

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 IPR2016-00151<sup>1</sup>  
U.S. Patent No. 8,141,154

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

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<sup>1</sup> Case IPR2016-01071 has been joined with this proceeding.

Patent Owner's Motion to Exclude (Paper No. 39, "Motion") should be granted for the reasons set forth below.

**I. THE BOARD SHOULD EXCLUDE THE NEW EXHIBITS OUTSIDE THE PROPER SCOPE OF REPLY (EXS. 1005 AND 1012).**

The Board should exclude the belated exhibits introduced in Petitioner's Reply to support its newly minted arguments. Motion at 1–3. Petitioner concedes that the new evidence introduced in its reply was available at the time it filed its Petition, which alone dictates exclusion. *See* Paper No. 42 ("Opposition") at 1–3.

This Motion is a proper vehicle to object to Petitioner's improper reply evidence. The Federal Circuit recognizes the appropriateness and timeliness of such requests: "[Patent Owner] may move to exclude evidence, whether as improper under the response-only regulation, under the Trial Practice Guide's advice, or on other grounds." *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081 (Fed. Cir. 2015); *see also Toshiba Corp. v. Optical Devices, LLC*, IPR2014-01447, Paper 34, at 44–47 (P.T.A.B. Mar. 9, 2016) (granting a patent owner's motion to exclude new arguments and evidence offered by Petitioner in a reply).

While Petitioner correctly notes that a reply is an opportunity to *respond* to arguments raised by a Patent Owner, a reply is not an opportunity to remedy deficiencies of a Petitioner by introducing new evidence and substantive arguments. *Toshiba Corp.*, IPR2014-01447, Paper 34, at 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.”). “[T]he expedited nature of IPRs bring[s] with it an obligation for petitioners to make their case in their petition...” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016). Petitioner is using its Reply to improperly supplement its *prima facie* case of invalidity with new and belated contentions that Finjan contests. Petitioner’s belated introduction of this evidence has “denied [Patent Owner] the opportunity to file responsive evidence,” warranting exclusion. *Scotts Co. v. Encap, LLC*, IPR2013-00110, Paper 79 at 5–6 (P.T.A.B. June 24, 2014).

Thus, the Board should exclude Exhibits 1005 and 1012 as outside the proper scope of reply.

## **II. THE BOARD SHOULD EXCLUDE DR. RUBIN’S TESTIMONY (EXS. 1002 AND 1005).**

As explained in the Motion, Dr. Rubin’s testimony should be excluded because it is contradictory and unreliable. Motion at 3-7.

*First*, Dr. Rubin's pseudocode is irrelevant and contrary to the law regarding obviousness because it was created well after the priority date of the ‘154 Patent. *See* Motion at 5–6. Petitioner admits that Dr. Rubin's pseudocode was created in 2016. *See* Opposition at 4. Instead, Petitioner argues that this 2016 code somehow shows obviousness to a person of skill in the art in 2005. *Id.* Petitioner's argument should be rejected because it is without any legal basis. Indeed, Petitioner makes no attempt to distinguish the *Nuvasive* case cited

by Patent Owner's motion, which rejects use of statements made after the priority date of the patent to show obviousness. Motion at 5–6.

*Second*, contrary to Petitioner's assertions, Dr. Rubin's testimony is inconsistent because Dr. Rubin provides two contrary opinions as to whether Ross's alleged "content," includes "a call to a first function." Opposition at 3–4. Dr. Rubin originally stated that Ross discloses "a call to a first function." Motion at 5–6. Dr. Rubin then directly contradicted himself by creating his own pseudocode to cure the missing "call to a first function." Motion at 5–6. This is contrary to Dr. Rubin's original declaration which asserted that the "content" processed by Ross already includes a call to a first function. *Id.* at 4–5. Petitioner argues that Dr. Rubin's pseudocode is merely an example of other means to achieve the functionality of Ross's pseudocode. Opposition at 3–4. However, this argument improperly ignores the issue that Dr. Rubin provides two contrary opinions as to whether Ross's alleged "content" includes "a call to a first function." Petitioner's new argument that Dr. Rubin's pseudocode is an example that is described in paragraph 31 of Ross is also without merit because Petitioner's only citation to paragraph 31 of Ross merely describes Fig. 4 of Ross itself, and makes no mention of the specific modifications that Dr. Rubin has included in his manufactured pseudocode. Ex. 1003, ¶ 31.

Thus, the Board should exclude Dr. Rubin's testimony as contradictory and unreliable.

**III. THE BOARD SHOULD EXCLUDE THE CITED PORTIONS OF THE DEPOSITION TRANSCRIPTS OF MR. YUVAL BEN-ITZHAK (EX. 1009) AND DR. MARC BERGER (EX. 1010).**

Petitioner relies on the cited portions of the deposition transcripts of Mr. Ben-Itzhak and Dr. Berger for a standard that is contrary to the law, and, as such, cannot be relevant. Motion at 7–9. In particular, Patent Owner needs to show reasonable diligence toward reduction to practice under a holistic rule of reason analysis. Petitioner's Opposition fails to rebut this showing.

*First*, the cited deposition is irrelevant under the applicable legal standard. Specifically, Petitioner seeks to use this irrelevant testimony to show that the '154 Patent does not antedate Ross despite the wealth of evidence proving that Ross is not prior art.

Petitioner is plainly incorrect in contending that *Perfect Surgical* does not support exclusion. In its reply, Petitioner relied on *Perfect Surgical* for the proposition that an inventor and attorney's recollections of the specific dates that certain calls took place somehow wipes away the existence of diligence. Paper No. 32 at 4. As explained in the Motion, Patent Owner is not required to prove diligence with the exacting standard that Petitioner wishes (i.e., the precise number of phone calls and the specific dates such phone calls took place), and rather, need

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