

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CROWDSTRIKE, INC.,  
Petitioner,

v.

OPEN TEXT INC.,  
Patent Owner.

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IPR2023-00289  
Patent 8,418,250 B2

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Before PATRICK M. BOUCHER, MICHELLE N. WORMMEESTER, and  
AARON W. MOORE, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

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

CrowdStrike, Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–30 of U.S. Patent No. 8,418,250 B2 (Ex. 1001, “the ’250 patent”). Paper 1 (“Pet.”). Open

Text Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. 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 grant the Petition and institute an *inter partes* review. The Board has not made a final determination regarding the patentability of any claim.

## I. BACKGROUND

### *A. The '250 Patent*

#### *1. Overview*

The '250 patent “relates generally to methods and apparatus for dealing with malware.” Ex. 1001, 1:4–5. Figure 2 of the '250 patent is reproduced below.

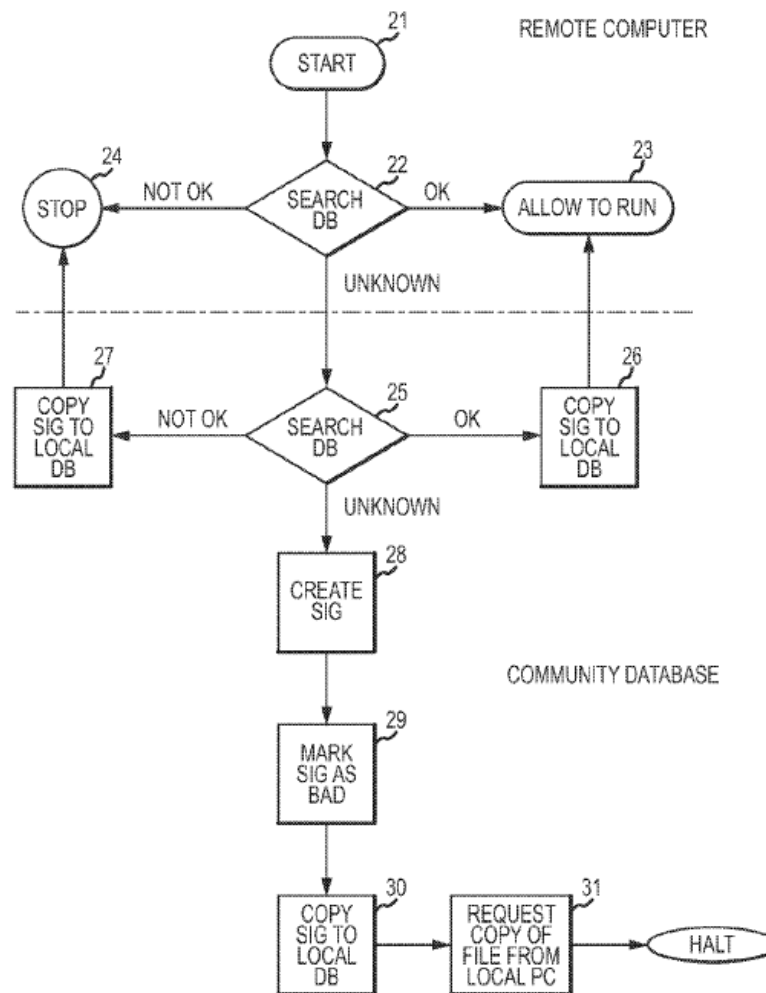


FIG.2

Figure 2 is a flowchart illustrating a method that starts at step 21 by running an object, such as a process, at a remote computer. *Id.* at 7:46–48, 8:17–18. At step 22, operation of such a process is hooked using local software running on the remote computer to search a local database for a signature or key representing that process and related objects. *Id.* at 8:18–24. If the signature indicates that the process is safe, it is allowed to run at step 23; if the signature indicates that the process is not safe, it is stopped at step 24. *Id.* at 8:24–33.

If the object is unknown locally, details are passed over a network, such as the Internet, for storage in, and comparison with, a community database that stores signatures representative of objects from multiple remote computers. *Id.* at 8:44–47. Specifically, such a community database is searched at step 25 for a signature for the object that has already been stored. *Id.* at 8:47–50. If found and identified as safe, then “a copy of the signature or at least a message that the object is safe” is sent to the remote computer at step 26; similarly, if found and identified as unsafe, a copy is provided to the remote computer with such a designation at step 27. *Id.* at 8:60–9:10. If the object is unknown to the community database, a signature is created at step 28 and marked as unsafe at step 29. *Id.* at 9:11–17. Such an unsafe designation may be changed as experience with the object is collected. *See id.* at 9:26–39.

Figure 3 of the '250 patent is reproduced below.

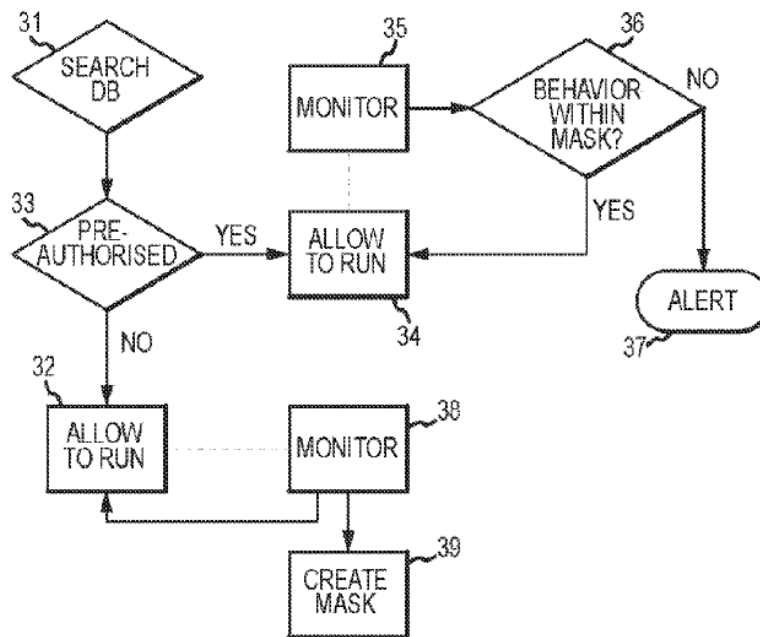


FIG.3

Figure 3 illustrates situations in which “[t]he signature of an object may comprise or be associated with a mask which can be built up with use of that object and which indicates the particular types of behaviour to be expected from the object.” *Id.* at 7:49–51, 14:55–58. The ’250 patent explains that, “[i]f an object is allowed to run on a remote computer [], even if the initial signature search [] indicates that the object is safe, then operation of that object may be monitored within the parameters of the mask.” *Id.* at 14:58–61. In particular,

[t]he mask might indicate for example, the expected behaviour of the object; any external requests or Internet connections that that object might legitimately have to make or call upon the remote computer [] to make, including details of any ports or interfaces that might be required to be opened to allow such communication; any databases, either local or over a local area network or wide area network or Internet, that may be expected to be interrogated by that object; and so on.

*Id.* at 14:61–15:2. “Thus, the mask can give an overall picture of the expected ‘normal’ behaviour of that object.” *Id.* at 15:2–4.

