UNITED STATES PATENT AND TRADEMARK OFFICE						
BEFORE THE PATENT TRIAL AND APPEAL BOARD						
PALO ALTO NETWORKS, INC.						
Petitioner						
V.						
FINJAN, INC.,						
Patent Owner						
Case IPR2016-00151						
Patent No. 8,141,154						

# PATENT OWNER'S PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107



## **TABLE OF CONTENTS**

			<u>Page</u>	
I.	INTR	RODUCTION1		
II. THE '154 PATENT			PATENT5	
	A.	Over	view5	
	B.	Chall	enged Claims6	
III.	CLA	IM CC	ONSTRUCTION8	
	A.	"dyna	amically generated" (claims 1, 3, 5, 6, 8, and 11)8	
IV.	. SPECIFIC REASONS WHY THE CITED REFERENCES DO NOT INVALIDATE THE CLAIMS, AND WHY INTER PARTES REVIEW SHOULD NOT BE INSTITUTED			
	A.	The Petition Should be Denied Under 35 U.S.C. § 325(d)1		
			nd 1: Ross Does Not Render Claims 1–8, 10 and 11 Obvious er 35 U.S.C. § 103(a)	
		1.	Ross does not disclose "a system for protecting a computer from dynamically generated malicious content" (claims 1 and 6)	
		2.	Ross does not disclose "a content processor (i) for processing content received over a network, the content including a call to a first function, and the call including an input" (claims 1, 4, 6, and 10)	
		3.	Ross does not disclose "calling a second function with a modified input variable" (claims 6 and 10)	
		4.	Ross does not disclose "wherein the input is dynamically generated by said content processor prior to being transmitted by said transmitter" (claims 3, 5, 8, and 11)	
	C.		nd 2: Ross in view of Calder Does Not Render Claims 9 and 12 ous Under 35 U.S.C. § 103(a)23	



# Patent Owner's Preliminary Response IPR2016-00151 (U.S. Patent No. 8,141,154)

	1.	Ross in view of Calder fails to show or suggest "wherein the input variable includes a call to an additional function, and wherein the modified input variable includes a call to a modified additional function instead of the call to the additional function"	
	2.	The Petition Contains Insufficient Motivation to Combine and Calder	
V.	OF LAW B	ER'S OBVIOUSNESS ARGUMENTS FAIL AS A MATTE BECAUSE IT DID NOT CONDUCT A COMPLETE NESS ANALYSIS	
VI	CONCLUS	SION	32



## **TABLE OF AUTHORITIES**

	Page(s)
Cases	
Apple Inc. v. Int'l Trade Comm'n, 725 F.3d 1356 (Fed. Cir. 2013)	29
Aventis Pharms. Inc. v. Amino Chems. Ltd., 715 F.3d 1363 (Fed. Cir. 2003)	10
GN Resound A/S v. Oticon A/S, Case No. IPR2015-00103 (P.T.A.B. June 18, 2015)	25
Insite Vision, Inc. v. Sandoz, Inc., 783 F.3d 853 (Fed. Cir. 2015)	29
Kinetic Techs., Inc., v. Skyworks Solutions, Inc., Case No. IPR2014-00530 (P.T.A.B. Sept. 29, 2014)	20, 27, 28
KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398 (2007)	27, 28, 29
Leo Pharm. Prods., Ltd. v. Rea, 726 F.3d 1346 (Fed. Cir. 2013)	31, 32
LG Elecs., Inc. v. ATI Techs., ULC, Case No. IPR2015-00327 (P.T.A.B. Sept. 2, 2015)	11
Mintz v. Dietz & Watson, Inc., 679 F.3d 1372 (Fed. Cir. 2012)	28
Novatek, Inc. v. Sollami Co., 559 Fed. Appx. 1011 (Fed. Cir. 2014)	13
Ortho-McNeil Pharm., Inc. v. Mylan Labs, Inc., 520 F.3d 1358 (Fed. Cir. 2008)	31
Plantronics, Inc. v. Aliph, Inc., 724 F.3d 1343 (Fed. Cir. 2013)	30, 31
Rambus Inc. v. Rea, 731 F.3d 1248 (Fed. Cir. 2013)	31



# Patent Owner's Preliminary Response IPR2016-00151 (U.S. Patent No. 8,141,154)

Ruiz v. A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000)	30
Symantec Corp. v. Finjan, Inc., Case No. IPR2015-01547	1, 34
Thorner v. Sony Computer Entm't Am. LLC, 669 F.3d 1362 (Fed. Cir. 2012)	9
Travelocity.com L.P. v. Conos Techs., LLC, Case No. CBM2014-00082	4
Statutes	
35 U.S.C. § 103(a)	12, 23, 30
35 U.S.C. § 108(a)	11
35 U.S.C. § 314(a)	11
35 U.S.C. § 325(d)	2, 10, 11, 12
Other Authorities	
37 C.F.R. § 42.6(e)	35
37 C.F.R. § 42.22(a)(2)	25
37 C.F.R. § 42.65(a)	20, 22, 27
37 C.F.R. § 42.71(d)	2
37 C.F.R. § 42.104(b)	15, 21
37 C.F.R. § 42.108(c)	1
157 Cong. Rec. S1360-S1394 (March 8, 2011)	11
77 Fed. Reg. 48756 at 48763 (Aug. 14, 2012)	22, 27



# DOCKET

# Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## **Real-Time Litigation Alerts**



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## **Advanced Docket Research**



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

#### **Analytics At Your Fingertips**



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

#### API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

#### **LAW FIRMS**

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

#### **FINANCIAL INSTITUTIONS**

Litigation and bankruptcy checks for companies and debtors.

#### **E-DISCOVERY AND LEGAL VENDORS**

Sync your system to PACER to automate legal marketing.

