

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Cisco System, Inc.
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

U.S. Patent No. 8,677,494
Issue Date: March 18, 2014
Title: Malicious Mobile Code Runtime Monitoring System and Methods

Inter Partes Review No.: IPR2017-02155

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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Cases

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I. INTRODUCTION

In Patent Owner's Preliminary Response, the Patent Owner (Finjan) requests that the Board exercise its discretion under 35 U.S.C. §314(a) and deny institution based on the *General Plastic* decision. *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017). However, Patent Owner's application of the *General Plastic* factors to this case is without legal support. Specifically, Petitioner (Cisco) had not been accused of infringement of the '494 Patent in litigation at the time any of the previous IPRs challenging the '494 Patent were filed by other parties, and therefore *General Plastic* simply does not apply. Moreover, even if *General Plastic* did apply, the factors weigh in Petitioner's favor, especially in view of the fact that any alleged delay in bringing this IPR petition was due to Patent Owner's own litigation tactics.

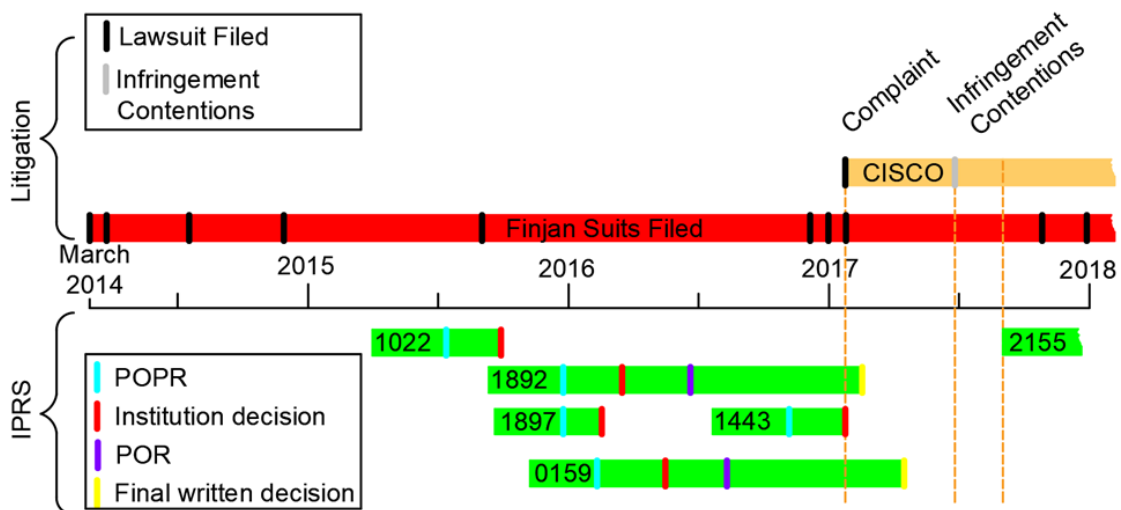
II. BACKGROUND

The '494 Patent has been the subject of multiple lawsuits filed by Patent Owner against various defendants over the last several years. Instead of filing all lawsuits in close temporal proximity, Patent Owner filed the lawsuits in serial fashion. For example, Patent Owner filed its first lawsuit alleging infringement of the '494 Patent in March 2014 (*Finjan, Inc. v. Sophos, Inc.*, Case 3:14-cv-01197, D.I. 1 (N.D.Cal. Mar. 14, 2014)), and recently filed its twelfth lawsuit alleging

infringement of the ‘494 Patent in December 2017 (*Finjan, Inc. v. Zscaler*, Case 3:17-cv-06946, D.I. 1 (N.D.Cal. Dec. 05, 2017)).

As a direct result of its infringement lawsuits, seven previous IPR petitions were filed challenging the ‘494 Patent (two of which were joined with previously filed petitions) and three IPR trials were instituted. *See* chart POPR p. 15. The first of the seven petitions was filed in April 2015, and the seventh (and final) previous petition was filed on July 15, 2016.

On January 12, 2017, Finjan served Cisco with a lawsuit asserting infringement of the ‘494 Patent. *Finjan, Inc. v. Cisco Systems, Inc.*, Case 5:17-cv-00072, D.I. 8 (N.D.Cal. Jan. 6, 2017). On June 22, 2017, Finjan served its infringement contentions on Cisco. On September 22, 2017, Cisco filed the instant IPR.. The timeline below shows the temporal relationship between the lawsuits filed by Finjan and the IPR petitions filed by defendants, including the present IPR.



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