UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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PALO ALTO NETWORKS, INC. and SYMANTEC CORP.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.
_____

Case IPR2016-00151[1]
Patent 8,141,154 B2

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

QUINN, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

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[1] This case is joined with IPR2016-01071. Paper 21 ("Decision on Institution of *Inter Partes* Review and Grant of Motion for Joinder," filed by Symantec Corp.).

Palo Alto Networks, Inc. and Symantec Corp. (collectively "Petitioner") each have filed petitions to institute *inter partes* review of claims 1–12 of U.S. Patent No. 8,141,154 B2 ("the '154 patent") pursuant to 35 U.S.C. § 311–319. Paper 2 ("Pet."); IPR2016-01071, Paper 1. In response to the petition filed by Palo Alto Networks, Inc. (Paper 2), Finjan, Inc. ("Patent Owner") filed a Preliminary Response. Paper 8 ("Prelim. Resp."). Upon consideration of the Petition and the Preliminary Response, we instituted trial as to challenged claims, 1–8, 10 and 11. Paper 10 ("Dec.").

Subsequently, we reviewed and granted Symantec Corp.'s petition, which sought review of the same claims of the '154 patent. IPR2016-01071, Paper 1. With its petition, Symantec Corp. filed a motion requesting to join IPR2016-01071 with this proceeding, and we granted the motion. Paper 21. Upon granting the motion, we terminated Case IPR2016-01071, and ordered consolidation of all Petitioner filings in this proceeding. *Id.* at 4–5.

During trial, Patent Owner filed a Patent Owner Response (Paper 19, "PO Resp."); and Petitioner filed a Reply (Paper 32, "Reply"). Patent Owner also filed a Motion for Observations of the December 20, 2016, cross-examination of Petitioner's declarant, Dr. Aviel Rubin. Paper 40. Petitioner responded to Patent Owner's Motion for Observations. Paper 43. Both parties also filed Motions to Exclude. Paper 38 ("Pet. Mot. to Exclude"); Paper 39 ("PO Mot. to Exclude"). Both parties filed Oppositions and Replies concerning the Motions to Exclude. Papers 42, 44, 45, 46. An oral hearing was held on January 24, 2017.[2]

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[2] A transcript of the oral hearing is entered in the record as Paper 49 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons discussed herein, and in view of the record in this trial, we determine that Petitioner has not shown by a preponderance of the evidence that claims 1–8, 10, and 11 of the '154 patent are unpatentable.

I. BACKGROUND

A. RELATED MATTERS

Petitioner identifies the '154 patent as the subject of various district court cases filed in the U.S. District Court for the Northern District of California and District of Delaware. Pet. 42. Petitioner also states that petitions for *inter partes* review have been filed regarding other related patents. *Id.* The '154 patent is also the subject of another *inter partes* review: IPR2015-01979 (and IPR2016-00919, joined therewith). In IPR2015-01979, we issue a Final Written Decision, under 35 U.S.C. § 318 (a), concurrently with the instant Final Written Decision.

B. FINAL WRITTEN DECISION IN IPR2015-01979

The parties have briefed whether estoppel under 35 U.S.C. § 315 (e)(1) affects our ability to render a Final Written Decision in this proceeding. *See* Papers 30, 31. As stated above, IPR2015-01979 is also directed to the '154 patent, and considers the same claims challenged in the instant proceeding. Because we issue final written decisions in both proceedings concurrently, we need not decide what effect, if any, the estoppel provisions of § 315 (e)(1) have on our ability to render this decision.

C. INSTITUTED GROUNDS

We instituted *inter partes* review of claims 1–8, 10, and 11 ("the challenged claims") based on Petitioner's challenge of those claims as unpatentable under 35 U.S.C. § 103(a) over Ross.[3] Petitioner supports its contentions of unpatentability with a declaration from Dr. Aviel Rubin. Ex. 1002 ("Rubin Declaration"). Patent Owner proffers a declaration from Dr. Nenad Medvidovic as evidence in support for its contentions. Ex. 2035 ("Medvidovic Declaration"). The cross-examinations of Dr. Rubin and Dr. Medvidovic are in the record as Exhibits 2012 and 1011, respectively.

D. THE '154 PATENT (EX. 1001)

The '154 patent relates to computer security and, more particularly, to systems and methods for protecting computers against malicious code such as computer viruses. Ex. 1001, 1:7–9, 8:38–40. The '154 patent identifies the components of one embodiment of the system as follows: a gateway computer, a client computer, and a security computer. *Id.* at 8:45–47. The gateway computer receives content from a network, such as the Internet, over a communication channel. *Id.* at 8:47–48. "Such content may be in the form of HTML pages, XML documents, Java applets and other such web content that is generally rendered by a web browser." *Id.* at 8:48–51. A content modifier modifies original content received by the gateway computer and produces modified content that includes a layer of protection to combat dynamically generated malicious code. *Id.* at 9:13–16.

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[3] Patent Application Pub. No. US 2007/0113282 A1 (Exhibit 1003) ("Ross").

E. ILLUSTRATIVE CLAIM

Challenged claims 1, 4, 6, and 10 are independent, and illustrative claim 1 is reproduced below.

> 1. A system for protecting a computer from dynamically generated malicious content, comprising:
>
> a content processor (i) for processing content received over a network, the content including a call to a first function, and the call including an input, and (ii) for invoking a second function with the input, only if a security computer indicates that such invocation is safe;
>
> a transmitter for transmitting the input to the security computer for inspection, when the first function is invoked; and
>
> a receiver for receiving an indicator from the security computer whether it is safe to invoke the second function with the input.

II. ANALYSIS

A. CLAIM INTERPRETATION

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142–46 (2016). Consistent with that standard, claim terms also are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). There are, however, two exceptions to that rule: "1) when a patentee sets out a definition and acts as his own lexicographer," and "2) when the patentee disavows the full scope of a claim

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