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.

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Case IPR2015-01974[1]
Patent 7,647,633 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] Case IPR2016-00480 (filed by Blue Coat Systems, Inc.) has been joined
with this proceeding.

Palo Alto Networks, Inc. and Blue Coat Systems, Inc. ("Petitioner") each filed a Petition to institute *inter partes* review of claims 1–4, 6–8, 13, 14, 19, 28, and 34 of U.S. Patent No. 7,647,633 B2 ("the '633 patent") pursuant to 35 U.S.C. § 311–319. IPR2015-01974, Paper 1 ("Pet."); IPR2016-00480, Paper 3. Finjan, Inc. ("Patent Owner") filed a Preliminary Response in both proceedings. IPR2015-01974, Paper 6; IPR2016-00480, Paper 8. Upon consideration of the information submitted by the parties at the preliminary stage, we instituted trial only as to claims 14 and 19 of the '633 patent. Paper 7 ("Dec."). We also granted Blue Coat Systems, Inc.'s motion requesting joinder of IPR2016-00480 with this proceeding. Paper 17. We terminated Case IPR2016-00480, and ordered consolidation of all Petitioner filings in this proceeding. *Id.* at 10.

During trial, Patent Owner filed a Patent Owner Response (Paper 22 ("PO Resp.")); and Petitioner filed a Reply (Paper 31 ("Reply")). Both parties filed Motions to Exclude, Oppositions, and Replies in connection with those Motions. Papers 35, 36, 39, 40, 42, and 43. We held oral argument on January 5, 2017. Paper 48 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6. 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 14 and 19 of the '633 patent are unpatentable.

## I.     BACKGROUND

### A.     RELATED MATTERS

Petitioner identifies the '633 patent as the subject of various district court cases filed in the U.S. District Court for the Northern District of California (Case Nos. 3-14-cv-04908, 13-cv-03133, 13-cv-03999, 5-13-cv-04398, 13-cv-05808, and 5-15-cv-01353).  Pet. 2.  Petitioner also states that petitions for *inter partes* review have been filed regarding other patents assigned to Patent Owner.  *Id.*

The '633 patent is also the subject of two *ex parte* reexamination proceedings with Control Nos. 90/013,016 and 90/013,652.  Paper 46 (Patent Owner updated mandatory notice pursuant to 37 C.F.R. § 42.8).  Neither of these *ex parte* reexamination proceedings involves the claims-at-issue in this *inter partes* review.

### B.     THE '633 PATENT (EX. 1001)

The '633 patent relates to a system and a method for protecting network-connectable devices from undesirable downloadable operation.  Ex. 1001, 1:30–33.  The patent describes that "Downloadable information comprising program code can include distributable components (e.g. Java™ applets and JavaScript scripts, ActiveX™ controls, Visual Basic, add-ins and/or others)."  *Id.* at 1:60–63.  Protecting against only some distributable components does not protect against application programs, Trojan horses, or zip or meta files, which are other types of Downloadable information.  *Id.* at 1:63–2:2.  The '633 patent "enables more reliable protection."  *Id.* at 2:27–28.  According to the Summary of the Invention,

In one aspect, embodiments of the invention provide for determining, within one or more network "servers" (e.g. firewalls, resources, gateways, email relays or other devices/processes that are capable of receiving-and-transferring a Downloadable) whether received information includes executable code (and is a "Downloadable"). Embodiments also provide for delivering static, configurable and/or extensible remotely operable protection policies to a Downloadable-destination, more typically as a sandboxed package including the mobile protection code, downloadable policies and one or more received Downloadables. Further client-based or remote protection code/policies can also be utilized in a distributed manner. Embodiments also provide for causing the mobile protection code to be executed within a Downloadable-destination in a manner that enables various Downloadable operations to be detected, intercepted or further responded to via protection operations. Additional server/information-destination device security or other protection is also enabled, among still further aspects.

*Id.* at 2:39–57.

C.     CHALLENGED CLAIMS

Challenged claims 14 and 19 are reproduced below.

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.
>
> 19. The method of claim 14, wherein the re-
> communicator is at least one of a firewall and a network server.

*Id*. at 21:58–22:5, 22:15–16.

### D.    INSTITUTED GROUNDS

We instituted *inter partes* review of claims 14 and 19 based on the
following grounds (Dec. 13–16):

| Reference(s) | Basis | Claims |
|---|---|---|
| Shin[2] | § 103 | 14 and 19 |
| Poison Java[3] and Brown[4] | § 103 | 14 and 19 |

Petitioner supports its contentions of unpatentability with a
declaration from Dr. Aviel Rubin.  Ex. 1002.  Patent Owner supports its
contentions of patentability with a declaration from Dr. Michael Goodrich.
Ex. 2019.  Patent Owner also proffers as support a declaration from Dr.
Harry Bims (Ex. 2020) and Michael Kim (Ex. 2021).  The
cross-examinations of Drs. Rubin, Goodrich, and Bim are in the record as
Exhibits 2022, 1097, and 1098, respectively.

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[2] 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) ("Shin").
[3] Eva Chen, *Poison Java*, IEEE SPECTRUM, August 1999 at 38 (Ex. 1004).
[4] Mark W. Brown, et al., SPECIAL EDITION USING NETSCAPE 3, (Que Corp.
1996) (Ex. 1041) ("Brown").

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