

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 REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE**

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

I. Introduction

The Board should grant Patent Owner's Motion to Exclude ("Motion," Paper 41) for the reasons set forth below and in the Motion.

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

The new evidence Petitioner introduced in its Reply should be excluded. Motion at 2–5. “[T]he expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute” unlike in district courts where “parties have greater freedom to revise and develop their arguments over time.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016). Indeed, contrary to Petitioner's assertions, the Federal Circuit recognizes the appropriateness and timeliness of Patent Owner's request here: “[Patent Owner] may move to exclude evidence, whether as improper under the response-only regulation, under the Trial Practice Guide's advice, or on other grounds.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081 (Fed. Cir. 2015).

First, Petitioner claims that the newly filed evidence submitted with its Reply was to rebut Patent Owner's arguments, but does not dispute that this information was available at the time it filed the Petition. Petitioner cannot explain away the new evidence it cites in order to cure deficiencies in its Petition. *See* Motion at 1–5. This is further exemplified by Petitioner's admission that it had considered Exhibits 1030 – 1032 and 1036 prior to filing its Petition, but failed to

submit these exhibits at the time of its Petition. Instead, Petitioner tried to sandbag Patent Owner with new references and arguments that Patent Owner has prejudicially had no opportunity to substantively respond to. Motion at 3–4.

Second, Petitioner should have been well aware that Patent Owner would challenge any date for the Swimmer document that Petitioner planned to rely on based on Patent Owner's objections to evidence. Motion at 2-4. Accordingly, at the very least, the Ford, Kiegel, and Hawes Declarations and supporting exhibits could have been served as supplemental evidence.

Therefore, the Board should exercise its discretion in excluding Exs. 1026, 1027, 1030-1032 and 1036-1043.

III. The Board Should Exclude Davidson's Declarations (Exs. 1018 and 1027).

The Board should exclude Dr. Davidson's testimony because his opinions are unreliable and conclusory. *See* Motion at 5–7. Indeed, Petitioner does not dispute that Dr. Davidson's testimony is unreliable because Dr. Davidson's testimony is directly contradicted by Petitioner's definition of "database." *Compare id. with* Petitioner's Opposition (Paper 48) at 11–12. Thus, the Board should exclude Exhibits 1018 and 1027.

IV. Petitioner Narrowly Represents Patent Owner's Objections and Swimmer Should Be Excluded.

As an initial matter, Patent Owner's objections to evidence include objections to the Swimmer Document (Ex. 1005), which indicates objections based on authentication, hearsay, and lack of personal knowledge. *See* Paper 11 at 2. In fact, Patent Owner specifically references its objections relating to the Swimmer's alleged "public accessibility as a printed publication." *Id.* Notwithstanding the foregoing, Petitioner disregards and fails to address Patent Owner's multiple reasons for seeking to exclude Swimmer. Thus, for this reason alone, and those set forth in its Motion, the Swimmer Document should be excluded. Motion at 10-14.

V. The Board Should Exclude the Hall-Ellis Declarations (Exhibits 1006 and 1037).

The Board should exclude both Hall-Ellis declarations, and at the very least, Exhibit 1037 because it was untimely for the reasons explained above. As a preliminary matter, it is *Petitioner's* burden to demonstrate the veracity of Dr. Hall-Ellis' statements and thus, Petitioner's contention that "Patent Owner provides no evidence whatsoever to refuse Dr. Hall-Ellis' testimony" is misleading. Petitioner's Opposition at 5. Moreover, Dr. Hall-Ellis repeatedly admitted that she lacked personal knowledge regarding the public availability of the Swimmer Document. Motion at 8-10. Her opinions, therefore, are conclusory and unreliable. *Id.* at 7-10.

Furthermore, and tellingly, Petitioner claims that “Dr. Hall-Ellis confirmed that the copy of Swimmer in Ex. 1026 is the same as in Exs. 1005 and 1010” but fails to point to *any* support in either her declarations or deposition testimony to confirm its representation. *Compare* Petitioner's Opposition at 6 *with* Motion at 9.

For these reasons, and those set forth in the Motion, the Hall-Ellis Declarations should be excluded.

VI. The Board Should Exclude the Newly Filed Hawes Declaration and Supporting Exhibits (Exhibits 1044 – 1048).

Petitioner's newly filed Hawes Declaration and supporting exhibits should be excluded as being untimely. Although Petitioner knew that Patent Owner was challenging the public availability of the Swimmer Document, Petitioner waited until its Opposition to Patent Owner's Motion to Exclude before filing these exhibits. The Board should not condone Petitioner's gamesmanship of submitting five new exhibits, which once again, could have been filed with its Petition, and at the very latest, with its Reply. Incredibly, Mr. Hawes' first declaration is dated in *October 2015* (Ex. 1044) and Mr. Hawes admitted that the exhibits in his second declaration (Ex. 1045) could have been included with his first declaration and in fact, certain of the exhibits are stored with and contained in the same manual as the exhibits to his first declaration. Ex. 2042, Hawes Rough Tr. at 34:4–20. Thus, Exhibits 1044–1048 should be excluded because Petitioner's reliance is highly prejudicial to Patent Owner. Fed. R. Evid. 403.

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