UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2015-01974[1]
U.S. Patent No. 7,647,633

PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE EVIDENCE

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

Patent Owner's Motion to Exclude ("Motion," Paper 36) should be granted.

I. The Board Should Exclude Dr. Rubin's Claim Construction Opinions.

The Board should exclude Dr. Rubin's claim construction opinions. Motion at 2–3. Petitioner tacitly admits that its now jettisoned objections were improper, making no attempt to defend them. Exclusion of the related testimony is warranted here where Petitioner's counsel has "improperly frustrate[d] the fair examination of the deponent, ***such as making improper objections or giving directions not to answer***." Fed. R. Civ. P. 30, comm. notes at 4. Petitioner's argument that there was no harm because "the court reporter merely notes objections and the witness answers subject to the objections" is plainly contrary to the record. What actually happened is that Petitioner's counsel improperly ***directed*** Dr. Rubin not to answer questions regarding the basis of his opinions and, further admitted that Dr. Rubin has failed to provide an opinion on claim construction. *See* Ex. 2022 at 94:4-8 (Q: In your opinion does claim 14 allow mobile protection code that modifies executable code? Mr. Eutermoser: Objection. Calls for legal conclusion. Vague. Ambiguous. ***Outside the scope of the declaration and irrelevant***.) (emphasis added). Patent Owner did not waive any complaint, as it sought the discovery during the deposition and was thwarted by Petitioner's improper instructions.

Thus, Dr. Rubin's claim construction opinions should be excluded because Dr. Rubin did not provide the basis for his opinions and therefore, his opinions are

unreliable. *Koito Mfg. Co. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1152 (Fed. Cir. 2004) (invalidity experts must explain in detail how each claim element is disclosed in the prior art reference). Given Petitioner's counsel's admissions that Dr. Rubin's testimony regarding claim terms is outside the scope of his declaration and is not relevant, Dr. Rubin's declaration and testimony fall apart and must be excluded as unreliable. *Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d 1304, 1315-16 (Fed. Cir. 2002).

II. The Board Should Exclude the Grenier Declaration (Ex. 1005).

The Board should exclude the Grenier Declaration (Ex. 1005). Motion at 3–4. Petitioner concedes Mr. Grenier lacks personal knowledge regarding Poison Java in particular and, instead, claims he relied on IEEE procedure. However, Mr. Grenier admits he even lacks personal knowledge as to the procedures IEEE used for printed publications and, therefore, he cannot authenticate the Poison Java document. Ex. 2023, Grenier Tr. at 33:5–34:11 (admitting that he was not involved with the printed version of the IEEE magazine). Petitioner also does not dispute that the May 2000 electronic publication is itself irrelevant as published after the priority date of the challenged claims. Thus, the Board should exclude Exhibit 1005 as irrelevant and for lack of foundation and personal knowledge.

III. The Board Should Exclude Exhibits 1006 (Author's Webpage), 1007 (Filewatcher Webpage), and 1008 (Kava Paper).

The Board should exclude Exhibits 1006 – 1008 for lack of proper

authentication, because they are hearsay, and are not relevant. Motion 4-6. These documents do not prove when Shin became publicly available.

First, Petitioner has failed to properly authenticate Exhibits 1006–1008. Motion at 4–6. Because Petitioner relies on the ***content*** in these pages, particularly the dates, it was required to provide a witness to properly authenticate these documents, which is an admissibility requirement, not an issue of the weight of the evidence. Fed. R. Evid. 901; *Specht v. Google Inc.*, 758 F. Supp. 2d 570, 580 (N.D. Ill. 2010) (excluding webpages that were not authenticated by a knowledgeable witness); *Standard Innovation Corp. v. Lelo, Inc.*, IPR2014-00148, Paper 42 at 10–11 (P.T.A.B. Apr. 23, 2015) (excluding exhibits for lack of authentication). Because Petitioner did not do so, these exhibits should be excluded.

Second, Petitioner relies on Exhibits 1006–1008 for a hearsay purpose—attempting to establish the date Shin was available. Motion at 4–6. These exhibits do not fall within the residual hearsay rule, even if offered to prove the purported consistency of documents as Petitioner suggests. *Standard Innovation*, IPR2014-00148, Paper 42 at 15–16 (rejecting petitioner's argument that the residual hearsay exception applied) (citing *Conoco Inc. v. Dep't of Energy*, 99 F.3d 387, 392 (Fed. Cir. 1996) (the residual exception to the hearsay rule is to be reserved for "***exceptional cases***" and is not "***a broad license on trial judges to admit hearsay***

statements that do not fall within one of the other exceptions.") (emphasis added).

IV. The Board Should Exclude the Kent Declaration (Ex. 1082)

Petitioner concedes Kent relied on a pre-published version of Brown, confirming exclusion is warranted. Motion at 6–7.

V. The Board Should Exclude the Sherfesee and Butler Affidavits (Exs. 1092, 1093, 1095)

Petitioner concedes that (1) Sherfesee never worked directly with Alexa's web crawling function in the relevant time frame and relies on (2) information that was gathered from the web crawling function prior to his career at Alexa and (3) statements made by others in conversations that he happened to overhear or from other staff members. Thus, the Board should exclude Exhibit 1093. Motion at 7-8.

Similarly, The Board should exclude the Butler Affidavits because Petitioner concedes Mr. Butler lacks personal knowledge of the existence of certain webpages and did not verify the links identified in Ex. 1092, Ex. A to determine whether what was in the hyperlinks was publicly available. Ex. 2025, Butler Tr. at 23:22–24 (indicating that he does not recall clicking on the hyperlinks); Ex. 1092, Butler Affidavit at Ex. A; Ex. 2025, Butler Tr. at 21:14–22:13.

VI. The Board Should Exclude Petitioner's Newly Minted Evidence (Exs. 1099, 1101, 1035, 2022).

This Motion is a proper vehicle to object to Petitioner's improper reply

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