

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYMANTEC CORP.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2015-01897
Patent 8,677,494 B2

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

BOUDREAU, *Administrative Patent Judge*.

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

I. INTRODUCTION

Symantec Corp. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review pursuant to 35 U.S.C. § 311 of claims 1, 2, 5, 6, 10, 11, 14, and 15 of U.S. Patent No. 8,677,494 B2 to Ederly *et al.* (Ex. 1001, “the ’494 patent”). Pet. 1. Finjan, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We review the Petition under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

For the reasons that follow and on this record, we are not persuaded that Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of any of the challenged claims on the asserted grounds. Accordingly, we *deny* Petitioner’s request to institute an *inter partes* review.

A. The ’494 Patent

The ’494 patent, entitled “Malicious Mobile Code Runtime Monitoring System and Methods,” issued March 18, 2014, from U.S. Patent Application No. 13/290,708 (“the ’708 application”), filed November 7, 2011. Ex. 1001, [21], [22], [45], [54]. On its face, the ’494 patent purports to claim priority from nine earlier applications, including U.S. Patent Application No. 08,964,388 (“the ’388 application”), filed November 6, 1997, which issued July 18, 2000, as U.S. Patent No. 6,092,194 (Ex. 1007, “the ’194 patent” or “Touboul I”). Ex. 1001, [60], [63], col. 1, ll. 7–55. For reasons stated below, we determine on this record that the challenged claims are entitled at least to the benefit of the November 6, 1997 filing date of the ’388 application.

B. Related Proceedings

The '494 patent is the subject of a district court action between the parties, *Finjan, Inc. v. Symantec Corp.*, 3:14-cv-02998 (N.D. Cal.), and has also been asserted in three other district court actions, *Finjan, Inc. v. Sophos, Inc.*, 3:14-cv-01197 (N.D. Cal.), *Finjan, Inc. v. Palo Alto Networks, Inc.*, 3:14-cv-04908 (N.D. Cal.), and *Finjan, Inc. v. Blue Coat Systems, Inc.*, 5:15-cv-03295 (N.D. Cal.). Pet. 1; Paper 5, 1. Petitioner also has filed another petition seeking *inter partes* review of the '494 patent, a petition seeking *inter partes* review of related U.S. Patent No. 6,154,844 (hereinafter "Touboul II"), and two petitions seeking *inter partes* review of related U.S. Patent No. 7,613,926, in Cases IPR2015-01892, IPR2015-01894, IPR2015-01893, and IPR2015-01895, respectively. Pet. 1. Palo Alto Networks, Inc. also has filed a petition seeking *inter partes* review of the '494 patent (Case IPR2016-00159, Paper 2), and a petition filed by Sophos Inc. seeking *inter partes* review of the '494 patent was denied on September 24, 2015 (Case IPR2015-01022, Paper 7).

C. References Relied Upon

Petitioner relies on the following references:

Exhibit	Reference
1007	US 6,092,194, issued July 18, 2000 ("Touboul I")
1016	US 6,154,844, issued Nov. 28, 2000 ("Touboul II")

Pet. 23–24. Petitioner also relies on the Declaration of Jack W. Davidson (Ex. 1021).

D. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of the challenged claims on the following four grounds:

Reference	Basis	Claims Challenged
Touboul I	§ 102(b)	1, 5, 6, 10, 14, and 15
Touboul I	§ 103(a)	2 and 11
Touboul II	§ 102(b)	1, 5, 6, 10, 14, and 15
Touboul II	§ 103(a)	2 and 11

Pet. 24.

II. DISCUSSION

A. Claim Interpretation

In an *inter partes* review proceeding, claims of an unexpired patent are given their broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1275–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 890 (2016). On this record and for purposes of this Decision, we determine that no claim terms require express construction.

B. Priority Date

1. Background

As filed, the '708 application from which the '494 patent issued claimed priority from the following seven earlier-filed applications:

1) U.S. Patent Application No. 08/964,388 (“the '388 application”) to Shlomo Touboul, which, as indicated in Section I.A. above, was filed on November 6, 1997, and issued as Touboul I on July 18, 2000;

2) U.S. Patent Application No. 09/539,667 (“the '667 application”) to Mr. Touboul, filed March 30, 2000, as a continuation of the '388 application; the '667 application issued October 12, 2004, as U.S. Patent No. 6,804,780 B1 (Ex. 1006, “the '780 patent”);

3) U.S. Patent Application No. 09/551,302 (“the '302 application”) to Mr. Touboul, filed April 18, 2000; the '302 application issued November 12, 2002, as U.S. Patent No. 6,480,962 B1 (Ex. 1009, “the '962 patent”);

4) U.S. Provisional Patent Application No. 60/205,591 (Ex. 1005, “the '591 provisional”) to Nimrod Itzhak Vered, Yigal Mordechai Edery, and David R. Kroll, filed May 17, 2000;

5) U.S. Patent Application No. 09/861,229 (“the '229 application”) to Messrs. Edery, Vered, Kroll, and Touboul,¹ filed May 17, 2001, as a

¹ The '229 application, as filed, named only Messrs. Vered, Edery, and Kroll as inventors. However, a Request to Correct Inventorship, requesting to add Mr. Touboul as an inventor, was filed on June 21, 2005. Ex. 2005, 3. The Request was accompanied by supporting papers, including a statement signed by Mr. Touboul and stating that the error in inventorship occurred inadvertently and that there was no deceptive intent on his part; an Assent of Assignee To Correction And/Or Addition of Inventor; a new Declaration signed by Messrs. Vered, Edery, Kroll, and Touboul; and an Assignment executed by Mr. Touboul. *Id.* at 4–14. The Office granted the Request on

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