

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2015-01979¹
Patent 8,141,154 B2

Before THOMAS L. GIANNETTI, RICHARD E. RICE, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

DECISION
ON PETITIONER'S REQUEST FOR REHEARING
37 C.F.R. § 42.71(d)

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

On March 15, 2017, the Board issued the Final Written Decision in this proceeding. Paper 62 (“Final Dec.”). On April 14, 2017, Palo Alto Networks, Inc. (“Petitioner”) filed a Request for Rehearing. Paper 63 (Req. Reh’g.). Petitioner’s Request focuses on our findings concerning the claim limitation “a content processor . . . for invoking a second function with the input, only if a security computer indicates that such invocation is safe” (claim 1) and “invoke the second function with the input only if the indicator indicates that such invocation is safe” (claim 4). *Id.*; (hereinafter “second function” limitation). Petitioner’s Request also addresses an asserted inconsistency in claim construction of the term “a call to a first function” with regard to another proceeding dealing with the patent-at-issue. *Id.* at 13–14 (referring to the Final Written Decision in IPR2016-00151²). We address each of the raised issues in turn.

A. INVOCATION OF THE SECOND FUNCTION LIMITATION

Petitioner argues that the Board misapprehended the plain meaning of the claim when finding that Khazan does not teach the second function limitation. Req. Reh’g 2–3. In particular, the issue is whether our findings regarding Khazan adequately considered that the claim requires invoking the second function *with the input*, only if the invocation is safe. *Id.* 3–12. We are not persuaded by Petitioner’s argument that we misapprehended the claim language in our findings of fact regarding this limitation.

In the Final Written Decision we made several findings of fact relevant to this issue, the most relevant being that,

² *Palo Alto Networks, Inc., v. Finjan, Inc.*, IPR2016-00151, Paper 51 (PTAB Mar. 15, 2017).

- 1) Khazan teaches or suggests that the call to the target function includes inputs in order to pass the parameters to the wrapper function (second function). Final Dec. 47–48.
- 2) Khazan discloses that in order for the wrapper function to be executed, the target function must be invoked first. *Id.* at 52.
- 3) When Khazan describes intercepting the target function, it refers to invoking the target function first, in order for the code inserted in the instrumented content to transfer control to the wrapper function. *Id.* at 52.
- 4) Although we agree with Petitioner that the target function is verified during pre-monitoring and execution is suspended, the verification only occurs after invocation of the target function. *Id.* at 53.
- 5) Petitioner has failed to point out any teaching in Khazan where the target function is not invoked first. *Id.*
- 6) The Petition only maps Khazan to the second function limitation. *Id.*

Petitioner’s first argument, provided at pages 15–16 of the Petition, relies on an overview of Khazan to assert that certain passages of paragraphs 84, 85, and 88 teach the second function limitation. Req. Reh’g 5–7. We are not persuaded by this first argument that rehearing should be granted, because the argument was not presented in the Petition or the Reply. These passages of Khazan are explained for the first time on rehearing to assert a point that was not made in the Petition: that the target function is invoked “with the input,” only after Khazan’s pre-monitoring verification is successful. Pages 15 and 16 of the Petition provide a summary or overview

of Khazan that is devoid of any explanation as to how the disclosures of Khazan there summarized teach or suggest any of the limitations of the challenged claims. We could not have misapprehended the cited content of Khazan that was not particularly tied to any claim limitation, as our rules require that the Petition “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4).³ It would be patently unfair to Patent Owner if we were to consider new citations to Khazan and arguments regarding those citations, addressing this claim element, when those arguments were not presented properly by Petitioner.

To be sure, the Petition addresses the second function limitation at pages 29–30 (addressing limitation “1[f]”: “and (ii) for invoking a second function *with the input*” (emphasis added)). Pet. 29–30; *see* Final Dec. 49 (noting that Petitioner’s arguments concerning the limitation are in pages 29–30 of the Petition). The Petition there points to paragraph 85, where Khazan describes “‘execution of the intercepted’ function if the pre-monitoring code verifies the intercepted function.” *Id.* at 29. That paragraph is reproduced below:

³ Petitioner also raises for the first time an argument that Dr. Rubin’s annotated Figure 7 supports its argument, but that annotated Figure 7 was not submitted either in the Petition or Reply as supporting the second function limitation, and does not explain in any detail how the input is not included in the intercepted target function. Req. Reh’g 7. Indeed, we find the argument presented on rehearing entirely inconsistent with the position that Dr. Rubin takes regarding the “call including an input” for which he opined that parameters would be passed from the wrapped function to the wrapper function in order to verify the parameter information. *See* Final Dec. 47 (crediting Dr. Rubin’s testimony on this point, Ex. 1002 ¶¶ 100–02).

The verification process of the pre-monitoring code may include examining the list of target and invocation locations **106** previously obtained during static analysis to verify that this call instance has been identified in the pre-processing step described elsewhere herein. In the event that the call is verified as being on the list **106**, execution of the intercepted routine may proceed. Otherwise, the verified call processing code portion of the pre-monitoring portion may determine that this is an MC segment and may perform MC processing without executing the routine called.

Ex. 1003 ¶ 85. This paragraph does not support Petitioner’s argument that the target function is not invoked with the input when it is intercepted. *See* Req. Reh’g 6 (“the system may perform malicious code processing without executing the routine called”); 8 (characterizing paragraph 85 as a “crucial disclosure”). To the contrary, we note that this paragraph is consistent with our findings in the Final Written Decision, at pages 49–53, that Khazan’s pre-monitoring code verifies the list of target functions and invocation locations *after the target routine is intercepted*, i.e., after the target routine (the alleged second function) is intercepted, which means that the target routine has been invoked. And considering our finding that the target function includes inputs that are passed to the wrapper function (Final Dec. 47–48), the target routine is invoked “with the input” when it is intercepted.

We agree that paragraph 85 states that the routine *called* may not be executed if the pre-monitoring code finds malicious code. However, that passage cannot be read in isolation from the rest of Khazan, which describes that the target routine was already invoked, and that it *continues* operation of the invoked target routine, including its parameters, if no malicious code is found. *See* Final Dec. 52; *see also* Ex. 1003 ¶ 88 (“After post-monitoring

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