

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUE COAT SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-01444
Patent 8,079,086 B1

Before JAMES B. ARPIN, PATRICK M. BOUCHER, and
ZHENYU YANG, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

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

On July 15, 2016, Blue Coat Systems, Inc. (“Petitioner”) filed a
Petition (Paper 2, “Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an
inter partes review of claims 1, 4–6, 9, 12–14, 17, 24, 35, 37, and 42 of U.S.

Patent No. 8,079,086 B1 (“the ’086 patent”). Finjan, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6) on November 18, 2016. Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we deny the Petition and do not institute an *inter partes* review.

I. BACKGROUND

A. The ’086 Patent

The ’086 patent discloses systems and methods capable of protecting 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, col. 2, ll. 30–35.

The ’086 patent matured from U.S. Patent Application No. 12/471,942, filed on May 26, 2009, and the face of the original patent bears claims to the benefit of the filing dates of several other applications under 35 U.S.C. § 120. *Id.* at [21], [22], [63]. The earliest of these, namely U.S. Patent Application No. 08/964,388 (now issued as U.S. Patent No. 6,092,194), has a filing date of November 6, 1997. *Id.* at [63].

Petitioner observes that “the applicant [of the ’086 patent] unsuccessfully attempted to claim priority to U.S. [Provisional Patent] Application No. 60/030,639, filed November 8, 1996.” Pet. 5 (citing Ex. 1011, 521–22, 378). Consequently, Petitioner contends that “the priority date of the ’086 patent is no earlier than the **November 6, 1997** filing date of U.S. patent application No. 08/964,388.” *Id.*

But on December 9, 2015, a request for *ex parte* reexamination of the '086 patent ("the reexamination") was filed by a third party requester. Ex. 3001. On September 1, 2016, (1) a petition ("the Priority Petition") was filed by the applicant of the '086 patent to accept an unintentionally delayed claim of priority under 35 U.S.C. §§ 119 and 120 for the benefit of a prior-filed application pursuant to 37 C.F.R. § 1.78; and (2) an amendment to the same effect ("the Reexamination Amendment") was filed concurrently in the reexamination. Exs. 3002, 3003. The Priority Petition and Reexamination Amendment sought, *inter alia*, correction of the '086 patent to reflect a claim for the benefit of the November 8, 1996, filing date of U.S. Provisional Patent Application No. 60/030,639. Ex. 3002, 2¹; Ex. 3003, 2.

The Priority Petition was granted on September 21, 2016. Ex. 3004. On October 31, 2016, the Office issued a Notice of Intent to Issue Ex Parte Reexamination Certificate that noted the grant of the Priority Petition. Ex. 3005, 6 ("In addition to the previous claimed priority, the '086 patent now also claims Application No. 08/790,097, now U.S. Patent No. 6,167,520 . . . , which claims priority to Provisional Patent Application No. 60/030,639."). A Reexamination Certificate issued on November 28, 2016, reflecting the claim for the benefit of the November 8, 1996, filing date of U.S. Provisional Application No. 60/030,639. Ex. 3006 at [60].

B. References

Petitioner relies on the following references. Pet. 7–12.

¹ References to page numbers in the Board's exhibits refer to the page numbers added in the bottom right-hand corner of each page.

Morton Swimmer, Baudouin Le Charlier, and Abdelaziz Mounji, *Dynamic Detection and Classification of Computer Viruses Using General Behaviour Patterns*, PROC. FIFTH INT’L VIRUS BULL. CONF. 75 (Virus Bulletin Ltd. 1995) (Ex. 1003) (“Swimmer”).

George C. Necula, *Proof-Carrying Code*, PROC. 24TH ACM SIGPLAN-SIGACT SYMP. ON PRINCIPLES OF PROGRAMMING LANGUAGES 106 (ACM 1997) (Ex. 1004) (“Necula”).

M. Douglas McIlroy, *Virology 101*, 2 COMP. SYS. 173 (1989) (Ex. 1005) (“McIlroy”).

Ari Luotonen and Kevin Altis, *World-Wide Web proxies*, 27 COMP. NETWORKS AND ISDN SYS. 147 (1994) (Ex. 1006) (“Luotonen”).

