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Paper 53
Entered: May 19, 2017

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[1]
Patent 8,141,154 B2

Before, THOMAS L. GIANNETTI, MIRIAM L. QUINN, PATRICK M. BOUCHER, *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge.*

DECISION
ON PETITIONER'S REQUEST FOR REHEARING
37 C.F.R. § 42.71(d)

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

On March 15, 2017, the Board issued a Final Written Decision in this proceeding. Paper 51 ("Final Dec."). On April 14, 2017, Palo Alto Networks, Inc. ("Petitioner") filed a Request for Rehearing. Paper 52 (Req. Reh'g.). Petitioner's Request urges the Board to review the construction of "a call to a first function" for consistency with the construction given to the same term in our Final Written Decision in IPR2015-01979.[2] We agree with Petitioner that the construction of "a call to a first function" must be consistent with our determination in IPR2015-01979.

Accordingly, we hereby modify our Final Written Decision in this proceeding to reflect that the construction for the term "a call to a first function" means "a statement or instruction in the content, the execution of which causes the function to provide a service." That construction remains, however, consistent with our analysis and determinations made in our Final Written Decision, and therefore requires no modification of our conclusions. For example, at page 8 of that Decision we stated that "we determine that the 'call' is a statement or instruction in the content, the execution of which causes the function to provide a service." Final Dec. 8. Accordingly, the last sentence of the first paragraph in page 9 of the Final Written Decision is modified to repeat what we stated earlier in page 8 of the Decision: "we determine that a 'call to a first function' means a statement or instruction in the content, the execution of which causes the function to provide a service."

Notwithstanding the modification to the sentence in page 9, we clarify that we do not agree with Petitioner's argument that this construction expands the scope of the term to include "invocations" of a function when

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[2] *Palo Alto Networks, Inc., v. Finjan, Inc.*, IPR2015-01979, Paper 62 (PTAB Mar. 15, 2017) ("1979 Final Dec.").

the "call" is to another function. For example, we understand Petitioner's argument on rehearing to be that as long as the "call" results in *invoking* the first function, the call's statement or instruction need not expressly include or identify the first function. In support of this argument, Petitioner points to portions of the '154 patent Specification where the words "call" and "invoke" allegedly are used interchangeably. Req. Reh'g 7.

We are not persuaded by Petitioner's argument. In our Final Written Decision, we considered Petitioner's "interchangeability" argument and rejected it. Final Dec. 8. Also, the Specification portions cited in the Request do not warrant reading the claims in the manner Petitioner requests. For example, the Specification states that the "call to Function() has been replaced with a call to Substitute[f]unction()." Ex. 1001, 9:25. This passage describes what the content modifier does to modify the incoming content. The call included in the content received at the client computer is a "call to a Substitutefunction()," and "Substitutefunction()" is the function that is invoked when the client processes the call in the modified content. There is no indication in this, or any other, cited portion of the Specification, that the '154 patent describes embodiments in which the "call" included in the modified content identifies a function different from the function that is invoked during processing.

Further, we do not agree that we "overlooked" an instance where the Specification states that content modifier inserts program code or a link to the substitute function. Req. Reh'g 7 (citing Ex. 1001, 9:37–40). That passage, again, describes the content modifier's insertion of *program code* into the content. And more particularly, the passage alludes to the function program code or a link to the function program code being included in the

content *in addition to* the call to that function. *See* Ex. 1001, 9:37–41; Table I (describing that the content modifier *also* inserts program code for the substitute function into the content, or a link to the substitute function, shown in Table I—which lists the function code, but does not show any inclusion of a link *in the call to the function*).

More important, the plain language of the claims forbids the reading Petitioner advocates. The word "call" is recited in claim 1 as a noun, and is the statement or instruction included in the content that causes the *first function* to provide a service. Final Dec. 7; Ex. 1001, 17:34–36. The word "invoking" appears elsewhere in the claim in connection with the transmission of the call's input, which occurs "when the first function is invoked." Ex. 1001, 17:39–40. The claim language is straightforward: the received content includes a call to a first function, and when that same first function is invoked, the function's input is transmitted to the security computer.

In summary, Petitioner's request urges us to view the claim construction as allowing the call included in the received content to request the services of a function different from the function in the call statement or instruction. To illustrate, if the content states "call function X" but instead, during runtime, function Y is invoked, Petitioner asserts that this scenario would be a "call" to function Y, and therefore meet the claim. As stated above, however, the claim language does not support this reading. The *call to the first function* must be included in the content, and it is the same *first function* that is invoked later in the claim. Our claim construction does not change the plain reading of the claim language. Therefore, the execution of the statement or instruction included in the content must cause *the function*

identified in the statement or instruction to provide a service. To illustrate, if the content states "call function X," during runtime, function X must be invoked. Ross,[3] as we discuss in our Final Written Decision, does not do this. *See* Final Dec. 17–19 (concluding that Ross invokes indirectly the hook function without any need to include a call to that hook function).

CONCLUSION

We have modified a sentence in the claim construction section of the Final Written Decision to clarify that a "call to a first function" means a statement or instruction in the content, the execution of which causes the function to provide a service. This modification, however, does not change our determination that Petitioner failed to show unpatentability of claims 1–8, 10, and 11 of the '154 patent for obviousness over Ross.

ORDER

In consideration of the foregoing, it is hereby

ORDERED that our Final Written Decision is modified only as to the clarification of the claim construction of a "call to a first function" to reflect the exact wording of the claim construction provided for the same term in IPR2015-01979: a "call to a first function" means a statement or instruction in the content, the execution of which causes the function to provide a service. No further modification of the Final Written Decision is warranted.

[3] Patent Application Pub. No. US 2007/0113282 A1 (Exhibit 1003) ("Ross").

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