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12 FINJAN, INC.

13 **IN THE UNITED STATES DISTRICT COURT**  
14 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**  
15 **SAN FRANCISCO DIVISION**

16 FINJAN, INC., a Delaware Corporation,

17 Plaintiff,

18 v.

19 JUNIPER NETWORKS, INC., a Delaware  
20 Corporation,

21 Defendant.

Case No.: 3:17-cv-05659-WHA

**PLAINTIFF FINJAN, INC.’S REPLY TO  
JUNIPER NETWORKS, INC.’S BRIEF  
REGARDING PATENT ELIGIBILITY OF  
U.S. PATENT NO. 8,677,494 (DKT. NO. 564)**

1 **I. CLAIM 10’S BEHAVIOR-BASED TECHNIQUE IS AN INVENTIVE CONCEPT**

2 Judge Orrick and Judge Freeman both already determined that Claim 10 of the ’494 Patent  
3 recites an inventive behavior-based scanning technique that identifies the operations of a file (instead of  
4 its byte patterns). The trial record here establishes that this type of scanning is inventive because it  
5 provides a concrete way of achieving a benefit – detecting unknown viruses and malicious  
6 Downloadables spreading via the Internet. Dkt. No. 565 (“Finjan Br.”) at 1-2, 4-6; *Finjan, Inc. v. Blue*  
7 *Coat Systems, LLC*, No. 15-cv-03295, 2016 WL 7212322, at \*11 (N.D. Cal. Dec. 13, 2016); *Finjan,*  
8 *Inc. v. Sophos, Inc.*, 244 F. Supp. 3d 1016, 1060-61 (N.D. Cal. 2017) (“*Sophos Order*”).

9 **A. The *Sophos Order* Should Apply to Inventiveness**

10 Judge Orrick’s decision in the *Sophos* order applied the same Rule 52 standard as to be applied  
11 here, and Juniper is incorrect that the *Sophos Order* a different standard. Dkt. No. 564 (“Juniper Br.”) at  
12 2-3 (“[t]he *Sophos* Court thus essentially adopted a favorable analysis of the ’494 Patent inform the  
13 *Blue Coat* case, which in turn was made in the context of a Rule 12 motion where the court expressly  
14 interpreted the ’494 Patent in a light most favorable to Finjan in its § 101 analysis.”). The *Sophos Order*  
15 is an “Order [Regarding] Post-Trial Motions.” *Sophos*, 244 F. Supp. 3d at 1023. Thus, the decision in  
16 the *Sophos Order* is made in the same context as the present case – namely, under Rule 52 of the  
17 Federal Rules of Civil Procedure. In addition, Judge Orrick did not simply adopt Judge Freeman’s  
18 analysis. Rather, Judge Orrick “*agree[s]* with Judge Freeman’s *conclusion*” with his independent  
19 analysis and the benefit of the trial record in the *Sophos* case. *Id.* at 1023, 1052-61 (emphasis added).

20 For reasons set forth in Finjan’s opening brief, the *Sophos Order* is also consistent with the trial  
21 record in this case, which clearly establishes that the behavior-based scanning technique in the ’494  
22 Patent was not well-understood, routine or conventional in 1996, when the virus scanning techniques  
23 focus on signatures of known viruses. *See* Finjan Br. at 1:9-3:3, 4:7-6:18. Finjan has provided strong  
24 evidence from multiple sources including trial testimonies, trial exhibits, and the patent itself to show  
25 that Claim 10 provides a non-traditional approach which has a number of benefits including proactively  
26 detecting new threats and addressing the threats arise as a result of Internet Downloadables. *Id.* at 1-2,  
27 4-6; *see also* Trial Tr. at 876:6-877:18 (explaining why the alleged references do not describe what

28 Claim 10 is directed to). Further, each of the alleged prior art references were with contexts unrelated

1 papers, which by definition, describe new concepts, not routine technologies. *See* Trial Exs. 1552,  
2 1070, 1069; *see also* Trial Tr. at 876:6-877:18 (explaining that the alleged references are describing  
3 novel concepts at the time).

