

Exhibit M

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Paper No. 11
Filed: April 3, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2017-02155
Patent 8,677,494 B2

Before ZHENYU YANG, CHARLES J. BOUDREAU, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

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undesirable, suspicious or other ‘malicious’ operations that might otherwise be effectuated by remotely operable code.” Ex. 1001, 2:51–56. “[R]emotely operable code that is protectable against can include,” for example, “downloadable application programs, Trojan horses and program code groupings, as well as software ‘components’, such as Java™ applets, ActiveX™ controls, JavaScript™/Visual Basic scripts, add-ins, etc., among others.” *Id.* at 2:59–64.

C. Illustrative Claim

Of the challenged claims, only claim 10, reproduced below, is independent.

10. A system for managing Downloadables, comprising:
 - a receiver for receiving an incoming Downloadable;
 - a Downloadable scanner coupled with said receiver, for deriving security profile data for the Downloadable, including a list of suspicious computer operations that may be attempted by the Downloadable; and
 - a database manager coupled with said Downloadable scanner, for storing the Downloadable security profile data in a database.

Ex. 1001, 22:7–16.

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D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claims	Basis	References
10, 11, 14–16	§ 103	Shear ¹ and Kerchen ²
10, 11, 14–16	§ 103	Crawford 91 ³ and the knowledge of a person of ordinary skill in the art

Pet. 24. Petitioner also relies on a Declaration of Dr. Paul Clark, filed as Exhibit 1003.

II. DISCUSSION

A. Claim Construction

Based on the '494 patent's claim of priority from U.S. Patent Application No. 08/790,097, filed January 29, 1997, the '494 patent expired no later than January 29, 2017. *See* 35 U.S.C. § 154(a)(2). In an *inter partes* review, we construe claims of an expired patent according to the standard applied by the district courts. *See In re Rambus Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). Specifically, we apply the principles set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc).

¹ US 6,157,721, issued Dec. 5, 2000 (filed Aug. 12, 1996) (Ex. 1004).

² Paul Kerchen et al., *Static Analysis Virus Detection Tools for UNIX Systems*, Proc. 13th Nat'l Computer Security Conf. 350 (1990) (Ex. 1019).

³ R. Crawford et al., *A Testbed for Malicious Code Detection: A Synthesis of Static and Dynamic Analysis Techniques*, Proc. 14th Ann. Conf. Dep't Energy Computer Security Group (1991) (Ex. 1011).

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Under that standard, the words of a claim are generally given their “ordinary and customary meaning,” which is the meaning the term would have to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *See Phillips*, 415 F.3d at 1312–13. Only those terms in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Petitioner contends that each of the claim terms in the challenged claims should be given its plain and ordinary meaning and that no specific construction of any term is required. Pet. 11. Petitioner nonetheless addresses the phrase “a list of suspicious computer operations,” as recited in independent claim 10, “in light of arguments that Patent Owner has made in previous proceedings.” *Id.* Patent Owner responds to Petitioner’s arguments concerning this phrase and additionally proposes that the term “database,” which also is recited in independent claim 10, should be construed. Prelim. Resp. 4–11.

1. “*a list of suspicious computer operations*”

Petitioner contends, in particular, that although neither the previous petitioners nor Patent Owner explicitly sought a construction of the phrase “a list of suspicious computer operations” in prior *inter partes* review proceedings, Patent Owner “implicitly sought a narrow claim construction in [IPR2015-01894] . . . by arguing that this element . . . excludes the identification of non-suspicious operations, code or functions in the DSP.”

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