

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PALO ALTO NETWORKS, INC.,  
Petitioner,

v.

FINJAN, INC.,  
Patent Owner.

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Case IPR2015-01979<sup>1</sup>  
U.S. Patent No. 8,141,154

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**PATENT OWNER'S MOTION TO EXCLUDE**

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<sup>1</sup> Case IPR2016-00919 has been joined with this proceeding.

## **I. Introduction**

Pursuant to 37 C.F.R. § 42.64, Patent Owner Finjan, Inc. ("Patent Owner") hereby moves to exclude evidence the following evidence submitted in this proceeding by Petitioners Palo Alto Networks, Inc. and Symantec Corp. (collectively, "Petitioner"): Exhibits 1004, 1008, 1012, 1024, 1036, 1039-1042, 1044-1045 and Petition Annotated Figures 1-4. The Board should grant Patent Owner's Motion to Exclude for the reasons set forth below.

## **II. Patent Owner's Objections Were Timely Made.**

Patent Owner timely raised the objections set forth herein. On April 4, 2016, Patent Owner timely served Petitioner with objections to the exhibits to its Petition. Paper 10. On June 22, 2016, Patent Owner timely served Petitioner with objections to evidence pursuant to the Board's order during a conference call held on June 14, 2016. Paper 20. On November 1, 2016, Patent Owner timely served Petitioner with objections to the exhibits to its Reply. Paper 36. Patent Owner does not assert any new objections in this Motion to Exclude.

## **III. The Board Should Exclude Petitioner's Belated Exhibits as Outside the Proper Scope of Reply (Exs. 1036, 1039-1042, 1044-1045).**

The Board should exclude Exhibits 1036, 1039-1042 and 1044-1045 and Petitioner's related arguments. Petitioner improperly introduced this new evidence and related arguments for the first time in its Reply. These exhibits and arguments are inadmissible under 37 C.F.R. § 42.61, and are properly subject to exclusion

because Petitioner is not permitted to introduce new evidence and arguments in its Reply in order to resolve the deficient arguments and evidentiary shortcomings of its Petition. *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081 (Fed. Cir. 2015) (“a party may move to exclude evidence, whether as improper under the response-only regulation, under the Trial Practice Guide’s advice, or on other grounds.”).

Specifically, Petitioner introduced for the first time in its Reply new exhibits, including a new rebuttal declaration from Dr. Rubin, references to which it does not rely upon in its Reply, declarations from a Finjan expert in unrelated district court proceedings, and additional support to attempt to establish the public accessibility of the Sierer document. There is no reason why Petitioner could not have included such evidence in its Petition. To the contrary, Exhibits 1036, 1039, 1040, 1041, 1042, 1044 and 1045 contain information that was available at the time Petitioner filed its Petition.

Petitioner may not use its Reply as a vehicle to add in new evidence that could have been included in its Petition, and all such evidence should be excluded. *See, e.g., Toshiba Corp. v. Optical Devices, LLC*, IPR2014-01447, Paper 34, pp. 44–47 (P.T.A.B. Mar. 9, 2016) (“[Section 42.23(b)], however, does not authorize or otherwise provide a means for supplementing the evidence of record.”); *Toyota Motor Corp. v. Am. Vehicular Scis. LLC*, IPR2013-00424, Paper 50, p. 21 (P.T.A.B. Jan. 12, 2015) (“[Petitioner] cannot rely belatedly on this evidence in its

Reply and Reply Declaration of [its expert] to make up for the deficiencies in its Petition.”); *The Scotts Co. LLC v. Encap, LLC*, IPR 2013-00110, Paper 79, pp. 5–6 (P.T.A.B. June 24, 2014) (declining to consider untimely evidence and arguments because the patent owner “was denied the opportunity to file responsive evidence.”).

Petitioner's attempt to sandbag Patent Owner with these untimely submissions is highly prejudicial, as Patent Owner has not had the opportunity to respond to this untimely evidence and Petitioner's related arguments.

**First**, Petitioner improperly offers Exhibit 1036 (the “DeSart Declaration”), and Exhibit A thereto, in its Reply as a belated attempt to supplement its evidence that the Sierer Document was publicly available prior art and to bolster its grounds of patent invalidity. The Board should not consider this evidence because it was available to Petitioner at the time it filed the Petition and, as explained more fully below, is simply a failed attempt to rectify Petitioner's withdrawn Sierer Declaration. Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767 (Aug. 14, 2012)(“[A] reply that raises a new issue or belatedly presents evidence will not be considered and may be returned. The Board will not attempt to sort proper from improper portions of the reply.”). “[I]ndications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for ... unpatentability ... and new evidence that could have been presented in a prior

filing.” *Id.*

**Second**, Petitioner also should have submitted Exhibit 1044 (“Nebenzahl”) and Dr. Rubin’s Supplemental Declaration (Ex. 1045) with its Petition. Instead, Petitioner submitted these exhibits for the first time with its Reply, in an attempt to supplement its *prima facie* invalidity case for the ’154 Patent by attempting to remedy the deficiencies of the Khazan reference. *See* Ex. 1045 at ¶ 11 (noting alleged “techniques for instrumenting Win32 EXE files, like those disclosed in Khazan, were widely known” to the “extent one might argue that Khazan’s disclosure does not provide enough detail”). During his deposition, Dr. Rubin confirmed that he was aware of Nebenzahl at the time he submitted his first declaration (and for over a decade prior to that), “followed closely” the associated research and could have cited Nebenzahl at the time Petitioner filed the Petition. Ex. 2035 (Rubin Tr.) pg. 10, line 10- pg. 11, line 20.

To the extent Dr. Rubin’s Supplemental Declaration (Ex. 1045) is not excluded in its entirety, at a minimum, Paragraph 12 should be excluded as improper new evidence belatedly introduced in a Reply. Paragraph 12 discusses the belated Nebenzahl reference (Ex. 1044).<sup>2</sup>

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<sup>2</sup> Petitioner does not cite to or rely on Exhibit 1044 in its Reply. However, Dr. Rubin cites to Exhibit 1044 in his belated Supplemental Declaration.

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