

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2018-00391
Patent No. 7,647,633

PATENT OWNER'S MOTION TO EXCLUDE PETITIONER'S EVIDENCE

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64, Patent Owner Finjan, Inc. (“Finjan”) hereby moves to exclude the following exhibits submitted in this proceeding by Petitioner Cisco Systems, Inc. (“Cisco”): Exhibit 1029 (Web Security & Commerce, O’Reilly & Associates, Inc. Garfinkel and Spafford, June 1997), Exhibit 1003 (Declaration of Dr. Paul Clark). On June 19, 2018, Finjan timely filed its objections to the evidence in Petitioner’s Petition. Paper No. 9. On December 17, 2018, Patent Owner timely filed its objections to evidence in Petitioner’s Reply. Paper No. 17. The Board should grant Patent Owner’s Motion to Exclude for the reasons set forth below.

II. ARGUMENT

A. **The Board Should Exclude the Web Security & Commerce, O’Reilly & Associates, Inc. Garfinkel and Spafford, June 1997 (“Exhibit 1029”)**

The Reply improperly introduced Exhibit 1029, which is inadmissible under 37 C.F.R. § 42.61 and is properly subject to exclusion. *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081 (Fed. Cir. 2015) (“a party may move to exclude evidence, whether as improper under the response-only regulation, under the Trial Practice Guide’s advice, or on other grounds.”)(citation omitted). This belated submission is inadmissible under FRE 403 and should be excluded because it is improper and highly prejudicial for Petitioner to introduce new evidence in its

Reply when it should have been included in its petition. “[T]he expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute” unlike in district courts where “parties have greater freedom to revise and develop their arguments over time” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016); *see also Scotts Co. v. Encap, LLC*, IPR2013-00110, Paper 79 at 5-6 (P.T.A.B. June 24, 2014) (granting motion to exclude materials that were outside of the proper scope of a reply, where the new evidence could have been included with an earlier motion).

Therefore, Exhibit 1029 should be excluded.

B. The Board Should Exclude the Declaration of Dr. Paul Clark (Exhibit 1003, “Clark Declaration”)

The Clark Declaration should be excluded because his opinions are conclusory, do not disclose underlying facts or data in support of his opinions, and are unreliable. Fed. R. Evid. 702; *Intellectual Ventures Mgmt., LLC v. Xilinx, Inc.*, Case IPR2012-00020, Paper 34 at 10 (P.T.A.B. Feb. 11, 2014) (stating that an expert’s “conclusory testimony is entitled to little or no weight.”)(citing 37 C.F.R. § 42.65(a)); *Tietex Int’l, Ltd. v. Precision Fabrics. Grp., Inc.*, Case IPR2014-01248, Paper 39 at 17 (P.T.A.B. Jan. 27, 2016) (a lack of objective support for an expert opinion “may render the testimony of little probative value in [a patentability] determination.”) (quoting *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294 (Fed. Cir. 1985)).

Dr. Clark's opinion does not near the evidentiary requirement for an expert opinion in IPR proceedings because he fails to provide the underlying facts or data for his conclusory assertions. For example, Dr. Clark claims that "Hanson describes and POSA would have understood that the security program is attached (tagged) to the data packets (executable code) as a separate object that does not modify the data packets (executable code)," but fails to explain the basis for this statement, such as what it means to "attach" or "tag" a security program to data packets. Clark Declaration at 64, n.5.

Accordingly, because the Clark Declaration is not based on a proper analysis, his opinions are not based on sufficient facts or data and are thus unreliable. The Clark Declaration is not credible, irrelevant, and cannot assist the trier of fact and thus should be afforded no weight. Fed. R. Evid. 401-402, 702. Therefore, the Board should exclude the Clark Declaration.

III. CONCLUSION

For the foregoing reasons, Patent Owner Motion to Exclude should be granted.

Patent Owner's Motion to Exclude
IPR2018-00391 (U.S. Patent No. 7,647,633)

Respectfully submitted,

Dated: January 30, 2019

/James Hannah/

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