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EXAMINER

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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FINJAN, INC.
Appellant

Appeal 2015-006304
Reexamination Control 90/013,017
Patent 7,058,822 B2
Technology Center 3900

Before STEPHEN C. SIU, JEREMY J. CURCURI, and
IRVIN E. BRANCH, *Administrative Patent Judges*.

Opinion for the board filed by *Administrative Patent Judge* CURCURI.

Opinion dissenting-in-part filed by *Administrative Patent Judge* BRANCH.

CURCURI, *Administrative Patent Judge*.

DECISION ON APPEAL

Patent 7,058,822 B2 (Edery et al.) is under reexamination. Appellant appeals under 35 U.S.C. §§ 134(b) and 306 from the Examiner's rejection of claims 1–8, 16–27, and 36–40. Final Act. 2. We have jurisdiction under 35 U.S.C. §§ 134(b) and 306, and we heard oral argument in the appeal on November 3, 2015.

Claims 4–6, 8, 16–27, 37, and 40 are rejected under 35 U.S.C. § 102(e) as anticipated by Ji (5,983,348; issued Nov. 9, 1999). Ans. 3–17.

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Claim 7 is rejected under 35 U.S.C. § 103(a) as obvious over Ji. Final Act. 9–10.

Claims 1–3 are rejected under 35 U.S.C. § 103(a) as obvious over Ji and Liu (6,058,482; issued May 2, 2000). Ans. 17–22.

Claims 4–8, 16–27, 37, and 40 are rejected under 35 U.S.C. § 103(a) as obvious over Ji and Liu. Ans. 22–27.

Claims 4–8, 16–27, 37, and 40 are rejected under 35 U.S.C. § 103(a) as obvious over Ji and Golan (5,974,549; issued Oct. 26, 1999). Ans. 27–33.

Claims 36, 38, and 39 are rejected under 35 U.S.C. § 305 as enlarging the scope of the claims. Final Act. 19–20.

We affirm-in-part.

STATEMENT OF THE CASE

Appellant’s invention relates to “protecting network-connectable devices from undesirable downloadable operation.” Edery, col. 1, ll. 28–29.

Claim 4 is illustrative:

4. A processor-based method, comprising:
 - receiving downloadable-information;
 - determining whether the downloadable-information includes executable code; and
 - causing mobile protection code to be communicated to at least one information-destination of the downloadable-information, if the downloadable-information is determined to include executable code,
- wherein the causing mobile protection code to be communicated comprises forming a sandboxed package including the mobile protection code and the downloadable-

information, and causing the sandboxed package to be communicated to the at least one information-destination.

ANALYSIS

THE ANTICIPATION REJECTION OF CLAIMS 4–6, 8, 16–27, 37, AND 40 BY JI

The Examiner finds Ji discloses all limitations of claim 4. Ans. 3–5. The Examiner finds “[b]y disclosing that applets are scanned while non-applets are not scanned, Ji at least implicitly discloses the step of determining whether the downloadable-information includes executable code.” Ans. 3 (citing Ji, col. 3, ll. 23–25; col. 4, l. 66–col. 5, l. 4). The Examiner finds Ji’s JAR file corresponds to the recited sandboxed package. Ans. 4–5 (citing Ji, col. 6, ll. 38–42; col. 7, ll. 13–28; col. 8, ll. 4–10).

Appellant presents the following principal arguments:

i. Ji does not disclose the recited (claim 4) “determining whether the downloadable-information includes executable code” because “Ji then scans only downloaded applets to look for malicious applet instructions; not to determine if the downloaded applet contains executable code.” App. Br. 16; *see also* App. Br. 17 (“[T]here are numerous ways that Ji can distinguish downloaded applets from non-applets without determining whether the downloadable-information includes executable code. For example, Ji could simply search for applet tags. A file with an applet tag is not a determination that the file contains executable code.”).

[O]ne of skill in the art would understand that an applet tag is not a determination that the file contains executable code because an applet tag does not mean executable code exists within the Downloadable, nor does the lack of an applet tag mean that executable code does not exist within the

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Downloadable. Furthermore, Ji only operates on applets and does not scan non-applets.

Declaration of Dr. Nenad Medvidovic ¶ 22; *see also id.* at ¶¶ 23–24.

ii. Ji’s JAR file containing the instrumented applet and monitoring package does not disclose the recited (claim 4) “sandboxed package.” *See* App. Br. 19–20; Declaration of Dr. Nenad Medvidovic ¶ 27.

In response, the Examiner further explains

It is not relevant to patentability whether Ji “passively assumes” or skeptically analyzes; the claim broadly requires determining. Since Ji’s system takes a first action for downloadable-information including executable code (*i.e.*, scanning Java applets assumed to be executable code) and takes a different action for other downloadable-information (*i.e.*, not scanning non-applet downloadable information), Ji’s system “determines whether the downloadable-information includes executable code”.

Ans. 37–38.

In response, the Examiner further explains Ji’s JAR file corresponds to the recited sandboxed package. *See* Ans. 40–43.

Appellant has shown error in the Examiner’s finding that Ji discloses the recited (claim 4) “determining whether the downloadable-information includes executable code.”

Ji (col. 3, ll. 23–25) discloses: “At this point the applets are statically scanned at the server by the scanner looking for particular instructions which may be problematic in a security context.” Ji (col. 4, l. 66–col. 5, l. 4) discloses:

Upon receipt of a particular Java applet, the HTTP proxy server 32, which is software running on server machine 20 and which has associated scanner software 26, then scans the applet and

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