UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

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Case IPR2015-01979
Patent 8,141,154 B2

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Before, THOMAS L. GIANNETTI, RICHARD E. RICE, and
MIRIAM L. QUINN, *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge.*

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

Palo Alto Networks, Inc. ("Petitioner") filed a Petition to institute *inter partes* review of claims 1–8, 10, and 11 of U.S. Patent No. 8,141,154 B2 ("the '154 patent") pursuant to 35 U.S.C. § 311–319. Paper 2 ("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 *grant* the Petition.

I.   BACKGROUND

A. RELATED MATTERS

Petitioner identifies that the patent-at-issue is the subject matter of various district court cases filed in the U.S. District Court for the Northern District of California (Case Nos. 3:14-cv-04908, 5:14-cv-02998, 5:15-cv-01353, 5:14-cv-04398, 3:14-cv-01197, and 3:13-cv-05808). Pet. 3. Petitioner also states that petitions for *inter partes* review have been filed regarding other patents at issue in the foregoing district court cases. *Id.*

B. ASSERTED GROUNDS

Petitioner contends that claims 1–8, 10, and 11("the challenged claims") are unpatentable under 35 U.S.C. § 103 based on the following specific grounds:

Reference[s]	Basis	Claims challenged
Khazan[1] and Sirer[2]	§ 103	1–5
Khazan, Sirer, and Ben-Natan[3]	§ 103	2, 4–8, 10, and 11

C. THE '154 PATENT (EX. 1001)

The '154 patent relates to computer security, and, more particularly, to systems and methods for protecting computers against malicious code such as computer viruses. Ex. 1001, 1:7–9, 8:38–40. The '154 patent identifies the components of one embodiment of the system as follows: a gateway computer, a client computer, and a security computer. *Id.* at 8:45–47. The gateway computer receives content from a network, such as the Internet, over a communication channel. *Id.* at 8:47–48. "Such content may be in the form of HTML pages, XML documents, Java applets and other such web content that is generally rendered by a web browser." *Id.* at 8:48–51. A content modifier modifies original content received by the gateway computer and produces modified content that includes a layer of protection to combat dynamically generated malicious code. *Id.* at 9:13–16.

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[1] Patent Application Pub. No. US 2005/0108562 A1 (Exhibit 1003) ("Khazan").
[2] Sirer et al., *Design and Implementation of a Distributed Virtual machine for Networked Computers* (1999) (Exhibit 1004) ("Sirer").
[3] U.S. Patent No. 7,437,362 B1 (Exhibit 1005) ("Ben-Natan").

D. ILLUSTRATIVE CLAIMS

Challenged claims 1, 4, 6, and 10 are independent, and illustrative claim 1 is reproduced below.

> 1. A system for protecting a computer from dynamically generated malicious content, comprising:
> a content processor (i) for processing content received over a network, the content including a call to a first function, and the call including an input, and (ii) for invoking a second function with the input, only if a security computer indicates that such invocation is safe;
> a transmitter for transmitting the input to the security computer for inspection, when the first function is invoked; and
> a receiver for receiving an indicator from the security computer whether it is safe to invoke the second function with the input.

II.   ANALYSIS

A. CLAIM INTERPRETATION

The Board interprets claims using the "broadest reasonable construction in light of the specification of the patent in which [they] appear[]." 37 C.F.R. § 42.100(b). We presume that claim terms have their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) ("The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.") (citation omitted).

Petitioner proposed constructions for four terms: "first function," "second function," "transmitter," "receiver." *See* Pet. 9–13. The proposed constructions are as follows:

Term	Petitioner's Proposed Construction
first function	Substitute function (Pet. 9–10)
second function	Original function (Pet. 10–11)
transmitter	A circuit or electronic device designed to send electrically encoded data to another location (Pet. 11–12)
receiver	A circuit or electronic device designed to accept data from an external communication system (Pet. 12–13).

Petitioner generally supports its proposed constructions with citations to the specification of the '154 patent and opinion testimony of its witness, Dr. Aviel Rubin (Rubin Decl. or Ex. 1002). *Id.*

Patent Owner submits that each of the terms has a plain and ordinary meaning understood to a person of ordinary and that no construction is needed. Prelim. Resp. 6–12. Upon review of the arguments and evidence presented in the Petition and the Preliminary Response, we conclude that none of these terms are at the heart of the parties' arguments, and, therefore, construction of these terms is not helpful in our determination of whether to institute *inter partes* review. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (only claim terms in controversy need to be construed, and only to the extent necessary to resolve the controversy). Accordingly, we do not construe any claim terms at this time.

B. OBVIOUSNESS GROUND BASED ON KHAZAN AND SIRER

Petitioner asserts that Khazan discloses "every element of the Petitioned Claims except a modified input variable and details of performing

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