal.); (3) *ESET, LLC v. Finjan, Inc.*, 3:16-cv-01704 (S.D. Cal.); (4) *Finjan, Inc. v. Blue Coat Systems, Inc.*, No. 5:15-cv-03295 (N.D. Cal.); (5) *Finjan, Inc. v. FireEye, Inc.*, No. 4:13-cv-03133 (N.D. Cal.); and (6) *Finjan, Inc. v. Proofpoint, Inc.*, No. 4:13-cv-05808 (N.D. Cal.). Pet. 2.

The parties also both identify the following *inter partes* reviews as involving the '086 patent: (1) *Blue Coat Systems, Inc. v. Finjan, Inc.*, IPR2016-01444 (“Blue Coat IPR”); (2) *FireEye, Inc. v. Finjan, Inc.*, IPR2017-00155 (“FireEye IPR”); and (3) *ESET, LLC v. Finjan, Inc.*, IPR2017-01969 (“ESET IPR”). Pet. 2; Paper 3, 1. We refer collectively herein to the Blue Coat IPR, the FireEye IPR, and the ESET IPR as “the prior IPRs.”

II. ANALYSIS

A. History of the Prior IPRs

The extensive history of the prior IPRs bears strongly on our exercise of discretion under 35 U.S.C. § 314(a) to deny institution of an *inter partes*

review in the instant proceeding. Accordingly, we summarize relevant aspects of that history as follows.

Nearly four years ago, on July 15, 2016, Blue Coat Systems, Inc. (“Blue Coat”) filed a petition requesting an *inter partes* review of claims 1, 4–6, 9, 12–14, 17, 24, 35, 37, and 42 of the ’086 patent. Blue Coat IPR, Paper 2, 14–15. Notably, except for the additional challenge to claim 42, this set of claims is identical to the set of claims challenged in the instant proceeding. And the bases for the challenges were also the same, relying principally on the combination of Swimmer and Necula, with McIlroy and Luotonen applied for limitations recited in certain dependent claims, as well as independent claims 35 and 37. *See id.*

On October 28, 2016, FireEye, Inc. (“FireEye”) filed its own petition challenging claims 1, 4–6, 9, 12–14, 17, 24, 35, 37, and 42 of the ’086 patent on the same bases advanced in the Blue Coat petition. FireEye IPR, Paper 1, 14. FireEye had been served with a complaint alleging infringement of the ’086 patent on July 11, 2013. *Id.*, Ex. 2050. Because that service occurred more than a year before FireEye filed its petition, institution of the FireEye IPR was barred by 35 U.S.C. § 315(b). Accordingly, concurrent with the filing of its petition, FireEye also filed a motion for joinder with the Blue Coat IPR to take advantage of the exception to the time bar for a request for joinder. *Id.*, Paper 3.

We initially denied institution of the Blue Coat IPR, on February 16, 2017, because we found Blue Coat’s evidence that Necula is prior art to the ’086 patent insufficiently addressed developments in a pending reexamination proceeding involving the ’086 patent that impacted the effective filing date of the ’086 patent’s claims. *See* Blue Coat IPR, Paper 9,

5–9. Blue Coat requested rehearing of that decision on March 20, 2017. *Id.*, Paper 10.

On May 1, 2017, recognizing that a rehearing of our decision in the Blue Coat IPR was pending, but statutorily required to render a decision on the FireEye petition by May 3, 2017, we denied FireEye’s petition as time barred and dismissed without prejudice FireEye’s motion for joinder with the Blue Coat IPR. FireEye IPR, Paper 9. FireEye filed a request for rehearing of that decision on May 31, 2017. *Id.*, Paper 10.

On July 18, 2017, we granted Blue Coat’s rehearing request and instituted the Blue Coat IPR as to all challenged claims. Blue Coat IPR, Paper 11. The next day, on July 19, 2017, we similarly granted FireEye’s rehearing request and joined FireEye to the Blue Coat IPR. FireEye IPR, Paper 11 (also entered as Paper 13 in the Blue Coat IPR).

