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Paper 10
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-00151
Patent 8,141,154 B2

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

QUINN, *Administrative Patent Judge.*

DECISION

Partial Institution of *Inter Partes* Review; Motion for Joinder
37 C.F.R. § 42.108; 35 U.S.C. § 315(c)

Palo Alto Networks, Inc. ("Petitioner") filed a Petition to institute *inter partes* review of claims 1–12 of U.S. Patent No. 8,141,154 B2 ("the '154 patent") pursuant to 35 U.S.C. §§ 311–319. Paper 2 ("Pet."). Petitioner also filed a Motion for Joinder (Paper 3, "Mot."). Finjan, Inc. ("Patent Owner") timely filed a Preliminary Response. Paper 8 ("Prelim. Resp."). In its Preliminary Response, Patent Owner addresses Petitioner's Motion for Joinder. *Id.* at 1. We have jurisdiction under 35 U.S.C. § 314.

For the reasons that follow, we *grant* the Petition as to claims 1–8, 10, and 11, and *deny* Petitioner's Motion for Joinder.

I. BACKGROUND

A. RELATED MATTERS

Petitioner states that Patent Owner "has filed a patent infringement lawsuit against Petitioner, and similar actions against other Defendants." Pet. 42. Those district court cases are identified as Case Nos.: 1-08-cv-00300-GMS (D. Del. May 21, 2008); 5:13-cv-03999-BLF (N.D. Cal. Aug. 28, 2013); 3-14-cv-04908-JSC (N.D. Cal. Nov. 4, 2014); 5-15-cv-03295-BLF (N.D. Cal. July 15, 2015). *Id.* Petitioner also states that petitions for *inter partes* review have been filed regarding other patents assigned to Patent Owner. *Id.*

B. ASSERTED GROUNDS

Petitioner contends that claims 1–12 ("the challenged claims") are unpatentable under 35 U.S.C. § 103 based on the following specific grounds:

Reference[s]	Basis	Claims challenged
Ross[1]	§ 103	1–8, 10, and 11
Ross and Calder[2]	§ 103	9 and 12

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.

[1] Patent Application Pub. No. US 2007/0113282 A1 (Exhibit 1003) ("Ross").
[2] Patent Application Pub. No. US 2002/0066022 A1 (Exhibit 1004) ("Calder").

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.'" (quoting *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed Cir. 2005) (en banc))).

Petitioner proposed a construction for one term: "dynamically generate[d]." *See* Pet. 8–9. Patent Owner responded that the term has a plain and ordinary meaning understood to a person of ordinary skill in the art, and that it needs no construction. Prelim. Resp. 8–10. We do not need

to construe a proposed term if the construction is not helpful in our determination of whether to institute trial. *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). Because the construction of the term "dynamically generate[d]" is not germane to our determination whether to institute trial, we do not consider either of the parties' arguments. Accordingly, we do not construe any claim terms at this time.

B. Section 325(d) and Motion for Joinder

The instant Petition was filed with a Motion for Joinder, alleging similarities with the petition filed previously, by Symantec, in IPR2015-01547 ("the 1547 IPR"). Mot. 2. The Motion states that the grounds alleged in both petitions "use the same art and substantially the same arguments to invalidate the claims of the . . . '154 patent." *Id.* Patent Owner urges the Board to decline institution of *inter partes* review under 35 U.S.C. § 325(d), given the above-mentioned statement in Petitioner's Motion. Prelim. Resp. 10–11. We do not agree with Patent Owner, and we decline to exercise our discretion and deny the Petition under § 325(d) for three reasons.

First, we find material differences in the arguments presented in the 1547 IPR and the Petition here. For example, we determined in the 1547 IPR that the petition there focused on web content being the "content received over a network," whereas here, we consider a different contention—that web content *and* hook scripts are the recited "content." Furthermore, the 1547 IPR petition proposed different grounds of challenge. Although Ross also was the centerpiece of the 1547 IPR, the Petitioner there contended Ross anticipated independent claims 1 and 4, with the same

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