4 Juniper’s argument that the *Sophos* Court did not have this case’s factual record (Juniper Br. at  
5 3-5) is a red herring because the trial record in this case is consistent with the *Sophos* Order. In  
6 particular, in the *Sophos* Order, Judge Orrick relied on the disclosure in the ’494 Patent to find that the  
7 claim recites two benefits, and the ’494 Patent is part of the trial record here. *Sophos*, 244 F. Supp. 3d  
8 at 1061 (“[I]ooking at the ’494 patent as a whole, the claims recite an inventive concept because they  
9 detail a system that involves scanning malware on an intermediate network, rather than an end-user  
10 computer, and because they detail a process for identifying unknown viruses by extracting specific  
11 suspicious operations from files.”). Therefore, Juniper’s argument that these benefits are somehow no  
12 longer applicable (*see* Juniper Br. at 3-5) is without merits because the basis of Judge Orrick’s  
13 conclusion (*i.e.* the ’494 Patent itself) did not change. Moreover, nothing in the present record shows  
14 that the ’494 Patent cannot be implemented to provide the disclosed benefits when installed on an  
15 intermediate network, or otherwise not able to identify new viruses by extracting file operations. Thus,  
16 both benefits from the *Sophos* Order still stand.

17 **B. Claim 10 Has Repeatedly Been Found Valid by the Patent Trial and Appeal**  
18 **Board (“PTAB”)**

19 As noted in Finjan’s opening brief, the PTAB has repeatedly found Claim 10 of the ’494 Patent  
20 valid over all cited prior art. Finjan Br. at 7-8. Thus, the PTAB’s determinations, which have found  
21 Claim 10 valid six times, supports that the claim are inventive and patent eligible. Additionally,  
22 Juniper’s argument (Juniper Br. at 5-6) that the PTAB’s decision on Claim 1 in view of an alleged prior  
23 art reference (Trial Ex. 1070) is somehow relevant to § 101 analysis for Claim 10 is erroneous, because  
24 Claim 10 was determined valid and the standards are different. Juniper Br. at 5-6. Claim 10 was valid  
25 before the *Sophos* Order and remains valid so now, because the PTAB found Claim 10 valid over the  
26 art raised for claim 1. *Symantec Corp. v. Finjan, Inc.*, Case IPR2015-01892, Paper 58 at 51 (P.T.A.B.  
27 Mar. 15, 2017) (“[w]e agree with Patent Owner that Swimmer does not teach or suggest either the  
28 ‘Downloadable scanner’ or the ‘database manager’ recited in claim 10.”). Importantly, the PTAB’s

1 decision for Claim 1 also cannot be legally be considered because the §§ 101 and 103 analyses are  
2 separate inquiries under Federal Circuit law, and § 101 inquiry requires “more than recognizing that  
3 each claim element, by itself, was known in the art.” *Bascom Global Internet Servs., Inc. v. AT&T*  
4 *Mobility LLC*, 827 F.3d 1341, 1349-50 (Fed. Cir. 2016).

