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.,
BLUE COAT SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

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Case IPR2016-00159[1]
U.S. Patent No. 8,677,494

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

[1] Case IPR2016-01174 has been joined with this proceeding.

Patent Owner's Motion to Exclude ("Motion," Paper 35) should be granted.

## I. Petitioner's Improper Reply Exhibits, Arguments Should be Excluded.

Petitioner's Exhibits 1091, 1093-1097, and related arguments, introduced in its Reply, should be excluded as improper new evidence. Motion at 1-5. The Federal Circuit recognizes the timeliness of this request here, and emphasizes the "obligation for petitioner[] to make [its] case in [its] petition to institute," rather than sandbag a Patent Owner in its Reply. *Id.*; *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016). Petitioner concedes that the information in the exhibits was available at the time it filed its Petition.

Petitioner admits it offers Exhibits 1095-1097 as evidence of Swimmer's alleged public availability. Paper 42 ("Opp.") at 2. Petitioner should have been aware that Patent Owner would challenge Swimmer's public accessibility date as it is ***Petitioner's*** burden to establish it. Motion at 3. Pointing out that Petitioner failed to carry its burden does not open the door for Petitioner to try again with new evidence. Rather than rebut Patent Owner's arguments, Petitioner is trying to rehabilitate its case. Thus, Exhibits 1095-1097 should be excluded. Motion at 2-4.

Similarly, Exhibits 1093 and 1094 should be excluded. Petitioner utilizes these exhibits in a belated attempt to remedy its Petition's deficiencies. Petitioner is ***not*** utilizing these exhibits to "rebut Finjan's characterizations" of a POSA's understanding of "some operations…as potentially malicious." Opp. at 3. Rather,

Petitioner uses them in an attempt to justify Petitioner's and Dr. Rubin's reliance on an MS-DOS book "to support that Swimmer's function numbers correspond to computer operations." Paper 26 at 9. This delayed use of evidence has "denied [Patent Owner] the opportunity to file responsive evidence" regarding key evidence to Petitioner's position and thus should be excluded. Motion at 3-4; *The Scotts Co. v. Encap, LLC*, IPR2013-00110, Paper 79 at 5-6 (PTAB June 24, 2014).

Exhibit 1091 should also be excluded as Petitioner improperly relies on it beyond the scope of its Reply. Patent Owner did not include this document as an exhibit and Petitioner does not offer any authority to support its dubious theory that a citation in one of Patent Owner's exhibits to Exhibit 1091 opens the door to Petitioner's unbridled use of this document. In particular, Petitioner admits that Exhibit 1091 pertains to Avast's products meeting the '494 Patent claims in connection with secondary considerations of non-obviousness. Opp. at 2-3. Petitioner, however, cites Exhibit 1091 in its Reply "to rebut Finjan's assertion that ***Swimmer*** does not disclose 'DSP data, including a list of suspicious operations.'" *Id.* at 2. Thus, Petitioner is improperly utilizing Exhibit 1091 to support a belated attempt in its Reply to remedy the deficiencies in its Petition. Motion at 4-5.

## II. The Board Should Exclude Exhibits 1088 and 1089.

Petitioner concedes it could have submitted Exhibit 1089, Mr. Hawes' second declaration, with its Petition and that the exhibits and information in it

could have been included with his first one. Motion at 9-10; Opp. at 4. On this basis alone, it should be excluded. Further, Petitioner solely cites to Exhibit 1089 in its Reply in connection with its contention that Swimmer was "distributed to 163 attendees and offered for sale." Paper 26 at 5. However, Mr. Hawes admitted that the "163 attendees" were only ***registered*** delegates and there was no confirmation that any of them attended the conference. Motion at 9-12; Ex. 2045 at 22:10-21. Thus, Exhibit 1089 should be excluded as untimely, unreliable and conclusory.

Petitioner also does not address that Exhibit 1088 should be excluded because Mr. Hawes testified that he did not begin working at Virus Bulletin until 10 years after the conference where Swimmer was allegedly distributed. Motion at 10-12. Mr. Hawes' statements regarding Swimmer's alleged public availability were based on hearsay and not confirmed when he wrote Exhibit 1088. *Id.* Thus, Exhibit 1088 should be excluded as unreliable, conclusory and unauthenticated.

## III. The Board Should Exclude Exhibit 1095.

Petitioner does not contest that it could have included Exhibit 1095 with its Petition and that it offers the document in support of Swimmer's alleged public availability. Petitioner also ignores Dr. Hall-Ellis' admission that the date on the MARC record she relies upon did not indicate whether Swimmer was publicly available at the Virus Bulletin International Conference. Motion at 7-9. This fact alone requires that Exhibit 1095 be excluded as untimely and unreliable. *Id.*

## IV. The Board Should Exclude Exhibits 1092, 1098 and 1100.

For the reasons set forth in the Motion, and those discussed herein, the portions of the Reply relying on Exhibits 1092, 1098 and 1100 should be excluded.

***First***, Petitioner now admits that Exhibit 1092 relates to an entirely different patent than that at issue here but failed to disclose this key fact in its Reply, which improperly implies that "Finjan's admission" regarding the meaning of "suspicious" in Exhibit 1092 pertains to the '494 Patent. Opp. at 7; Paper 26 at 7. Furthermore, Petitioner does not even address the key differences, outlined in Patent Owner's Motion, between the claim language of the '844 Patent and the '494 Patent. *Compare* Opp. at 7 *with* Motion at 5-6. Thus, the portions of the Reply relying on Exhibit 1092 should be excluded as irrelevant and prejudicial.

***Second***, the portions of the Reply citing to Exhibits 1098 and 1100 should be excluded because Petitioner misrepresents their contents in alleging that Patent Owner has not shown licensees' products practice the claims. Motion at 6-7. Both Drs. Medvidovic and Goodrich evaluated the licensees' practice of the patent claims. Dr. Medvidovic simply explained that "additional analysis" for ***one*** of the claim charts would be necessary to ***prove*** infringement – a standard not required here. Opp. at 8. Similarly, Dr. Goodrich explained that the various third party products practice the '494 Patent. Motion at 6-7. Thus, because of Petitioner's misrepresentations of these exhibits, the portions of the Reply relying on them

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