

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.

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Case IPR2015-00907  
Patent 7,613,926 B2

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

ARPIN, *Administrative Patent Judge*.

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

## I. INTRODUCTION

Sophos, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review pursuant to 35 U.S.C. § 311 of claims 15, 18, 19, and 22 of Patent No. US 7,613,926 B2 to Edery *et al.* (Ex. 1001, “the ’926 patent”). Pet. 4. 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 not persuaded that Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of any of the challenged claims on the asserted grounds. Accordingly, we *deny* Petitioner’s request to institute an *inter partes* review.

### A. The ’926 Patent

The ’926 patent issued November 3, 2009, from U.S. Patent Application No. 11/370,114, filed March 7, 2006. The ’926 patent also claims priority from six earlier applications, of which the earliest-filed is U.S. Patent Application No. 08/964,388, filed November 6, 1997. Ex. 1001, [60], [63], col. 1, ll. 8–32.

The ’926 patent is directed to systems and methods to protect personal computers and other network accessible devices from “harmful, undesirable, suspicious or other ‘malicious’ operations that might otherwise be effectuated by remotely operable code.” Ex. 1001 col. 2, ll. 27–31. The protection paradigm involves hashing an incoming Downloadable to derive an identifier, referred to as a “Downloadable ID,” which is used to reference security profile data for the incoming Downloadable in a database indexed

according to Downloadable IDs. *Id.* at col. 2, l. 27–col. 4, l. 49; Fig. 1b and 1c.

The Downloadable security profile data for each Downloadable includes “a list of suspicious computer operations that may be attempted by the Downloadable.” *Id.* at col. 21, ll. 66–67. Thus, security profile data for a Downloadable is derived from that Downloadable. Patent Owner contends that security profile data are different from “security policies, for example, which include policies specific to particular users and generic policies that determine whether to allow or block an incoming Downloadable.” Paper 7, 4 (citing Ex. 1001, col. 4, ll. 27–37).

The Downloadable and representation of the Downloadable security profile data are sent to a destination computer. Ex. 1001, col. 22, ll. 1–4. Because previously generated profiles can be retrieved efficiently, the systems and methods allow accurate security decisions to be made without the need to generate profiles for all incoming Downloadables, and it is not necessary for the Downloadable to be scanned by the device for malicious operations because the Downloadable security profile already lists malicious operations. *See* Ex. 1001, col. 10, ll. 44–50.

### *B. Related Proceedings*

The '926 patent is the subject of a district court action between the parties, *Finjan, Inc. v. Sophos, Inc.*, 3:14-cv-01197 (N.D. Cal.), and also has been asserted in two other district court actions, *Finjan, Inc. v. Symantec Corp.*, 3:14-cv-02998 (N.D. Cal.), and *Finjan, Inc. v. Palo Alto Networks, Inc.*, 3:14-cv-04908 (N.D. Cal.). Pet. 1–2; Paper 6, 1. Petitioner also has filed a petition seeking *inter partes* review of a related patent, Patent No. US

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8,677,494 B2 to Edery *et al.* *Sophos, Inc. v. Finjan, Inc.*, Case IPR2015-01022, Paper 1.

*C. Illustrative Claim*

Petitioner challenges claims 15, 18, 19, and 22 of the '926 patent. Claims 15 (method) and 22 (system) are independent. Each of claims 18 and 19 depends directly from independent claim 15. Claim 15 is illustrative and is reproduced below:

15. A computer-based method, comprising the steps of:  
receiving an incoming Downloadable;

*performing a hashing function on the incoming Downloadable to compute an incoming Downloadable ID;*

*retrieving security profile data for the incoming Downloadable from a database of Downloadable security profiles indexed according to Downloadable IDs, based on the incoming Downloadable ID, the security profile data including a list of suspicious computer operations that may be attempted by the Downloadable; and*

*transmitting the incoming Downloadable and a representation of the retrieved Downloadable security profile data to a destination computer, via a transport protocol transmission.*

Ex. 1001, col. 21, l. 58–col. 22, l. 4 (emphases added). Disputed limitations are emphasized.

*D. Applied References and Declaration*

Petitioner relies on the following references and declaration in support of its asserted grounds of unpatentability:

<b>Exhibit</b>	<b>References and Declaration</b>	<b>Date</b>
1003	Declaration of Charles H. Sauer	NA
1004	Patent No. US 5,983,348 to Ji (“Ji”)	Sept. 10, 1997
1005	Patent No. US 6,263,442 B1 to Mueller <i>et al.</i> (“Mueller”)	May 30, 1996
1025	Donald E. Knuth, <i>The Art of Computer Programming</i> , Vol. 3, Sorting and Searching (Addison Wesley Publishing Co., Inc. 1973) (“Knuth”)	1973
1027	Jan Hruska, <i>Computer Viruses and Anti-Virus Warfare</i> (Ellis Horwood Ltd, 2nd rev. ed. 1992) (“Hruska”)	1992

As noted above, the '926 patent claims the benefit of the November 6, 1997 filing date of U.S. Patent Application No. 08/964,388. Ex. 1001, col. 1, ll. 22–24; Paper 7, 59–60. Petitioner argues, however, that the '926 patent is entitled only to priority from U.S. Provisional Patent Application No. 60/205,591, filed May 17, 2000. Paper 1, 8. Nevertheless, because each of the applied references has an effective date prior to November 6, 1997, we agree with Patent Owner that we need not determine whether the '926 patent is entitled to a priority date later than its earliest claimed priority date for purposes of this Decision. Paper 7, 59.

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