

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Palo Alto Networks, Inc. and
Blue Coat Systems, Inc.,
Petitioners

v.

Finjan, Inc.
Patent Owner

Case IPR2016-00159¹
Patent No. 8,677,494

**PETITIONER'S MOTION TO EXCLUDE
EVIDENCE UNDER 37 C.F.R. § 42.64(c)**

¹ Case IPR2016-01174 has been joined with the instant proceeding.

Pursuant to 37 C.F.R. § 42.64(c), Petitioner moves to exclude paragraphs 159-66 of Dr. Medvidovic's Declaration (Ex. 2011) and exhibits 2016, 2020, 2022, 2024, and 2025 submitted by Patent Owner. Petitioner objected to these exhibits on Aug. 19, 2016. (Paper 18.)

I. PARAGRAPHS 159-66 OF THE MEDVIDOVIC DECLARATION (EX. 2011) SHOULD BE EXCLUDED

Dr. Medvidovic's opinions on licensing (paragraphs 159-60) and a purported nexus with the challenged claims (paragraphs 161-66) should be struck because they are outside the scope of Dr. Medvidovic's technical expertise and are not based on reliable facts or methods. *See* Fed. R. Evid. 702, 703.

Dr. Medvidovic performed no independent investigation or analysis concerning any Finjan licenses. (Ex. 2011 at ¶¶ 159-60; Ex. 1100, Medvidovic Dep. at 65:8-66:17.) In fact, Dr. Medvidovic (1) did not cite or attach any Finjan licenses as exhibits; (2) did not identify the amount paid under any Finjan license; (3) did not identify the number of patents licensed by Finjan to any of its licensees (3) merely relied on attorney-relayed information; and (4) admitted that additional analysis would be required to prove infringement by the licensees. (Ex. 1100, Medvidovic Dep. at 65:8-66:24, 68:18-70:1, 71:9-73:8.) Expert testimony based only on attorney-relayed facts is unreliable. *See Apple, Inc. v. Ameranth, Inc.*, CBM2015-00080, Paper 44, at *38-39 (PTAB Aug. 26, 2016) (finding alleged

evidence of nexus to be merely attorney argument where counsel provided the annotated evidence and the witness had merely relied on the attorney provided evidence to provide his opinion). Because Dr. Medvidovic identifies no other basis for his opinions concerning Finjan licenses, paragraphs 159-60 should be excluded on this basis alone. *See* Fed. R. Evid. 702, 703.

Dr. Medvidovic's licensing opinions are also deficient because they provide neither adequate evidence nor sufficient analysis to show nexus. *See Apple*, CBM2015-00080, Paper 44 at *36-37. The mere existence of a license is insufficient to establish nexus. *See, e.g., In re Antor Media Corp.*, 689 F.3d 1282, 1293-94 (Fed. Cir. 2012). Dr. Medvidovic admitted that at least some if not all of Finjan's licenses are portfolio licenses that cover multiple patents. (Ex. 1100, Medvidovic Dep. at 66:2-17.) Furthermore, Dr. Medvidovic admitted that he performed no analysis of what portion of any license payment, if any, was allocable to the '494 patent. (*Id.* at 65:17-20.) Accordingly, Dr. Medvidovic's licensing opinions are unreliable and unhelpful to the Board. *See* Fed. R. Evid. 702, 703.

Dr. Medvidovic's opinions concerning a purported nexus between the challenged claims and Finjan's alleged evidence of secondary considerations (paragraphs 161-66) should be excluded for similar reasons. *See Graftech Int'l Holdings, Inc. v. Laird Techs, Inc.*, 652 Fed. Appx. 973, 978-79 (Fed. Cir. June 17,

2016) (nexus must exist between the claimed invention and the commercial success). Dr. Medvidovic also did not analyze whether the allegedly infringing products contained non-patented features, or what portion, if any, of the accused infringers' revenues were attributable to the claimed inventions. (Ex. 1100, Medvidovic Dep. at 75:5-16, 65:17-20, 81:23-84:19.) Similarly, Dr. Medvidovic did not provide any market share analysis for purposes of his opinions. *Universal Remote Control, Inc. v. Universal Elecs. Inc.*, IPR2014-01106, Paper 49 at *25 (PTAB Dec. 15, 2015) (finding dollar amounts of sales did not establish commercial success where patentee did not discuss or present market share information); *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996) (finding insufficient information to determine commercial success where patentee indicated only the number of units sold without any indication as to whether it represented a substantial quantity in the market); *see* Ex. 2011 at ¶¶ 161-66.) Without such evidence, paragraphs 161-66 of the Medvidovic Declaration are unreliable and should be excluded. *See* Fed. R. Evid. 702, 703.

II. THE DAVIDSON TRANSCRIPT (EX. 2016) SHOULD BE EXCLUDED

The transcript for the deposition of Jack Davidson in *Symantec Corp. v. Finjan, Inc.*, Case No. IPR2015-01892, should be excluded because it is inadmissible hearsay. (*See* Ex. 2016; Fed. R. Evid. 802.)

Exhibit 2016 contains out-of-court statements offered for the truth of the

matter asserted. *See* Fed. R. Evid. 801. For example, Finjan relies on Dr. Davidson's characterizations of Swimmer to support Finjan's interpretations of Swimmer. (Paper 17 at 22-23, 33-34, 40.) Patent Owner did not argue that a hearsay exception applies. Fed. R. Evid. 802. Patent Owner may try to argue that the Davidson transcript is a public record under Federal Rule of Evidence 803(8). But a public office record is admissible only if it sets out office activities, a matter observed while under a legal duty to report, or fact findings from an authorized investigation. Fed. R. Evid. 803(8). A deposition transcript does not "set out" office activities or matters observed under a duty to report and are not fact findings from an authorized investigation.

III. THE WIKIPEDIA DEFINITION OF "LOGFILE" (EX. 2020) SHOULD BE EXCLUDED

The Wikipedia entry that purportedly displays an explanation of "logfile" (Ex. 2020) should be excluded because it is irrelevant hearsay with no applicable hearsay exception and because it lacks authentication. Patent Owner relies on Exhibit 2020 in its Response and in the Declaration of Dr. Medvidovic. (Paper 17 at 30-31; Ex. 2011 at ¶¶ 62, 107, 121.)

Exhibit 2020 is a Wikipedia page for "logfile," which Patent Owner relies on to provide the definition of "logfile" as understood by a person of ordinary skill in 1996-1997. (Paper 17 at 31; Ex. 2011 at ¶¶ 62, 107, 121.) Evidence is relevant if

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