At step 31 of Figure 3, local and/or community databases are searched when a process is run, as described in connection with Figure 2 above. *Id.* at 15:35–37. Figure 3 contemplates that some processes may be preauthorized, such as by “a trusted partner, such as a major software company, a verification authority, a Government department, and so on.” *See id.* at 15:26–29. Thus, if a process is not preauthorized, the steps of Figure 2 may be followed, and the process may be allowed to run or not at step 32. *Id.* at 15:37–39. If the process is preauthorized, at determined at step 33, it is immediately allowed to run at step 34. *Id.* at 15:39–41. The process may then be monitored while running at step 35 to determine whether its

behavior falls within its preauthorized mask, as indicated at step 36. *Id.* at 15:42–45. If the behavior deviates from the preauthorized mask, such behavior is flagged at step 37, allowing various actions to be taken, such as terminating the process, contacting the preauthorization authority, modifying the mask, or marking the process as unsafe. *Id.* at 15:47–58. Processes that are not preauthorized, but which have nonetheless been allowed to run, may similarly be monitored at step 38 to generate a mask that represents the normal behavior of that process at step 39. *Id.* at 15:59–62.

## 2. Illustrative Claim

Challenged independent claim 1 is representative of the challenged claims, and is reproduced below.

1. A method of classifying a computer object as malware, the method comprising:
  - at a base computer, receiving data about a computer object from each of plural remote computers on which the object or similar objects are stored, the data including information about the behaviour of the object running on one or more remote computers;
  - determining in the base computer whether the data about the computer object received from the plural computers indicates that the computer object is malware;
  - classifying the computer object as malware when the data indicates that the computer object is malware;
  - when the determining does not indicate that the computer object is malware, initially classifying the computer object as not malware;
  - automatically generating a mask for the computer object that defines acceptable behaviour for the computer object, wherein the mask is generated in accordance with normal behaviour of the object determined from said received data;
  - running said object on at least one of the remote computers;

automatically monitoring operation of the object on the at least one of the remote computers;  
allowing the computer object to continue to run when behaviour of the computer object is permitted by the mask;  
disallowing the computer object to run when the actual monitored behaviour of the computer object extends beyond that permitted by the mask; and,  
reclassifying the computer object as malware when the actual monitored behaviour extends beyond that permitted by the mask.

Ex. 1001, 20:19–50.

### 3. *Prosecution History*

During prosecution of the application that matured into the '250 patent, the Examiner issued multiple rejections and the Applicant made various amendments before the claims were deemed in condition for allowance. *See generally* Ex. 1002. We highlight certain of those rejections and amendments as relevant to our analysis, particularly those that bear on independent claim 1's recitation of “automatically generating a mask for the computer object that defines acceptable behaviour for the computer object,” and corresponding limitations recited in the other independent claims. The claims as initially filed did not recite “automatically” generating a mask. *Id.* at 51–61.

After a rejection for obviousness over U.S. Patent Publ. No. 2003/0177394 (“Dozortsev”) and U.S. Patent Publ. No. 2002/0099952 (“Lambert”), the Applicant amended the independent claims to recite “automatically” generating a mask in this context.<sup>1</sup> *Id.* at 595–606. In doing

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<sup>1</sup> The word “automatically” was added to claims earlier during prosecution with respect to other limitations. Ex. 1002, 546–561.

so, the Applicant distinguished Lambert, asserting that “[t]here is no teaching or suggestion of receiving behaviour information and using normal behaviour to define a mask.” *Id.* at 585. The Applicant specifically observed that “Lambert teaches that an administrator classifies the software using the criteria and sets the rules for the token.” *Id.* at 585–586. According to the Applicant, “[t]his is clearly manual, and not automatic generation of a mask.” *Id.* at 586.

The Examiner subsequently rejected these amended claims over Dozortsev and U.S. Patent Publ. No. 2005/0210035 (“Kester”), which is notably one of the references applied by Petitioner in this proceeding. *Id.* at 607–618. The Examiner stated that

Dozortsev does not explicitly teach receiving data about the behavior of the object running on the remote computer, automatically generating a mask in accordance with normal behavior of the object determined from the received data that defines acceptable behavior for the computer object, and only allowing the computer object to continue to run when the behavior of the computer object is permitted by the mask, and disallowing the computer object to run when the actual monitored behavior extends beyond that permitted by the mask.

*Id.* at 611. For these limitations, the Examiner relied on Kester’s disclosure of a “workstation management module monitoring the behavior of an application . . . , wherein the behavior of the application is used to determine the access privileges for the application,” as well as Kester’s “teach[ing] that the privileges are used to determine what actions are permitted.” *Id.*

Traversing this rejection, the Applicant argued that Kester “does not teach or suggest reclassifying an object as malware if its monitored behavior

extends beyond that permitted by the mask.” *Id.* at 633. According to the Applicant,

This is clearly different from the claims of the present invention. The present invention is concerned with a method of classifying a computer object as malware. As part of this process, a mask is automatically generated defining acceptable behavior for the object based on the normal behavior of the object. The automatically generated mask is used to automatically monitor the operation of the object and to reclassify the object as malware if the behavior extends beyond the mask. A human decision is not necessary to generate the mask or monitor the operation.

*Id.* The Examiner thereafter allowed the claims, stating that the Applicant’s arguments were “persuasive” and that the Applicant’s “reply make[s] evident the reasons for allowance, satisfying the ‘record as a whole’ proviso of the rule 37 CFR 1.104(e).” *Id.* at 796–804.

### *B. Evidence*

Petitioner relies on the following references:

|         |                    |                |          |
|---------|--------------------|----------------|----------|
| Kester  | US 2005/0210035 A1 | Sept. 22, 2005 | Ex. 1004 |
| Honig   | US 7,225,343 B1    | May 29, 2007   | Ex. 1005 |
| Kennedy | US 7,594,272 B1    | Sept. 22, 2009 | Ex. 1006 |

In addition, Petitioner relies on a Declaration by Wenke Lee, Ph.D. Ex. 1003. Patent Owner relies on a Declaration by Nenad Medvidovic, Ph.D. Ex. 2001.

*C. Asserted Grounds of Unpatentability*

Petitioner challenges claims 1–30 on the following grounds. Pet. 10.

| <b>Claim(s)<br/>Challenged</b> | <b>35 U.S.C.<br/>§<sup>2</sup></b> | <b>References</b>      |
|--------------------------------|------------------------------------|------------------------|
| 1, 2, 7–14, 19–30              | 103                                | Kester, Honig          |
| 3–6, 15–18                     | 103                                | Kester, Honig, Kennedy |

*D. Real Parties in Interest*

Petitioner identifies CrowdStrike, Inc. and CrowdStrike Holdings, Inc. as real parties in interest. Pet. 69. Patent Owner identifies Open Text Inc. and Webroot LLC as real parties in interest. Paper 3, 1. “Out of an abundance of caution, Patent Owner further identifies the following affiliates: Carbonite, LLC; Open Text Corporation; and Open Text Holdings, Inc.” *Id.*

*E. Related Matters*

Both parties identify *Webroot, Inc. v. CrowdStrike, Inc.*, No. 6:22-cv-00241 (W.D. Tex.) (“the related litigation”) as a related matter in which the ’250 patent is the subject of a patent-infringement lawsuit filed against Petitioner. Pet. 69; Paper 3, 1. Both parties also identify the following related matters as involving the ’250 patent with different defendants: (1) *Webroot, Inc. v. Trend Micro Inc.*, No. 6:22-cv-00239 (W.D. Tex.); (2) *Webroot, Inc. v. Sophos Ltd.*, No. 6:22-cv-00240

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<sup>2</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C §§ 102 and 103. The ’250 patent was filed on June 30, 2006. Ex. 1001, code (22); Pet. 7–8. We accordingly apply the pre-AIA versions of §§ 102 and 103 herein.

