UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2015-02001
Case IPR2016-00157
Patent No. 8,225,408 B2[1]

PATENT OWNER RESPONSE

[1] These proceedings have been consolidated.

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TABLE OF AUTHORITIES

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Cases

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Graham v. John Deere Co.,
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