

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 REPLY

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

Table of Contents

	Page
I. INTRODUCTION	1
II. SWIMMER & MARTIN WERE PUBLICLY AVAILABLE	3
A. Swimmer was publicly available	3
B. Martin was publicly available	5
III. SWIMMER AND MARTIN RENDER CLAIMS 1-6, 10, AND 11-15 OBVIOUS.....	6
A. Swimmer Renders Obvious Claims 1-2, 6, 10-11, and 15.....	6
1. Swimmer renders obvious “deriving security profile data for the Downloadable, including a list of suspicious computer operations.” (cls. 1[c], 10[c], 6, 15).....	6
a. Finjan improperly reads a limitation into the claims.	6
b. Swimmer renders obvious the deriving DSP data limitation under its plain and ordinary meaning.	8
c. Swimmer renders obvious the deriving DSP data limitation even under Finjan’s interpretation.	10
2. Swimmer renders obvious “a Downloadable scanner” (cl. 10[c])	13
3. Swimmer renders obvious “storing the DSP data in a database.” (cls. 1[d], 10[d]).....	14
4. Swimmer renders obvious “a database manager coupled with said Downloadable scanner, for storing the DSP data in a database.” (cl. 10[d])	18
5. Swimmer renders obvious storing “a date & time when the Downloadable Security profile data was derived, in the database” (cls. 2, 11).....	18
B. Swimmer and Martin Render Obvious Claims 3-5, 12-14	19
1. Swimmer and Martin render obvious “wherein the Downloadable includes an “applet” (cls. 3, 12), “active control” (cls. 4, 13), or “program script” (cls. 5, 14).....	19

Table of Contents
(continued)

	Page
2. A POSA would have been motivated to combine Swimmer and Martin.	20
C. None of Finjan’s Remaining Arguments Carry Any Weight	22
IV. SECONDARY CONSIDERATIONS	22
A. Finjan fails to establish nexus between its licensing program and the challenged claims	23
B. Finjan fails to establish nexus between alleged commercial success and the challenged claims	24
C. Finjan fails to establish nexus between alleged praise by others and the challenged claims	25
D. Finjan fails to show long-felt need, skepticism, or failure by others	25
V. CONCLUSION	26

Table of Authorities

	Page(s)
Cases	
<i>In re Am. Acad. of Sci. Tech Ctr.</i> , 367 F.3d 1359 (Fed. Cir. 2004)	7
<i>In re Antor Media Corp.</i> , 689 F.3d 1282 (Fed. Cir. 2012)	23
<i>Apple, Inc. v. Ameranth, Inc.</i> , CBM2015-00080, Paper 44	22, 24, 25
<i>B/E Aerospace, Inc. v. MAG Aerospace Industries, LLC</i> , IPR2014-01513, Paper 104 (PTAB Mar. 18, 2016)	25
<i>Bruckelmyer v. Ground Heaters, Inc.</i> , 445 F.3d 1374 (Fed. Cir. 2006)	3
<i>Ebay Inc. v. MoneyCat Ltd.</i> , CBM2014-00091, Paper 50 (PTAB Sept. 23, 2015)	6
<i>Facebook, Inc. v. Software Rights Archive, LLC</i> , IPR2013-00479, Paper 54 (PTAB Feb. 2, 2015)	24
<i>Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC</i> , IPR2012-00001, Paper 59 (PTAB Nov. 13, 2013)	17, 18
<i>Geosys-Intl, Inc. v. Farmers Edge</i> , IPR2015-00711, Paper 34 (PTAB Aug. 17, 2016)	25
<i>GrafTech Int’l Holdings, Inc. v. Laird Techs.</i> , 652 Fed. Appx. 973 (Fed. Cir. June 17, 2016)	22
<i>In re Hall</i> , 781 F.2d 897 (Fed. Cir. 1986)	3, 4
<i>In re Klopfenstein</i> , 380 F.3d 1345 (Fed. Cir. 2004)	5
<i>Mass. Institute of Tech. v. AB Fortia</i> , 774 F.2d 1104 (Fed. Cir. 1985)	5

Table of Authorities
(continued)

	Page(s)
<i>Merck v. Biocraft Labs.</i> , 874 F.2d 804 (Fed. Cir.), <i>cert. denied</i> , 493 U.S. 975 (1989)	12
<i>MotivePower, Inc. v. Cutsforth, Inc.</i> , IPR2013-00274, Paper 44 (PTAB Sept. 9, 2016).....	25
<i>Ormco Corp. v. Align Tech., Inc.</i> , 463 F.3d 1299 (Fed. Cir. 2006)	23
<i>In re Paulsen</i> , 30 F.3d 1475 (Fed. Cir. 1994)	24
<i>Sophos, Inc. v. Finjan, Inc.</i> , IPR2015-01022, Paper 7 (PTAB Sept. 24, 2015).....	16
<i>Tissue Transplant Tech. v. Mimedx Group</i> , IPR2015-00420, Paper 25 (PTAB July 7, 2016)	13
<i>Universal Remote Control v. Universal Elecs. Inc.</i> , IPR2014-01106, Paper 49 (PTAB Dec. 15, 2015)	24
<i>In re Wyer</i> , 655 F.2d 221 (Fed. Cir. 1981)	5

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.