(W.D. Tex.); and (3) *Webroot, Inc. v. AO Kaspersky Lab*, No. 6:22-cv-00243 (W.D. Tex.). Pet. 69; Paper 3, 1.

The parties further identify certain *inter partes* review proceedings involving “unrelated patents” that are asserted in the related litigation, namely IPR2022-01522, IPR2023-00124, IPR2023-00126. Paper 3, 2.

## II. DISCRETION UNDER 35 U.S.C. § 314(a)

As noted above, the ’250 patent is the subject of parallel proceedings in the form of the related litigation. *Supra*, § I.E. Patent Owner asks that we exercise our discretion to deny the Petition based on the state of the related litigation. Prelim. Resp. 4–21.

Institution of an *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a) (2018) (stating “[t]he Director *may not* authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition”) (emphasis added); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). The advanced state of a parallel district court action may warrant exercising discretion on behalf of the Director to deny a petition for *inter partes* review. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”); *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 at 5–6, 8 (PTAB March 20, 2020) (precedential) (“*Fintiv*”); Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 58 & n.2, *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>

(“Trial Practice Guide”). Whether to exercise such discretion is informed by the Director’s Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (“Interim Procedure”).<sup>3</sup>

We consider the following factors in assessing “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding”:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

*Fintiv* at 5–6. In evaluating these factors, we “take[] a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at 6.

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<sup>3</sup> Available at [https://www.uspto.gov/sites/default/files/documents/interim\\_proc\\_discretionary\\_denials\\_aia\\_parallel\\_district\\_court\\_litigation\\_memo\\_20220621\\_.pdf](https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf).

### 1. Possibility of Stay

A stay of a related proceeding pending resolution of the PTAB trial “allays concerns about inefficiency and duplication of efforts.” *Fintiv* at 6. At this time, no stay has been requested or ordered in the related litigation, although Petitioner states that it “may seek a stay if institution is granted.” Pet. 65; *see also* Prelim. Resp. 5. According to Patent Owner, even if Petitioner does seek a stay, it is unlikely the court will grant one because of the complexity of the related litigation, which includes multiple patents, additional defendants, and various counterclaim allegations. Prelim. Resp. 8–12. Patent Owner also contends that past decisions by the judge managing the related litigation suggest that he is unlikely to stay the related litigation. *Id.* at 12.

Although we agree with Patent Owner that a stay appears unlikely even if we institute trial, there has been no actual denial of a stay as contemplated by *Fintiv* to weigh this factor against exercising discretion to deny institution. *See Fintiv* at 6–7. Conversely, we recognize that Patent Owner cites certain routine (nonbinding) Board decisions that have weighed this factor in favor of discretionary denial, even in the absence of any stay motion. *See* Prelim. Resp. 5–6. While we have considered such decisions, we find them of limited relevance to the specific facts before us, as applied within *Fintiv*’s binding guidance.

We treat this factor as neutral.

### 2. Schedules

According to *Fintiv*, “[i]f the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in

favor of exercising authority to deny institution.” *Fintiv* at 9. Petitioner advises us that the district court recently entered an amended scheduling order setting August 19, 2024, as the trial date for the related litigation. Pet. 65–66. Patent Owner notes that this scheduled date is generally consistent with median time-to-trial statistics in the Western District of Texas, where the related litigation is pending. Prelim. Resp. 13. This is also after the Board’s deadline to issue a final written decision. Although Petitioner contends that the complexity of the related litigation “may” result in a later trial for the related litigation, we give little weight to this speculation. See Pet. 65–66.

We treat this factor as neutral.

### 3. *Investment in Parallel Proceeding*

“[I]f, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition, this fact favors denial” of the Petition. *Fintiv* at 9–10. Petitioner highlights certain dates in addressing this factor, including scheduled *Markman* hearings, all of which have passed. See Pet. 66. We agree with Patent Owner that “Petitioner wrongly limits its analysis of the parties’ investment to the stage of proceedings at the time the petition was filed, but *Fintiv* counsels consideration investment at the time of the institution decision.” See Prelim. Resp. 14–15. In addition to noting that “fact discovery on the ’250 Patent is already underway,” Patent Owner emphasizes that “the proposed construction of ‘automatically’ that Petitioner and its expert apply in this proceeding now conflicts with the district court’s claim construction of ‘automatically.’” *Id.* at 15. Although this supports Patent Owner’s

position, the strength of that support is mitigated by the fact (discussed further below) that the district court has not yet provided the reasoning that underlies its construction. See Ex. 2012, 2 (“The Court issues this Order to memorialize the Court’s final claim construction rulings for the parties, and to inform the parties that the Court plans to issue a more-detailed Order explaining its analysis in due course.”).

We treat this factor as neutral.

#### 4. *Overlap of Issues*

“[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Fintiv* at 12. “Petitioner stipulates that if the Board institutes [*inter partes* review], Petitioner will not seek resolution in the District Court of any ground of invalidity for the ’250 Patent that utilizes *Kester*, *Honig*, or *Kennedy*—the prior art references relied upon in the Proposed Grounds.” Pet. 66. Such a stipulation is more restrictive than a *Sand Revolution* stipulation but less restrictive than a *Sotera* stipulation. See *Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24, 11–12 (PTAB June 16, 2020) (informative); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 13–14 (Dec. 1, 2020) (precedential). Thus, while not rising to the level of a stipulation that the Director’s Interim Procedure indicates would preclude discretionary denial, Petitioner’s stipulation does mitigate concern about overlapping issues with the related litigation. See Interim Procedure, 7–8.

We treat this factor as weighing against exercising discretion to deny institution.

### 5. *Overlap of Parties*

If Petitioner was unrelated to a defendant in the related litigation, that might weigh against exercising discretion to deny institution. *Fintiv* at 13. But here, the parties are the same as in the related litigation. Pet. 67; Prelim. Resp. 19. Because trial in the related litigation is scheduled to occur after the deadline for a Final Written Decision in this proceeding, this factor weighs against exercising discretion to deny institution. See *Huawei Tech. Co. v. WSOU Inv., LLC*, IPR2021-00225, Paper 11 at 14 (PTAB June 14, 2021) (“this factor favors denial if trial precedes the Board’s Final Written Decision and favors institution if the opposite is true”) (internal quotation marks omitted); *Google LLC v. Parus Holdings, Inc.*, IPR2020-00846, Paper 9 at 21 (PTAB Oct. 21, 2020) (“Here, . . . Petitioner is the defendant in the parallel proceeding. This fact could weigh either in favor of, or against, exercising discretion to deny institution, depending on which tribunal was likely to address the challenged patent first.”).