On August 16, 2017, ESET, LLC (“ESET”) filed a petition requesting an *inter partes* review of claims 1, 2, 4–6, 9, 10, 12–14, 17, 24, 35, and 37 of the ’086 patent. ESET IPR, Paper 1, 4. Like the petitions filed in the Blue Coat and FireEye IPRs, the challenges principally applied Swimmer and Necula, with McIlroy and Luotonen applied for limitations recited in certain dependent claims, as well as independent claims 35 and 37. *See id.* The set of claims challenged was also substantially the same as the set of claims challenged in the Blue Coat and FireEye IPRs, differing only in additional challenges to claims 2 and 10, and omitting a challenge to claim 42. Like the FireEye petition, ESET’s petition appeared to be barred under 35 U.S.C. § 315(b) because ESET had been served with a complaint alleging infringement of the ’086 patent on July 1, 2016, i.e., more than one year before the filing of ESET’s petition. *See id.*, Paper 3, 4. Accordingly,

concurrent with its petition, ESET filed a motion for joinder to the Blue Coat IPR. *Id.*

On December 1, 2017, we terminated the Blue Coat IPR with respect to Blue Coat after determining that there was good cause to do so in light of a settlement between Patent Owner and Blue Coat. Blue Coat IPR, Paper 48. Later, on February 16, 2018, we terminated the Blue Coat IPR with respect to all parties after determining that there was good cause to do so in light of a further settlement between Patent Owner and FireEye. *Id.*, Paper 53.

But in the interim, i.e., after termination of the Blue Coat IPR with respect to original petitioner Blue Coat but before termination with respect to joined petitioner FireEye, we considered ESET's petition and motion to join the Blue Coat IPR. At that time, only FireEye remained as a petitioner in the Blue Coat IPR, a party that would have been time barred except for its joinder to the proceeding while Blue Coat remained active. ESET was similarly time barred except for its effort to daisychain to become a party to the Blue Coat IPR through joinder.

In denying ESET's petition and motion for joinder on January 9, 2018, we noted that "joinder to the [Blue Coat IPR] would disrupt the progress of that proceeding by adding additional issues and evidence addressing those additional issues." ESET IPR, Paper 8, 10. We also denied ESET's request for rehearing of that decision on February 15, 2018, explaining that "we are mindful of the equities resulting from the procedural history, in which Patent Owner repeatedly finds itself defending its patent, in the same proceeding, against new petitioners who rise up to replace those with whom it has settled." *Id.*, Paper 12, 5–6.

B. Legal Principles

“Although we recognize that an objective of the [America Invents Act] is to provide an effective and efficient alternative to district court litigation, we also recognize the potential for abuse of the review process by repeated attacks on patents.” *General Plastic Indus. Co. v. Canon Kabushiki Keisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017) (precedential). Accordingly, the Board has identified seven nonexclusive factors that bear on the issue of whether the Board should exercise its discretion to deny institution of an *inter partes* review, based on a follow-on petition on the same patent, under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a):

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and

7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic at 9–10.

C. Assessment

The Petition filed in the instant proceeding is the *fourth* petition filed against the '086 patent. It challenges substantially the same claim set as the previous three petitions, and it does so using the same prior art asserted in those prior challenges. Patent Owner argues that the *General Plastic* factors weigh in favor of a discretionary denial of the Petition under 35 U.S.C. § 314(a). Prelim. Resp. 27–39. Petitioner argues the contrary. Pet. 6–9. We accordingly address each of the factors below.

1. “whether the same petitioner previously filed a petition directed to the same claims of the same patent”

In addressing the first *General Plastic* factor, “whether the same petitioner previously filed a petition directed to the same claims of the same patent,” Patent Owner acknowledges that Petitioner has not previously filed any petition for *inter partes* review against the '086 patent. *See* Prelim. Resp. 29. Nevertheless, Patent Owner contends that, “[b]ecause [Petitioner] challenges the exact same set of claims previously challenged by [ESET] and a set of claims substantially similar to the set challenged by Blue Coat and FireEye, factor 1 weighs against institution in this case.” *Id.* at 29–30. Petitioner does not directly address this factor.

