

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 7,647,633

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY

TABLE OF CONTENTS

	<u>Page</u>
I. Introduction.....	1
II. Claim Construction.....	2
A. Finjan’s Proposed Constructions Are Timely.....	2
B. Finjan’s Proposed Constructions Are Correct.....	2
1. “downloadable-information”	3
2. “information re-communicator/monitor”	5
3. “determining... whether the downloadable-information includes executable code”	7
III. The Challenged Claims Are Patentable.....	9
A. Petitioner Has Not Met Its Burden to Show That Hanson Discloses “receiving downloadable-information”	9
B. Petitioner Did Not Meet Its Burden to Show That Hanson in View of Hypponen Discloses an “information re- communicator”	12
C. Petitioner Did Not Meet Its Burden to Show That Hanson Discloses “providing a system”.....	13
D. Hanson Modifies Its Executable Code and Fails to Enable the Claim 14	14
E. Petitioner’s Arguments Regarding Factual Issues Identified by the Board In the Institution Decision Violate 37 C.F.R. § 42.23(b)	18
1. Finjan Did Not Waive Its Claim Construction Position	18
2. Petitioner Improperly “Replies” to Arguments Not Raised in the POR.....	19

3.	If The Board Considers Petitioner's Arguments It Should Consider Finjan's Arguments	22
4.	The Institution Decision Correctly Found Insufficient Evidence to Demonstrate the Unpatentability of Claims 1-4, 8, 11, 12, and 13	23
F.	Petitioner Did Not Submit a Statement of Material Facts	26
IV.	CONCLUSION.....	27

TABLE OF AUTHORITIES

	Page(s)
Federal Cases	
<i>Beachcombers v. Wildewood Creative Prods., Inc.</i> , 31 F.3d 1154 (Fed. Cir. 1994)	7
<i>Belden Inc. v. Berk-Tek LLC.</i> , 805 F.3d 1064 (Fed. Cir. 2015)	20
<i>Google Inc. v. Grandeye Ltd.</i> , IPR2013-00547, Paper 34 (P.T.A.B. Nov. 25, 2014).....	2
<i>Intelligent Bio-Systems v. Illumina Cambridge, Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	21
<i>In re Magnum Oil Tools Int'l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016)	20
<i>In re NuVasive, Inc.</i> , 842 F.3d 1376 (Fed. Cir. 2016)	20
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303, 1317 (Fed. Cir. 2005)).....	8
<i>SAS Institute, Inc. v. Complementsoft, LLC</i> , 825 F.3d 1341 (Fed. Cir. 2016)	19
Regulations	
37 C.F.R. § 42.23	1, 18, 19, 23
37 C.F.R. § 42.104	7, 21
37 C.F.R. § 42.107	20
37 C.F.R. § 42.120	20

PATENT OWNER'S EXHIBIT LIST

	Description
Exhibit-2001	Decision on Appeal, Ex Parte FINJAN, INC., Appeal 2016-004279, Reexamination Control No. 90/013,016, dated June 29, 2016.
Exhibit-2002	Final Written Decision, Palo Alto Networks, Inc. v. Finjan, Inc., Case No. IPR2015-01974, Paper 49, filed March 16, 2017.
Exhibit-2003	Decision - Partial Institution of Inter Partes Review - Palo Alto Networks, Inc. v. Finjan, Inc., Case No. IPR2015-01974, Paper 7, filed March 29, 2016.
Exhibit-2004	U.S. Patent No. 5,983,348 ("Ji").
Exhibit-2005	Eva Chen "Poison Java" IEEE Spectrum (1999).
Exhibit-2006	Insik Shin, et al., "Java Bytecode Modification and Applet Security" (1998).
Exhibit-2007	Declaration of James Hannah in Support of Patent Owner's Preliminary Response, Cisco Systems, Inc. v. Finjan, Inc., IPR2018-00391.
Exhibit-2008	Declaration of Dr. Nenad Medvidovic.
Exhibit-2009	Java™ 2: The Complete Reference, Third Ed., 1999 (excerpts).
Exhibit-2010	Just Java, 1996 (excerpts).
Exhibit-2011	Deposition Transcript of Dr. Paul Clark.
Exhibit-2012	Declaration of Phil Hartstein. (PROTECTIVE ORDER MATERIAL)

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.