C. Asserted Grounds of Unpatentability

Petitioner challenges claims 1, 4–6, 9, 12–14, 17, 24, 35, 37, and 42 under 35 U.S.C. § 103(a) over the following combinations of references. Pet. 14–15.

References	Claims
Swimmer and Necula	1, 5, 9, 13, 17, 24, and 42
Swimmer, Necula, and McIlroy	4 and 12
Swimmer, Necula, and Luotonen	6, 14, 35, and 37

D. Related Proceedings

Both parties identify *Finjan, Inc. v. Blue Coat, Inc.*, No. 5:15-cv-03295 (N.D. Cal.) as involving the ’086 patent. Pet. 13; Paper 3, 1. Petitioner also identifies the following matters as involving the ’086 patent: *Finjan, Inc. v. Symantec Corp.*, No. 3:14-cv-02998 (N.D. Cal.); *Finjan, Inc. v. Sophos Inc.*, No. 3:14-cv-01197 (N.D. Cal.); and *Finjan, Inc. v. Palo Alto Networks, Inc.*, No. 3:14-cv-04908 (N.D. Cal.). Pet. 13–14. Patent Owner

additionally identifies the following matters as involving the '086 patent: *Finjan, Inc. v. ESET, LLC*, No. 3:16-cv-03731 (N.D. Cal.) and *Finjan, Inc. v. FireEye, Inc.*, No. 4:13-cv-03133 (N.D. Cal.). Paper 3, 1.

Patent Owner's Mandatory Notices, filed August 5, 2016, identify the reexamination as a related matter: "An *ex parte* reexamination of the '086 Patent is pending in Control No. 09/013,654." Paper 3, 1.

II. ANALYSIS

Each of Petitioner's challenges relies on Necula, and Petitioner provides considerable argument in its Petition to support its contention that Necula is prior art to the claims of the '086 patent. But all of that argument is based on the original priority claim set forth on the face of the '086 patent, and Petitioner's conclusion that "the priority date of the '086 patent is no earlier than the **November 6, 1997** filing date of U.S. patent application No. 08/964,388" based on that claim. Pet. 5. Specifically, Petitioner asserts that Necula "was published at least by January 17, 1997, . . . and publicly available prior to November 6, 1997." Pet. 18. Petitioner relies on various facts to support this assertion.

First, Petitioner contends that "Dr. Necula presented in Session 3 [of the 24th ACM SIGPLAN-SIGACT symposium on Principles of programming languages] on January 15th, 1997 and the Necula paper was distributed as part of the conference materials." *Id.* at 17 (citing Ex. 1020, v, 106–119).

Second, Petitioner contends that "Dr. Lee, a co-author of the Necula paper, maintained a public website that identified the Necula paper, discussed its contents, and made the paper available for download by

hyperlink at least by May 12, 1997.” *Id.* (citing Ex. 1025). Although Petitioner provides evidence of a paper linked on such a web site that bears the same title as Necula, it identifies the authors as “George Necula and Peter Lee,” while Necula identifies only “George C. Necula” as its sole author. *Compare* Ex. 1025, 1 with Ex. 1004, 1.

Third, Petitioner contends that “Dr. Bestavros recalls Necula circulating in the technical community in early 1997 and personally recalls reading the paper.” Pet. 17 (citing Ex. 1002 ¶¶ 58–59).²

Fourth, Petitioner contends that “numerous publications prior to November 6th, 1997 cited the Necula 1997 POPL paper, demonstrating its accessibility to the public.” *Id.* at 18 (citing Exs. 1017, 1018, 1019, 1021, 1022, 1024).

We need not assess this evidence because, in view of the impact of the amendment to the ’086 patent’s priority claim entered during reexamination, Petitioner’s arguments regarding the earliest priority date of the ’086 patent are based on facts that have changed demonstrably since the filing of the Petition, namely, that the ’086 patent does not claim priority successfully to U.S. Provisional Patent Application No. 60/030,639.

