

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOPHOS, INC.,

Petitioner,

v.

FINJAN, INC.,

Patent Owner.

Case IPR2015-01022

Patent 8,677,494

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

TABLE OF CONTENTS

I. INTRODUCTION 1

II. THE ‘494 PATENT 4

 A. Overview 4

 B. The Prior Art 6

 C. Challenged Claims 8

 D. Prosecution History 8

III. CLAIM CONSTRUCTION 8

 A. “Downloadable” (claims 1, 10, 14, and 14): 8

 B. “suspicious computer operations” (claims 1, 10, 14, and 18) 9

 C. “database” (claims 1, 10, 14, and 18) 12

 D. “program script” (claim 14) 14

IV. THE ASSERTED REFERENCES 16

 A. TBAV (Ex. 1006) 16

 1. TBAV IS NOT PRIOR ART UNDER 35 U.S.C. § 102(a) 18

 B. Ji (Ex. 1009) 19

 C. Chen (Ex. 1010) 20

 D. Arnold (Ex. 1008) 21

V. SPECIFIC REASONS WHY THE CITED REFERENCES DO NOT
INVALIDATE THE CLAIMS, AND WHY INTER PARTES REVIEW
SHOULD NOT BE INSTITUTED 21

 A. Ground 1: TBAV in view of Ji does not render the Challenged Claims
obvious under 35 U.S.C. § 103(a) 21

1.	TBAV in view of Ji fails to disclose: “receiving an incoming Downloadable”	21
2.	TBAV in view of Ji fails to disclose: “deriving security profile data for the Downloadable, including a list of suspicious computer operations that may be attempted by the Downloadable”	23
3.	TBAV in view of Ji fail to disclose: “storing the Downloadable security profile data in a database.”	27
4.	The Proposed Combination of TBAV with Ji is a Product of Hindsight Bias	32
B.	Ground 2: TBAV in view of Ji and Chen does not render the Challenged Claims obvious under 35 U.S.C. § 103(a)	34
1.	TBAV in view of Ji and Chen fail to disclose: “wherein the Downloadable includes program script”	34
2.	The Proposed Combination of TBAV and Ji with Chen is a Product of Hindsight Bias	36
C.	Ground 3: Arnold in view of Chen and Ji does not render the Challenged Claims obvious under 35 U.S.C. § 103(a)	37
1.	Arnold fails to disclose: “receiving an incoming Downloadable”	37
2.	Arnold in view of Chen and Ji fail to disclose: “deriving security profile data for the Downloadable, including a list of suspicious computer operations that may be attempted by the Downloadable”	38
3.	Arnold in view of Chen and Ji fail to disclose: “storing the Downloadable security profile data in a database.”	43
4.	Arnold in view of Chen and Ji does not disclose: “wherein the Downloadable includes program script	46
5.	The Proposed Combination of Arnold with Ji is a Product of Hindsight Bias	47

D. Ground 4: Chen in view of Arnold and Ji does not render the Challenged Claims obvious under 35 U.S.C. § 103(a)49

1. Chen fails to disclose: “receiving an incoming Downloadable”49

2. Chen in view of Arnold and Ji fail to disclose: “deriving security profile data for the Downloadable, including a list of suspicious computer operations that may be attempted by the Downloadable”50

3. Chen in view of Arnold and Ji fail to disclose: “storing the Downloadable security profile data in a database.”51

4. The Proposed Combination of Chen with Arnold is a Product of Hindsight Bias.....53

5. Chen in view of Arnold and Ji does not disclose: “wherein the Downloadable includes program script54

6. The Proposed Combination of Chen with Ji is a Product of Hindsight Bias.....54

VI. PETITIONER’S OBVIOUSNESS ARGUMENTS FAIL AS A MATTER OF LAW BECAUSE IT DID NOT CONDUCT A COMPLETE OBVIOUSNESS ANALYSIS55

VII. THE PROPOSED GROUNDS ARE CUMULATIVE59

VIII. TBAV IS NOT PRIOR ART UNDER 35 U.S.C. § 102(a).....59

IX. CONCLUSION.....60

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Al-Site Corp. v. VSI Int'l</i> , 174 F.3d 1308 (Fed. Cir. 1999)	34
<i>Apple Inc. v. Int'l Trade Comm'n</i> , 725 F.3d 1356 (Fed. Cir. 2013)	56
<i>In re Baxter Int'l</i> , 678 F.3d 1357 (Fed. Cir. 2012)	12
<i>In re Cortright</i> , 165 F.3d 1353 (Fed. Cir. 1999)	28
<i>Digital-Vending Services International, LLC v. The University of Phoenix, Inc.</i> , No. 11-1216 (Fed. Cir. Mar. 7, 2012).....	4, 10
<i>Estee Lauder Inc. v. L'Oreal, SA</i> , 129 F.3d 588 (Fed. Cir. 1997)	25
<i>Graham v. John Deere Co. of Kansas City</i> , 383 U.S. 1 (1966).....	42, 56
<i>Insite Vision, Inc. v. Sandoz, Inc.</i> , 783 F.3d 853 (Fed. Cir. 2015)	29, 33
<i>Interactive Gift Express, Inc. v. Compuserve, Inc.</i> , 256 F.3d 1323 (Fed. Cir. 2001)	9
<i>KSR v. Teleflex</i> , 550 U.S. 398 (2007).....	<i>passim</i>
<i>Leo Pharmaceutical v. Rea</i> , 726 F.3d 1346 (Fed. Cir. 2013)	57, 58
<i>Microsoft Corp. v. Proxyconn, Inc.</i> , Nos. 2014-1542, 2014-1543, 2015 WL 3747257 (Fed. Cir. 2015).....	12

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.