## 5 **II. JUNIPER CANNOT SHOW CLAIM 10 WAS INVALID BY CLEAR AND** 6 **CONVINCING EVIDENCE**

7 Juniper failed to meet the clear and convincing standard for invalidity. First, Juniper did not  
8 rebut that Claim 10 as a combination recites an inventive concept because Juniper’s sole argument is  
9 the legally irrelevant argument that “[t]he activities [the elements] perform are not arranged in an  
10 inventive way, but are instead arranged in the “only one order that makes sense.”” Juniper Br. at 2, 8.  
11 The inventive concept inquiry is not about how many ways claim elements can be arranged, instead it  
12 requires considering the elements *as a whole* to determine whether the claim is providing an inventive  
13 technique. *See McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016).  
14 Next, Juniper also failed to meet the Federal Circuit’s requirement of going beyond what is “prior art”  
15 to establish what was actually “well-understood, routine, and conventional.” *Berkheimer v. HP Inc.*,  
16 881 F.3d 1360, 1369 (Fed. Cir. 2018). Dr. Rubin’s testimony failed because he only argued that  
17 individual components such as receiver, scanner, and database manager are disclosed in the prior art  
18 and then equated the teaching of a prior art to the requirement of “well-known” (Juniper Br. at 6-8).  
19 This again directly contradicts the Federal Circuit’s instruction. *Bascom*, 827 F.3d at 1349-50 (rejecting  
20 an analysis which “looks similar to an obviousness analysis under 35 U.S.C. § 103, except lacking an  
21 explanation of a reason to combine the limitations as claimed.”). Aside from a few conclusory  
22 statements, Dr. Rubin did not establish how any of the alleged prior art references such as Trial Exhibits  
23 1552, 1070, and 1069 disclose the claimed Downloadable scanner or how it derives security profile data  
24 including a list of suspicious computer operations. In fact, the PTAB already found that the reference  
25 cited by Rubin does not teach Claim 10. *Symantec Corp. v. Finjan, Inc.*, Case IPR2015-01892, Paper  
26 58 at 51 (P.T.A.B. Mar. 15, 2017). Trial Exs. 1069 and 1552 were also previously considered by the  
27 Patent Office and both explicitly support Finjan’s position, namely the conventional approach at the  
28 time was signature-based scanning. ’494 Patent at p. 2 (citing Trial Ex. 1552 (“Chen”)), p. 6 (citing

1 Trial. Ex. 1069 (“Stang”)); Trial Ex. 1069 at 3 (“The traditional approach for dealing with removal was  
2 to 'hard code' the instructions for removal into the product: move the file pointer, copy bytes, then  
3 truncate the file”); Trial Ex. 1552 at 1:19-20 (“Viruses are commonly detected using signature scanning  
4 techniques.”).

5 Juniper argument regarding the '194 Patent also failed because the '194 Patent at 5:42-45  
6 (Juniper Br. at 7) does not show that the scanner element as claimed is well-known, because it only  
7 states that the conventional parsing technique is one of the parsing techniques that can be used to  
8 decompose the code. Claim 10 does not simply claim a parsing technique, rather it is about analyzing a  
9 file to identify its behaviors (i.e. suspicious computer operations) for downloadable security profile data.  
10 *See, e.g.*, '194 Patent at 9:20-42 (“The code scanner 325 in step 720 registers the commands and  
11 command parameters into a format based on command class (e.g., file operations, network operations,  
12 registry operations, operating system operations, resource usage thresholds”). Juniper’s argument that  
13 “using a database manager to store things in a database is ‘well known in the art’” (Juniper Br. at 8) also  
14 failed because the claim is not about storing *anything* in a database. Rather, database manager solves a  
15 specific problem related to deriving DSP data (e.g. that it’s time consuming to perform on the fly),  
16 where such problem does not exist in the conventional system since the conventional system uses byte  
17 sequence matching which does not involve analyzing a file’s behaviors. Trial Tr. at 233:8-23  
18 (explaining signature-based scanning).

19 Juniper cases such as *buySAFE*, *Fitbit*, *Mortg. Grader*, *Zkey Invs.*, and *Procter & Gamble*  
20 should be ignored because they do not establish the state of the art of the '494 Patent as they are for  
21 different patents and inventions, and from different time frames. If anything, the Court must adopt the  
22 Federal Circuit’s *Blue Coat* decision on parent of the '494 Patent finding that the behavior-based  
23 scanning technique is non-abstract, as the Federal Circuit’s decision addresses similar subject matter  
24 with the same priority date as Claim 10. *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1302-06  
25 (Fed. Cir. 2018). Furthermore, since the behavior-based scanning technique is non-abstract as found by  
26 the Federal Circuit, the Court should end its analysis there and does not even need to look at Juniper’s  
27 evidence which only pertains to the inventive concept inquiry. *Id.*, 879 F.3d at 1306 (Fed. Cir. 2018)

28 (“The claim is non-abstract and thus is eligible to proceed to the next step of the Alice.”)

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