

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYMANTEC CORP. and
BLUE COAT SYSTEMS LLC,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2015-01892¹
Patent 8,677,494 B2

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

BOUDREAU, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

¹ Case IPR2016-00890 has been joined with the instant proceeding.

I. INTRODUCTION

Symantec Corp. and Blue Coat Systems, Inc., now known as Blue Coat Systems LLC,² (collectively, “Petitioner”) filed petitions requesting *inter partes* review of claims 1, 2, 5, 6, 10, 11, 14, and 15 of U.S. Patent No. 8,677,494 B2 (Ex. 1001, “the ’494 patent”). Paper 1 (“Petition” or “Pet.”); *see also* IPR2016-00890, Paper 2.

Based on the information provided in the Petition, and in consideration of the Preliminary Response (Paper 7) of Patent Owner, Finjan, Inc., we instituted a trial pursuant to 35 U.S.C. § 314(a) with respect to claims 1, 2, 5, 6, 10, 11, 14, and 15 and subsequently joined Case IPR2016-00890 with the instant case. Paper 9 (“Decision on Institution” or “Dec. on Inst.”); *see also* Paper 30 (copy of decision instituting *inter partes* review in Case IPR2016-00890 and granting motion for joinder; also filed as IPR2016-00890, Paper 8).

After institution, Patent Owner filed a Partial Request for Rehearing Pursuant to 37 C.F.R. §§ 42.71(c) and 42.71(d) (Paper 13), challenging our decision to institute trial, and we issued a Decision Denying Patent Owner’s Request for Rehearing (Paper 21, “Rehearing Decision” or “Reh’g Dec.”). Thereafter, Patent Owner filed a Response (Paper 27 (“PO Resp.”)), and Petitioner filed a Reply (Paper 31, “Pet. Reply”). Petitioner proffered Declarations of Sylvia Hall-Ellis, Ph.D. (Ex. 1006) and Jack W. Davidson, Ph.D. (Ex. 1018) with its Petition; and a Reply Declaration of Dr. Davidson (Ex. 1027), a Supplemental Declaration of Dr. Hall-Ellis (Ex. 1037), and Declarations of Richard Ford, D.Phil. (Ex. 1038) and Joseph

² *See* Paper 54, 1.

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Kiegel (Ex. 1041) with its Reply. Patent Owner proffered Declarations of Nenad Medvidovic, Ph.D. (Ex. 2007) and S.H. Michael Kim (Ex. 2010) with its Response. Also, deposition transcripts were filed for Dr. Medvidovic (Ex. 1034), Dr. Hall-Ellis (Ex. 2011), and Dr. Davidson (Ex. 2012).

Patent Owner moves to exclude certain of Petitioner's Exhibits, including each of the Declarations proffered with the Reply. Paper 41. Petitioner filed an Opposition (Paper 48) to the motion, and Patent Owner filed a reply (Paper 51).

Patent Owner also filed an identification of arguments alleged to exceed the proper scope of Petitioner's Reply (Paper 39), to which Petitioner filed a response (Paper 46). Patent Owner further filed a Motion for Observations on Testimony of Dr. Davidson (Paper 42), and Petitioner filed a response thereto (Paper 47).

An oral hearing was held on December 16, 2016; a transcript of the hearing is included in the record (Paper 56, "Tr.").

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1, 2, and 6 of the '494 patent are unpatentable.

We also deny-in-part and dismiss-in-part Patent Owner's Motion to Exclude.

II. BACKGROUND

A. *Related Proceedings*

The parties identify six district court actions involving the '494 patent: *Finjan, Inc. v. Sophos, Inc.*, No. 3:14-cv-01197 (N.D. Cal. 2014) ("the

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Sophos litigation”), *Finjan v. Websense, Inc.*, No. 14-cv-01353 (N.D. Cal. 2014), *Finjan, Inc. v. Symantec Corp.*, No. 3:14-cv-02998 (N.D. Cal. 2014), *Finjan, Inc. v. Palo Alto Networks, Inc.*, No. 3:14-cv-04908 (N.D. Cal. 2014), *Finjan, Inc. v. Blue Coat Systems, Inc.*, No. 5:15-cv-03295 (N.D. Cal. 2015), and *Finjan, Inc. v. Cisco Systems Inc.*, No. 17-cv-00072 (N.D. Cal. 2017). Pet. 1; Paper 6, 1; PO Resp. 57; Paper 54, 1.

The '494 patent is also the subject of an *inter partes* review in *Palo Alto Networks, Inc. v. Finjan, Inc.*, Case IPR2016-00159, to which *Blue Coat Systems, Inc. v. Finjan, Inc.*, Case IPR2016-01174, has been joined; and was the subject of denied petitions for *inter partes* review in *Sophos Inc. v. Finjan, Inc.*, Case IPR2015-01022, *Symantec Corp. v. Finjan, Inc.*, Case IPR2015-01897, and *Blue Coat Systems, Inc. v. Finjan, Inc.*, Case IPR2016-01443.

B. The '494 Patent

The '494 patent, entitled “Malicious Mobile Code Runtime Monitoring System and Methods,” issued March 18, 2014, from U.S. Patent Application No. 13/290,708 (“the '708 application”), filed November 7, 2011. Ex. 1001, [21], [22], [45], [54]. On its face, the '494 patent purports to claim priority from nine earlier applications: (1) U.S. Provisional Application No. 60/030,639 (“the '639 provisional”), filed November 8, 1996; (2) U.S. Patent Application No. 08/790,097, filed January 29, 1997, and issued as U.S. Patent No. 6,167,520 (“the '520 patent”); (3) U.S. Patent Application No. 08/964,388 (“the '388 application”), filed November 6, 1997, and issued as U.S. Patent No. 6,092,194 (Ex. 1013, “the '194 patent”); (4) U.S. Patent Application No. 09/539,667, filed March 30, 2000, and issued as U.S. Patent No. 6,804,780 (Ex. 2028, “the '780 patent”);

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(5) U.S. Patent Application No. 09/551,302, filed April 18, 2000;
(6) U.S. Provisional Patent Application No. 60/205,591, filed May 17, 2000;
(7) U.S. Patent Application No. 09/861,229, filed May 17, 2001;
(8) U.S. Patent Application No. 11/370,114 (“the ’114 application”), filed March 7, 2006; and (9) U.S. Patent Application No. 12/471,942, filed May 26, 2009. Ex. 1001, [63]. In our Decision on Institution in Case IPR2016-00159, we determined on the record then before us in that case that the ’494 patent is not entitled to an earlier priority date than the November 6, 1997, filing date of the ’388 application, due to the failure of the intermediate ’114 application to include priority claims either to the ’639 provisional or to the ’097 application. *See* IPR2016-00159, slip op. at 10–13 (PTAB May 13, 2016) (Paper 8). That determination does not affect any of our conclusions in this case.

The ’494 patent describes protection systems and methods “capable of protecting a personal computer (‘PC’) or other persistently or even intermittently network accessible devices or processes from harmful, undesirable, suspicious or other ‘malicious’ operations that might otherwise be effectuated by remotely operable code.” Ex. 1001, 2:51–56. “Remotely 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.

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