UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CISCO SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

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Case IPR2017-02155
Patent 8,677,494 B2

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Before ZHENYU YANG, CHARLES J. BOUDREAU, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

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

I. INTRODUCTION

Cisco Systems, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 10, 11, and 14–16 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 authorization from the Board, Petitioner additionally filed a Reply to Patent Owner's Preliminary Response (Paper 8, "Reply"), to address Patent Owner's arguments concerning application of the Board's decision in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357 (PTAB Sept. 6, 2017) (Paper 19), which was designated as a precedential decision after the filing of the Petition; and Patent Owner filed a Corrected Sur-reply (Paper 10, "Sur-reply").

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. Related Proceedings

The parties report that the '494 patent is the subject of several district court actions, including *Finjan, Inc. v. Cisco Systems, Inc.*, 5:17-cv-00072 (N.D. Cal. 2017). Pet. 4–5; Paper 4, 1.

Certain claims of the '494 patent were challenged previously in petitions for *inter partes* review filed by Sophos, Inc. (Case IPR2015-01022), Symantec Corp. (Cases IPR2015-01892 and IPR2015-01897), Palo Alto Networks, Inc. (Case IPR2016-00159), and Blue Coat Systems, Inc. (Cases IPR2016-00890, IPR2016-01174, and IPR2016-01443). We denied the petitions in IPR2015-01022 on Sept. 24, 2015, IPR2015-01897 on February 26, 2016, and IPR2016-01443 on January 23, 2017. We instituted a trial in IPR2015-01892, to which we later joined Blue Coat as a petitioner on a motion for joinder filed in IPR2016-00890, and we issued a final written decision on March 15, 2017. We also instituted a trial in IPR2016-00159, to which we also later joined Blue Coat as a petitioner on a motion for joinder filed in IPR2016-01174, and we issued a final written decision on April 11, 2017. Both final written decisions are currently on appeal to the U.S. Court of Appeals for the Federal Circuit, in Appeal Nos. 17-2034 and 17-2543, respectively.

In addition to the instant Petition, Petitioner also has filed a petition seeking *inter partes* review of related U.S. Patent No. 6,154,844, which also is involved in the above-referenced *Finjan, Inc. v. Cisco Systems, Inc.* district court action. IPR2017-02154, Paper 1.

B. The '494 Patent

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. "[R]emotely 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.

C. Illustrative Claim

Of the challenged claims, only claim 10, reproduced below, is independent.

10. A system for managing Downloadables, comprising:

a receiver for receiving an incoming Downloadable;

a Downloadable scanner coupled with said receiver, for deriving security profile data for the Downloadable, including a list of suspicious computer operations that may be attempted by the Downloadable; and

a database manager coupled with said Downloadable scanner, for storing the Downloadable security profile data in a database.

Ex. 1001, 22:7–16.

D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claims	Basis	References
10, 11, 14–16	§ 103	Shear[1] and Kerchen[2]
10, 11, 14–16	§ 103	Crawford 91[3] and the knowledge of a person of ordinary skill in the art

Pet. 24. Petitioner also relies on a Declaration of Dr. Paul Clark, filed as Exhibit 1003.

II. DISCUSSION

A. Claim Construction

Based on the '494 patent's claim of priority from U.S. Patent Application No. 08/790,097, filed January 29, 1997, the '494 patent expired no later than January 29, 2017. *See* 35 U.S.C. § 154(a)(2). In an *inter partes* review, we construe claims of an expired patent according to the standard applied by the district courts. *See In re Rambus Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). Specifically, we apply the principles set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc).

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[1] US 6,157,721, issued Dec. 5, 2000 (filed Aug. 12, 1996) (Ex. 1004).

[2] Paul Kerchen et al., *Static Analysis Virus Detection Tools for UNIX Systems*, Proc. 13th Nat'l Computer Security Conf. 350 (1990) (Ex. 1019).

[3] R. Crawford et al., *A Testbed for Malicious Code Detection: A Synthesis of Static and Dynamic Analysis Techniques*, Proc. 14th Ann. Conf. Dep't Energy Computer Security Group (1991) (Ex. 1011).

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