

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SOPHOS INC.,  
Petitioner

v.

FINJAN, INC.,  
Patent Owner

U.S. Patent No. 8,677,494

Filing Date: November 7, 2011

Issue Date: March 18, 2014

Title: Malicious Mobile Code Runtime Monitoring System And Methods

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*Inter Partes* Review No.: IPR2015-01022

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**PETITIONER'S REQUEST FOR REHEARING OF  
DECISION DENYING INSTITUTION OF *INTER PARTES* REVIEW OF  
U.S. PATENT NO. 8,677,494**

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Pursuant to 37 CFR §42.71, Sophos Inc. (“Petitioner”) respectfully moves for rehearing of the Decision Denying Institution of *Inter Partes* Review issued on September 24, 2015 (Paper 7) (the “Decision”), as to claims 1, 10, 14, and 18 (“challenged claims”) of U.S. Patent No. 8,677,494 (the “’494 patent”) (Ex. 1001).

## **I. Introduction**

Petitioner seeks reconsideration of the denial of two of the four grounds of unpatentability raised in the petition the grounds based on TBAV, Grounds 1 and 2. The Board denied institution on these two grounds because it found that TBAV did not disclose two claim elements. First, the Board found that TBAV did not disclose deriving a “list of suspicious computer operations” because the Board disagreed with Petitioner’s construction, finding that “‘instructions’ are not themselves ‘operations.’” However, the Board acknowledged that “operations” can be the result of executing “instructions,” and the Petition includes multiple statements that TBAV disclosed “instructions that perform ... operations.” Thus, the Board abused its discretion by finding that the Petition failed to establish that TBAV discloses deriving a “list of suspicious computer operations” through its identification in TBAV of suspicious instructions that perform suspicious operations.

The Board also denied institution on the Grounds 1 and 2 because it adopted a construction of “database” and found that TBAV did not disclose storing

downloadable security profile data in a “database” under that construction. This construction is legal error because it is not the broadest reasonable construction. The Board acknowledged that there was no evidence of any disavowal of claim scope in the intrinsic evidence, but then proceeded to select the narrowest of four definitions of “database” despite the fact that the other broader definitions were consistent with the specification. Under the correct broadest reasonable construction, TBAV discloses the storage of security profile data in a “database.” Accordingly, both reasons given by the Board for failing to institute trial based on the TBAV are faulty and Petitioner’s request for rehearing should be granted.

## **II. Factual Background**

Petitioner submitted its Petition on April 8, 2015. The Petition presented four grounds of unpatentability of the challenged claims based on four prior art references: *ThunderBYTE Anti-Virus Utilities User Manual*, ThunderBYTE B.V. (1995) (“TBAV”) (Ex. 1006), U.S. Patent No. 5,440,723 (“Arnold”) (Ex. 1008), U.S. Patent No. 5,623,600 (“Ji”) (Ex. 1009), and U.S. Patent No. 5,951,618 (“Chen”) (Ex.101). Petition at 4. Petitioner supported its petition with the Declaration of Paul Clark (“Clark Declaration”) (Ex. 1002).

Patent Owner filed its Preliminary Response to the Petition (Paper 6) on July 14, 2015. The Board, citing to several of Patent Owner’s arguments, denied institution of *inter partes* review on all grounds in the Petition.

### III. Legal Standard

In considering a rehearing request under 37 C.F.R. § 42.71(d), the Board reviews a prior decision “for an abuse of discretion.” 37 C.F.R. § 42.71(c). “The burden of showing a decision should be modified lies with the party challenging the decision. The request 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, an opposition, or a reply.” 37 C.F.R. § 42.71(d). “An abuse of discretion occurs when a ‘decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or... a clear error of judgment.’” *Illumina, Inc. v. Trustees of Columbia University*, IPR2013-00011, Paper 44 at 2 (Patent Tr. & App. Bd. May 10, 2013) (citing *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988)). When the Board misapprehends or overlooks issues establishing a reasonable likelihood of success for the Petitioner, an *inter partes* review should be granted. *Handi Quilter, Inc. v. Bernina International, AG*, IPR 2014-00720, paper 17 at 23-24. (Patent Tr. & App. Bd. December 30, 2014).

### IV. Argument

The Board, relying on Patent Owner’s arguments in its Preliminary Response (at 16-37), concluded that the challenged claims are not obvious over TBAV in view of Ji and/or Chen. The Patent Owner’s arguments were supported

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