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Paper 9
Entered: June 24, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUE COAT SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-00480
Patent 7,647,633 B2

Before THOMAS L. GIANNETTI, MIRIAM L. QUINN, and PATRICK M. BOUCHER *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Blue Coat Systems, Inc. ("Petitioner" or "Blue Coat") filed a Petition (Paper 3, "Pet.") requesting *inter partes* review of claims 1–4, 6–8, 13, 14, 19, 28, and 34 ("the challenged claims") of U.S. Patent No. 7,647,633 B2 (Ex. 1001, "the '633 patent"), and concurrently filed a Motion for Joinder (Paper 4, "Mot."). The Motion for Joinder seeks joinder of this proceeding with *Palo Alto Networks, Inc. v. Finjan, Inc.*, Case IPR2015-01974 ("the PAN IPR"). Mot. 1. Patent Owner filed a Preliminary Response (Paper 8) that includes an opposition to the Motion for Joinder. For the reasons described below, we institute an *inter partes* review of claims 14 and 19, and grant Petitioner's Motion for Joinder.

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds as those we considered in the PAN IPR, which was instituted on March 29, 2016. *See* Pet. 4–5. The trial in the PAN IPR is directed to the grounds of unpatentability challenging claims 14 and 19 as obvious over:

1) Shin[1]; and
2) Poison Java[2] and Brown.[3]

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[1] Insik Shin, et al., *Java Bytecode Modification and Applet Security* (Technical Report, Computer Science Dept., Stanford University, 1998), https://web.archive.org/web/19980418130342/http://www-cs-students.stanford.edu/~ishin/reserach.html (Ex. 1009).

[2] Eva Chen, *Poison Java*, IEEE SPECTRUM, August 1999 at 38 (Ex. 1004).

[3] MARK W. BROWN, SPECIAL EDITION USING NETSCAPE 3, (Que Corp. 1996) (Ex. 1041).

PAN IPR, slip. op. at 16 (PTAB March 29, 2016) (Paper 7) ("'1974 Decision"). All other grounds in the PAN IPR were denied institution. Upon review of the Petition here, we note that it is an identical, almost word-for-word copy of the Petition in the PAN IPR. Mot. 1 ("The Petition . . . is practically a copy of Palo Alto Network's petition with respect to the proposed grounds, including the same analysis of the prior art and expert testimony.").

Notwithstanding the fact that the petitions are practically identical, Patent Owner argues that the Petition here should be denied on the merits for two reasons. First, Patent Owner argues that Shin does not disclose "downloadable-information" and "executable code." Prelim. Resp. 43–45. Second, Patent Owner argues that neither Shin nor Poison Java discloses "the executable code at the destination." *Id.* at 45–47; 53–56. We are not persuaded at this juncture by either argument.

Claim 14 recites the following:

> **14.** A computer program product, comprising a computer usable medium having a computer readable program code therein, the computer readable program code adapted to be executed for computer security, the method comprising:
>
> providing a system, wherein the system comprises distinct software modules, and wherein the distinct software modules comprise an information re-communicator and a mobile code executor;
>
> receiving, at the information re-communicator, downloadable-information including executable code; and
>
> causing mobile protection code to be executed by the mobile code executor at a downloadable-information destination such that one or more operations of the executable code at the

> destination, if attempted, will be processed by the mobile protection code.

Patent Owner argues that claim 14 requires the disclosure of "downloadable-information" as well as "executable code," but that Petitioner has only pointed to Shin's Java applet without identifying separately each of the "downloadable-information" and "executable code." Prelim. Resp. 44. In other words, Patent Owner argues that Petitioner has failed to meet the burden of showing that these two claim limitations are met by a specific (and distinct) disclosure in Shin. *Id.* This argument is not persuasive because it ignores that Petitioner specifically identified distinct Shin components as meeting the two claim limitations. For example, we note that the Petition identifies messages received by the HTTP proxy server as meeting the recited "downloadable information." Pet. 39 (also stating that the HTTP proxy server of Shin forwards messages between client and web server). On the other hand, the Petition points to a Java applet as "executable code." Pet. 41 (stating that "Shin also discloses that the safeguarding code processes operations attempted by the applet ('executable code')"). Accordingly, the Petition here points to two different disclosures in Shin—messages between client and web server, and a Java applet—as teaching the two limitations of "downloadable information" and "executable code." Patent Owner's argument that the Petition conflates the two limitations is, therefore, unpersuasive.

Patent Owner next argues that the executable code at the destination, according to the claim, must be the same executable code that was received at the information re-communicator. Prelim. Resp. 45–46. Shin, according to Patent Owner, however, "ensures that an applet received by its HTTP

proxy server is modified into a *different* executable entity before it can reach a client browser." *Id.* at 46 (emphasis added). We are not persuaded, at this juncture, by this argument. We addressed this argument in the '1974 Decision:

> The claim recites the "downloadable information" received at the re-communicator as "including executable code" (emphasis added). The claim language does not require that the only content of the downloadable-information be executable code, nor that it include only one executable code. *See* Ex. 1001, 2:49 ("one or more received Downloadables"). The claim further states that one or more operations "of the executable code at the destination" are processed, but does not require "the executable code" to encompass the entirety or an intact version of executable code received. It also appears that the claim may be read broadly, but reasonably, to state that "one or more operations of the executable code" are at the destination at the time of processing. Therefore, we find persuasive, on the current record, Petitioner's assertion that the received "downloadable-information" includes an applet, and that the operations "of the executable code at the destination" are operations in the modified applet that satisfy the limitation.

'1974 Dec. 14. We relied on the above analysis also to find unpersuasive Patent Owner's argument regarding the deficiencies in Poison Java, which were the same as the argument proffered with regards to Shin. '1974 Dec. 15. For the same reasons stated in the '1974 Decision, and based on the present record, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its challenge of unpatentability that claims 14 and 19 would have been obvious in view of Shin alone, or in view of the combination of Poison Java and Brown.

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