

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.
Petitioner

v.

FINJAN, INC.
Patent Owner

Inter Partes Review No. 2015-01979¹
U.S. Patent No. 8,141,154

**PALO ALTO NETWORKS, INC.’S
REQUEST FOR REHEARING OF FINAL WRITTEN DECISION
UNDER 37 C.F.R. § 42.71(d)(2)**

¹ Case IPR2016-00919 has been joined with this proceeding.

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Pursuant to 37 C.F.R. § 42.71(d)(2), Petitioner Palo Alto Networks, Inc.² moves for rehearing of the Final Written Decision (Paper No. 62) on claims 1-5 of U.S. Patent No. 8,141,154 (hereafter the “Decision”).

I. INTRODUCTION

Rehearing of the Decision on claims 1-5³ is warranted because the Board misapprehended the plain and ordinary meaning of the limitation “invoking a second function with the input, only if a security computer indicates that such invocation is safe” (hereafter the “invoking a second function with the input” limitation).⁴ The crucial aspect of this limitation that was misapprehended by the Board is that it refers to invoking the second/target function with the input – i.e., both the second/target function *and* the input must be invoked.

² Petitioner Symantec Corporation in joined Case IPR2016-00919 joins this Request.

³ Petitioner reserves the right to appeal any and all aspects of the findings of fact and conclusions of law contained in the Decision, regardless whether they are addressed in this motion.

⁴ Claim 4 contains immaterial differences in the wording of the limitation. It states, “invoke the second function with the input only if the indicator indicates that such invocation is safe.”

The “with the input” portion of the limitation is important because it realizes the benefits that are allegedly provided by the ’154 patent. The ’154 patent is directed at inspecting dynamically generated function call inputs at runtime to determine if they contain malicious code. (*See generally* Paper 2 at 8; Ex. 1001 Title (“System and Method for Inspecting Dynamically Generated Executable Code”).) As the patent explains, it is only at runtime that dynamically generated malicious input takes the determinate form <SCRIPT>malicious JavaScript</SCRIPT> that can be inspected. (Ex. 1001 at Col 4:46-50; Ex. 1002 at ¶¶ 49-51 (describing risks of dynamically generated content).) Because the input is dynamically generated at runtime and potentially malicious, the claims prohibit “invoking the second/target function *with the input*” until a security computer determines that *the input* generated at runtime is safe. (Paper 2 at 6-7.)

The Decision is erroneous because it fails to give effect to the clause “with the input.” The Decision reads-out the clause “with the input” from the claims. Rather than considering whether the Khazan reference delays invoking the second/target function *with the input* until after a security computer determines if the input is safe, the Decision analyzed whether Khazan “invokes” the second/target function before the security computer determines it is safe. (Paper 62 at 51 (“the claims require invocation of the second function *only if* a security computer or the indicator indicates that the invocation is safe.”); Paper 62 at 52

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