We agree with Patent Owner that the similarity of the set of challenged claims, which has been repeated over multiple petitions for *inter partes* review, weighs in favor of a discretionary denial. But this is counterbalanced by the fact that Petitioner is not “the same petitioner” who filed such prior petitions. Accordingly, we treat this factor as neutral in our weighing of the *General Plastic* factors.

2. “*whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it*”

In addressing the second *General Plastic* factor, “whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it,” Petitioner represents that it “first became aware of the prior art asserted in this Petition upon reviewing the ’086 patent.” Pet. 8. Petitioner further represents that it “was not aware of the prior art asserted in the Blue Coat IPR when the Blue Coat IPR was filed.” *Id.*

In evaluating this factor, we are sensitive to the limited nature of Petitioner’s representations, which do not address whether Petitioner was aware of Swimmer and Necula (as well as the other art applied in the earlier petitions) at the time of filing of the FireEye or ESET petitions—which also preceded Petitioner’s filing. Petitioner offers no indication of when it began “reviewing the ’086 patent,” thereby limiting our ability to determine when it affirmatively knew of the prior art asserted in its position, against the backdrop of the lengthy and complex history of proceedings before the Board involving the ’086 patent.

The second *General Plastic* factor “includes considering whether the prior art relied on in the later petition ‘could have been found with reasonable diligence.’” *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00064, Paper 10 at 11 (PTAB May 1, 2019) (precedential). More than a year passed between the filing of the Blue Coat petition and the ESET petition. During that time, the proceedings of the Blue Coat and FireEye IPRs were public such that the art relied on in the instant Petition could easily have been found through the exercise of reasonable diligence.

In light of these considerations, we conclude that the second *General Plastic* factor weighs in favor of a discretionary denial of instituting the proceeding.

3. “*whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition*”

The third *General Plastic* factor, “whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition,” is meant to take into account “undue inequities” that may result from a petitioner being able to study a patent owner’s arguments, as well as the Board’s institution decisions. *General Plastic* at 17 (“Multiple, staggered petitions challenging the same patent and the same claims raise the potential for abuse.”). Patent Owner identifies a number of documents from the prior IPRs that articulate its positions with respect to the ’086 patent, as well as the Board’s evaluation of

those positions and the positions of the prior petitioners. Prelim. Resp. 32 (“This factor weighs strongly against institution in this case because Petitioner has had the opportunity to study the following [thirteen] documents.”). In addition, Patent Owner provides compelling argument that “Petitioner **has actually used** these documents as a roadmap to construct new evidence and arguments.” *Id.* at 33. As Patent Owner specifically observes, Petitioner’s evidence includes “an entirely new declaration from Blue Coat and FireEye’s expert, Dr. Bestavros,” as well as “new exhibits that respond to Finjan’s arguments that Swimmer and Necula were not public[ly] accessible before the ’086 Patent’s priority date.” *Id.* (citing Exs. 1002, 1004, 1051).

Patent Owner also highlights refinement in Petitioner’s arguments directed at certain claims. For example, in the Blue Coat IPR, Blue Coat addressed independent claims 35 and 37 by arguing in its petition that “Luotonen’s firewall would reasonably be the destination computer for the firewall taught by Swimmer in view of Necula.” Blue Coat IPR, Paper 2, 58. Patent Owner addressed this argument directly in its Response in the Blue Coat IPR:

Petitioner’s argument rests on the assertion that “Luotonen’s firewall would reasonably be the destination computer for the firewall taught by Swimmer in view of Necula.” Petition at 58. But in claims 35 and 37, the “destination computer” is not the component that does the recited “receiving security profile data” and “transmitting the Downloadable and a representation of the Downloadable security profile data.” *See* claims 35 and 37. Thus, it would not “have been obvious to use Luotonen’s proxy server to (1) receive the Downloadable and appended[□] security profiles from the system disclosed in Swimmer and Necula, and (2) transmit the Downloadable and attached security profile to code consumers” because—according to

Petitioner’s theory—those steps would already have been completed if Luotonen’s proxy server was to be considered the claimed destination computer. Second Medvidovic Decl., ¶ 137; Petition at 58-59.

