

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*.

DECISION  
Institution of *Inter Partes* Review  
35 U.S.C. § 314(a)

Cisco Systems, Inc. (“Petitioner”) filed a Petition to institute *inter partes* review of claims 1–4, 8, 11, 13, and 14 of U.S. Patent No. 7,647,633 B2 (“the ’633 patent”) pursuant to 35 U.S.C. § 311–319. Paper 1 (“Pet.”). Finjan, Inc. (“Patent Owner”) timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

For the reasons that follow, we institute *inter partes* review.

## I. BACKGROUND

### A. RELATED MATTERS

The parties identify a multitude of district court cases (N.D. Cal.) in which the ’633 patent is involved. Pet. 5; *see also* Paper 4. The ’633 patent has also 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 operation. Ex. 1001, 1:30–33. The patent describes that “Downloadable 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.

#### D. ASSERTED REFERENCES AND GROUNDS OF UNPATENTABILITY

Petitioner asserts three grounds of unpatentability based on the following references:

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

The grounds identified in the Petition are as listed below (Pet. 32).

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

Petitioner further relies on the Declaration of Paul Clark, Ph.D., in support of the asserted grounds. Ex. 1003 (“Clark Declaration”).

## II. ANALYSIS

### A. CLAIM CONSTRUCTION

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). With regard to terms drafted in means-plus-function language, “[a]pplication of § 112, ¶ 6 requires identification of the structure in the specification which performs the recited function.” *Micro Chemical, Inc., v. Great Plains Chemical Co., Inc.*, 194 F.3d 1250, 1257 (Fed. Cir. 1999); *see also* 37 C.F.R. § 42.104(b)(3). Further, the statute does not permit “incorporation of structure from the written description beyond that necessary to perform the claimed function.” *Id.* at 1258.

#### 1. Means-Plus-Function Terms

Petitioner proposes construction for various terms written in means-plus-function format, recited in claim 13. Pet. 20–22. Patent Owner addresses those means-plus-function terms. Prelim. Resp. 11–13. The differences between the parties’ proposed constructions are noted below with regard to the alleged structures:

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