

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 IPR2015-01022  
Patent 8,677,494 B2

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

BOUDREAU, *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 1, 10, 14, and 18 of U.S. Patent No. 8,677,494 B2 to Edery *et al.* (Ex. 1001, “the ’494 patent”). Pet. 4. Finjan, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“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 ’494 Patent

The ’494 patent issued March 18, 2014, from U.S. Patent Application No. 13/290,708, filed November 7, 2011. The ’494 patent also claims priority from nine earlier applications, of which the earliest-filed is U.S. Provisional Application No. 60/030,639, filed November 8, 1996 (Ex. 1005, “the ’639 application”). Ex. 1001, [60], [63], col. 1, ll. 7–55.

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 col. 2, ll. 51–56.

“[R]emotely 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 ll. 59–64.

### *B. Related Proceedings*

The ’494 patent is the subject of a district court action, *Finjan, Inc. v. Sophos, Inc.*, 3:14-cv-01197 (N.D. Cal.), and has also 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. 2; Paper 5, 1. Petitioner also has filed a petition seeking *inter partes* review of a related patent, U.S. Patent No. 7,613,926 B2 to Edery *et al.* *Sophos, Inc. v. Finjan, Inc.*, Case IPR2015-00907, Paper 1.

### *C. Illustrative Claims*

Of the challenged claims, claims 1 and 10 are independent. Each of challenged claims 14 and 18 depends directly from claim 10. Independent claims 1 and 10 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, col. 21, ll. 19–25, col. 22, ll. 7–16.

*D. References Relied Upon*

Petitioner relies on the following references:

<b>Exhibit</b>	<b>Reference</b>
1006	ThunderBYTE Anti-Virus Utilities User Manual (“TBAV”)
1008	Arnold, US 5,440,723, issued Aug. 8, 1995
1009	Ji, US 5,623,600, issued Apr. 22, 1997 (filed Sept. 26, 1995)
1010	Chen, US 5,951,698, issued Sept. 14, 1999 (filed Oct. 2, 1996)

Petitioner also relies on the Declaration of Dr. Paul C. Clark (Ex. 1002).

*E. Asserted Grounds of Unpatentability*

Petitioner challenges the patentability of the challenged claims on the following four grounds:

<b>#</b>	<b>References</b>	<b>Basis</b>	<b>Claim(s) Challenged</b>
1	TBAV and Ji	§ 103(a)	1, 10, 18
2	TBAV, Ji, and Chen	§ 103(a)	14
3	Arnold, Chen, and Ji	§ 103(a)	1, 10, 14, 18
4	Chen, Arnold, and Ji	§ 103(a)	1, 10, 14, 18

## II. DISCUSSION

### A. Claim Interpretation

In an *inter partes* review proceeding, claims of an unexpired patent are given their broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). *See also In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278 (Fed. Cir. 2015) (“We conclude that Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA.”). Under this standard, we interpret claim terms using “the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). We presume that claim terms have their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.”) (internal quotation marks omitted). A patentee, however, may rebut this presumption by acting as his own lexicographer, providing a definition of the term in the specification with “reasonable clarity, deliberateness, and precision.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner proposes constructions for four claim terms: “Downloadable,” “suspicious program operations,” “database,” and “program script.” Pet. 12–14. Patent Owner responds to each of Petitioner’s

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