PROTECTIVE ORDER MATERIAL

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 U.S. Patent No. 8,141,154

PATENT OWNER RESPONSE



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	A.		'154 Patent Was Conceived and Diligently Reduced to Practice a Time Predating Ross	
V.			Not Render Claims 1–8, 10 and 11 Obvious Under 35 U.S.C.	16
	A.	the c	s does not disclose processing content received over a network, content including a call to a first function, and the call including aput (claims 1, 4, 6, and 10)	
		1.	The Board's Institution Decision Identifies the Hook Script as Content Received Over the Network	
		2.	Petitioner Has Not Identified a Call to a First Function in Ros	
		3.	Ross Does not Teach or Suggest Content Received Over a Network Including a Call to a First Function	.22
		4.	Ross Does not Teach or Suggest Receiving Content Over a Single Network, the Content Including a Call to a First Function	.25
		5.	Ross's Third Device Embodiment Fails to Disclose "Processis Content Received Over a Network"	_
	B.	Ross	does not disclose "for invoking a second function with the inpu	



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	C.	Ross does not disclose a receiver for receiving an indicator from the security computer whether it is safe to invoke the second function with the input"	
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TABLE OF AUTHORITIES

1	agc(s)
Cases	
Apple Inc. v. Int'l Trade Comm'n, 725 F.3d 1356 (Fed. Cir. 2013)	52
Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547 (Fed.Cir.1989)	33
Bey v. Kollonitsch, 806 F.2d 1024 (Fed. Cir. 1986)	9
Bicon, Inc. v. Straumann Co. 441 F.3d 945 (Fed. Cir. 2006)	36
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Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387 (Fed. Cir. 1988)	45
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Hyatt v. Boone, 146 F.3d 1348 (Fed. Cir. 1998)	5
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Monsanto Co. v. Mycogen Plant Sci., Inc., 261 F.3d 1356 (Fed. Cir. 2001)	6
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Osram Sylvania Inc. v. Am. Induction Techs., Inc., 701 F.3d 698 (Fed. Cir. 2012)	52
In re Payne, 606 F2d 303 (C.C.P.A. 1979)	33
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In re Wilson, 424 F 2d 1382 (CCPA 1970)	36 38



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