UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Palo Alto Networks, Inc.
Petitioner

v.

Finjan, Inc.
Patent Owner

U.S. Patent No. 7,647,633
Filing Date: June 22, 2005
Issue Date: January 12, 2010

Title: Malicious Mobile Code Runtime Monitoring System and Methods

Inter Partes Review No. 2015-01974

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**PETITIONER PALO ALTO NETWORKS, INC.'S
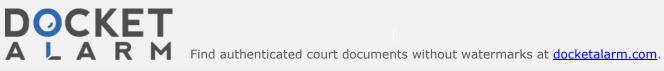REQUEST FOR REHEARING UNDER 37 C.F.R. § 42.71(c)**

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Pursuant to 37 C.F.R. § 42.71(c), Petitioner Palo Alto Networks, Inc. ("Petitioner" or "PAN") moves for rehearing of the Patent Trial & Appeal Board's ("Board") Decision (hereafter the "Decision") denying institution of *inter partes* review of claims 1-4, 6-8, and 13 of U.S. Patent No. 7,647,633 ("the '633 patent"). (Paper 7.) Rehearing of the Board's denial of institution is warranted because the Decision was based on the clearly erroneous conclusion that the teachings of Insik Shin & John C. Mitchell, "Java Bytecode Modification and Applet Security," (Ex. 1009) are substantially the same as the teachings of U.S. Patent No. 5,983,348 to Ji (Ex. 2006). (Decision at 9-11.)

I.   INTRODUCTION AND STATEMENT OF RELIEF REQUESTED

Petitioner Palo Alto Networks respectfully moves for rehearing because the Board misapprehended Shin's teachings, and its denial of institution under § 325(d) resulted from clearly erroneous findings regarding the similarity of the teachings in the Shin and Ji prior art references.

Grounds 1 and 3 of the Petition rely on Shin's teaching of searching for a Java class header called a "magic byte code sequence" to satisfy the limitation in the '633 patent claims that requires "determining . . . whether the downloadable information includes executable code". (Petition at 4, 29-30, 48-50.) The '633 patent specification specifically identifies the very same method Shin teaches— searching a Java class header—as one embodiment that satisfies the "determining"

limitation. (Petition at 29-30, 48 ("File-reader 502 can, for example, be configured to analyze a received potential-Downloadable for a file header, which is typically included in accordance with conventional data transfer protocols, such as a portable executable or standard ".exe" file format for Windows OS application programs, **a Java class header for Java applets**, and so on for other applications, distributed components, etc.") (emphasis added); *see also* Rubin Decl., Ex. 1002, at ¶¶ 111, 114.)

The Board overlooked Shin's express disclosure of searching for a Java class header, and the '633 patent's disclosure that searching for a Java class header satisfies the "determining" limitation, when it erroneously concluded that Shin's teachings are substantially the same as Ji's teachings. The Board's factual finding is incorrect. Shin's teaching expressly matches the '633 patent's disclosure for the "determining" limitation. In contrast, the Board found in a related proceeding concerning Finjan's '822 patent that Ji's method of scanning for <applet> tags to determine whether a downloadable includes executable code does *not* satisfy the "determining" limitation. (Ex. 2002 at 4-6.) A prior art teaching that expressly matches an embodiment of a claim element described in the specification of a challenged patent cannot, as a matter of law, be "substantially the same as" a teaching in another prior art reference that fails to disclose a key claim element.

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