

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 FOR OBSERVATIONS

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

Patent Owner Finjan, Inc. submits the following observations of the
December 20, 2016 cross-examination of Aviel Rubin (Ex. 2043):

Observations Concerning the Missing “Call to a First Function”

Observation #1 : “There is no explicit call to a hooked function”

Dr. Rubin confirmed in his deposition that “there is no explicit call to a hooked function” in Ross and confirmed that Dr. Rubin 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 relevant because it 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)...”). This testimony is relevant because it confirms the required “call to a first function” was not disclosed by the cited prior art.

Observation #2 : Dr. Rubin Adds Code “Not in the Original Pseudocode”

Dr. Rubin confirmed in his deposition that “there's no explicit call in the pseudocode” of Ross and that his own pseudocode adds code that “was not in the original pseudocode” of Ross. Ex. 2043 at 88:25-89:3 (“Q: What do you mean by there's no explicit call in the pseudocode? A: The line that I added in the pseudocode was not in the original pseudocode.”).

This testimony is relevant because it confirms that Dr. Rubin's added code “was not in the original pseudocode” disclosed by Ross. This testimony is relevant because it undermines the argument that Ross's alleged “content” includes a “*call* to a first function,” as required by claim 1. Ex. 1002 at ¶107 (“The ‘content’ received by the script processing engine 618 (i.e., a content processor) *includes a call to a first function.*”)(emphasis added).

Observation #3: How Dr. Rubin's Pseudocode Differs From Ross

Dr. Rubin further testified as to how his own pseudocode differs from Ross's pseudocode in multiple ways. Ex. 2043 at 89:2-9 (“I added a line that's a function called hooked active X object which has a single line in that function which is a call to the substitute active X object and then I changed the name of the hooked active X object to be substitute active X object.”).

This testimony demonstrates that Ross's pseudocode fails to include the recited “call to a first function” and that Dr. Rubin's invalidity opinion improperly

relies on changing Ross's original pseudocode to include what is missing from Ross. The testimony is relevant because the statements contradict Dr. Rubin's assertion in his declaration that the "content" processed by Ross already includes a call to a first function. Ex. 1002 at ¶107 ("The 'content' received by the script processing engine 618 (i.e., a content processor) includes a call to a first function."); *see also id.* 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)...").

Observation #4 : Dr. Rubin's Pseudocode was Created in 2016 Not 2005

Dr. Rubin confirmed in his deposition that his pseudocode, labeled My Pseudocode, was created approximately a month ago in November of 2016. Ex. 2043 at 89:14-21 ("Q: So it's -- the code labeled my pseudocode, when did you create this? A: This was maybe about a month ago, approximately. Q: So it would be fair to say that you created the code labeled my pseudocode in November of 2016? A: I don't remember the exact date, but that's very likely the case."). Dr. Rubin further confirmed in his deposition that his pseudocode was not created in 2005. Ex. 2043 at 90:4-7 ("Q: So is it true that the code labeled my pseudocode that appears on paragraph 7 of your declaration was not created in 2005? A: It was not...").

This testimony is relevant because it confirms that Dr. Rubin's pseudocode was created after the priority date of the '154 Patent. This testimony is relevant to Dr. Rubin's Reply declaration where he attempts to cure the deficiency of Ross's pseudocode by creating his own code labeled "My Pseudocode," created in 2016. Ex. 1005 at ¶7. This testimony is relevant because it confirms the required "call to a first function" was not disclosed by Ross at the time of the claimed invention.

Observation #5 : Dr. Rubin's Pseudocode was Created Using Hindsight Bias

Dr. Rubin confirmed in his deposition that he looked to the disclosure of the '154 Patent itself to create his pseudocode. Ex. 2043 at 90:14-17 (testifying that he looked to "table III of the '154 patent in creating the code labeled my pseudocode" in order "[t]o emphasize the similarity between my pseudocode and the pseudocode of table III.>").

The testimony that Dr. Rubin used the specification of the '154 Patent to create his pseudocode is relevant because it demonstrates Dr. Rubin's improper reliance on ex post reasoning and hindsight bias. This testimony is relevant because it undermines Dr. Rubin's Reply declaration testimony that the claimed invention "would have been obvious to a POSITA, at the time of the filing of the '154 patent." Ex. 1005 at ¶6.

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