UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

PALO ALTO NETWORKS, INC.
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

---

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

---

**PATENT OWNER'S REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. §§ 42.71(c) and 42.71(d)**

# TABLE OF CONTENTS

**Page**

# TABLE OF AUTHORITIES

**Page(s)**

## Cases



## Statutes



## Other Authorities

## I. INTRODUCTION

Patent Owner, Finjan, Inc. ("Finjan" or "Patent Owner"), respectfully requests rehearing of the Board's Decision on Institution (IPR2016-00159, Paper No. 8) (the "Institution Decision") under 37 C.F.R. § 42.71(d). In particular, Finjan requests reconsideration of the decision to institute trial on claims 1, 2, 6, 10, 11, and 15 over Morton Swimmer et al., *Dynamic Detection and Classification of Computer Viruses Using General Behaviour Patterns*, VIRUS BULL. CONF. 75 (Sept. 1995) (Ex. 1006, "Swimmer") and claims 3–5 and 12–14 over the combination of Swimmer and David M. Martin, Jr. et al., *Blocking Java Applets at the Firewall*, PROC. 1997 SYMP. ON NETWORK & DISTRIBUTED SYS. SEC. (©1997) (Ex. 1047, "Martin").

Reconsideration of the Institution Decision is appropriate because the Board overlooked Patent Owner's request that the Board exercise its discretion to reject the Petition under 35 U.S.C. § 325(d). *See* Patent Owner Preliminary Response, *Palo Alto Networks, Inc., v. Finjan, Inc.*, IPR2016-00159, Paper 6 at 1-2 (P.T.A.B. Feb. 17, 2016) ("POPR"). Because the Board overlooked Patent Owner's argument, and because this case is particularly suited for denial under § 325(d), the Institution Decision "represents an unreasonable judgment in weighing relevant factors" and, therefore, meets the stringent "abuse of discretion" standard. *See Star Fruits S.N.C. v. U.S.*, 393 F. 3d 1277, 1281 (Fed. Cir. 2005) ("An abuse of

discretion occurs where the decision is based on an erroneous interpretation of the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors.") (citation omitted). Accordingly, Patent Owner respectfully requests that the Board reconsider its decision to institute trial on claims 1–6 and 10–15 of the '494 Patent and deny the Petition in its entirety using the discretion provided under 35 U.S.C. § 325(d).

## II. THE BOARD SHOULD HAVE DENIED THE PETITION UNDER 35 U.S.C. § 325(D)

35 U.S.C. § 325(d) provides the Board with the discretion to deny institution of a petition for *inter partes* review in the event that the same or similar prior art or arguments were previously presented to the USPTO:

> In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, **the same or substantially the same prior art or arguments previously were presented to the Office**.

35 U.S.C. § 325(d) (emphasis added). In this case, Petitioner presented two sets of grounds that were substantially similar in terms of the prior art cited and the arguments made to those raised in two separate Petitions filed by Symantec Corp against claims of the '494 Patent, IPR2015-01892 and IPR2015-01897 (the

DOCKET ALARM

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

**LAW FIRMS**
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

**FINANCIAL INSTITUTIONS**
Litigation and bankruptcy checks for companies and debtors.

**E-DISCOVERY AND LEGAL VENDORS**
Sync your system to PACER to automate legal marketing.