

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUE COAT SYSTEMS LLC,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-01443
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

Blue Coat Systems, Inc., now known as Blue Coat Systems LLC,¹ (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review pursuant to 35 U.S.C. § 311 of claims 7–9 and 16–18 of U.S. Patent No. 8,677,494 B2 (Ex. 1001, “the ’494 patent”). Pet. 1. Finjan, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With leave from the Board, Petitioner subsequently filed a Reply, limited to addressing arguments in the Preliminary Response that the Petition is procedurally barred under 35 U.S.C. §§ 312, 315(e)(1), and 325(d) (Paper 7, “Reply”), and Patent Owner filed a Sur-Reply (Paper 8, “Sur-Reply”) responsive to Petitioner’s Reply.

Based on the particular circumstances of this case, we exercise our discretion under 37 C.F.R. § 42.108 and do not institute an *inter partes* review of the challenged claims.

II. BACKGROUND

A. The ’494 Patent

The ’494 patent, titled “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, of which the earliest-filed is U.S. Provisional Application No. 60/030,639, filed November 8, 1996 (Ex. 1002, “the ’639 application”). We need not make a determination on this record whether or

¹ See Paper 9, 1.

not the challenged claims are entitled to the benefit of the filing dates of any of those earlier applications.

The '494 patent describes protection systems and methods “capable of protecting a personal computer (‘PC’) or other persistently or even intermittently network accessible devices or processes from harmful, undesirable, suspicious or other ‘malicious’ operations that might otherwise be effectuated by remotely operable code.” Ex. 1001, 2:51–56. “Remotely operable code that is protectable against can include,” for example, “downloadable application programs, Trojan horses and program code groupings, as well as software ‘components’, such as Java™ applets, ActiveX™ controls, JavaScript™/Visual Basic scripts, add-ins, etc., among others.” *Id.* at 2:59–64.

B. Related Proceedings

The parties report that the '494 patent is the subject of a district court action between the parties, *Finjan, Inc. v. Blue Coat Systems, Inc.*, No. 5:15-cv-03295 (N.D. Cal. 2015), and that the '494 patent also has been asserted in four other district court actions, *Finjan, Inc. v. Sophos, Inc.*, No. 3:14-cv-01197 (N.D. Cal. 2014), *Finjan, Inc. v. Symantec Corp.*, No. 3:14-cv-02998 (N.D. Cal. 2014), *Finjan, Inc. v. Palo Alto Networks, Inc.*, No. 3:14-cv-04908 (N.D. Cal. 2014), and *Finjan, Inc. v. Cisco Systems Inc.*, No. 17-cv-00072 (N.D. Cal. 2017). Pet. 15; Paper 4, 1; Paper 10, 1.

The '494 patent also is the subject of Case IPR2015-01892, in which trial was instituted with respect to claims 1, 2, 5, 6, 10, 11, 14, and 15 on a petition filed by Symantec Corporation; and Case IPR2016-00159, in which trial was been instituted with respect to claims 1–6 and 10–15 on a petition

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filed by Palo Alto Networks, Inc. *Symantec Corp. v. Finjan, Inc.*, Case IPR2015-01892 (PTAB Mar. 18, 2016) (Paper 9) (“Symantec Dec. on Inst.”); *Palo Alto Networks, Inc. v. Finjan, Inc.*, Case IPR2016-00159 (PTAB May 13, 2016) (Paper 8) (“PAN Dec. on Inst.”).

Petitioner previously filed two additional petitions for *inter partes* review of the ’494 patent, in Cases IPR2016-00890 and IPR2016-01174, accompanied by motions for joinder with the ongoing *inter partes* reviews initiated by Symantec Corporation and Palo Alto Networks, Inc. in Cases IPR2015-01892 and IPR2016-00159, respectively. *Blue Coat Sys., Inc. v. Finjan, Inc.*, Case IPR2016-00890, Paper 2 (challenging claims 1, 2, 5, 6, 10, 11, 14, and 15), Paper 3 (requesting to join Case IPR2015-01892); *Blue Coat Sys., Inc. v. Finjan, Inc.*, Case IPR2016-01174, Paper 2 (challenging claims 1–6 and 10–15), Paper 3 (requesting to join Case IPR2016-00159). We instituted trial on both of Petitioner’s previous petitions and granted both motions for joinder. *Blue Coat Sys., Inc. v. Finjan, Inc.*, Case IPR2016-00890 (PTAB Aug. 30, 2016) (Paper 8); *Blue Coat Sys., Inc. v. Finjan, Inc.*, Case IPR2016-01174 (PTAB Oct. 4, 2016) (Paper 8).

The ’494 patent also was the subject of two other petitions, both of which were denied. *Sophos, Inc. v. Finjan, Inc.*, Case IPR2015-01022 (PTAB Sept. 24, 2015) (Paper 7); *Symantec Corp. v. Finjan, Inc.*, Case IPR2015-01897 (PTAB Feb. 26, 2016) (Paper 7).

C. Illustrative Claims

None of the challenged claims is independent; rather, each of challenged claims 7–9 depends from unchallenged independent claim 1, and each of challenged claims 16–18 depends from unchallenged independent

claim 10. Challenged claims 7–9 are illustrative and are reproduced below with unchallenged independent claim 1 also reproduced for context:

1. A computer-based method, comprising the steps of:
receiving an incoming Downloadable;
deriving security profile data for the Downloadable, including a list of suspicious computer operations that may be attempted by the Downloadable; and
storing the Downloadable security profile data in a database.
7. The computer-based method of claim 1 wherein the Downloadable security profile data includes a URL from where the Downloadable originated.
8. The computer-based method of claim 1 wherein the Downloadable security profile data includes a digital certificate.
9. The computer-based method of claim 1 wherein said deriving Downloadable security profile data comprises disassembling the incoming Downloadable.

Ex. 1001, 21:19–25, 21:38–22:6. Challenged claims 16–18 recite limitations similar to claims 7–9, respectively. *Id.* at 22:31–38.

D. References Relied Upon

Petitioner relies on the following references:

Exhibit	Reference
1005	Morton Swimmer et al., <i>Dynamic Detection and Classification of Computer Viruses Using General Behaviour Patterns</i> , Virus Bull. Conf. 75 (Sept. 1995) (“Swimmer”)
1006	US 5,983,348, issued Nov. 9, 1999 (filed Sept. 10, 1997) (“Ji”)
1007	Luotonen et al., <i>World-Wide Web Proxies</i> , 27 Comput. Networks & ISDN Sys. 147 (1994) (“Luotonen”)

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