

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Palo Alto Networks, Inc.
Petitioner

v.

Finjan, Inc.
Patent Owner

U.S. Patent No. 8,141,154
Filing Date: June 14, 2010
Issue Date: March 20, 2012

Title: System and Method for Inspecting
Dynamically Generated Executable Code

Inter Partes Review No. 2015-01979

Petitioner's Objections to Supplemental Evidence Under 37 C.F.R. § 42.64

Petitioner Palo Alto Networks, Inc. ("Petitioner") objects to the Declaration of Michael Goodrich served by Finjan, Inc. ("Patent Owner") as supplemental evidence in support of its Patent Owner Response.

Patent Owner served its Patent Owner's Response on July 12, 2016. Paper No. 22. Petitioner objected to Patent Owner's evidence on July 19, 2016. Paper No. 23. Patent Owner served supplemental evidence on August 2, 2016. Petitioner's objections to Patent Owner's supplemental evidence are timely under 37 C.F.R. § 42.64(b)(1). By serving these objections on Patent Owner, Petitioner reserves its right to file a motion to exclude the Goodrich Declaration under 37 C.F.R. § 42.64(c).

I. DECLARATION OF MICHAEL GOODRICH

Petitioner objects to the admissibility of the Goodrich Declaration under FRE 702 because it does not disclose supporting facts or data, or is based on unreliable facts, data, or methods, or includes testimony outside the scope of Dr. Goodrich's specialized knowledge that will not assist the trier of fact.

For example, Dr. Goodrich opines that the infringement charts discussed by Dr. Medvidovic: "[D]emonstrate that the companies discussed therein were able to obtain success as a result of their licenses from Finjan for the '154 Patent. These charts confirm that the '154 Patent is not obvious because they are adequate secondary considerations of licensing and commercial success." Goodrich Decl. at

9. Dr. Goodrich's opinion with respect to Dr. Medvidivic's opinions regarding secondary considerations is not based on sufficient facts or data, is not the product of reliable principles and methods, will not assist the trier of fact because the subject of the testimony is not within the scope of Dr. Goodrich's alleged expertise and should therefore be excluded under FRE 702.

In another example, Dr. Goodrich states that his review of the Kim Declaration (Ex. 2004) confirms that Mr. Kim had personal knowledge of competitors in the security field, knowledge of Patent Owner's assertions of infringement, and extensive experience in the field of computer network security. Goodrich Decl. at 10. The Goodrich Declaration's opinions regarding the Kim Declaration are not based on personal knowledge, are not helpful to the determination of a fact in issue, are irrelevant, are confusing, and are of minimal probative value and should be excluded under FRE 401, 402, 403, 602 and 701.

To the extent Dr. Goodrich's testimony related to the Kim Declaration are intended to be expert opinions, the opinions are outside the scope of Dr. Goodrich's alleged technical expertise. For example, Dr. Goodrich is not an expert in the fields of competition in the network security business and Patent Owner's licensing programs. For these reasons, the Goodrich Declaration is also inadmissible under FRE 702.

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The Goodrich Declaration provides opinions related to the articles submitted by Patent Owner as Exhibits 2009, 2011-2013. Dr. Goodrich's opinions regarding Exhibits 2009, 2011-2013 are not based on adequate supporting facts or data and are therefore inadmissible under FRE 702.

Finally, Petitioner objects to the Goodrich Declaration because it is not cited in Patent Owner's Response and is an untimely submission of new expert testimony.

Dated: August 9, 2016

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Respectfully submitted,
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on August 9, 2016, a complete and entire copy of this **Petitioner's Objections to Supplemental Evidence Under 37 C.F.R. § 42.64**, was served by filing this document through the Patent Review Processing System and via electronic mail upon the following counsel of record for Patent Owner:

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