

**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

Patent No. 8,141,154

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*Inter Partes* Review No. IPR2016-00151

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## I. INTRODUCTION

Patent Owner Finjan's response to Petitioner's motion relies on inapposite case law and ignores the issue at hand: that it has failed to provide "independent evidence" to satisfy the authentication requirement. Patent Owner offers no reason for the Board to deviate from its holding in *Neste Oil* in finding insufficient corroborative evidence of authentication. *See Neste Oil Oyj v. Reg Synthetic Fuels, LLC*, No. IPR2013-00578, Paper No. 52 at 3-4 (P.T.A.B. Mar. 12, 2015). The Board should grant the motion and exclude pages 3-20 of Exhibit 2007.

## II. ARGUMENT

### A. Patent Owner Has Provided No Independent Evidence Authenticating Pages 3-20 of Exhibit 2007

Finjan relies on a declaration from Mr. Ben-Itzhak, the inventor, and two declarations from Dr. Berger, who prosecuted the patent application, in its attempt to authenticate Exhibit 2007. (Opp'n, Paper No. 44 at 2.) Exhibit 2007 consists of an email chain (on pages 1-2) and an undated, unsigned draft patent application (on pages 3-20). (Ex. 2007.) The only evidence tying the draft patent application to the date of October 31, 2005 is the Berger declaration stating that the draft application was attached to an email of that date.

As discussed in Petitioner's motion, because Finjan relies on Exhibit 2007 in an attempt to prove prior invention, independent corroborative evidence of authenticity other than the inventor's testimony is required. (Mot., Paper No. 38 at

3 (citing *Neste Oil*.) The Board, citing Federal Circuit precedent, explained that “[t]his rule is proper to avoid ‘circular’ situations in which a party seeks to rely on a document to corroborate a witness’ testimony, but relies on that witness’ testimony to provide the date or other authentication of that document.” *Neste Oil* at 4.

Contrary to Finjan’s argument, this case involves exactly the “circular” authentication situation prohibited by *Neste Oil*. (Opp’n at 4-5.) Similar to *Neste Oil*, in which the lab notebook page was “unsigned, undated, and unwitnessed,” the draft application at issue here is also unsigned, undated, and unwitnessed. The markings on Exhibit 2007 show that the exhibit is in fact three separate documents that have been stitched together into one exhibit. The first page of Exhibit 2007 shows that it is page “1 of 1” printed out on December 12, 2005. The second page of Exhibit 2007 bears the same markings and shows that it is a separate document from page one, and also shows that it is page “1 of 1” printed out on December 12, 2005. However, the document at pages 3 to 20 bears no markings showing any date, nor does it bear any signature. Thus, Finjan’s argument that the draft patent application is “dated” misses the point entirely. (Opp’n at 4.)

Patent Owner attempts to distinguish *Neste Oil* by alleging that Mr. Yuval Ben-Itzhak’s testimony authenticates the draft patent application. Putting aside Mr. Ben-Itzhak’s lack of competence as an inventor, he never even testified that

pages 3-20 of Exhibit 2007 is the draft application that he supposedly sent to Dr. Berger. Patent Owner's failure to offer testimony from Mr. Ben-Itzhak, the purported author of the draft patent application, about Exhibit 2007 only further calls into question its authenticity. Thus, Mr. Ben-Itzhak does not and cannot provide any evidence to authenticate that the draft patent application of Exhibit 2007 is the draft of October 31, 2005.

### **B. Patent Owner's Case Law Is Inapposite**

Petitioner's motion demonstrated that the testimony presented by Finjan is not independent, as it is from Finjan's inventor and the application's patent prosecutor. (Mot. at 3-4 (citing *Microsoft Corp. v. Surfcast, Inc.*, No. IPR2013-00292, Paper No. 93 at 16-17 (P.T.A.B. Oct. 14, 2014); *Sprint Commc'ns Co. v. Comcast IP Holdings, LLC*, No. 12-1013-RGA, 2015 U.S. Dist. LEXIS 10836, at \*10-11 (D. Del. Jan. 30, 2015); *see also Lacks Indus., Inc. v. McKechnie Vehicle Components USA, Inc.*, 322 F.3d 1335, 1350 (Fed. Cir. 2003)).) As such, Petitioner showed that the testimony offered by Finjan is insufficient to authenticate the draft patent application on pages 3-20 of Exhibit 2007.

Nowhere in its response, however, does Finjan distinguish the case law cited by Patent Owner, nor does Finjan cite to any case law to the contrary. Finjan relies on *Lacotte* and *Reese* for the unremarkable proposition that "testimony of a witness, other than an inventor to the actual reduction to practice" may be used to

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