Id., Paper 47, 47–48 (footnote observing that neither claim 35 nor 37 recites “appended security profiles” omitted). Petitioner appears to have modified the original argument in two ways. First, Petitioner substitutes “appended DSP data” in its argument for the references to “appended security profiles” that appeared in Blue Coat’s petition, thereby tracking the claim language more closely. Second, and more important, Petitioner replaces the cursory argument that Luotonen’s firewall corresponds to the destination computer for the firewall in the Swimmer-Necula combination with the following elaboration:

The combination results in the following system. A user’s computer would send a request for a file through *Luotonen’s* proxy, which would then pass through *Swimmer* and *Necula’s* firewall to a host of the file. The host would respond with the file and that file would reach *Swimmer* and *Necula’s* firewall. *Swimmer* and *Necula’s* firewall would generate the DSP and append it to the file; it would then be sent to *Luotonen’s* proxy which would then send the file and the appended DSP data to the user’s computer that requested the file initially. EX1002 ¶208, 207, 200.

Pet. 63.

In addressing this factor, Petitioner correctly observes that it “is not pursuing different grounds of unpatentability than those presented in the Blue Coat IPR” and that it “did not modify the references asserted in [those grounds] based on Finjan’s preliminary response, the Board’s institution decision, or Finjan’s patent owner response.” Pet. 8. But missing from

Petitioner's assertions is any indication that it refrained from attempting to strengthen certain arguments in light of its study of those materials. Indeed, at least with respect to claims 35 and 37, it is apparent that Petitioner introduced elaboration meant to preempt arguments made by Patent Owner in the Blue Coat IPR. And, more generally, it does not necessarily follow that the presentation of the same grounds and arguments as advanced in an earlier proceeding is divorced from influence by a Board decision assessing the strengths and weaknesses of those grounds and arguments.⁴

In light of these considerations, we conclude that the third *General Plastic* factor weighs heavily in favor of a discretionary denial of instituting the proceeding.

⁴ For a further example, Patent Owner refers to the omission of claim 42 from Petitioner's challenge. Patent Owner asserts that, in the Blue Coat IPR, Patent Owner "pointed out that Blue Coat's arguments with respect to how the combination of Swimmer and Necula allegedly read on Claim 42 fundamentally conflicted with its argument that Swimmer and Necula read on Claims 1, 4-6, 9, 12-14, 17, 24, 35, and 37." Prelim. Resp. 34-35 (citing Blue Coat IPR, Paper 47, 34, 37-40). Although Patent Owner's position that there was an inconsistency in Blue Coat's arguments appears to have merit, Patent Owner's inference that the omission of claim 42 from Petitioner's challenge is a wholesale capitulation to that position is not sufficiently apparent on the record before us. We thus give little weight to this additional example in our consideration.

4. “the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second”

When Congress created *inter partes* review proceedings, it was faced with balancing competing considerations—the desire to address deficiencies in *inter partes* reexamination proceedings and the risk of creating avenues for harassment of patent owners:

The Committee recognizes the importance of quiet title to patent owners to ensure continued investment resources. While this amendment is intended to remove current disincentives to current administrative processes, the changes made by it are not to be used as tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent. Doing so would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation.

H.R. Rep. No. 112-98, pt. 1, at 48 (2011). Accordingly, certain of the *General Plastic* factors are meant to allow the Board “to assess and weigh whether a petitioner should have or could have raised the new challenges earlier.” *General Plastic* at 18.

