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115222	7590	09/08/2014	EXAMINER	
Bey & Cotropia PLLC (Finjan Inc.) 213 Bayly Court Richmond, VA 23229			PROCTOR, JASON SCOTT	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/013,017.

PATENT NO. 7058822.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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FINAL REJECTION

This Office Action addresses claims 1-8, 16-27, and new claims 36-40 of US Patent No. 7,058,822 issued to Edery et al. (“the ‘822 Patent”). Claims 9-15 and 28-35 are not subject to this reexamination proceeding.

A Request for *Ex Parte* Reexamination was filed on 7 October 2013 (“the Request”). The Decision Granting *Ex Parte* Reexamination (“the Order”) was entered on 6 December 2013. A Non-Final Rejection (“NF Rejection”) was entered on 6 December 2013, wherein claims 1-8 and 16-27 were rejected.

An in-person interview was conducted on 4 February 2014. *See* Examiner Interview Summary, 28 February 2014.

Patent Owner timely filed a response to the NF Rejection on 6 March 2014 (“PO Remarks”) including a Declaration by Phil Hartstein (“Hartstein Decl.”) and Nenad Medvidovic (“Medvidovic Decl.”), and claim amendments to present new claims 36-40. Accordingly, claims 1-8, 16-27, and 36-40 are subject to this reexamination proceeding. Patent Owner filed a Petition to accept an unintentionally delayed priority claim under 37 CFR §1.78 (“PO Petition”). This petition was granted in the Petition Decision entered on 25 July 2014.

Furthermore, in the 5 June 2014 IDS, Patent Owner has provided notice that related proceeding N.D. Cal. C 13-03133 SBA styled *Finjan Inc. vs. Fireeye, Inc.*, was STAYED pending reexamination on 30 May 2014.

Patent Owner’s written response and submitted evidence has been fully considered. For the reasons set forth below,

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Claims 1-8, 16-27, and 36-40 are rejected.

Claims 9-15 and 28-35 are not subject to this reexamination proceeding.

I. INFORMATION DISCLOSURE STATEMENTS

Regarding IDS submissions, MPEP 2256 recites the following: “Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information.”

Accordingly, the IDS submissions have been considered by the Examiner only to the extent that their relevance to the instant proceeding has been explained by the filing party and within the scope required by MPEP 2256.

In the 28 February 2014 IDS, several citations have been lined through. In pages 1, 4, and 5, the citations do not match the provided US patent numbers and have not been considered. In pages 6, 7 and 11, Patent Owner acknowledges that “no copy of the reference was provided,” thus these references have not been considered. In pages 9 and 12, neither the citations nor the references bear any date, thus it is impossible to determine whether the reference are prior art relative to the claimed invention. In page 11, the copy of Sekar, *et al.* provided with the IDS is illegible, thus it cannot be properly considered. In page 13, the citation to a list of publications lacks a date, while the Ronaix publication is illegible. In page 14, the Slade reference was not found among the documents submitted with the IDS. In page 15, the provided copies of the cited references are illegible and cannot be properly considered.

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In the 29 March 2014 IDS, page 11, the copy of Garfinkel, *et al.* provided with the IDS is illegible, thus it cannot be properly considered.

In the 24 June 2014 IDS, several citations have been lined through. In page 2, the copy of “ThunderBYTE Anti-Virus Utilities User Manual” provided with the IDS is illegible, thus it cannot be properly considered.

II. REFERENCES CITED IN REJECTIONS

US Patent No. 5,983,348 issued 9 November 1999 to Ji (“Ji”)

US Patent No. 6,058,482 issued 2 May 2000 to Liu (“Liu”)

US Patent No. 5,974,549 issued 26 October 1999 to Golan (“Golan”)

III. EFFECTIVE FILING DATE OF CLAIMED SUBJECT MATTER

Patent Owner filed the PO Petition to accept an unintentionally delayed priority claim under 37 CFR 1.78, and it was granted on 25 July 2014. As a result, the ‘822 Patent now claims priority (via intermediate priority documents) to US Patents 6,167,520 filed on 29 January 1997; and 6,092,194 filed on 6 November 1998.

To determine the earliest effective filing date of an invention claimed in a US application, where the priority claim involves continuations and continuations-in-part, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims which are fully

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