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Paper 7
Date: April 21, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner

Case IPR2016-00165
Patent 6,804,780 B1

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

GIANNETTI, *Administrative Patent Judge*.

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

Palo Alto Networks, Inc. ("Petitioner") filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of all claims (claims 1–18) of U.S. Patent No 6,804,780 B1 (Ex. 1001, "the '780 patent"). Paper 2 ("Pet."). Finjan, Inc. ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp."). Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we deny Petitioner's request and deny institution of an *inter partes* review of all challenged claims.

I. BACKGROUND

A. The '780 Patent (Ex. 1001)

The '780 patent is titled "System and Method for Protecting a Computer and a Network from Hostile Downloadables." The abstract describes the subject matter as follows:

> A computer-based method for generating a Downloadable ID to identify a Downloadable, including obtaining a Downloadable that includes one or more references to software components required by the Downloadable, fetching at least one software component identified by the one or more references, and performing a function on the Downloadable and the fetched software components to generate a Downloadable ID. A system and a computer-readable storage medium are also described and claimed.

Ex. 1001, Abstract.

The invention is illustrated by Figure 8 of the patent, reproduced here:

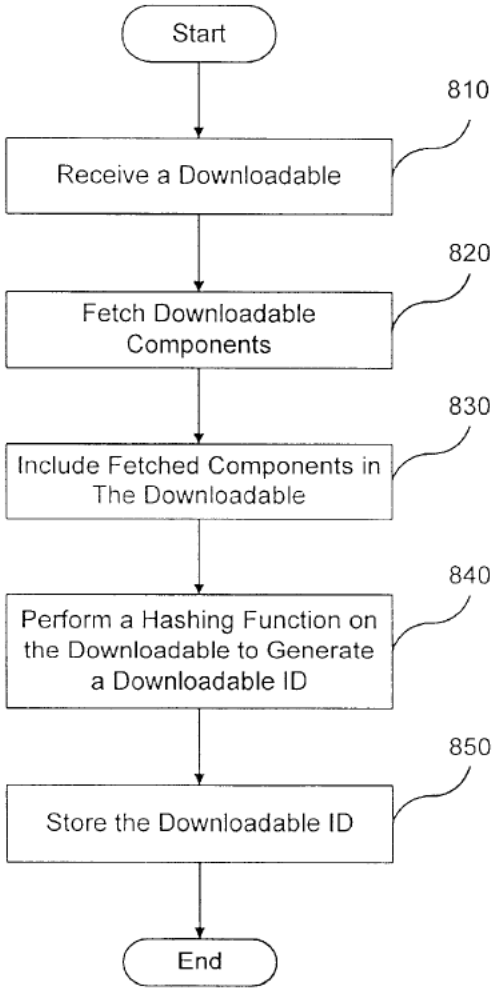

Figure 8 is a flowchart illustrating a method for generating a Downloadable ID for identifying a Downloadable. Ex. 1001, col, 9, ll. 58–60. According to the '780 patent, a "Downloadable" is "an executable application program, which is downloaded from a source computer and run on the destination computer." *Id.* at col. 1, ll. 50–53. Also according to the

patent, a Downloadable "is typically requested by an ongoing process such as by an Internet browser or web engine." *Id.* at col. 1, ll. 53–55. Examples of a Downloadable from the '780 patent include Java applets, JavaScript scripts, and ActiveX controls. *Id.* at col, 1, ll. 55–59.

As described in the patent, the method of generating a Downloadable ID begins at step 810 of Figure 8, with an ID generator (not shown) receiving a Downloadable from an external computer network. Ex. 1001, col. 9, ll. 60–62. In step 820, the ID generator fetches some or all components referenced in the Downloadable code and, in step 830, includes the fetched components in the Downloadable code. *Id.* at col. 9, ll. 62–65.

In step 840, the ID generator performs a hashing function on at least a portion of the Downloadable code (including the fetched components) to generate a Downloadable ID. *Id.* at col. 9, ll. 65–67. The ID generator, in step 850, stores the generated Downloadable ID in a security database as a reference to the appropriate Downloadable Security Profile ("DSP") data. Accordingly, the Downloadable ID will be the same for the identical Downloadable each time it is encountered. *Id.* at col. 9, l. 67–col. 10, l. 5.

The Downloadable ID, in conjunction with the DSP, is used to identify potentially hostile operations. *Id.* at col. 5, ll. 45–67.

B. Illustrative Claim

The '780 patent has four independent claims: 1, 9, 17, and 18. Claim 1 illustrates the relevant subject matter of the patent:

> 1. A computer-based method for generating a Downloadable ID to identify a Downloadable, comprising:

obtaining a Downloadable that includes one or more references to software components required to be executed by the Downloadable;

fetching at least one software component identified by the one or more references; and

performing a hashing function on the Downloadable and the fetched software components to generate a Downloadable ID.

C. Related Proceedings

Patent Owner and Petitioner are involved in ongoing litigation, *Finjan, Inc. v. Palo Alto Networks, Inc.*, Case No. 4:14-cv-04908 (N.D. Cal.), in which the '780 patent has been asserted. Pet. 3, Paper 5, 1. Petitioner also has filed petitions for *inter partes* review of numerous related patents. Pet. 3–4.

Patent Owner also has asserted the '780 patent against Blue Coat Systems, Inc., in *Finjan, Inc. v. Blue Coat Systems, Inc.*, Case No. 5:13-cv-03999 (N.D. Cal. 2013) ("the Blue Coat Litigation"). Paper 5, 1. Exhibits 2010 and 2011 are, respectively, excerpts from the trial transcript and the jury's verdict form from that litigation.

Patent Owner identifies two other cases in which it has asserted the '780 patent: *Finjan, Inc. v. FireEye, Inc.*, 4:13-cv-03133 (N.D. Cal.); and *Finjan, Inc. v. Sophos, Inc.*, 3:14-cv-01197 (N.D. Cal.). Paper 5, 1.

D. Real Party-in-Interest

The Petition names one real party-in-interest: Palo Alto Networks, Inc. Pet. 3. The Preliminary Response does not challenge this.

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