### 6. *Other Circumstances*

The final factor takes into account any other relevant circumstances, including the merits. “For example, if the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution.” *Fintiv* at 14–15. We address the merits of Petitioner’s challenges below. For the reasons we explain, Petitioner’s challenges meet the “reasonable likelihood” standard that we apply in determining whether to institute *inter partes* review, but Patent Owner raises points that would benefit from development at trial. See Pet. 67–68 (Petitioner asserting that

“[t]he strength of Petitioner’s Proposed Grounds weighs strongly in favor of institution”); Prelim. Resp. 13–14 (Patent Owner asserting that “Petitioner’s prior art grounds rely on a non-analogous primary reference and contain critical deficiencies, failing to demonstrate a reasonable likelihood—let alone a high likelihood—that at least one claim is unpatentable”).

We accordingly treat this factor as neutral.

### 7. *Assessment*

As discussed above, no *Fintiv* factor weighs in favor of exercising our discretion to deny institution, while two factors weigh against, and four factors are neutral. Although we recognize that the investment in the parallel proceeding has advanced to some degree, this is counterbalanced by Petitioner’s stipulation, which mitigates concerns about overlapping issues with the related litigation. We decline to exercise our discretion under 35 U.S.C. § 314(a) to deny the Petition.

### III. DISCRETION UNDER 35 U.S.C. § 325(d)

“In determining whether to institute or order [an *inter partes* review], the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). Patent Owner asks that we exercise the Director’s discretion under that provision to deny the Petition. See Prelim. Resp. 30–36. The Director has delegated that discretion to the Board. 37 C.F.R. § 42.4(a).

In *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential)

(“*Advanced Bionics*”), the Board applied a two-part framework in considering whether to exercise discretion to deny institution under § 325(d): “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics* at 8.

Within this two-part framework, the Board considers a number of non-exclusive factors in evaluating whether to exercise its discretion under § 325(d). *See Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first para.) (“*Becton, Dickinson*”); *see also Advanced Bionics* at 9–11. The factors set forth in *Becton, Dickinson* are as follows:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art;
- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

*Becton, Dickinson* at 17–18.

Factors (a), (b), and (d) of the *Becton, Dickinson* factors relate to whether the art or arguments presented in the Petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics* at 10. Factors (c), (e), and (f) “relate to whether the petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Id.* Only if the same or substantially the same art or arguments were previously presented to the Office do we then consider whether petitioner has demonstrated a material error by the Office. *Id.* “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

With respect to the first part of the *Advanced Bionics* framework, it is undisputed that Petitioner’s challenges rely on the same Kester reference that was considered during prosecution, but also involve other references (particularly Honig) that were not considered. *See* Pet. 5–6 (Petitioner acknowledging); Prelim. Resp. 31 (Patent Owner acknowledging). Patent Owner argues that, even with the application of different references, there is significant overlap between the arguments made during prosecution and the way Petitioner relies on the prior art in the instant proceeding. *See* Prelim. Resp. 33–35. For example, Patent Owner asserts that “Petitioner argues that a [person of ordinary skill in the art] would have been motivated to automate Kester’s process in view of Honig’s adaptive model generator,” and that “the applicant previously explained to the examiner [that] it would not have been obvious to automate the human determination(s) in Kester.” *Id.* at 34.

In contrast, Petitioner asserts that its challenges “rely on *Kester* in a fundamentally different way than it was analyzed during prosecution” and

that its challenges “include teachings from *Honig* not considered during prosecution.” Pet. 6. Petitioner explains that Kester “was advanced in an office action as a secondary reference for the purpose of teaching ‘automatically generating a mask,’” and that the Examiner agreed with the Applicant’s argument that Kester did not teach this automatic process. *Id.* According to Petitioner, its challenges “do not ask the Board to reconsider that conclusion” because Petitioner relies on *Honig* for automatic mask generation. *Id.*

Patent Owner disagrees with Petitioner’s characterization primarily because the Applicant advanced arguments during prosecution beyond those directed at the limitation of “automatically generating a mask.” Prelim. Resp. 32–34 (noting that “the applicant noted several distinctions between Kester and the ’250 patent, including that: unlike Kester, ‘human decision is not necessary to generate the mask or monitor the operation’ in the ’250 patent; ‘a skilled person would have no motivation to adapt Kester to . . . automatically generate a mask” (alteration in original); and “Kester also does not teach or suggest reclassifying an object as malware if its monitored behavior extends beyond that permitted by the mask”). In addition, Patent Owner contends that the Applicant “explained to the examiner [that] it would not have been obvious to automate the human determination(s) in Kester.” *Id.* at 34.

During prosecution, the Applicant presented the following argument while traversing the rejection over Dozortsev and Kester:

Kester is concerned with a system to allow an employee to control what their employees can do on their computers. This is in essence a matter of individual policy for each company and may vary between companies or even between users in a

company. It is therefore essential to have the Network Administrator review each program for each user to decide what policy is appropriate for their company. Thus, a skilled person would have no motivation to adapt Kester to result in the present invention to automatically generate a mask, as to do so would mean that the system of Kester would no longer be able to perform its function of allowing a company to implement appropriate policies governing what their employees can do on their computers.

Ex. 1002, 633–634. Divorced from the context of the rejection the Examiner was reconsidering, namely over the combination of Dozortsev and Kester, this argument conceivably supports Patent Owner’s position. But within that context, the Examiner evidently found convincing that it would not have been obvious to modify Dozortsev to automate mask generation in light of Kester’s teachings. It is not apparent that the Examiner considered whether it would have been obvious to modify Kester to incorporate such automation, particularly in light of the teachings of an additional reference that was not before the Examiner. *See id.* at 802–803 (Examiner declining to provide specific reasons for allowance). That is, we agree with Petitioner that the challenges it advances over Kester and Honig are different in character from the combination of Dozortsev and Kester that the Examiner considered. *See* Pet. 6. We necessarily consider the Applicant’s argument against the backdrop of the Dozortsev-Kester rejection that was at issue during prosecution, not how that argument might be differently perceived if it had been made with respect to the Kester-Honig challenge presented by Petitioner.

We conclude that substantially the same art or arguments were not previously presented to the Office, such that the first part of the *Advanced*

*Bionics* framework is not satisfied. We accordingly do not reach the second part of that framework in our evaluation, and we decline to exercise our discretion under 35 U.S.C. § 325(d) to deny the Petition.

#### IV. ANALYSIS

##### A. *Legal Principles*

A claim is unpatentable for obviousness under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of nonobviousness, i.e., secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)); see *In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333 (Fed. Cir. 2016) (citing *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006)).

*B. Level of Ordinary Skill in the Art*

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person of ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). “This legal construct is akin to the ‘reasonable person’ used as a reference in negligence determinations” and “also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan.” *Id.* (citing *In re Carlson*, 983 F.2d 1032, 1038 (Fed. Cir. 1993)).

Petitioner proposes that a person of ordinary skill in the art “would be a person having a bachelor’s degree in computer science, computer engineering, or an equivalent, as well as two years of industry experience and would have had a working knowledge of host monitoring systems, software security analysis, and dynamic malware analysis.” Pet. 9. Petitioner adds that “[a]dditional graduate education could substitute for professional experience, or significant experience in the field could substitute for formal education.” *Id.* Petitioner supports its articulation of the level of ordinary skill in the art with testimony by Dr. Lee. Ex. 1003 ¶¶ 38–41.

