

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYMANTEC CORP.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2015-01892
Patent 8,677,494 B2

Before JAMES B. ARPIN, ZHENYU YANG, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

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

I. INTRODUCTION

Symantec Corp. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review pursuant to 35 U.S.C. § 311 of claims 1, 2, 5, 6, 10, 11, 14, and 15 of U.S. Patent No. 8,677,494 B2 to Edery et al. (Ex. 1001, “the ’494 patent”). Pet. 1. Finjan, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). We review the Petition under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

For the reasons that follow and on this record, we are persuaded that Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of each of the challenged claims. Accordingly, we institute an *inter partes* review as to those claims.

A. 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, of which the earliest-filed is U.S. Provisional Application No. 60/030,639, filed November 8, 1996 (Ex. 1002, “the ’639 application”). We need not make a determination on this record whether or not the challenged claims are entitled to the benefit of the filing dates of any of those earlier applications.

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.” *Id.* at 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.

B. Related Proceedings

The '494 patent is the subject of a district court action between the parties, *Finjan, Inc. v. Symantec Corp.*, 3:14-cv-02998 (N.D. Cal. 2014), and has also been asserted in three other district court actions, *Finjan, Inc. v. Sophos, Inc.*, 3:14-cv-01197 (N.D. Cal. 2014), *Finjan, Inc. v. Palo Alto Networks, Inc.*, 3:14-cv-04908 (N.D. Cal. 2014), and *Finjan, Inc. v. Blue Coat Systems, Inc.*, 5:15-cv-03295 (N.D. Cal. 2015). Pet. 1; Paper 5, 1.

Petitioner also filed another petition seeking *inter partes* review of the '494 patent (Case IPR 2015-01897), a petition seeking *inter partes* review of related U.S. Patent No. 6,154,844 (Case IPR2015-01894), and two petitions seeking *inter partes* review of related U.S. Patent No. 7,613,926 (Cases IPR2015-01893 and IPR2015-01895). Pet. 1. Each of those petitions has been denied (Case IPR2015-01893, Paper 8; Case IPR2014-01894, Paper 7; Case IPR2015-01895, Paper 7; Case IPR2015-01897, Paper 7).

Additionally, a petition filed by Sophos Inc. seeking *inter partes* review of the '494 patent was denied on September 24, 2015 (Case IPR2015-01022,

Paper 7), and a petition filed by Palo Alto Networks, Inc. seeking *inter partes* review of the '494 patent is pending currently (Case IPR2016-00159, Paper 1).

C. Illustrative Claims

Of the challenged claims, claims 1 and 10 are independent. Those claims are illustrative 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.

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, 21:19–25, 22:7–16. Each of challenged claims 2, 5, and 6 depends directly from claim 1; and each of challenged claims 11, 14, and 15 depends directly from claim 10. *Id.* at 21:26–28, 21:33–37, 22:17–20, 22:26–30.

D. References Relied Upon

Petitioner relies on the following references:

Exhibit	Reference
1003	US 5,313,616, issued May 17, 1994 (“Cline”)
1004	Stephanie Forrest et al., <i>A Sense of Self for Unix Processes</i> , PROC. 1996 IEEE SYMPOSIUM ON SEC. & PRIVACY 120 (1996) (“Forrest”) ¹
1005	Morton Swimmer et al., <i>Dynamic Detection and Classification of Computer Viruses Using General Behaviour Patterns</i> , VIRUS BULL. CONF. 75 (Sept. 1995) (“Swimmer”) ²
1012	US 5,623,600, issued Apr. 22, 1997 (filed Sept. 26, 1995) (“Ji”)

Pet. 3–5. Petitioner also relies on declarations of Sylvia Hall-Ellis, Ph.D. (Ex. 1006) and Jack W. Davidson, Ph.D. (Ex. 1018).

¹ Petitioner adduces evidence that Forrest was available to the public as of June 21, 1996. Pet. 4 (citing Ex. 1006, 7–8, 11–12, 15–17; Ex. 1008; Ex. 1009).

² Petitioner adduces evidence that Swimmer was available to the public as of December 1, 1995. Pet. 4–5 (citing Ex. 1006, 7–8, 11–12, 18–20; Ex. 1010; Ex. 1011).

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.