

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-00151¹
U.S. Patent No. 8,141,154

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

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

Pursuant to 37 C.F.R. § 42.64, Patent Owner Finjan, Inc. ("Patent Owner") moves to exclude the following evidence submitted in these proceedings by Petitioner Palo Alto Networks, Inc. ("Petitioner"). Patent Owner timely raised the objections set forth in this Motion in its Objections to Evidence. Papers 12 and 33. The Board should grant Patent Owner's Motion for the reasons set forth below.

I. THE BOARD SHOULD EXCLUDE EXHIBITS THAT ARE OUTSIDE THE PROPER SCOPE OF REPLY (EXS. 1005 AND 1012).

Petitioner's Reply (Paper 32) improperly introduced new evidence and arguments in an attempt to resolve the deficient arguments and evidentiary shortcomings of its Petition. Specifically, Petitioner introduced for the first time in its Reply a new declaration from Dr. Rubin (Ex. 1005) and a new TCP/IP Network Administration reference (Ex. 1012). The Board should exclude these belated submissions because it is improper for Petitioner to introduce new evidence and arguments in its Reply. *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081 (Fed. Cir. 2015) ("a party may move to exclude evidence, whether as improper under the response-only regulation, under the Trial Practice Guide's advice, or on other grounds.") (citation omitted).

Dr. Rubin's Declaration contains newly minted arguments regarding the "*call* to a first function" that is required to be included in the "content received over a network" as recited in claim 1. The Petition only maps the recited "content" and the recited "first function," while ignoring the "*call to a* first function"

requirement. Dr. Rubin's Reply declaration attempts to rectify this shortcoming by advancing a belated new theory that Ross purportedly teaches that "hook scripts could include a call to a first function," modifying Ross with his own extrinsic pseudocode. Ex. 1005 at ¶¶ 3-14; Ex. 2043 at 88:11-16 ("the reason I wrote this and the opinion that I have is that in the pseudocode in figure 4, there's no explicit call to a hooked function. But I showed in my pseudocode how, by adding a trivial amount of code, that functionality can be shown..."). The Board should exclude these untimely arguments contained in Dr. Rubin's declaration (¶¶ 3-14) which were not in the Petition and to which Patent Owner had no opportunity to respond.

Tacitly recognizing that its arguments regarding Ross are flawed, Petitioner offers the TCP/IP Network Administration reference (Ex. 1012) as another belated attempt to supplement its arguments regarding the invalidity of the '154 Patent. Ex. 1005, ¶ 19 ("TCP/IP [is] the preeminent communications protocol for linking together diverse computer systems since 1992."). The TCP/IP Network Administration reference and all of the arguments based on this reference were not previously identified in the Petition, and should thus be excluded. Paper 32 at 16 (citing Ex. 1005 at ¶ 19).

Petitioner may not use its Reply as a vehicle to add in new evidence that could have been included in its Petition, and all such evidence should be excluded. *See, e.g., Toshiba Corp. v. Optical Devices, LLC*, IPR2014-01447, Paper 34, at 44-

47 (P.T.A.B. Mar. 9, 2016) (“[Section 42.23(b)], however, does not authorize or otherwise provide a means for supplementing the evidence of record.”); *Toyota Motor Corp. v. Am. Vehicular Scis. LLC*, IPR2013-00424, Paper 50, at 21 (P.T.A.B. Jan. 12, 2015) (“[Petitioner] cannot rely belatedly on this evidence in its Reply and Reply Declaration of [its expert] to make up for the deficiencies in its Petition.”); *The Scotts Co. LLC v. Encap, LLC*, IPR 2013-00110, Paper 79, at 5–6 (P.T.A.B. June 24, 2014) (declining to consider untimely evidence and arguments because the patent owner “was denied the opportunity to file responsive evidence.”). Here, there is no reason Petitioner could not have included Exhibits 1005 and 1012 and the related arguments in its Petition.

Petitioner's attempt to sandbag Patent Owner with these untimely and technically incorrect submissions is highly prejudicial, as Patent Owner has not had the opportunity to respond to this belated evidence and Petitioner's related arguments. Thus, the Board should exclude the newly filed Rubin Declaration and TCP/IP reference and related arguments. *See, e.g.*, Paper 32 at 16 (citing Ex. 1005 at ¶ 19).

II. THE BOARD SHOULD EXCLUDE DR. RUBIN'S TESTIMONY (EXS. 1002, 1005).

The Board should exclude the testimony of Dr. Rubin (Exhibits 1002 and 1005) because his opinions are conclusory and unreliable. Fed. R. Evid. 702; *Tietex Int'l, Ltd. v. Precision Fabrics Grp., Inc.*, Case IPR2014-01248, Paper 39 at

17 (P.T.A.B. Jan. 27, 2016) (a lack of objective support for an expert opinion “may render the testimony of little probative value in [a patentability] determination.”) (quoting *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294 (Fed. Cir. 1985)). As discussed further below, although Dr. Rubin purports that the “content” processed by Ross already includes a call to a first function, he contradicted himself on multiple occasions when he admitted that Ross fails to disclose the claimed “call to a first function.”

First, Dr. Rubin's testimony is unreliable because he confirmed that “there is no explicit call to a hooked function” in Ross and confirmed that he actually relies on his own pseudocode, labeled “My Pseudocode,” to show what is missing from the pseudocode in figure 4 of Ross. Ex. 2043 at 88:11-16 (“the opinion that I have is that in the pseudocode in figure 4, there's no explicit call to a hooked function. But I showed in my pseudocode how, by adding a trivial amount of code, that functionality can be shown...”). This testimony is contrary to Dr. Rubin's declaration testimony that the “content” processed by Ross already includes a call to a hook function, which is alleged to be the “call to a first function.” Ex. 1002 at ¶109 (“a POSITA would have understood that the hook scripts (i.e., content) processed by the script processing engine 224 to include a call to a first function call (i.e., hook functions within a hook script)...”). Therefore, Dr. Rubin's testimony should be excluded as unreliable because it is self-contradictory. Fed. R.

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