Patent Owner’s statement of the level of ordinary skill is generally similar, and supported with testimony by Dr. Medvidovic, who characterizes

the parties’ respective positions as having “minor variations.” Prelim. Resp. 29–30; Ex. 2001 ¶¶ 62–65. According to Patent Owner, a person of ordinary skill in the art “would have had a Bachelor’s degree in an accredited program of Electrical Engineering, Computer Engineering, or Computer Science or in a similar discipline, and have 2-3 years of practical work or research experience in the general fields of electrical engineering, computer science, networking, communications, and device and network security.” Prelim. Resp. 29–30. Patent Owner adds that “[m]ore advanced degrees and/or training in a related discipline can compensate for shorter work experience.” *Id.*

For purposes of this Decision, we adopt Petitioner’s proposal, which we find consistent with the level of skill reflected by the prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art may reflect an appropriate level of skill in the art). But we note that we would reach the same ultimate conclusion to institute *inter partes* review if we were to adopt Patent Owner’s proposal. *See* Ex. 2001 ¶ 65 (Dr. Medvidovic testifying that the “minor variations” in the parties’ proposals “would not alter [his] opinions”).

### *C. Claim Construction*

The Board uses “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (2019); *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005)

(en banc). The parties address the term “automatically,” which is recited in independent claims 1, 13, and 25, but otherwise agree that we should apply the plain and ordinary meaning to all other terms. Pet. 7–9; Prelim. Resp. 26–29.

With respect to the term “automatically,” Petitioner contends that “the file history is unequivocal that the term ‘automatically’ excludes human involvement.” Pet. 8. In advancing this contention, Petitioner points specifically to the Applicant’s assertion during prosecution that, in the context of the claimed invention, “[a] human decision is not necessary to generate the mask or monitor the operation.” *Id.* (quoting Ex. 1002, 633) (alteration in original). Petitioner also draws our specific attention to the Applicant’s argument distinguishing Lambert because “an administrator classifies software,” which the Applicant asserted “is clearly manual, and not automatic generation of a mask.” *Id.* (quoting Ex. 1002 585–586).

Patent Owner instead contends that the term is properly construed as “including, but not limited to, without human involvement.” Prelim. Resp. 26–28. Patent Owner elaborates that the prosecution history supports an understanding, contrary to Petitioner’s proposal, that “human decision is not **necessary** to the step of generating a mask and monitoring an object.” *Id.* at 27–28. Patent Owner supports its position by referring us to the district court’s construction in the related litigation, which we agree is consistent with Patent Owner’s proposal. *Id.* at 26 (citing Ex. 2012, 4).

As a matter of comity, we take particular note of the district court’s construction of “automatically” as having its “[p]lain-and-ordinary meaning which includes, but is not limited to ‘without human involvement.’” See Ex. 2012, 4. Nevertheless, Petitioner appears to have a legitimate basis for

supporting its narrower proposal. We are also limited at this stage in giving weight to the district court’s construction because that construction was provided without explanation. Instead, “[t]he Court issue[d its] Order to memorialize the Court’s final claim construction rulings for the parties, and to inform the parties that the Court plans to issue a more-detailed Order explaining its analysis in due course.” *Id.* at 2.

As we explain below, we determine that Petitioner meets the standard applicable at this stage under the narrower construction of “automatically” that excludes human involvement. To the extent construction of “automatically” bears on the ultimate issues at trial, we accordingly invite the parties to develop the claim-construction issue more fully, including providing a copy of the district court’s complete analysis when available. At this juncture, we do not find it necessary to construe this or any additional terms for purposes of this Decision. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

#### *D. Overview of the Prior Art*

##### *1. Kester*

Recognizing that employee activation of software applications can “pose new threats to an employer,” Kester describes “monitoring and controlling application files” operating on computing devices. Ex. 1004 ¶¶ 3, 5. Figure 1 of Kester is reproduced below.

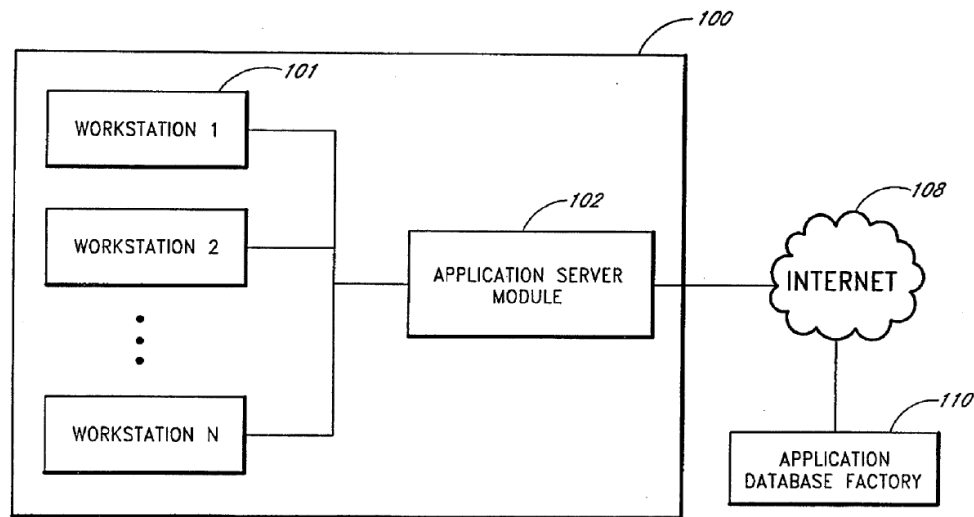


*FIG. 1*

Figure 1 “is a block diagram of a site collection system for controlling application files on a workstation.” *Id.* ¶ 12. Multiple workstations 101, each of which includes a “workstation management module,” are coupled to application server module 102, which communicates via Internet 108 to upload and download applications with application database factory 110. *Id.* ¶¶ 35–39.

Each workstation management module maintains a “hash/policy table” that stores “the expected network activity” associated with various applications. *Id.* ¶ 39, 45. When an application that accesses the network is launched, the workstation management module calculates a hash for comparison with the hash/policy table. *Id.* ¶¶ 51–53. “If the hash and collection data correspond to a hash stored in the hash/policy table [] and the collection data associated with the hash in the hash/policy table [], . . . the policy associated with the hash is applied in response to the network access request.” *Id.* ¶ 143. “For example, an access privilege can include allowing the launched application to run on the workstation.” *Id.* ¶ 40.

“To determine the access privilege for the workstation 101 and/or user, the workstation management module 101 can utilize a predetermined association between the application and an expected network behavior or activity for the application.” *Id.* ¶ 43. Such predetermined associations are made by a network administrator who “interfaces with the application server module 102 via [a] classification user interface” and “can classify uncategorized applications and/or recategorize previously categorized applications.” *Id.* ¶ 71. In particular, the network administrator receives data from an application inventory database via the classification user interface and “select[s] or create[s] access privileges/policies/rules for users, workstation, and/or groups of users/workstations.” *Id.* ¶ 72.

## 2. *Honig*

Honig “relates to systems and methods for detecting anomalies in a computer system, and more particularly to an architecture and data format for using a central data warehouse and heterogeneous data sources.” Ex. 1005, 1:44–47. Figure 1 of Honig is reproduced below.

