UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2015-01979
Patent 8,141,154

PATENT OWNER'S PARTIAL REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. §§ 42.71(c) and 42.71(d)

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Patent Owner, Finjan, Inc., ("Finjan" or "Patent Owner") respectfully requests rehearing of the Board's Decision on Institution (Paper No. 8) ("Institution Decision") under 37 C.F.R. § 42.71(d). In particular, Finjan respectfully requests reconsideration of the decision to institute trial on Grounds 1 and 2 of the Petition, which propose that claims 1–8, 10, and 11 of U.S. Patent No. 8,141,154 ("the '154 Patent") are unpatentable under 35 U.S.C. § 103(a) over Khazan et al. U.S. Patent Application Publication No. 2005/0108562 (Ex. 1003, "Khazan") in view of Sirer et al., *Design and Implementation of a Distributed Virtual Machine for Networked Computers* (Ex. 1004, "Sirer") and Ben-Natan U.S. Patent No. 7,437,362 (Ex. 1005, "Ben-Natan").

I. INTRODUCTION

On March 21, 2016, the Board decided to institute *inter partes* review as to Grounds 1 and 2 which asserts that claims 1–5 of the '154 Patent are unpatentable over Swimmer in view of Sirer under 35 U.S.C. § 103(a), and claims 6–8, 10, and 11 of the '154 Patent are unpatentable over Swimmer in view of Sirer and Ben-Natan. Finjan requests reconsideration of the Institution Decision because the Board "misapprehended or overlooked" arguments presented in Patent Owner's Preliminary Response (Paper No. 6) ("POPR"). *See* 37 C.F.R. § 42.71(d). The matters misapprehended or overlooked by the Board amount to an abuse of discretion. *See Star Fruits S.N.C. v. U.S.*, 393 F. 3d 1277, 1281 (Fed. Cir. 2005)

("An abuse of discretion occurs where the decision is based on an erroneous interpretation of the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors.") (citation omitted).

Reconsideration of the Institution Decision is appropriate because the Board overlooked or misapprehended Petitioner's and Patent Owner's common identification of the "content" that must include the call to the first function. In particular, both Petitioner and Patent Owner agree that the "content received over a network" is the "application executable," which is separate and apart from the "libraries" that are actually "instrumented." *See* Petition at 19–20 (citing Khazan at ¶¶ [0029], [0040], and [0073], Fig. 1, Fig. 4A, and claim 35); POPR at 15–17.

Overlooking Petitioner's and Patent Owner's common identification of "content" led the Board to institute trial based an invalidity theory that was never raised in the Petition. *See* Institution Decision at 9–10 (citing Khazan to support an "instrumented application and libraries" theory that does not appear in the Petition. In contrast, the law dictates that it is Petitioner's burden to "establish that it is entitled to the requested relief" and to do so "***[t]he petition must*** specify where each element of the claim is found in the prior art" and provide "a detailed explanation of the significance of the evidence." *See* 37 C.F.R. §§ 42.20(c), 42.22(a)(2), and 42.104(b)(4) (emphasis added). The Board's reliance on an

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