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.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.
_____

Case IPR2016-00159
Patent 8,677,494 B2
_____

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

BOUDREAU, *Administrative Patent Judge*.

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

I. INTRODUCTION

Palo Alto Networks, Inc. ("Petitioner") filed a Petition for an *inter partes* review of claims 1–18 of U.S. Patent No. 8,677,494 B2 (Ex. 1001, "the '494 patent"). Paper 1 ("Pet."). Finjan, Inc. ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp."). We review the Petition under 35 U.S.C. § 314.

For the reasons that follow and on this record, we are persuaded that Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of claims 1–6 and 10–15 of the '494 patent on certain of the grounds asserted. Accordingly, we institute an *inter partes* review as to those claims.

A. Related Proceedings

According to the parties, Patent Owner previously asserted the '494 patent against Petitioner in *Finjan, Inc. v. Palo Alto Networks, Inc.*, 3:14-cv-04908 (N.D. Cal. 2014). Pet. 2; Paper 5, 1.

The '494 patent also has been asserted in at least four other district court actions: *Finjan, Inc. v. Sophos, Inc.*, 3:14-cv-01197 (N.D. Cal. 2014); *Finjan, Inc. v. Websense, Inc.*, 5:14-cv-01353 (N.D. Cal. 2014); *Finjan, Inc. v. Symantec Corp.*, 3:14-cv-02998 (N.D. Cal. 2014); and *Finjan, Inc. v. Blue Coat Systems, Inc.*, 5:15-cv-03295 (N.D. Cal. 2015). Pet. 2; Paper 5, 1. The '494 patent also has been the subject of petitions in Case IPR2015-01022, filed by Sophos, Inc., and Cases IPR2015-01892 and IPR2015-01897, filed by Symantec Corporation. We previously denied the first and third of those petitions and granted the second on one asserted ground. *Sophos, Inc. v.*

Finjan, Inc., Case IPR2015-01022 (PTAB Sept. 24, 2015) (Paper 7);
Symantec Corp. v. Finjan, Inc., Case IPR2015-01892 (PTAB Mar. 18, 2016)
(Paper 9); *Symantec Corp. v. Finjan, Inc.*, Case IPR2015-01897 (PTAB Feb.
26, 2016) (Paper 7).

B. The '494 Patent

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." Ex. 1001, 2:51–56. "Remotely
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 2:59–64.

C. Illustrative Claims

Of the challenged claims, claims 1 and 10 are independent. Those
claims 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, 21:19–25, 22:7–16. Each of challenged claims 2–9 depends directly from claim 1; and each of challenged claims 11–18 depends directly from claim 10. *Id.* at 21:26–22:6, 22:17–39.

D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claims	Basis	Reference(s)
1, 3–6, 9, 10, 12–15, and 18	§ 102	Touboul[1]
2 and 11	§ 103	Touboul and Swimmer[2]
7 and 16	§ 103	Touboul and Ji[3]
8 and 17	§ 103	Touboul

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[1] International Patent Publication No. WO 98/21683 to Shlomo Touboul, published May 22, 1998 (Ex. 1026, "Touboul").
[2] Morton Swimmer et al., *Dynamic Detection and Classification of Computer Viruses Using General Behaviour Patterns*, VIRUS BULL. CONF. 75 (Sept. 1995) (Ex. 1006, "Swimmer").
[3] U.S. Patent No. 5,983,348 to Shuang Ji, issued Nov. 9, 1999 (Ex. 1010, "Ji").

Claims	Basis	Reference(s)
1, 2, 6, 10, 11, and 15	§ 103	Swimmer
3–5 and 12–14	§ 103	Swimmer and Martin[4]

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, the Board interprets a claim term in an unexpired patent according to its broadest reasonable construction in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 778 F.3d 1271, 1278–81 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 890 (mem.) (2016). Under this standard, we interpret claim terms using "the broadest reasonable meaning of the words in their ordinary usage as they

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[4] David M. Martin, Jr. et al., *Blocking Java Applets at the Firewall*, PROC. 1997 SYMP. ON NETWORK & DISTRIBUTED SYS. SEC. (©1997) (Ex. 1047, "Martin"). For reasons stated below, we conclude herein that each of the challenged claims is entitled to the benefit of a November 6, 1997 priority date. *See infra* Sections II.B.1.a., b. We note that Martin states on its face that it is from the proceedings of a symposium held February 10–11, 1997 (Ex. 1047, 1), but that the record copy of Martin bears a date stamp of June 5, 1998 (*id.* at 3), does not indicate a publication date, and merely has a 1997 copyright date (*id.* at 1). The Petition relies on a declaration of Dr. Aviel D. Rubin, Ph.D., one of the named authors of Martin, who declares that Martin was distributed to approximately 400 conference attendees in February 1997. Pet. 7 (citing Ex. 1002 ¶ 58). Patent Owner does not contest this evidence in its Preliminary Response, and we assume, for purposes of this Decision only, that Martin was published on the last day of February 1997.

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