

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
U.S. Patent No. 8,141,154

**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE**

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

Patent Owner's Motion to Exclude ("Motion," Paper 48) should be granted.

I. The Board Should Exclude the Simer Declaration (Ex. 1008).

The Board should exclude the Simer Declaration.

First, the Board should disregard the Simer Declaration (Ex. 1008) because Petitioner still has not made Dr. Simer available for deposition, despite Patent Owner's explicit request on the November 16, 2016 call with the Board. Motion at 5–7; *see also* Ex. 2037, 11/16/16 Teleconference Tr. at 13:2–6; *HTC Corp. and HTC Am., Inc. v. NFC Tech., LLC*, Case IPR2014-01198, Paper 41, at 2–5 (P.T.A.B. Nov. 6, 2015) (expunging a declaration where the witness was not made available and declining to give any weight to the expunged exhibit).

Indeed, the Board forewarned Petitioner that it would need to make Dr. Simer available if it wanted the Board to give any weight to the Simer Declaration. Ex. 2037, 11/16/16 Teleconference Tr. at 12:2–6 ("So you know, you pick your poison in a way. So if you rely on it, then you know what our rules are on declarations that have not – have not had the benefit of cross-examination."). Petitioner entirely ignored this in its Opposition, even though the call took place nearly *two weeks* prior to Petitioner's Opposition. Indeed, Petitioner completely mischaracterizes the facts of this case, and overlooks its own prior admission that "there'd be a huge bias problem that would make the testimony worthless anyway." Paper 43 at 15:13-14. Now, in a sandbagging attempt, Petitioner improperly attempts to shift

the blame to Patent Owner. Petitioner Opp. at 5–6. Therefore, because Petitioner violated the Rules through its failure to make Dr. Simer available, the Board should exclude the Simer Declaration.

Second, because Petitioner has not made Dr. Simer available, his declaration should be considered hearsay since it is an out-of-court statement being used to prove the truth of the matter asserted. Motion at 7. Petitioner's preventing Patent Owner from cross-examining Dr. Simer justifies classifying the Simer Declaration as an out-of-court statement. *See* Motion at 7; Fed. R. Evid. 801(c). Therefore, the Board should exclude the Simer Declaration as impermissible hearsay.

Third, Dr. Simer fails to offer support indicating any personal knowledge for his testimony that the article was publicly accessible. In fact, he provides nothing more than conclusory statements. *See* Motion at 7–8. Again, the Simer Declaration itself does not provide the basis for his statements. Accordingly, the Board should exclude the Simer Declaration based on lack of personal knowledge.

II. Exhibits Outside the Proper Scope of Reply.

The new evidence Petitioner introduced in its Reply should be excluded. Motion at 1–5. In fact, Petitioner does not dispute that this newly filed evidence was available at the time it filed its Petition. “[T]he expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute” unlike in district courts where “parties have greater freedom to revise and develop

their arguments over time.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016).

Petitioner's claims that it is only directly replying to Patent Owner's arguments are belied by the untimely filed Reply evidence to support its newly minted arguments. As explained in the Motion, Petitioner attempts to use the Rubin Declaration to cure its *prima facie* case of invalidity by discussing what was purportedly widely known. See Motion at 4. Patent Owner has not had a fair opportunity to respond to this evidence because Petitioner's belated introduction of it has “denied [Patent Owner] the opportunity to file responsive evidence.” *The Scotts Co. v. Encap, LLC*, IPR2013-00110, Paper 79 at 5–6 (PTAB June 24, 2014).

Similarly, Petitioner's reliance on Dr. Medvidovic's declarations (Exhibits 1039-1041) from other prior cases is not only outside the proper scope of reply, but is also irrelevant and misleading. Petitioner purports that these declarations support Dr. Rubin's constructions, which only further demonstrates that Petitioner could have introduced these exhibits with its Petition. Motion at 5.

Further, Exhibits 1039-1041 are consistent with Dr. Medvidovic's opinion in this case, which demonstrates that they are not proper reply or impeachment evidence. Petitioner Opp. at 4-5. During his deposition, Dr. Medvidovic explained that his position in Exhibits 1039-1041 was entirely consistent with this case. Ex. 1038 at 142:20-146:11. Specifically, for Exhibit 1039, Dr. Medvidovic testified

that he did not believe a construction of the plain and ordinary meaning of “content” was necessary for the Websense case. *Id.* at 143:10-144:16. However, in this case, given the Petitioner's extreme position, it was necessary to provide a construction of the plain and ordinary meaning of content. *Id.*

Exhibits 1040 and 1041 discuss *different terms* that are more limiting than “content.” *See* Ex. 1040 (discussing the term “content processor”); Ex. 1041 (discussing the term “content processor for processing content...”). Even if those terms were relevant, which they are not, Dr. Medvidovic's positions are entirely consistent. In Exhibit 1040, Dr. Medvidovic states that “the content processor processes scripts and other code.” Ex. 1040 at 15. His disagreement with Petitioner's construction was that it was too limiting because the content processor does not require “render[ing] the content for interactive viewing on a display monitor” which imports numerous unnecessary limitations such as “interactive viewing” and a “display monitor.” *Id.* at 14-15. With regard to Exhibit 1041, Dr. Medvidovic provided the opinion that the limitation “content processor for processing content...” is not a means plus function terms as Proofpoint suggested, which is entirely consistent with his position in this case. Ex. 1041 at 17-19.

In sum, such untimely evidence, which Petitioner has mischaracterized in support of its arguments, is highly prejudicial to Patent Owner who has no opportunity to respond to such arguments.

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