

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,

Petitioner,

v.

TAASERA LICENSING LLC,

Patent Owner.

Patent No. 8,850,517

Filing Date: June 15, 2013

Issue Date: September 30, 2014

Inventor: Srinivas Kumar

Title: RUNTIME RISK DETECTION BASED ON USER, APPLICATION, AND
SYSTEM ACTION SEQUENCE CORRELATION

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2023-00704

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Exhibit No.	Description of Document
2001	Sixth Amended Docket Control Order, Dkt. 239, <i>In re: Taasera Licensing LLC, Patent Litigation</i> , No. 2:22-md-03042-JRG (E.D. Tex. June 27, 2023)
2002	Defendant Palo Alto Network, Inc.’s Patent L.R. 3-3 Invalidity Contentions and Subject Matter Ineligibility Contentions, <i>In re: Taasera Licensing LLC, Patent Litigation</i> , No. 2:22-md-03042-JRG, served April 29, 2023
2003	Joint Patent L.R. 4-3 Claim Constructions and Prehearing Statement, Dkt. No. 249, <i>In re: Taasera Licensing LLC, Patent Litigation</i> , No. 2:22-md-03042-JRG, filed July 13, 2023
2004	Redline Comparison of the Declaration of Kevin Jeffay, Ph.D. (Ex. 1003) to the Petition

I. INTRODUCTION

On March 10, 2023, Palo Alto Networks, Inc. (“Petitioner”) submitted a petition (Paper 2, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 8,850,517 (Ex. 1001, “the ’517 Patent”), challenging claims 1-24 (the “Challenged Claims”). The Petition asserts that the Challenged Claims are obvious (1) over U.S. Patent App. Pub. No. 2013/0254880 to Alperovitch et al. (Ex. 1004, “Alperovitch”); (2) Alperovitch in view of U.S. Patent No. 9,117,075 to Yeh (Ex. 1005, “Yeh”); (3) Alperovitch in view of U.S. Patent No. 9,117,078 to Chien et al. (Ex. 1006, “Chien”); and (4) Alperovitch in view of Yeh and Chien. Pet. at 3. However, the Board should deny the Petition for at least two reasons: (1) the Petitioner fails to identify how certain elements of the Challenged Claims are obvious over Alperovitch, Yeh, Chien, or any combination thereof; and (2) the Board should exercise its discretion to deny the Petition under 35 U.S.C. § 314(a).

Petitioner only addresses the combination of Alperovitch with Yeh and/or Chien to disclose the “storing, in a rules database, a plurality of rules, wherein each rule identifies an action sequence. . wherein the action sequence is a sequence of at least two performed actions” limitations in Claims 1 and 13. Petitioner fails to address the combination of Alperovitch with Yeh and/or Chien for any other claim limitations of Claims 1 or 13 or any of the challenged dependent claims.

Petitioner relies only on Alperovitch for the remainder of the claim limitations of Claims 1 and 13 and all of the challenged dependent claims, but Alperovitch fails to render obvious these claims. Alperovitch does not describe a database of rules that each identify an action sequence but only a database that aggregates application information, including application actions. Alperovitch is silent on rules that correspond with and *identify specific action sequences*, as required by the claimed invention. Alperovitch also does not disclose a relationship between policies and underlying rules that identify action sequences because the policies of Alperovitch are directed towards “identify[ing] *a suitable action* that may be taken *with respect to the mobile application* based on its reputation score.” Ex. 1004, [0018]. Therefore, any risk or reputation score disclosed in Alperovitch is based on the application as a whole and is not a “behavior score” based on a specific action sequence, as in the claimed invention.

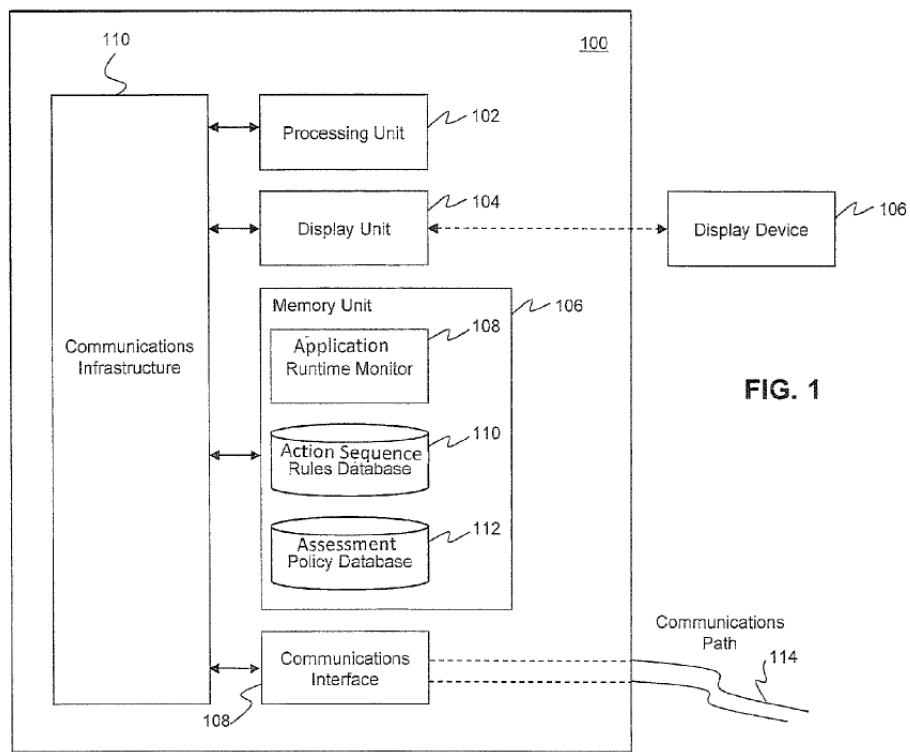
The Board should exercise its discretion to deny this Petition for at least the following reasons: (i) There exists a parallel District Court proceeding between the same parties regarding the same subject patent (the '517 Patent); (ii) the Petition is co-extensive with invalidity arguments that Petitioner has already raised in the District Court Litigation; (iii) the District Court's trial will be almost *five months before* the projected statutory deadline; (iv) the parties have heavily invested in the District Court proceeding since they have already exchanged proposed claim terms,

preliminary claim constructions, intrinsic and extrinsic evidence, and expert declarations for those terms, fact discovery closes in approximately three months on October 16, 2023, and a trial date is set for March 15, 2024, which is less than eight months away; and (v) there is no stay of the parallel District Court Litigation.

