EXHIBIT A

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

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PALO ALTO NETWORKS, INC.,
Appellant

v.

FINJAN, INC.,
Cross-Appellant

————————————

2017-2543, 2017-2623

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Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2016-00159, IPR2016-01174.

FINJAN, INC.,
Appellant

v.

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,
Intervenor

————————————

2   PALO ALTO NETWORKS, INC. v. FINJAN, INC.

2017-2047

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Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2015-01892, IPR2016-00890.

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Decided: July 2, 2019

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ORION ARMON, Cooley LLP, Broomfield, CO, argued for appellant Palo Alto Networks, Inc.

PAUL J. ANDRE, Kramer Levin Naftalis & Frankel LLP, Menlo Park, CA, argued for cross-appellant and appellant Finjan, Inc. Also represented by JAMES R. HANNAH.

ROBERT MCBRIDE, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, argued for intervenor. Also represented by THOMAS W. KRAUSE, MAI-TRANG DUC DANG, FARHEENA YASMEEN RASHEED.

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Before WALLACH, LINN, and HUGHES, *Circuit Judges.*

HUGHES, *Circuit Judge.*

This decision arises from the consolidated appeals of three *inter partes* reviews of a computer security patent. Symantec Corp., Blue Coat Systems LLC, and Palo Alto Networks, Inc., petitioned for *inter partes* review of U.S. Patent No. 8,677,494 B2. The Patent Trial and Appeal Board instituted partial review of the challenged claims. The Board found claims 3–5 and 10–15 to be not unpatentable but determined that claims 1, 2, and 6 of the '494 patent are unpatentable as obvious over Swimmer. Palo Alto Networks appeals the Board's decision on the '494 patent's priority date and the patentability of claims 10, 11, and 15.

Finjan, Inc. cross-appeals the Board's finding that claims 1, 2, and 6 are unpatentable. For the following reasons, we affirm the Board's final decision.

I

A.

Finjan, Inc., owns the '494 patent, which expired on January 29, 2017, and is directed to "protection systems and methods capable of protecting a personal computer [] or other" devices from "'malicious' operations." '494 patent col. 2 ll. 51–56. The '494 patent addresses issues in virus detection. Internet browsers allow individuals to attach executable programs to their websites, some of which may contain malicious code that runs automatically upon opening a website. Early antivirus software systems had trouble processing these programs, called Downloadables. The '494 patent describes a method to detect viruses within Downloadables using a two phased approach comprised of an inspection phase and a determination phase.

Independent claims 1 and 10 of the '494 patent are representative for purposes of this appeal and are reproduced below.

> 1. A computer-based method, comprising the steps of:
>
> receiving an incoming Downloadable;
>
> *deriving security profile data for the Downloadable, including a list of suspicious computer operations that may be attempted by the Downloadable*; and
>
> storing the Downloadable security profile data in a database.

'494 patent col. 21 ll. 19–25 (emphasis added).

> 10. A system of managing Downloadables, comprising:

PALO ALTO NETWORKS, INC. v. FINJAN, INC.

> a receiver for receiving an incoming Downloadable;
>
> *a Downloadable scanner* coupled with said re-ceiver, for deriving security profile data for the Downloadable, including a list of suspicious com-puter operations that may be attempted by the Downloadable; and
>
> a database manager coupled with said Down-loadable scanner, for storing the Downloadable se-curity profile data in a database.

Id. col. 22 ll. 7–16 (emphasis added).

Only the inspection phase is relevant to this appeal. It entails three steps. First, the computer receives a Down-loadable from an external network. Second, the system an-alyzes the executable code of the Downloadable to generate Downloadable security profile (DSP) data. The Down-loadable scanner in claim 10 is a code scanner that gener-ates the DSP data by decomposing the code using conventional parsing techniques. The code scanner identi-fies suspicious computer operations in the Downloadable code and lists them as DSP data. Finally, the DSP data for the Downloadable is stored in a database.

B.

On March 6, 2014, Finjan filed a Petition to Accept an Unintentionally Delayed Priority Claim pursuant to 37 C.F.R. § 1.78 to fix a break in the '494 patent's priority chain. Finjan sought to include U.S. Patent Nos. 6,092,194 (Touboul) and 6,167,502 as parent applications in U.S. Pa-tent No. 7,058,822, which is a parent of the '494 patent. On February 16, 2016, the Patent Office issued a reexamina-tion certificate amending the specification of the '822 pa-tent. Because the '494 patent is a continuation of the '822 patent, this certificate effectively amended the specifica-tion of the '494 patent to incorporate Touboul by reference and change its priority date to 1997.

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