We recognize that the priority claim was amended after the Petition was filed. Nevertheless, Patent Owner complied with our regulation

² In a footnote, Petitioner remarks that Dr. Bestavros testifies that the “content of Necula” also is found in another reference that bears a date of “September 1996” and includes a date stamp of February 19, 1997. Pet. 17–18 n.1 (citing Ex. 1016; Ex. 1002 ¶¶ 58–59). We accord this remark no weight. The Petition neither relies on Exhibit 1016 to support its challenges nor presents any argument that the “September 1996” date that it bears is a publication date or other evidence of public accessibility.

requiring both parties to “[i]dentify any . . . administrative matter *that would affect*, or be affected by, a decision in the proceeding” by filing Mandatory Notices that unambiguously identify the reexamination as such a related administrative proceeding. 37 C.F.R. § 42.8(b)(2) (emphasis added); Paper 3, 1; see Office Trial Practice Guide, 77 Fed. Reg. 48756, 48760 (Aug. 14, 2012) (“Administrative matters include every application and patent claiming, or which may claim, the benefit of the priority of the filing date of the party’s involved patent or application as well as any *ex parte* and *inter partes* reexaminations for an involved patent.”). The underlying purpose of this aspect of the mandatory notices requirement is self-evident: by apprising the parties and the Board of related proceedings, it affords an opportunity and expectation that actions be taken to account for impactful developments in such related proceedings. Indeed, our regulations specifically contemplate and provide an opportunity for additional briefing when good cause exists to do so. *See generally* 37 C.F.R. § 42.108(c) (petitioner may seek leave to file a reply to a preliminary response with a showing of good cause); *see also Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073, 1082 (Fed. Cir. 2015) (“With no Board denial of concrete, focused requests before us, we are not prepared to find that Belden was denied a meaningful opportunity to respond to the grounds of rejection . . .”).

Petitioner has taken no steps to explain or respond to the effect of those developments on its argument, leaving the Board to surmise what Petitioner’s position might be in light of the amended priority claim. For example, the Petition makes the following argument in contending that the

“priority date of the ‘086 patent is no earlier than the November 6, 1997 date of U.S. patent application No. 08/964,388”:

During prosecution, the applicant unsuccessfully attempted to claim priority to U.S. Application No. 60/030,639, filed on November 8, 1996. EX1011 at 521-22, 378. The examiner, however, determined that the ‘639 application did not provide support for *the pending claims* to claim priority to the November 1996 date. EX1011 at 119. In addition, U.S. Patent No. 7,613,926 fails to claim priority to the ‘639 provisional application and instead the earliest priority document cited in the ‘926 patent is U.S. Patent No. 6,092,194 (‘the ‘194 patent’). EX1012 at 1:8-32.

Pet. 5 (emphasis added). Not only does this argument not account for the amended priority claim, it refers to “*pending claims*” that subsequently were canceled during prosecution, rather than the claims that ultimately issued. Ex. 1011, 98–109 (emphasis added); *see id.* at 108 (“Applicants have cancelled claims **77–97** *without acquiescence* to the Examiner’s reasons for rejection, and submit that rejection of these claims is thus rendered moot.” (emphasis added)). The Petition, thus, fails to link this argument to the *issued* claims that it now challenges. Consequently, we are not persuaded that Petitioner’s arguments regarding the once pending, but now canceled, claims can be applied properly to the challenged, *issued* claims in light of the amended priority claim and Applicants’ express refusal to acquiesce to

the Examiner's rejection of the canceled claims.³ It is not appropriate for the panel to correct and then reinterpret Petitioner's Petition, and we cannot determine that Petitioner has shown a reasonable likelihood of prevailing on arguments based on an incorrect statement of the facts.

Accordingly, on this record, we conclude that Petitioner has not demonstrated a reasonable likelihood of prevailing on any of its challenges, and deny the Petition.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied*, and no *inter partes* review is instituted.

³ The Federal Circuit instructs that once a petitioner satisfies its initial burden of production that a reference is prior art, the burden of production shifts to the patent owner to demonstrate that the reference is not prior art. *See Dynamic Drinkware, LLC. v. National Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015) ("The burden of production then shifted to National Graphics to argue or produce evidence that either Raymond does not actually anticipate, or, as was argued in this case, that Raymond is not prior art because the asserted claims in the '196 patent are entitled to the benefit of a filing date (constructive or otherwise) prior to the filing date of Raymond."). We do not reach the question of such burden shifting, however, when the petitioner provides a mere assertion based on an incorrect *and uncorrected* statement of the supporting facts.

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