

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2015-01974¹
U.S. Patent No. 7,647,633

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

¹ Case IPR2016-00480 has been joined with this proceeding.

Patent Owner Finjan Inc. ("Patent Owner") opposes Petitioner Palo Alto Networks, Inc. and Blue Coat Systems, Inc.'s ("Petitioner") Motion to Exclude (Paper 35, "Motion"). The Board should deny Petitioner's request to exclude paragraph 57 of the Goodrich Declaration (Ex. 2019), paragraphs 13-27 and 30-34 of the Bims Declaration (Ex. 2020, "Bims Decl."), and Exhibits 2004, 2007, 2012, 2014, 2016, 2018, 2027, 2028, 2029, 2037, and 2048 because Petitioner has failed to meet its "burden of proof to establish that it is entitled to the requested relief." 37 C.F.R. § 42.20(c). Patent Owner has submitted two declarations from its experts, Drs. Goodrich and Bims, which establish the relevance of these exhibits. Petitioner's objections as to hearsay are inapposite as, even if true, an expert may rely on such materials. And Petitioner waived its remaining objections by failing to timely assert them. Accordingly, the Board should deny Petitioner's Motion.

I. Paragraph 57 of the Goodrich Declaration is Admissible.

Paragraph 57 of the Goodrich Declaration is admissible. Paragraph 57 of the Goodrich Declaration (Ex. 2019) is admissible under FRE 702 and 703 because Dr. Goodrich provides (1) independent analysis for opinion concerning licensing and copying; (2) overwhelming evidence or sufficient analysis to show nexus; and (3) applies the correct legal understanding of "copying." As a preliminary matter, the Board should reject Petitioner's arguments because Petitioner failed to object to the admissibility of paragraph 57 of the Goodrich Declaration on these bases. *See*

Paper 23 (“Objections”) at 2-3. Nonetheless, these arguments also fail for the reasons set forth below.

First, paragraph 57 of Dr. Goodrich’s declaration states that he performed independent analysis for his licensing and copying opinions. In fact, Dr. Goodrich independently “reviewed Dr. Harry Bims’ Declaration on secondary considerations” and determined that “secondary considerations are relevant here, especially because [the] ‘633 Patent was licensed to Websense and Proofpoint after being accused of infringement.” *See* Ex. 2019 at ¶ 57; Ex. 2051 (“Goodrich Suppl. Decl.”) at ¶¶ 1–6. Dr. Goodrich also independently analyzed evidence of copying by “review[ing] the various documents from Petitioner that show (1) Petitioner knew of Finjan’s patent and (2) wanted to compete with Finjan in detecting malicious mobile code.” Ex. 2019 at ¶ 57; *see also* Goodrich Suppl. Decl. at ¶ 6. During deposition, Dr. Goodrich further confirmed that he undertook an independent analysis of the underlying materials by reviewing many of the documents that Dr. Bims cites to determine the accuracy and verifiability of the opinions he draws. *See* Ex. 1097, Goodrich Tr. at 74:17-24, 75:21-25; *see also id.*, Goodrich Tr. at 69:19-70:13. Furthermore, “the facts and data underlying [Dr. Goodrich’s] testimony do not need to be independently admissible.” *L-3 Commc’ns Holdings, Inc. v. Power Survey, LLC*, Case IPR2014-00834, Paper 68 at 30 (PTAB Nov. 23, 2015) (denying petitioner’s motion to exclude); FRE 703.

Thus, the Board should overrule Petitioner's objections.

Second, Petitioner's assertions regarding Dr. Goodrich's testimony confirm that Petitioner's challenges are improperly directed to the *sufficiency* of his opinions rather than their *admissibility*. See *Valeo N. Am., Inc. v. Magna Elecs.*, IPR2014-00220, Paper 59 at 10-11 (PTAB May 28, 2015); 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012) ("A motion to exclude ... may not be used to challenge the sufficiency of the evidence to prove a particular fact."). Thus, Petitioner's assertions regarding paragraph 57 of Dr. Goodrich's declaration are not grounds to exclude the admissibility of this opinion.

Because Petitioner fails to identify any legitimate basis for exclusion, the Board should deny Petitioner's request to exclude Dr. Goodrich's testimony.

II. Paragraphs 13-27 and 30-34 of the Bims Declaration Concerning Copying, Licensing Nexus and Long-Felt Need Are Admissible.

Petitioner's assertions, raised for the first time now, are that Dr. Bims' testimony is "based on insufficient facts and data." Motion at 4-6. These claims, however, are undermined given that Dr. Bims relied on substantial third party information, including factual information regarding Websense's products, Proofpoint, and Armorize's products. This information comes directly from Websense, Proofpoint, and Armorize and he analyzes the benefits of the patented technology to those products and revenues that these third parties make publicly available. Bims Decl. at ¶¶ 26-31; Ex. 2050 ("Bims Suppl. Decl.") at ¶ 24. To the

extent Petitioner disagrees, it only confirms, once again, that Petitioner's challenges are improperly directed to the *weight* of his opinions, but is not grounds to challenge the *admissibility* of his opinions. As a "non-jury tribunal with administrative expertise, [the Board] is well positioned to determine and assign appropriate weight and/or relevance to evidence presented." *HTC Corp. v. NFC Tech., LLC*, IPR2014-01198, Paper 56 at 47 (PTAB Feb. 3, 2016)(citing *Gnosis S.p.A. v. S. Ala. Med. Sci. Found.*, Case IPR2013- 00118, slip op. at 43 (PTAB June 20, 2014) (Paper 64)).

Moreover, Petitioner waived its objections to Paragraphs 13-27 and 30-34 of the Bims Declaration because Petitioner failed to identify Paragraphs 13-27 and 30-34 of the Bims Declaration concerning copying, licensing, nexus and long-felt need in Petitioner's Objections. Further, Petitioner waived any objections regarding copying, licensing, nexus and long-felt need because it failed to object to the admissibility of the Bims Declaration on these bases in its Objections. When any objections to evidence are not filed within the required time period, they are waived and cannot be relied upon in a motion to exclude. 37 C.F.R. § 42.64; *see also Valeo N. Am., Inc. v. Magna Elects., Inc.*, IPR2014-01204, Paper 52 at 8-22 (PTAB Jan. 25, 2016).

To the extent Petitioner attempts to point to a general, unspecified objection to Dr. Bims Declaration, Petitioner failed to put Patent Owner on notice of the

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