UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SYMANTEC CORP.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

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Case IPR2015-01894
Patent 6,154,844

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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 ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review pursuant to 35 U.S.C. § 311 of claims 1, 7, 11, 15, 16, 41, and 43 of Patent No. US 6,154,844 to Touboul et al. (Ex. 1001, "the '844 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 '844 Patent*

The '844 patent, titled "System and Method for Attaching a Downloadable Security Profile to a Downloadable," issued November 28, 2000, from U.S. Patent Application No. 08/995,648 ("the '648 application"), filed December 22, 1997. Ex. 1001, [21], [22], [45], [54].

The '844 patent is directed to systems and methods "for attaching a Downloadable security profile to a Downloadable to facilitate the protection of computers and networks from a hostile Downloadable." Ex. 1001, 1:23–27. "A 'Downloadable' is an executable application program . . . downloaded from a source computer and run on [a] destination computer." *Id.* at 1:44–47. "Examples of Downloadables include Java™ applets . . . ,

JavaScript™ scripts . . . , ActiveX™ controls . . . , and Visual Basic [scripts]." *Id.* at 1:49–55. "Downloadables may also include plugins, which add to the functionality of an already existing application program." *Id.* at 1:56–57.

According to the '844 patent, "the Internet has become a major source of many system damaging and system fatal application programs, commonly referred to as 'viruses,'" and "programmers continue to design computer and computer network security systems for blocking these viruses." *Id.* at 1:32–39. Although, "[o]n the most part, these security systems have been relatively successful," the '844 patent explains, "these security systems are not configured to recognize computer viruses which have been attached to or configured as Downloadable application programs, commonly referred to as 'Downloadables.'" *Id.* at 1:40–44. The subject matter of the '844 patent, accordingly, "provides systems for protecting a network from suspicious Downloadables." *Id.* at 1:62–63. "The network system includes an inspector for linking Downloadable security profiles to a Downloadable, and a protection engine for examining the Downloadable and Downloadable security profiles to determine whether or not to trust the Downloadable security profiles." *Id.* at 1:65–2:2. In particular, according to the '844 patent, the system and method "may examine the Downloadable code to determine whether the code contains any suspicious operations, and thus may allow or block the Downloadable accordingly." *Id.* at 2:54–3:2. Further, "because the system and method . . . link a verifiable Downloadable security profile a Downloadable, the system and method may avoid decomposing the Downloadable into the Downloadable security profile on the fly." *Id.* at 3:3–7.

In the operation of a preferred embodiment of the '844 patent, a developer obtains or generates an uninspected Downloadable and transmits the Downloadable to the inspector for "hostility inspection," along with a developer certificate used to authenticate the developer. Ex. 1001, 3:55–65. The inspector includes a "content inspection engine" for examining a received Downloadable (e.g., the signed Downloadable from the developer), for generating a Downloadable security profile ("DSP") based on a rules base, and for attaching the DSP to the Downloadable. *Id.* at 3:66–4:4. The DSP "preferably includes a list of all potentially hostile or suspicious computer operations that may be attempted by the Downloadable, and may also include the respective arguments of these operations." *Id.* at 4:4–7. Preferably, the content inspection engine performs a full-content inspection, and generating a DSP includes searching the Downloadable code for undesirable patterns and patterns suggesting the code was written by a hacker, as well as comparing a Downloadable against Downloadables known to be hostile, Downloadables known to be non-hostile, and Downloadables previously examined by the content inspection engine. *Id.* at 4:7–17. After performing content inspection, the inspector attaches an inspector certificate to the Downloadable, verifying the authenticity of the DSP attached to the Downloadable, and transmits the signed, inspected Downloadable to a web server. *Id.* at 4:65–5:5. The web server then may transmit the Downloadable via a network gateway to a computer client. *Id.* at 5:11–13.

B. Priority Date of the '844 Patent

The Related U.S. Application Data field on the front page of the '844 patent includes a reference to Provisional Application No. 60/030,639 ("the

'639 provisional"), filed November 8, 1996. Ex. 1001, [60]. Separately, in a section entitled "PRIORITY REFERENCE TO RELATED APPLICATIONS," the '844 patent states that the '648 application "claims benefit of and . . . incorporates by reference [the '639 provisional]; patent application Ser. No. 08/964,388, . . . filed on Nov. 6, 1997 . . . ; and patent application Ser. No. 08/790,097, . . . filed on Jan. 29, 1997." *Id.* at 1:7–17. That statement, however, does not indicate how the '648 application and the earlier applications are related to one another (e.g., as continuations, continuations in part, or divisionals). *See* 37 C.F.R. § 1.78(a)(2) (1997) ("Any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications . . . must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior application . . . indicating the relationship of the applications.").

In March 2003, Patent Owner filed a "Petition to Amend Priority Claims Listed in Patent" (Ex. 1005, 1–3). Patent Owner's petition acknowledges that the '639 provisional had expired before the filing date of the '648 application and that priority "cannot be claimed directly from this application," but asserts that "priority is still achieved through the chain of priority" and requests that "[r]eference to the indirect claim of priority to the provisional application" be added. Ex. 1005, 2. Notably, the proposed amendment also does not indicate the relationship among the applications as required by 37 C.F.R. § 1.78(a)(2).

Petitioner points out that the Office never ruled upon Patent Owner's petition and contends that the petition was improper, in any event, under the rules in effect at the time the '648 application was filed. Pet. 4. Petitioner

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