UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD
JUNIPER NETWORKS, INC.
Petitioner,
V
V.
FINJAN, INC.,
Patent Owner.
Case IPR2019-00060
Patent 7,647,633

PATENT OWNER'S PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107



### **TABLE OF CONTENTS**

		<u>Page</u>			
I.	INTE	RODUCTION1			
II.	FAC	FACTS			
	A.	Overview of '633 Patent4			
	B.	Challenged Claims5			
III.	CLA	CLAIM CONSTRUCTION5			
	A.	"executable code" (all challenged claims)6			
	B.	"mobile protection code" (all challenged claims)6			
	C.	"downloadable-information" (all challenged claims)8			
	D.	"determining, by the computer, whether the downloadable-information includes executable code"			
	E.	"information re-communicator" and "information monitor" (claims 8 and 14)			
	F.	"A Computer Program Product The Method Comprising" (claims 14 and 19)			
IV.	THE	PETITION SHOULD BE DENIED UNDER 35 U.S.C. § 325(d)14			
	A.	The similarities and material differences between the asserted art and the prior art involved during examination			
	В.	The cumulative nature of the asserted art and the prior art evaluated during examination			
	C.	The extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection			
	D.	The extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;			



	E.	Whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art			
	F.	the P	extent to which additional evidence and facts presented in etition warrant reconsideration of the prior art or ments.	20	
V.	THE PETITION SHOULD BE DENIED UNDER 35 U.S.C. § 314(a)			20	
	A.	Facto	or 1 Weighs Slightly Against Institution or is Neutral	22	
	B.	Facto	or 2 Weighs Against Institution	22	
	C.	Facto	or 3 Weighs Against Institution	23	
	D.	Facto	or 4 Weighs Against Institution	25	
	E.	Facto	or 5 Weighs Against Institution	26	
	F.	Factor 6 Weighs Against Institution			
	G.	Factor 7 is Neutral			
VI.	THE CHALLENGED CLAIMS ARE PATENTABLE				
	A.	Ground 1 Fails to Demonstrate a Reasonable Likelihood That Any Challenged Claim is Unpatentable			
		1.	Sonnenberg In View of Jensen Fails to Disclose "determining, by the computer, whether the downloadable-information includes executable code" (claims 1 and 8)	28	
		2.	Sonnenberg In View of Jensen Fails to Disclose "mobile protection code" (all challenged claims)	31	
	B.		on Alone and Hanson in View of Lemay Fail to Render ous Claims 1, 8, 14, and 19	33	
		1.	Hanson Alone and Hanson in View of Lemay Does Not Disclose "receiving[] downloadable-information"	34	



# Patent Owner's Preliminary Response IPR2019-00060 (U.S. Patent No. 7,647,633)

	2.	Hanson in View of Learnay Does Not Disclose an "information re-communicator" or an "information	
		monitor"	36
	3.	Hanson Alone and Hanson in View of Leamay Does Not Disclose an "determining, by the computer, whether the downloadable-information includes executable code"	37
	4.	Hanson Alone Does Not Disclose "causing mobile protection code to be executed by the mobile code executor at a downloadable-information destination such that one or more operations of the executable code at the destination, if attempted, will be processed by the mobile protection code"	39
		a. Petitioner's Argument That Hanson Does Not Disclose Modifying the Executable Code Should be Rejected	40
		b. Hanson is Not Enabled	42
		c. To the Extent That Hanson is Comprehensible, it Teaches Modifying the Executable Code	43
	5.	Hanson Does Not Disclose "providing a system, wherein the system comprises distinct software modules, and wherein the distinct software modules comprise an information re-communicator and a mobile code	
		executor"	46
Л	CONCLUS	ION	48



### **TABLE OF AUTHORITIES**

	Page(s)
Cases	
Aqua Prods., Inc. v. Matal, 872 F.3d 1290 (Fed. Cir. 2017)	8
Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1551 (Fed. Cir. 1989)	42
Becton, Dickinson & Co. v. B. Braun Melsungen AG, Case IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017)	16
In re Cuozzo Speed Techs., LLC, 793 F.3d 1268 (Fed. Cir. 2015)	6
Eset, LLC v. Finjan, Inc., Case IPR2017-01738, Paper 21 (P.T.A.B. June 18, 2018)	16
General Plastic Industrial Co. v. Canon Kabushiki Kaisha, Case IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017)	passim
In re Kumar, 418 F.3d 1361 (Fed. Cir. 2005)	42
Microsoft Corp. v. Proxyconn, Inc., 789 F. 3d 1292, 1298 (Fed. Cir. 2015)	8
Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1471 (Fed.Cir.1997)	42
See NetApp Inc. v. Realtime Data LLC, Case IPR2017-01195, Paper 9 at 10 (P.T.A.B. Oct. 12, 2017)	21, 22
In re NTP, Inc., 654 F.3d 1279, 1288 (Fed. Cir. 2011)	8
Palo Alto Networks, Inc. v. Finjan, Inc., IPR2015-01974, Final Written Decision, Paper 49 (P.T.A.B. Mar. 16, 2017)	39



# DOCKET

# 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.

