

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-00145
Patent 7,613,926 B2

Before JAMES B. ARPIN, ZHENYU YANG, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

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

INTRODUCTION

Palo Alto Networks, Inc. (“Petitioner”) filed a Petition for an *inter partes* review of claims 1–5, 8–12, 15–19, 22–26, 29, and 30 of U.S. Patent No. 7,613,926 B2 (Ex. 1001, “the ’926 patent”). Paper 1 (“Pet.”). Finjan, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

Based on this record, we determine Petitioner has not established a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim. *See* 35 U.S.C. § 314(a). Therefore, we deny the Petition for an *inter partes* review.

Related Proceedings

According to the parties, Patent Owner previously asserted the ’926 patent against Petitioner in *Finjan, Inc. v. Palo Alto Networks, Inc.*, 3:14-cv-04908 (N.D. Cal.). Pet. 1–2; Paper 6, 1.

The ’926 patent is the subject of *Finjan, Inc. v. Sophos, Inc.*, 3:14-cv-01197 (N.D. Cal.), and *Finjan, Inc. v. Symantec Corp.*, 3:14-cv-02998 (N.D. Cal.). Pet. 2; Paper 6, 1. The ’926 patent was also the subject of IPR2015-00907, filed by Sophos Inc., and IPR2015-01893 and IPR2015-01895, filed by Symantec Corporation. We previously denied those petitions. *Sophos, Inc. v. Finjan, Inc.*, IPR2015-00907 (PTAB Sept. 24, 2015) (Paper 8); *Symantec Corp. v. Finjan, Inc.*, IPR2015-01893 (PTAB Mar. 11, 2016) (Paper 8); *Symantec Corp. v. Finjan, Inc.*, IPR2015-01895 (PTAB Feb. 26, 2016) (Paper 7).

The '926 Patent

The '926 patent is directed to systems and methods to protect personal computers and other network accessible devices from “harmful, undesirable, suspicious or other ‘malicious’ operations that might otherwise be effectuated by remotely operable code.” Ex. 1001, 2:27–31. The protection paradigm involves hashing an incoming Downloadable to derive a “Downloadable ID,” which is used to reference security profile data for the incoming Downloadable in a database indexed according to Downloadable IDs. *Id.* at 2:27–4:49. The Downloadable security profile (“DSP”) data for each Downloadable include “a list of suspicious computer operations that may be attempted by the Downloadable.” *Id.* at 21:66–67. The Downloadable and a representation of the DSP data are sent to a destination computer. *Id.* at 22:1–4.

Illustrative Claim

Among the challenged claims, claims 1, 8, 15, 22, 29, and 30 are independent. Claim 1 is illustrative and is reproduced below:

1. A computer-based method, comprising the steps of:
receiving an incoming Downloadable;
performing a hashing function on the incoming Downloadable to compute an incoming Downloadable ID;
retrieving security profile data for the incoming Downloadable from a database of Downloadable security profiles indexed according to Downloadable IDs, based on the incoming Downloadable ID, the security profile data including a list of suspicious computer operations that may be attempted by the Downloadable;

appending a representation of the retrieved Downloadable security profile data to the incoming Downloadable, to generate an appended Downloadable; and
transmitting the appended Downloadable to a destination computer.

Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claims	Basis	References
1–5, 8–12, 29	§ 103	Touboul ¹ and the '583 publication ²
15–19, 22–26, 30	§ 103	Touboul I, the '583 publication, and Ji ³

In support of its patentability challenge, Petitioner relies on the Declaration of Dr. Aviel D. Rubin. Ex. 1002.

ANALYSIS

Claim Construction

In an *inter partes* review, the Board interprets a claim term in an unexpired patent according to its broadest reasonable construction in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 890 (mem.) (2016).

¹ Shlomo Touboul, International Pub. No. WO 98/21683, published on May 22, 1998 (Ex. 1003, “Touboul”).

² Shlomo Touboul, International Pub. No. WO 99/35583, published on July 15, 1999 (Ex. 1005, “the '583 publication”).

³ Shuang Ji and Eva Chen, U.S. Patent No. 5,623,600, issued on April 22, 1997 (Ex. 1006, “Ji”).

Petitioner contends that “[t]he broadest reasonable interpretation of ‘append/append’ [a representation of the retrieved Downloadable security profile data to the Downloadable] is ‘attach/attaching.’” Pet. 18–19. Patent Owner disagrees, arguing that the terms “need no specific construction as they are readily understood by one of skill in the art. Prelim. Resp. 12. For purposes of this Decision, we adopt Petitioner’s proposed construction.

On this record and for purposes of this Decision, we determine that no other claim terms require express construction.

Discussion

Petitioner contends that the combination of Touboul and the ’583 publication renders claims 1–5, 8–12, and 29 obvious. Pet. 25–52. In addition, Petitioner argues that the combination of Touboul, the ’583 publication, and Ji renders claims 15–19, 22–26, and 30 obvious. *Id.* at 52–60. According to Petitioner, Touboul I, the ’583 publication, and Ji qualify as prior art because the challenged claims are only entitled to a March 7, 2006 priority date. *Id.* at 9–15. Alternatively, Petitioner argues, the earliest possible priority date is May 17, 2001. *Id.* at 15–16. Based on the record before us, and for the following reasons, we are not persuaded.

