

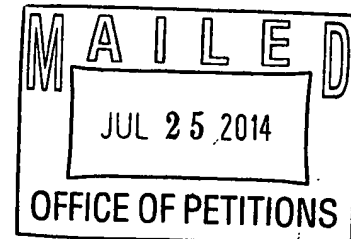


UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Bey & Cotropia PLLC (Finjan Inc.)  
213 Bayly Court  
Richmond VA 23229

Ryan W. Cobb  
DLA Piper LLP  
401 B Street, Suite 1700  
San Diego CA 92101



<i>Ex Parte</i> Reexamination Proceeding	: <b>DECISION GRANTING PETITION</b>
Control No.: 90/013,017	: <b>TO ACCEPT UNINTENTIONALLY</b>
Filed: October 7, 2013	: <b>DELAYED PRIORITY CLAIM UNDER 37</b>
For: U.S. Patent No. 7,058,822	: <b>C.F.R. § 1.78(e)</b>

This is a decision on the March 6, 2014, 2014 patent owner petition entitled "PETITION TO ACCEPT UNINTENTIONALLY DELAYED PRIORITY CLAIM UNDER 37 C.F.R. § 1.78". The petition will be treated under 37 CFR § 1.78(e).

The petition is before the Office of Patent Legal Administration for consideration.

The March 6, 2014 patent owner petition is **granted**.

#### RELEVANT BACKGROUND

1. On June 6, 2006, United States Patent No. 7,058,822 B2 was issued to Finjan Software, Ltd. (Finjan, Inc.).
2. On October 7, 2013, a request for ex parte reexamination of U.S. Patent No. 7,058,822 B2 was filed, and was assigned Reexamination Control No. 90/013,017.
3. On March 6, 2014, patent owner filed a petition to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the concurrently filed amendment.

Svmantec 1015

## DECISION

As stated in MPEP 2258 (IV)(E), a patent owner may correct the failure to adequately claim (in the application for the patent reexamined) benefit under 35 U.S.C. 120 of an earlier filed copending U.S. patent application. For a patent to be reexamined which matured from a utility or plant application filed on or after November 29, 2000, the patent owner must file a grantable petition for an unintentionally delayed priority claim under 37 CFR 1.78(e).

A petition for acceptance of a claim for late priority under 37 CFR § 1.78(e) is applicable to those applications filed after the expiration of the period specified in 37 CFR § 1.78(d)(3). In addition, the petition under 37 CFR § 1.78(e) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR § 1.78(d)(2) of the prior-filed application;
- (2) the petition fee set forth in § 1.17(m); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR § 1.78(d)(3) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

37 CFR § 1.78(e) requires a statement that the entire delay between the date the claim was due under 37 CFR § 1.78(d)(3) and the date the claim was filed was unintentional. Since the statement appearing in the petition varies from the required language, the statement is being construed as the statement required by 37 CFR § 1.78(d)(3). If this is not a correct reading of the statement appearing in the petition, petitioner should promptly notify the Office.

All the above requirements having been satisfied, the late claim for benefit of priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

**The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR § 1.78(e) should not be construed as meaning that this application is entitled to the benefit of the filing date of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and under 1.78 must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.**

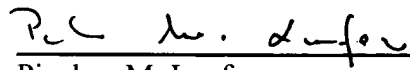
A corrected Filing Receipt, which includes the priority claim to the prior-filed applications, accompanies this decision on petition.

### CONCLUSION

The petition under 37 CFR § 1.78(e) is **granted**.

Any questions concerning this matter may be directed to Petitions Attorney Shirene Willis Brantley at (571) 272-3230. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 3992 for consideration by the examiner of the claim under 35 U.S.C. § 120 of the prior-filed nonprovisional applications.

  
\_\_\_\_\_  
Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

July 24, 2014

ATTACHMENT : Corrected Filing Receipt



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	TOT CLAIMS	IND CLAIMS
90/013,017	10/07/2013	3992	12000	FINREXM0006	35	6

CONFIRMATION NO. 6388

CORRECTED FILING RECEIPT



\*OC000000069789307\*

115222  
Bey & Cotropia PLLC (Finjan Inc.)  
213 Bayly Court  
Richmond, VA 23229

Date Mailed: 07/24/2014

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

## Inventor(s)

7058822, Residence Not Provided;  
FINJAN INC., SAN JOSE, CA;  
RYAN W. COBB (3RD PTY REQ.), SAN DIEGO, CA;

## Applicant(s)

RYAN W. COBB DLA PIPER LLP (US), EAST PALO ALTO, CA

## Assignment For Published Patent Application

FINJAN, INC., SAN JOSE, CA

**Power of Attorney:** The patent practitioners associated with Customer Number 115222

## Domestic Priority data as claimed by applicant

This application is a REX of 09/861,229 05/17/2001 PAT 7058822  
which claims benefit of 60/205,591 05/17/2000  
and is a CIP of 09/539,667 03/30/2000 PAT 6804780  
which is a CON of 08/964,388 11/06/1997 PAT 6092194  
and said 09/861,229 05/17/2001  
is a CIP of 09/551,302 04/18/2000 PAT 6480962  
which is a CON of 08/790,097 01/29/1997 PAT 6167520

**Foreign Applications** for which priority is claimed (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see <http://www.uspto.gov> for more information.) - None.

*Foreign application information must be provided in an Application Data Sheet in order to constitute a claim to foreign priority. See 37 CFR 1.55 and 1.76.*

If Required, Foreign Filing License Granted: 07/23/2014

page 1 of 3

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 90/013,017**

**Projected Publication Date:** None, application is not eligible for pre-grant publication

**Non-Publication Request:** No

**Early Publication Request:** No  
**Title**

MALICIOUS MOBILE CODE RUNTIME MONITORING SYSTEM AND METHODS

**Preliminary Class**

726

**Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications:** No

## **PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES**

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4258).

# 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.