UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Juniper Networks, Inc.,
Petitioner

v.

Finjan, Inc.,
Patent Owner

IPR2019-00060
Patent No. 7,647,633

PETITIONER'S REQUEST FOR REHEARING

Mail Stop: PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

Page(s)

I. INTRODUCTION

On April 29, 2019, the Board denied institution of *inter partes* review of U.S. Patent No. 7,647,633 ("the '633 Patent"), rejecting Petitioner's assertion that certain claims of the '633 Patent are unpatentable over prior art Sonnenberg in view of prior art Jensen (Ground 1). *See* Paper 7 (Institution Decision) at 13. In its Institution Decision, the Board misapprehended the critical difference between Petitioner's and Patent Owner's constructions of the term "mobile protection code" and, as a result, failed to resolve the key claim construction dispute between the parties as required. *See Homeland Housewares, LLC v. Whirlpool Corp.*, 865 F.3d 1372, 1374-75 (Fed. Cir. 2017) (citing *O2 Micro Int'l, Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008)) (requiring the Board to resolve claim construction disputes when a disputed term is relied upon for a holding on the merits). As explained further below, the Board's failure to resolve the key claim construction dispute led to a logically unsupportable holding regarding the purported deficiency in the prior art. Rehearing is therefore warranted to resolve the claim construction dispute between the parties and fix the plain error in the Institution Decision.

II. LEGAL STANDARD

"A party dissatisfied with a decision may file a request for rehearing without prior authorization from the Board" and must "specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each

matter was previously addressed in a motion, opposition, or a reply." 37 C.F.R. § 42.71(d). This request is timely filed within 30 days from the Institution Decision denying institution. *See* 37 C.F.R. § 42.71(d)(2).

III. ARGUMENT

The Board fundamentally misapprehended the dispute between the parties regarding the construction of the term "mobile protection code" (hereinafter, "MPC"). In the Institution Decision, the Board stated:

> According to Patent Owner, the difference between Petitioner and Patent Owner's constructions is that Petitioner's broader construction does not specify that the mobile protection code monitors and intercepts operations *without modifying the executable code*.

Paper 7 (Institution Decision) at 5 (emphasis in original). The Board erred in adopting Patent Owner's characterization of the claim construction dispute.[1] The actual dispute between the parties is completely different and has nothing to do with whether MPC modifies the executable code or not.

[1] Petitioner does not oppose Patent Owner's proposal that MPC operate "without modifying the executable code" and therefore there is no dispute with respect to this issue.

As background, the Petition proposed that the broadest reasonable interpretation of "mobile protection code" (MPC) is "code ***for causing*** one or more predetermined malicious operations or operation combinations of a Downloadable to be monitored or otherwise intercepted." Paper 2 (Petition) at 9 (emphasis added). The Petition explained the practical import of this "for causing" language was that the MPC does not ***itself*** have to monitor or intercept operations but rather may work in conjunction with other software, such as the operating system, in order to cause monitoring or intercepting to occur. *Id.* at 9-10. The Petition then explained how, under this construction that does not require the MPC to itself monitor or intercept, prior art Jensen's "protection wrappers" constitute MPC because Jensen's protection wrappers cause monitoring or intercepting by the operating system's Access Control Lists. *See* Paper 2 (Petition) at 25-27.

In its argument distinguishing the prior art, Patent Owner implicitly disputed Petitioner's claim construction of MPC with respect to whether MPC must "itself" monitor or intercept. Patent Owner argued that prior art Jensen did not teach MPC for the following reason:

> As Petitioner readily acknowledges, Jensen's technique involves a "protection wrapper" that does not, ***itself*** "monitor[] or intercept[] actually or potentially malicious

DOCKET ALARM

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.