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 IPR2018-00391
Patent 7,647,633 B2

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Before THOMAS L. GIANNETTI, MIRIAM L. QUINN, and
PATRICK M. BOUCHER, *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318

I. INTRODUCTION

We instituted *inter partes* review pursuant to 35 U.S.C. § 314 to review claims 1–4, 8, and 11–14 of U.S. Patent No. 7,647,633 B2 ("the '633 patent"), owned by Finjan, Inc. We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, Petitioner has shown by a preponderance of the evidence that claims 1–4, 8, and 11–13 of the '633 patent are unpatentable. Petitioner, however, has not shown by a preponderance of the evidence that claim 14 of the '633 patent is unpatentable.

II. BACKGROUND

A. RELATED MATTERS

The parties identify several district court cases (N.D. Cal.) involving the '633 patent. Pet. 5; *see also* Paper 4. The '633 patent also has been the subject of various proceedings at the USPTO, including *Palo Alto Networks, Inc. v. Finjan, Inc.*, Case IPR2015-01974 (PTAB), in which the Board issued a Final Written Decision concerning claims 14 and 19 of the '633 patent. Paper 4; Ex. 2002. The '633 patent also has been the subject of an ex parte reexamination (Control No. 90/013,016). Ex. 2001.

B. THE '633 PATENT (EX. 1001)

The '633 patent relates to a system and a method for protecting network-connectable devices from undesirable downloadable operations. Ex. 1001, 1:30–33. The patent describes that "[d]ownloadable information comprising program code can include distributable components (e.g.

JAVA™ applets and JAVAScript scripts, ActiveX™ controls, Visual Basic, add-ins and/or others)." *Id.* at 1:60–63. Protecting against only some distributable components does not protect against application programs, Trojan horses, or zip or meta files, which are other types of "Downloadable information." *Id.* at 1:63–2:2. The '633 patent "enables more reliable protection." *Id.* at 2:27–28. According to the Summary of the Invention,

> In one aspect, embodiments of the invention provide for determining, within one or more network "servers" (e.g. firewalls, resources, gateways, email relays or other devices/processes that are capable of receiving-and-transferring a Downloadable) whether received information includes executable code (and is a "Downloadable"). Embodiments also provide for delivering static, configurable and/or extensible remotely operable protection policies to a Downloadable-destination, more typically as a sandboxed package including the mobile protection code, downloadable policies and one or more received Downloadables. Further client-based or remote protection code/policies can also be utilized in a distributed manner. Embodiments also provide for causing the mobile protection code to be executed within a Downloadable-destination in a manner that enables various Downloadable operations to be detected, intercepted or further responded to via protection operations. Additional server/information-destination device security or other protection is also enabled, among still further aspects.

Id. at 2:39–57.

C. ILLUSTRATIVE CLAIMS

Challenged claims 1, 8, 13, and 14 of the '633 patent are independent. Illustrative claims 1 and 14 are reproduced below.

> 1. A computer processor-based method, comprising:
> receiving, by a computer, downloadable-information;
> determining, by the computer, whether the

downloadable-information includes executable code; and
based upon the determination, transmitting from the computer mobile protection code to at least one information-destination of the downloadable-information, if the downloadable-information is determined to include executable code.

14. A computer program product, comprising a computer usable medium having a computer readable program code therein, the computer readable program code adapted to be executed for computer security, the method comprising:
providing a system, wherein the system comprises distinct software modules, and wherein the distinct software modules comprise an information re-communicator and a mobile code executor;
receiving, at the information re-communicator, downloadable-information including executable code; and
causing mobile protection code to be executed by the mobile code executor at a downloadable-information destination such that one or more operations of the executable code at the destination, if attempted, will be processed by the mobile protection code.

Id. at 20:54–62, 21:58–22:5. We refer to the three steps of claim 1 as the "receiving step," the "determining step," and the "transmitting step," respectively.

D. PROCEDURAL HISTORY

Petitioner, Cisco Systems, Inc., filed a Petition for *inter partes* review challenging claims 1–4, 8, and 11–14 of the '633 patent. Paper 1 ("Pet."). Patent Owner, Finjan, Inc., filed a Preliminary Response. Paper 6 ("Prelim. Resp."). On June 5, 2018, we determined that Petitioner had shown a reasonable likelihood of prevailing on its unpatentability challenge as at least one claim, and we instituted trial. Paper 7 ("Dec. on Inst.").

During trial, Patent Owner filed a Patent Owner Response (Paper 12 ("PO Resp.")) and Petitioner filed a Reply (Paper 16 ("Reply")). Patent Owner requested authorization to file a Sur-reply, which we granted. Paper 18; Paper 22 ("Sur-reply"). Both parties filed Motions to Exclude and corresponding responsive papers. Papers 19, 23, 24, 27–29. We heard oral argument on March 6, 2019, a transcript of which is filed in the record. Paper 32 ("Tr.").

E. EVIDENCE OF RECORD

Petitioner relies upon the following references as evidence of prior art:

1) *Hanson*: PCT Published Application WO 98/31124, published on July 16, 1998 (Exhibit 1004);

2) *Hyppönen*: U.S. Patent No. 6,577,920 B1, issued on June 10, 2003 (Exhibit 1005); and

3) *Touboul*: PCT Published Application WO 98/21683 (Exhibit 1007).

In addition, Petitioner supports its contentions with the Declaration of Paul Clark, Ph.D. Ex. 1003 ("Clark Declaration"). With its Patent Owner Response, Patent Owner provides a Declaration of Nenad Medvidovic, Ph. D. Ex. 2008 ("Medvidovic Declaration").

F. GROUNDS OF UNPATENTABILITY

The following grounds of unpatentability are at issue (Pet. 32):

Claim(s)	Basis	References
1–4, 8, 11, 13, 14	§ 103	Hanson and Hyppönen
12	§ 103	Hanson, Hyppönen, and Touboul

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