

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYMANTEC CORP., and
BLUE COAT SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2015-01892¹
U.S. Patent No. 8,677,494

PATENT OWNER'S MOTION TO EXCLUDE

¹ Case IPR2016-00890 has been joined with the instant proceeding.

I. Introduction

Pursuant to 37 C.F.R. § 42.64, Patent Owner Finjan, Inc. (“Patent Owner”), through this Motion to Exclude, moves to exclude certain evidence, discussed below, that Petitioner Symantec Corp. and Blue Coat Systems, Inc. (together, “Petitioner”) submitted in this proceeding. The Board should grant Patent Owner’s Motion to Exclude for the reasons set forth below.

II. Patent Owner’s Objections Were Timely Made.

Patent Owner timely raised the objections set forth herein. On April 1, 2016, Patent Owner timely served Petitioner with objections to the exhibits in its Petition. Paper 11. On September 23, 2016, Patent Owner timely served Petitioner with objections to Exhibits 1026, 1027, 1030–1032 and 1036–1043 in its Reply brief. Paper 32. Patent Owner does not assert any new objections in this Motion to Exclude.

III. The Board Should Exclude Exhibits Outside the Proper Scope of Reply (Exs. 1026, 1027, 1030-1032 and 1036-1043).

Petitioner’s Reply improperly introduced new evidence and arguments that are inadmissible under 37 C.F.R. § 42.61, and are properly subject to exclusion.²

² The Board granted Patent Owner’s request to identify specific portions of Petitioner’s Reply and evidence that Patent Owner contends is outside the proper scope of reply, to be submitted by Due Date 4. Paper 37.

Belden Inc. v. Berk-Tek LLC, 803 F.3d 1064, 1081 (Fed. Cir. 2015) (“a party may move to exclude evidence, whether as improper under the response-only regulation, under the Trial Practice Guide’s advice, or on other grounds.”) (citation omitted). These belated submissions should be excluded because it is improper for Petitioner to introduce new evidence and arguments in its Reply in order to resolve the deficient arguments and evidentiary shortcomings of its Petition.

Specifically, Petitioner introduced for the first time in its Reply 18 new exhibits, including a new 70-page rebuttal declaration from Dr. Davidson, additional prior art references, and additional support to attempt to establish the public accessibility of the Swimmer document. There is no reason why Petitioner could not have included such evidence in its Petition. To the contrary, Exhibits 1026, 1027, 1030–1032 and 1036–1043 contain information that was available at the time Petitioner filed its Petition.

First, Petitioner improperly offers Exhibits 1026 and 1037–1041 in its Reply as a belated attempt to revise its argument or supplement its evidence that the Swimmer Document was publicly available prior art. The Board should not consider this evidence because it was available at the time that Petitioner filed its Petition. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,156, 48,767 (Aug. 14, 2012) (“[A] reply that raises a new issue or belatedly presents evidence will not be considered and may be returned. The Board will not attempt to sort proper from

improper portions of the reply.”). “[I]ndications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for ... patentability or unpatentability ... and new evidence that could have been presented in a prior filing.” Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767.

Petitioner also should have submitted Exhibits 1030–1032 and 1036 with the Petition instead of using its Reply to supplement its *prima facie* invalidity case for the '494 Patent. Dr. Davidson confirmed that he could have cited Ex. 1032 and Ex. 1030 in his earlier declaration that was submitted with Petitioner's Petition (Ex. 1018), but that he and counsel made a conscious decision not to use them in the Petition. Ex. 2041 (“Davidson Tr.”) at 12:13–13:8. Accordingly, at the very least, paragraphs 18, 19, 27, 28, 33, 39, 40, 46, 63, 98 of Davidson's Rebuttal Declaration (Ex. 1027) should be excluded and any reliance on Denning (Ex. 1032) (including Ex. 1042, which Petitioner introduces to establish Denning as publicly available prior art) and Comer (Ex. 1030), should be excluded as improper new evidence belatedly introduced in a Reply.

Petitioner may not use its Reply as a vehicle to add in new evidence that could have been included in its Petition, and all such evidence should be excluded. *See, e.g., Toshiba Corp. v. Optical Devices, LLC*, Case IPR2014-01447, Paper 34 at 44–47 (P.T.A.B. Mar. 9, 2016) (“[Section 42.23(b)], however, does not

authorize or otherwise provide a means for supplementing the evidence of record.”); *Toyota Motor Corp. v. Am. Vehicular Scis. LLC*, Case IPR2013-00424, Paper 50 at 21 (P.T.A.B. Jan. 12, 2015) (“[Petitioner] cannot rely belatedly on this evidence in its Reply and Reply Declaration of [its expert] to make up for the deficiencies in its Petition.”); *The Scotts Co. v. Encap, LLC*, Case IPR 2013-00110, Paper 79 at 5–6 (P.T.A.B. June 24, 2014) (declining to consider untimely evidence and the arguments based on the belated evidence because the patent owner “was denied the opportunity to file responsive evidence.”).

Second, in its Reply, Petitioner improperly attempts to introduce four new references to supplement its grounds for invalidity of the '494 Patent based on the Swimmer Document. Specifically, Petitioner relies on Exhibits 1030–1032, 1036 to support its assertion that Swimmer discloses a database. *See, e.g.*, Ex. 1027, ¶¶ 18, 19, 27, 28, 33, 39, 40, 46, 63, 98 (relying on these exhibits to support a database as a flat-file database). This is improper because the Board instituted IPR of the '494 Patent based on Swimmer alone, thus these additional references are irrelevant and should be excluded under FRE 401–403 because they are not part of the instituted grounds in this IPR proceeding.

Third, Petitioner's belated Reply should be excluded as unfairly prejudicial to Patent Owner. The Board “may exclude relevant evidence if its probative value is substantially outweighed by a danger of ... unfair prejudice.” Fed. R. Evid. 403.

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