UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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PALO ALTO NETWORKS, INC.,
Petitioner

v.

FINJAN, INC.,
Patent Owner

Patent No. 8,141,154

_____

Inter Partes Review No. IPR2016-00151
_____

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE

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CASES

Petitioner Palo Alto Networks, Inc. provides this Opposition to the Patent

Owner's Motion to Exclude Evidence Pursuant to 37 C.F.R. § 42.64(c) (Paper

No. 39, "Motion"). Patent Owner's Motion should be denied in all respects.

I.   PETITIONER'S MOTION TO EXCLUDE IS PROCEDURALLY IMPROPER

Although styled as a motion to exclude, the Motion does not raise

evidentiary issues and should therefore be rejected. "While a motion to exclude

may raise issues related to admissibility of evidence, it is not an opportunity to file

a sur-reply, and also is not a mechanism to argue that a reply contains new

arguments. . . ." *Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.*, No.

CBM2012-00002, Paper No. 66 at 62 (P.T.A.B. Jan. 23, 2014). The Motion

violates both of these principles. Throughout the Motion, Patent Owner argues

that evidence presented in the Petitioner reply is not sufficient or persuasive, and

that it supposedly presents improper new argument. The Motion does not raise any

issue that genuinely relates to the admissibility of evidence. As a result, the

motion fails at the outset. *Gnosis S.P.A. v. S. Ala. Med. Sci. Found.*, No. IPR2013-

00118, Paper No. 64 at 43 (P.T.A.B. June 20, 2014); *see also Xilinx, Inc.* v.

Intellectual Ventures I LLC, No. IPR2013-00112, Paper No. 51 at 44-45 (P.T.A.B.

June 26, 2014).

II.   EXHIBITS 1005 AND 1012 ARE RESPONSIVE TO PATENT OWNER'S ARGUMENTS IN ITS PATENT OWNER RESPONSE

Patent Owner argues that the entirety of Dr. Rubin's reply declaration (Ex. 1005) and the TCP/IP reference (Ex. 1012) submitted with the Petitioner reply are "improperly introduced new evidence." (Motion at 1.) However, in a reply, a petitioner legitimately may respond to arguments made in an opposition. To do so, often it is necessary to rely on new evidence. *Volkswagen Grp. of Am., Inc. v. Emerachem Holdings, LLC*, No. IPR2014-01555, Paper No. 36 at 5 (P.T.A.B. Oct. 9, 2015). Here, both Dr. Rubin's testimony and the TCP/IP reference are responsive to arguments made by the Patent Owner in its response and are therefore properly submitted in reply.

Dr. Rubin described during cross-examination how each portion of his reply declaration maps to arguments made by the Patent Owner in its response to the petition. (*See* Ex. 2043 at 52:11-57:9.) For example, Patent Owner cites FIG. 4 of Ross as allegedly demonstrating that Ross fails to teach or suggest the "call to a first function" claim limitation. (*See* Patent Owner Response, Paper No. 19 at 19.) In response to Patent Owner's use of FIG. 4, Dr. Rubin's testimony addresses how FIG. 4 in fact teaches and suggests this feature, and his testimony is consistent with his original declaration which states that Ross' hook scripts teach or suggest "a call to a first function" within the content received over a network. (Ex. 1002 ¶ 107.)

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