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 8,141,154

PATENT OWNER'S PARTIAL REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. §§ 42.71(c) and 42.71(d)

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES

Page(s)

Cases

Statutes

Other Authorities

I. INTRODUCTION

Patent Owner, Finjan, Inc. ("Finjan" or "Patent Owner"), respectfully requests rehearing of the Board's Decision on Institution (IPR2016-00151, Paper No. 10) (the "Institution Decision") under 37 C.F.R. § 42.71(d). In particular, Finjan requests reconsideration of the decision to institute trial on claims 1–8, 10, and 11 on obviousness grounds over Ross U.S. Patent Publication No. 2007/0113282 (Ex. 1003, "Ross"). Reconsideration of the Institution Decision is appropriate because the Board misapprehended the significance of its decision to institute trial on a ground of unpatentability based on substantially the same prior art and arguments that were previously presented to the Office. Supreme Court case law regarding judicial and evidentiary admissions, weight of the authority stemming from the language of 35 U.S.C. § 325(d), the legislative history behind § 325(d), each and every Informative Decision released by the Board concerning § 325(d), and the dire practical ramifications of the Board's Institution Decision in this case all favor granting Patent Owner's Request for Rehearing and termination of the instant *inter partes* review proceedings.

The Board's misapprehension in this case resulted in an Institution Decision that "represents an unreasonable judgment in weighing relevant factors" and which, therefore, meets the stringent "abuse of discretion" standard. *See Star Fruits S.N.C. v. U.S.*, 393 F. 3d 1277, 1281 (Fed. Cir. 2005) ("An abuse of

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