

EXHIBIT 19

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Paper 7
Date: April 21, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner

Case IPR2016-00165
Patent 6,804,780 B1

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

GIANNETTI, *Administrative Patent Judge*.

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

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information provided by Petitioner and the supporting Declaration of Aviel D. Rubin. We are persuaded, based on this record, that Petitioner has not demonstrated a reasonable likelihood of prevailing on this challenge.

1. Overview of Rubin (Ex. 1003)

As described by Petitioner, Rubin discloses a method for secure distribution of files over the Internet. Pet. 2. The disclosure is summarized in the Abstract as follows:

The process is composed of two phases, a registration phase and an electronic file distribution phase. In the registration phase, a trusted third party receives information about an author, including the author's public key, and affirmatively verifies the accuracy of this information. In the file distribution phase, an author sends to the trusted third party a signed message containing the hash of the file the author wants to distribute. The trusted third party creates an electronic certificate, signed by the trusted third party, containing the hash of the file sent by the author.

A user desiring to receive the file retrieves the file with the certificate, and uses the certificate to verify, first, that the certificate was created by the trusted third party, and, second, that the hash of the file in the certificate is the same as the hash that is computed from the retrieved file. If these two hashes match, then the user is assured that the file did originate with the author and is uncorrupted.

Ex. 1003, Abstract (paragraphing added and minor typographical errors corrected).

2. Overview of Waldo (Ex. 1004)

As described by Petitioner, Waldo discloses a system that uses hashing functions to generate unique inputs for identifying objects (i.e., software components) referenced in software program code. Pet. 2. The

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Patent Owner responds further that Petitioner’s showing of motivation to combine the references is insufficient:

Petitioner fails to explain why a person of ordinary skill in the art would be motivated to modify Rubin’s trusted third party based technique for assuring “that [a] file did originate with the author and is uncorrupted” (Rubin at Abstract) with Waldo’s system “for uniquely identifying object ‘types’ for objects that are used in processing of object-oriented programs and the like” (Waldo at 4:27–30).

Prelim. Resp. 34. Patent Owner further contends that there would have been no reason to combine Rubin and Waldo because to certify that a downloaded file is not corrupted, as in Rubin, would not require either Rubin or Waldo to fetch any software components referenced in the file. *Id.* at 35. Patent Owner also points out that Petitioner does not look to either reference for the motivation to combine them, but to the disclosure of the ’780 patent itself. *Id.* at 36.

4. Discussion

a. Motivation to Combine References

We are persuaded by Patent Owner’s argument that Petitioner has not provided a sufficient rationale for combining Rubin and Waldo. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)(“[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). The problem addressed by Rubin is “establishing the integrity of an electronic document as it is distributed over a network.” Ex. 1003, col. 1, ll. 6–8. Specifically, the “invention provides a trusted third party certification process which enables a recipient of an electronic document to verify that the content of the document is uncorrupted and verify that the

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author of the document is the one identified, independent of any knowledge of the identity of the sending entity.” *Id.* at col. 1, ll. 8–13. We agree with Patent Owner that in such an application, there is “no need . . . to fetch any software components referenced in the downloaded file.” Prelim. Resp. 35.

Waldo, on the other hand, addresses a different problem. Waldo describes generating “fingerprint” identifiers for uniquely identifying types of objects, such as classes that are used in processing of Java and other object-oriented programs. Ex. 1004, col. 2, ll. 30–33. We agree with Patent Owner that Petitioner does not present a persuasive reason why a person of ordinary skill would have been motivated to modify Rubin’s trusted third-party technique for assuring the integrity of downloaded files with Waldo’s system for uniquely identifying object types. It would, in fact, be contrary to the purpose of Rubin to provide such multiple fingerprints, as in Waldo. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1334 (Fed. Cir. 2013):

While a prior art reference may support any finding apparent to a person of ordinary skill in the art, prior art references that address different problems may not, depending on the art and circumstances, support an inference that the skilled artisan would consult both of them simultaneously. *See Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1366 (Fed.Cir.2012) (finding invention nonobvious when none of the “reference[s] relate to the [problem] described in the patents” and no evidence was proffered “indicating why a person having ordinary skill in the art would combine the references”).

Petitioner’s principal argument for combining Rubin and Waldo relies on the availability of Java. Pet. 16. According to Petitioner, “as of the ’780 patent’s effective filing date, a POSA would have understood that software programs downloaded in accordance with Rubin’s teachings would include programs written in Java.” *Id.* According to Petitioner, by combining Rubin

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