Priority Date

The ’926 patent issued from Application No. 11/370,114, filed on March 7, 2006. Ex. 1001, (21), (22). According to the ’926 patent, the ’114 application is a continuation of Application No. 09/861,229 (“the ’229 application”), filed on May 17, 2001, now U.S. Patent No. 7,058,822 B2 (“the ’822 patent”). *Id.* at 1:8–32. The ’229 application is a continuation-in-part of Application No. 09/539,667, filed on March 30, 2000, now U.S.

Patent No. 6,804,780 B1 (“the ’780 patent”), which is a continuation of Application No. 08/964,388, filed on November 6, 1997, now U.S. Patent No. 6,092,194 (“the ’194 patent”). *Id.* Thus, on its face, the earliest claimed priority date for the ’926 patent is November 6, 1997.

According to Petitioner, however, “[i]ndependent claims in the ’926 patent recite new subject matter that was not introduced until the filing date of the ’926 patent—March 7, 2006.” Pet. 9. Specifically, Petitioner points out that claims 1, 8, and 29 recite “appending a representation of the retrieved Downloadable security profile data to the incoming Downloadable, to generate an appended Downloadable.” *Id.* at 12. Claims 1, 8, and 29 further recite “transmitting the appended Downloadable to a destination computer,” and claims 15, 22 and 30 recite “transmitting the incoming Downloadable and a representation of the retrieved Downloadable security profile data to a destination computer.” *Id.* at 14. Petitioner argues that these limitations were “first described in the originally-filed claims of the ’926 patent.” *Id.* at 11. As a result, Petitioner asserts, the earliest possible priority date of the challenged claims is March 7, 2006, the filing date of the ’926 patent. *Id.*

Patent Owner counters that the ’194 patent discloses “the DSP data can be retrieved by the code scanner before sending the Downloadable and the DSP data, as shown by the arrow from DSP Data 310 within Security Database 240 to Code Scanner 325 in FIG. 3” of the ’194 patent. Prelim. Resp. 21. Patent Owner refers to the ’194 patent for disclosing:

The code scanner **325** then stores the DSP data into DSP data **310** (corresponding to its Downloadable ID), and sends the

Downloadable, the DSP data to the ACL comparator **330** for comparison with the security policy **305**.

The ACL comparator **330** receives the Downloadable, the corresponding DSP data and the security policy **305** from the code scanner **325**, and compares the DSP data against the security policy **305**.

Ex. 1007, 6:5–19; Prelim. Resp. 21. Patent Owner points out that the '194 patent discloses that “any component of the invention may be implemented as network connected computer such as a network of interconnected conventional components.” *Id.* at 20 n.4 (citing Ex. 1007, 9:65–10:1). Thus, Patent Owner concludes, the '194 patent discloses both the appending and the transmitting steps, even though it does not use the exact word for the description. *Id.* at 22–23. Based on this record, we find Patent Owner's argument more persuasive.

The '194 patent describes the code scanner sending the Downloadable and the DSP data to the ACL comparator for comparison with the security policy. Ex. 1007, 6:9–12. Petitioner does not argue that the Downloadable and the DSP data must be transmitted independently. In other words, the Downloadable and the DSP data may be transmitted together, that is, with the DSP data attached to the Downloadable. As stated above, we accept Petitioner's proposed construction of “append/appending” to mean “attach/attaching.” *See supra* at 5. Thus, we are persuaded by Patent Owner that the '194 patent provides written description support for both the appending and the transmitting limitations.

Because the '194 and '780 patents share essentially the same disclosure (Ex. 1042, 1:7–11), and the '822 patent and the '926 patent each

incorporates the '780 patent by reference (Ex. 1001, 1:8–22; Ex. 1041, 1:11–14), we agree with Patent Owner that there is continuity in written description support for the appending and the transmitting limitations in the priority chain of the '926 patent.

Thus, based on the record before us and for the reasons stated above, we determine that the challenged claims of the '926 patent are entitled to the benefit of the November 6, 1997, filing date.

Obviousness Grounds

Petitioner contends that the combination of Touboul, the '583 publication, and Ji renders the challenged claims obvious. Pet. 25–60. As explained above, the challenged claims are entitled to the benefit of the November 6, 1997 filing date. Touboul was published on May 22, 1998 (Ex. 1003 (43)), while the '583 publication was published on July 15, 1999 (Ex. 1005 (43)). Thus, neither qualifies as prior art. We conclude, therefore, that Petitioner has not demonstrated that the combination of Touboul and the '583 publication, or the combination of Touboul, the '583 publication, and Ji, renders the challenged claims obvious.

CONCLUSION

On this record, Petitioner has not shown that Touboul and the '583 publication are prior art to the challenged claims of the '926 patent. Accordingly, Petitioner has not demonstrated a reasonable likelihood of prevailing on its challenges to the patentability of at least one of those claims on the grounds asserted in the Petition.

ORDER

Accordingly, it is

ORDERED that Petitioner's request for an *inter partes* review of claims 1–5, 8–12, 15–19, 22–26, 29, and 30 of the '926 patent is *denied*.

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