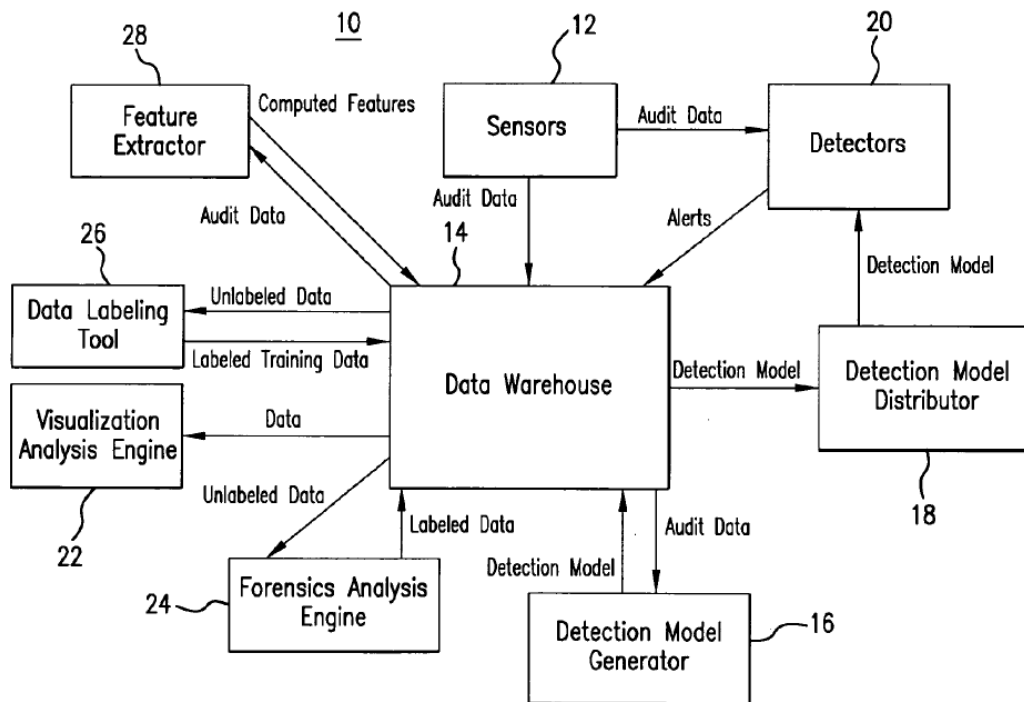


FIG. 1

Figure 1 illustrates an “adaptive model generation” system that “provides and automates many of the critical processes in the deployment and operation of real time data mining-based intrusion detection systems.” *Id.* 6:50–54, 7:53–54. The system “abstract[s] the processes of data collection, data aggregation, detection model evaluation, detection model generation, and model distribution,” and “uses a general XML-based data and model representation scheme that facilitates the translation of data from what is collected at the audit stream to the form necessary for generation of detection models.” *Id.* at 6:54–63.

Sensors 12 gather information from an environment and send the data to data warehouse 14, which is accessed by detection model generators 16 to “generate models that classify activity as either malicious or normal.” *Id.* at 8:14–18. Model distributor 18 deploys the model to real-time detector 20,

which uses the model to evaluate audit data received from sensors 12 to detect intrusions. *Id.* at 8:19–24. Data analysis engines 22, 24, 26, 28 retrieve data from data warehouse 14, allowing for “implement[ation of] many systems that are helpful in the deployment of an intrusion detection system.” *Id.* at 8:25–33. Honig describes at least three general types of model-detection algorithms that its architecture may support: “misuse detection,” which trains on labeled normal and attack data; “supervised (traditional) anomaly detection,” which trains on normal data; and “unsupervised anomaly detection,” which trains on unlabeled data. *Id.* at 20:33–38.

### 3. *Kennedy*

Kennedy “pertains in general to computer security and in particular to detection [of] a computer worm and/or other type of malicious software.” Ex. 1006, 1:7–9. Figure 4 of Kennedy is reproduced below.

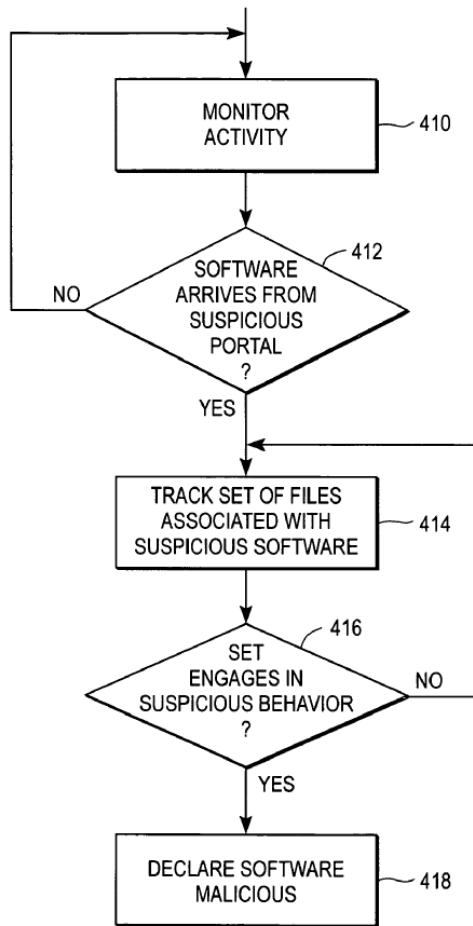


FIG. 4

Figure 4 is a flowchart illustrating steps of a “malicious software detection module (MSDM) [that] monitors a storage device of the computer system for the arrival of software from a suspicious portal.” *Id.* at 1:41–47, 1:63–65.

While monitoring activity on a local storage device at step 410, the MSDM detects the arrival of new software and the portal through which the software arrived. *Id.* at 5:51–54. As checked at step 412, if the software arrived from a portal designated as suspicious, the MSDM designates the software itself as suspicious. *Id.* at 5:54–56. At step 414, the MSDM tracks files associated with the suspicious software and may create a logical set of

files associated with the suspicious software. *Id.* at 5:57–61. As checked at step 416, if the files in the set (individually or collectively) engage in suspicious behavior, the MSDM declares the software as malicious at step 418 and takes corrective action. *Id.* at 5:64–6:2.

### *E. Independent Claim 1*

#### *a. Overview*

Petitioner challenges independent claim 1 as unpatentable under 35 U.S.C. § 103(a) over Kester and Honig. Pet. 13–39. In doing so, Petitioner presents two alternative theories, the first of which relies on Kester for most limitations, with Honig applied for the limitation of “automatically generating a mask.” *Id.* Petitioner’s alternative theory similarly relies on Kester for most limitations, but proposes to apply Honig more comprehensively also to meet the limitations requiring “determining . . . whether the data . . . indicates that the computer object is malware,” with classifications as “malware” or “not malware” consistent with such determining. *See id.* at 21–24, 25–26, 27. In particular, under both theories, Petitioner draws a correspondence between (1) the recited “base computer” and Kester’s application server module 102 and/or application database factory 110, (2) the recited “plural remote computers” and Kester’s workstations 101, and (3) between the recited “computer object” and Kester’s program or application. *Id.* at 14–15.