Our evaluation of the fourth factor, “the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second,” bears on this assessment. But that evaluation is complicated by the fact that Petitioner never clearly states when it learned of the prior art it relies on. Instead, Petitioner merely asserts that “Petitioner’s review was diligent, and Petitioner did not delay filing this Petition to wait for developments in any other proceeding involving the ’086 patent—in fact, there were no other developments due to the settlement of the Blue Coat IPR.” Pet. 9. Conversely, Patent Owner contends that “if

Petitioner were truly interested in filing a Petition asserting the grounds raised herein, it could have and should have joined [the Blue Coat and ESET IPRs] while those cases were pending.” Prelim. Resp. 35.

There is no question that significant time has elapsed since the prior IPRs. And, as we explain above, Petitioner should have known of the prior art it asserts, at least as of the time the ESET petition was filed, more than two years before filing of the instant Petition. Because Petitioner’s statements addressing the fourth *General Plastic* factor do not provide any basis for us to reconsider that determination, we conclude that this factor weighs in favor of a discretionary denial of instituting the proceeding.

5. “*whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent*”

Petitioner conflates the fourth *General Plastic* factor with the fifth, “whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent.” See Pet. 8–9 (addressing fourth and fifth factors together). Although both factors are related to assessing “whether a petitioner should have or could have raised the new challenges earlier,” they are distinct inquiries. See *General Plastic* at 18. While the fourth factor focuses on when a petitioner learned of prior art it later asserts in a petition for *inter partes* review, the fifth factor is concerned with the time elapsed between filings of multiple petitions.

Even the most generous consideration, i.e., one that focuses on the filing of the ESET petition as “the first petition,” results in a determination

that more than two years elapsed until the filing of the instant Petition. If the filing of the original Blue Coat petition is considered as “the first petition” instead, the elapsed time increases to more than three years. Petitioner provides inadequate explanation for such a long elapse of time.

Notwithstanding Petitioner’s assertions, we do not perceive the similarity of challenges among the different proceedings as a factor that mitigates the impact of a long elapse of time. *See* Pet. 9 (statements that “Petitioner is pursuing the same grounds” and “Petitioner did not modify the references asserted in the grounds”).

Accordingly, we conclude that this factor weighs in favor of a discretionary denial of instituting the proceeding.

6. “*the finite resources of the Board*”

Petitioner suggests that the sixth *General Plastic* factor, “the finite resources of the Board,” is not implicated because “there are presently no other IPR or reexamination proceedings involving the ’086 patent.” Pet. 9. This reasoning is not persuasive, and is counter to other pronouncements by the Board regarding the application of its limited resources to multiple serial petitions. For example, in the precedential *Valve* decision, the Board cautioned that “[i]n general, having multiple petitions challenging the same patent, *especially when not filed at or around the same time* as in this case, is inefficient and tends to waste resources.” *Valve* at 16 (emphasis added); *see also Pharmacosmos A/S v. Am. Regent, Inc.*, IPR2019-01142, Paper 13 at 15 (PTAB Dec. 10, 2019) (finding consideration of a second petition filed four years after a first petition “tends to waste resources”).

Accordingly, we conclude that this factor weighs in favor of exercising our discretion to deny the Petition.

7. “*the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review*”

Like the sixth *General Plastic* factor, the seventh factor, “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review,” implicates an efficiency consideration. Because there is no evidence towards or persuasive argument towards this factor, we determine this factor weighs neither for nor against institution.

8. *Summary*

To summarize, we conclude that five of the seven *General Plastic* factors weigh in favor of exercising our discretion to deny institution of the proceeding, and no factor weighs against doing so. One of those five factors weighs heavily in favor of exercising that discretion.

III. CONCLUSION

For the foregoing reasons, we exercise our discretion under 35 U.S.C. § 314(a) and deny the Petition.

IV. ORDER

In consideration of the foregoing, it is
ORDERED that the Petition is *denied* and no trial is instituted.

IPR2019-01611
Patent 8,079,086 B1

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