

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner

v.

FINJAN, INC.,
Patent Owner

Patent No. 8,141,154

Inter Partes Review No. IPR2016-00151¹

PETITIONER'S REQUEST FOR REHEARING

¹ Case IPR2016-01071 has been joined with this proceeding.

Petitioner Palo Alto Networks, Inc. requests rehearing under 37 C.F.R. § 42.71(d) of the Board’s March 15, 2017 Final Written Decision (Paper No. 51).² Petitioner respectfully submits that the Board erred as a matter of law in adopting a construction of “a call to a first function” that is inconsistent with the definition of the same term adopted in IPR2015-1979, an IPR involving the same patent, claims, and parties. When the claim term is properly construed, the prior art invalidates all of the involved claims.

I. THE BOARD ISSUED CONFLICTING CLAIM CONSTRUCTIONS IN THIS CASE AND A RELATED IPR INVOLVING THE SAME PATENT AND PARTIES

The Boards in this case and in IPR2015-01979 (“the ’979 IPR”) issued conflicting claim constructions for “a call to a first function.” Both IPRs involve the same patent, the same claims, and the same parties, and the final decisions were issued on the same day. The Board in this case construed “a call to a first function” to mean “a statement or instruction in a program *requesting the services* of a particular (i.e., first) function.” IPR2016-00151, Paper No. 51 at 9 (P.T.A.B. Mar. 15, 2017) (emphasis added). In the ’979 IPR, by contrast, the Board construed “a call to a first function” to mean “a statement or instruction in the content, *the execution of which causes the function to provide a service.*” IPR2015-01979, Paper No. 62 at 16 (P.T.A.B. Mar. 15, 2017) (emphasis added).

² Petitioner Symantec Corporation in joined Case IPR2016-01071 joins this Request.

These constructions are inconsistent with one another in ways that directly affected the outcome. In this case, the Board limited the “call to a first function” to a “statement or instruction in a program requesting the services” of a particular function. It then found that Ross failed to disclose such a “call” because the Board credited testimony from Patent Owner’s expert Dr. Medvidovic that “Ross describes the combined hook script and the original script as using an ‘assignment,’ not a ‘call’ for invoking the first function.” IPR2016-00151, Paper No. 51 at 14. The Board thus found that Ross disclosed using an “assignment” statement that resulted in “invoking” the required first function, but did not include a “statement or instruction in a program requesting the services” of the function.

In the ’979 IPR, by contrast, the Board construed the term “call to a first function” more broadly to mean “a statement or instruction in the content, the execution of which causes the function to provide a service.” There can be no question that Ross discloses a function call that satisfies this definition, as the Board found based on Patent Owner’s own expert evidence that Ross discloses an “assignment” instruction that results in “invoking the first function” and thus “causes the function to provide a service.” IPR2016-00151, Paper No. 51 at No. 14; *see also id.* at 16 (“Dr. Medvidovic explains that the call to new ActiveXObject(“Microsoft.XMLHTTP”) indirectly invokes ‘function HookedActiveXObject,’ using Ross’s assignment technique.”).

Thus, if the Board in this case had adopted the broader construction of “a call to a first function” as in the ’979 IPR, it would have found that Ross disclosed a “call to a first function” and that all of the challenged claims were unpatentable.

II. THE BOARD SHOULD GRANT REHEARING TO RESOLVE THE INCONSISTENT CLAIM CONSTRUCTIONS

Rehearing is an appropriate vehicle to resolve these inconsistent claim constructions. As in *Valeo North America, Inc. v. Magna Electronics, Inc.*, IPR2014-00220, the Board can grant rehearing to “to avoid an inconsistent outcome.” *Id.*, Paper No. 61 at 3 (P.T.A.B. July 14, 2015). In the *Valeo* case, the Board reconsidered its final decision to ensure that a narrower claim was evaluated consistently with a broader claim. In this case, the Board should grant rehearing to ensure that the same claim term is treated consistently in the two IPR proceedings.

There was no reason for the Board to reach different conclusions as to the meaning of the claim term. The Boards in each of the IPRs cited to the same evidence in arriving at the construction of “a call to a first function.” Both decisions cite to identical passages from the specification in which the term “function call” appears. *Compare* IPR2016-00151, Paper No. 51 at 7, *with* IPR2015-01979, Paper No. 62 at 14. Both decisions also cite to an embodiment in the disclosure that uses the “Substitute_function(input,*)” function call. *Compare* IPR2016-00151, Paper No. 51 at 7-8, *with* IPR2015-01979, Paper No. 62 at 15. Both decisions contain identical language regarding the particular format of the

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instruction and details regarding the function's parameters. *Compare* IPR2016-00151, Paper No. 51 at 8, *with* IPR2015-01979, Paper No. 62 at 15. Finally, both decisions cite to the same extrinsic evidence, including identical testimony from Dr. Medvidovic and the same dictionary definition. *Compare* IPR2016-00151, Paper No. 51 at 6-7 *with* IPR2015-01979, Paper No. 62 at 14. Thus, there is no reason in the records of these two proceedings for the Board to arrive at contrary claim constructions. The Board should grant rehearing to resolve this inconsistency.

Having a consistent construction between this proceeding and IPR2015-01979 serves the public interest. In *Markman v. Westview Instruments, Inc.*, the Supreme Court explained that the purpose of patent claims is to apprise the public of what is and is not protected by a particular patent, and emphasized the “importance of uniformity” in the treatment (i.e., the claim construction) of a given patent. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996). Uniformity in claim construction serves the public interest: “the limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public.” *Id.* (quoting *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938)). The Board's inconsistent constructions of the term “call to a first function” create an impermissible “zone of

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