In proposing to combine the teachings of Kester and Honig, Petitioner contends that “it would have been obvious to implement *Kester*’s application categorization process, such that the application server module and/or database factory uses an adaptive learning system (rather than or in addition

to a human reviewer) to determine whether received data indicates the application is malware, as taught by *Honig*.” *Id.* at 21–22. In particular, Petitioner observes that Honig teaches various adaptive learning systems that make such determinations, including those based on misuse detection, supervised anomaly detection, and unsupervised anomaly detection. *Id.* at 22 (citing Ex. 1005, 8:4–24, 20:33–21:38, 24:43–45). Based on such disclosures, and supported by Dr. Lee’s testimony, Petitioner specifically contends that a person of ordinary skill in the art “would have understood *Honig* to disclose an adaptive learning system that programmatically determines whether data is malware.” *Id.* at 22–23 (citing Ex. 1005, 7:38–41, Ex. 1003 ¶ 94).

Petitioner reasons that “[i]t would have been obvious to implement *Kester*’s application server module and/or database factory to determine whether received data indicates a program/application is malware as taught by *Honig*.” *Id.* at 23. Noting that Kester teaches that “[c]ategorization can be based upon word analysis, *adaptive learning systems*, and image analysis,” Petitioner explains that, in its proposed combined Kester-Honig system, “*Kester*’s server module and/or database factory would categorize applications using an adaptive learning model,” such as taught by Honig. Ex. 1004 ¶ 92 (emphasis added); Pet. 23. According to Petitioner, and supported by Dr. Lee’s testimony, a person of ordinary skill in the art would have been motivated to implement the combined system in this way “to reduce the workload of the human reviewer, furthering one of the expressly stated goals of *Kester*—to ‘enhance productivity of the human reviewer.’” Pet. 23 (citing Ex. 1003 ¶¶ 95–98; quoting Ex. 1004 ¶ 90). Dr. Lee’s testimony also supports Petitioner’s contentions that “this combination

would have been a combination of prior art elements according to known methods to yield predictable results” and that “such a modification would have been well within the capabilities of one of ordinary skill in the art such that there would have been a reasonable expectation of success.” Ex. 1003 ¶¶ 95–98; Pet. 23–24.

Similar reasoning undergirds Petitioner’s proposed combination of Kester and Honig when addressing the “automatically generating” limitation. See Pet. 27–32. That is, Petitioner similarly relies on Kester’s disclosure that “[c]ategorization can be based upon word analysis, *adaptive learning systems*, and image analysis” as providing a motivation to implement adaptive learning systems such as those taught by Honig. *Id.* at 29–31; Ex. 1004 ¶ 92 (emphasis added). According to Petitioner, such a combination meets the “automatically generating” limitation because it allows a mask to be generated without human involvement. Pet. 30–31. Although we have not specifically construed “automatically” at this time, it necessarily follows that generating a mask without human involvement means that human decision is not necessary for mask generation, such that the limitation is met under either party’s proposed construction. Dr. Lee’s testimony supports Petitioner’s position that, in light of Honig, automating mask generation would be a predictable improvement to Kester, well within the capabilities of a person of ordinary skill in the art, and would have a reasonable expectation of success. Ex. 1003 ¶¶ 121–131; Pet. 31–32.

We have reviewed Petitioner’s element-by-element analysis of independent claim 1 for both of its theories. Pet. 13–39. On the preliminary record, Patent Owner presents a number of arguments, which we address in greater detail below.

*b. Whether Kester is Analogous Art*

To qualify as prior art for an obviousness determination, a reference must be “analogous to the claimed invention.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (citing *In re Clay*, 399 F.2d 656, 658 (Fed. Cir. 1992)). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed; and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference is still “reasonably pertinent to the particular problem with which the inventor is involved.” *Bigio*, 381 F.3d at 1325. Patent Owner contends that Kester meets neither of these tests. Prelim. Resp. 47 (“Kester is non-analogous art to the ’250 patent, as it is neither in the same field of endeavor nor reasonably pertinent to the problems considered by the inventors of the ’250 patent.”).

In arguing that Kester is in the same field of endeavor as the ’250 patent, Petitioner characterizes both as providing “a method and apparatus for classifying a computer object as malware.” Pet. 10. This characterization is recited specifically by the ’250 patent itself, and, to support a similar characterization of Kester, Petitioner points to Kester’s description of classifying applications into groups, one of which specifically includes “Malware.” *Id.* at 10–11 (citing Ex. 1004 ¶¶ 98, 134, Fig. 4A).

Patent Owner disputes this on two principal bases: first, that the Office classified the ’250 patent and Kester differently; and, second, that Petitioner’s characterization of Kester is “based on a single exemplary category Kester discloses.” Prelim. Resp. 48–49. With respect to the first of these bases, Patent Owner asserts that “[t]he ’250 patent was classified as ‘information security,’” while “Kester was classified as ‘data processing.’”

*Id.* at 47, 48. Although these classifications acknowledgedly differ at some level, such that “the diverse Patent Office classification of the references [provides] *some* evidence of ‘non-analogy,’ . . . we consider the similarities and differences in structure and function of the inventions disclosed in the references to carry far greater weight.” *In re Ellis*, 476 F.2d 1370, 1372 (CCPA 1973); *see also In re Clay*, 966 F.2d 656, 660 (Fed. Cir. 1992) (quoting *Ellis* with approval). Indeed, these classifications are generally consistent with Patent Owner’s second basis because Kester provides a comprehensive disclosure that is not limited only to malware or other aspects of information processing.

Conversely, Petitioner’s position is supported by the Examiner’s finding during prosecution that Kester is from the field of endeavor of “monitoring for malware.” Ex. 1002, 612 (“Dozortsev and Kester are from the same field of endeavor, monitoring for malware.”). Patent Owner makes the point that the Applicant traversed that finding, and the Examiner subsequently allowed the application. Prelim. Resp. 53; *see* Ex. 1002, 634 (“One of ordinary skill in the relevant art attempting to cure the deficiencies in Dozortsev would have no motivation to look to Kester for relevant teachings as the two documents are in different fields and are concerned with different problems.”). But this was one of multiple bases on which Patent Owner traversed the rejection, such that it is not apparent from the prosecution history that the Examiner agreed that Kester is not properly characterized as from the field of “monitoring for malware.” *See generally* Ex. 1002, 629–636.

Regardless, under the standard we apply at this stage, Petitioner sufficiently shows that Kester is “reasonably pertinent to certain problems

addressed by the '250 Patent such as the need to initially classify an object as not malware, to generate a mask for the object that defines acceptable behavior for the object, and to reclassify the object if the actual monitored behavior is not normal (extending beyond the mask).” See Pet. 11 (citing Ex. 1001, 4:21–30, 15:2–5; Ex. 1004 ¶¶ 179–181, claims 1–2; Ex. 1003 ¶¶ 57–63). A reference is “reasonably pertinent” if “it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011). According to Patent Owner, this test is not met because “Kester itself embodies the same problems the '250 patent sought to solve,” including “requir[ing] that a human reviewer conduct a detailed analysis of each application such as Internet research, determine expected network activity, decide how applications should be categorized, and make policy decisions based on the specific user or workstation.” Prelim. Resp. 52. But Petitioner does not rely on Kester to address these aspects, and instead relies on Kester’s teachings related to malware-classification of objects and related mask generation. See Pet. 11, 13–39. For automatic mask generation, Petitioner relies on Honig. See *id.* at 6.

On the current record, we thus determine that Petitioner sufficiently shows Kester to be analogous art to the '250 patent. The parties are free to develop their positions further with respect to either test after considering these reasons for our preliminary determination.

*c. “automatically generating a mask”*

According to Patent Owner, Petitioner “fails to show that Kester in view of Honig renders obvious ‘*automatically generating a mask*,’ and that

Petitioner makes a critical error regarding Kester’s disclosure, because modification of Kester to include an adaptive learning system would still not disclose this limitation, and because Petitioner fails to explain how one would actually implement Honig’s teachings in Kester to practice this limitation.” Prelim. Resp. 57–58.

First, Petitioner’s “critical error,” according to Patent Owner, involves conflating distinct “predetermined associations” taught by Kester, one related to “expected network activity” and the other related to categorization applied to applications or requests. *Id.* at 58. Patent Owner understands Petitioner’s argument regarding the “automatically generating a mask” limitation to rely on Kester’s disclosure of adaptive learning systems for *categorization*, improperly applied to Kester’s *determination* of expected network activity. *Id.* at 59. While the distinction Patent Owner identifies has potential merit, Petitioner has not yet had an opportunity to respond. And Dr. Lee elaborates on Petitioner’s apparent reasoning that a person of ordinary skill in the art would apply the automation identified for one portion of Kester’s human-reviewer activities to other portions of those activities. Ex. 1003 ¶¶ 121–132. Dr. Lee’s testimony may be subject to meaningful cross-examination that would clarify this issue, such that we determine Petitioner makes a sufficient showing at this preliminary stage.

Second, Patent Owner contends that, even adoption of an adaptive learning system with Kester’s disclosure would not meet the “automatically generating a mask” limitation because Kester suggests such tools as an aid to, rather than a replacement of, human review. Prelim. Resp. 60–61. This argument is also amenable to development during trial, including cross-examination of Dr. Lee’s supporting testimony. See Ex. 1003 ¶¶ 121–132.

Third, Patent Owner faults Petitioner for “provid[ing] no analysis of how a [person of ordinary skill in the art] would combine Kester and Honig’s teachings” to practice the “automatically generating a mask limitation.” Prelim. Resp. 61–64. Patent Owner relies extensively on Dr. Medvidovic’s supporting testimony for this point. *See* Ex. 2001 ¶¶ 133–139. But we need not resolve the disagreement between the experts at this juncture because “[c]laims may be obvious in view of a combination of references, even if the features of one reference cannot be substituted physically into the structure of the other reference” and “[w]hat matters in the § 103 nonobviousness determination is whether a person of ordinary skill in the art, having all of the teachings of the references before him, is able to produce the structure defined by the claim.” *Orthopedic Equip. Co. v. U.S.*, 702 F.2d 1005, 1013 (Fed. Cir. 1983); *see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. . . . Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”). The parties’ will each have an opportunity to develop their respective positions on this point during the trial.

*d. Motivation to Modify Kester in view of Honig*

Patent Owner additionally argues that a person of ordinary skill in the art would not have been motivated to modify Kester in view of Honig. Prelim. Resp. 64–70. We address these arguments only briefly because they reiterate themes we discuss above.

First, Patent Owner contends that Kester and Honig are not analogous because “Kester’s method relates to ‘monitoring and controlling application files’ on computing devices” and “Honig’s invention relates to ‘detecting anomalies in a computer system, and more particularly to an architecture and data format for using a central data warehouse and heterogeneous data sources.’” *Id.* at 64. Honig’s computer-system anomaly detection is clearly related to malware detection, and, as we discuss above, Kester is at least reasonably pertinent to such problems.

Second, Patent Owner recasts its argument that Kester’s disclosure is limited to automation of *categorization*, as contrasted with *determination* of expected network activity, as a basis for concluding that a person of ordinary skill in the art would not be motivated to modify Kester. *Id.* at 65–66. For the reasons we discuss above, Petitioner’s showing is sufficient at this stage, with the parties’ respective positions amenable to productive development during trial.

Third, Patent Owner provides arguments directed at the specific implementation of Honig’s binary classifier as precluding a motivation to modify Kester. *Id.* at 66–70. Such bodily-incorporation arguments do not sufficiently address the overall *teachings* of the references, even when cast in the context of whether there is a motivation to effect Petitioner’s proposed modification of Kester.

*e. Objective Indicia of Nonobviousness*

“Patent Owner contends that secondary objective indicia of nonobviousness exist,” but provides no details supporting that contention at

this time. Prelim. Resp. 71. Without such details, consideration of objective indicia does not contribute to our analysis.

*f. Summary*

For the reasons discussed above, we conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of independent claim 1 as unpatentable under 35 U.S.C. § 103(a) over Kester and Honig.

*F. Independent Claims 13 and 25*

Independent claims 13 and 25 share many aspects of their limitations with independent claim 1, notably including the “automatically generating a mask” limitation, and Petitioner relies substantially on its analysis of independent claim 1 in contending that claims 13 and 25 are unpatentable under 35 U.S.C. § 103(a) over Kester and Honig. *Compare* Ex. 1001, 20:19–50 *with id.* at 21:37–67 *and id.* at 22:57–24:7. Patent Owner also does not present separate arguments for independent claims 13 and 25. *See generally* Prelim. Resp. 45–71.

We have reviewed Petitioner’s analysis of independent claims 13 and 25 and conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of those claims as unpatentable under 35 U.S.C. § 103(a) over Kester and Honig.

*G. Dependent Claims*

Petitioner challenges claims 2, 7–12, 14, and 19–30 as unpatentable under 35 U.S.C. § 103(a) over Kester and Honig; and challenges claims 3–6

and 15–18 as unpatentable under 35 U.S.C. § 103(a) over Kester, Honig, and Kennedy. Pet. 39–46, 48–50, 53–64. Patent Owner does not separately address any dependent claim outside of its arguments directed at the underlying independent claims. See Prelim. Resp. 71.

We have reviewed Petitioner’s analysis of the dependent claims and conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of claims 2, 7–12, 14, and 19–30 as unpatentable under 35 U.S.C. § 103(a) over Kester and Honig; and on its challenge of claims 3–6 and 15–18 as unpatentable under 35 U.S.C. § 103(a) over Kester, Honig, and Kennedy.

## V. CONCLUSION

For the foregoing reasons, we conclude that the information presented in the Petition establishes a reasonable likelihood that Petitioner would prevail in showing that at least one of the challenged claims is unpatentable. Accordingly, we institute *inter partes* review as to all challenged claims and grounds presented in the Petition. See *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); 37 C.F.R. § 42.108(a).

## VI. ORDER

In consideration of the foregoing, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted as to claims 1–30 of the '250 patent on all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, commencing on the entry date of this Decision.

IPR2023-00289  
Patent 8,418,250 B2

For PETITIONER:

Adam P. Seitz  
Paul R. Hart  
ERISE IP, P.A.  
Adam.Seitz@eriseip.com  
Paul.Hart@eriseip.com

For PATENT OWNER:

Brian Eutermoser  
Russell E. Blythe  
Mikaela Stone  
KING & SPALDING LLP  
beutermoser@kslaw.com  
rblythe@kslaw.com  
mikaela.stone@kslaw.com