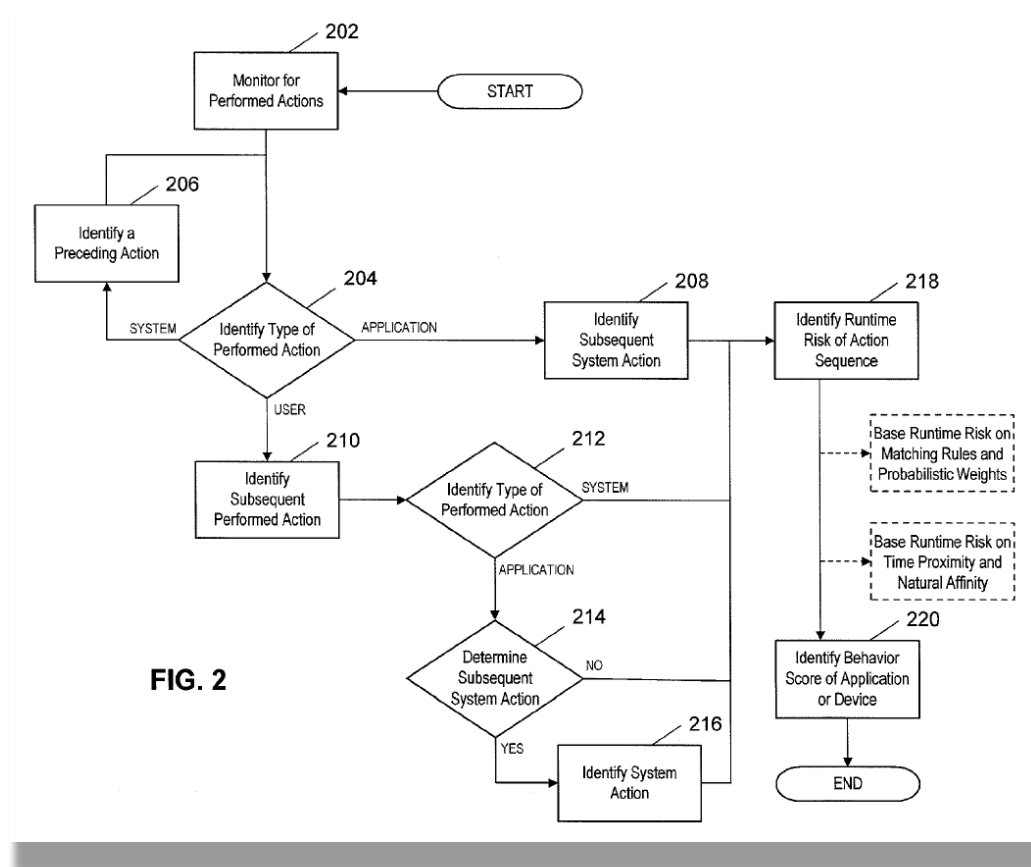
Moreover, the Board should not credit the expert testimony of Dr. Jeffay because his expert Declaration merely repeats the language of the Petition. *See generally* Ex. 2004.

II. THE '517 PATENT AND ITS PROSECUTION

The '517 Patent discloses and claims methods and systems “for assessing runtime risk for an application or device.” '517 Patent, Abstract. In particular, the methods and systems described in the '517 Patent identify an action sequence and assess a runtime risk and subsequent behavior score based on the identified action sequence, as shown in Figs. 1 and 2 reproduced below.



Ex. 1001, Fig. 1.



Id. at Fig. 2.

The '517 Patent describes how assessing a runtime risk and subsequent behavior score based on an *identified action sequence* is an improvement over traditional methods and systems that evaluate individual actions or the application as a whole. An assessment based on an identified action sequence provides a greater level of scrutiny and accuracy and provides the added benefit of less processing:

The runtime monitor 108 may be further configured to identify the authenticity of the action sequence 308, such that an authentic action sequence may indicate that there is a forensic chain of events or a natural progression between the performed actions. In such an instance,

authenticating action sequences may enable the runtime monitor 108 to not consider action sequences that are purely circumstantial (e.g., where an application action 304 or system action 306 is not a result of the user action 302). ***This may result in more accurate scoring of behaviors and runtime risk, and also result in more efficient identification of runtime risks and behavior scores due to less processing required.***

Id. at 7:57-8:1.

The '517 Patent defines a precise relationship between rules, a rule database, policies, and a policy database in order to assess runtime risk based on at least one policy and provide the aforementioned benefit over traditional systems and methods:

The runtime risk may be identified using at least one assessment policy stored in the policy database 112. Each assessment policy may comprise one or more rules stored in the rules database 110 and may identify the runtime risk based on matching rules and probabilistic weights and scores.

Id. at 6:14-19.

The runtime monitor 108 may authenticate an action sequence 308 and determine the runtime risk using at least one assessment policy, which in turn includes at least one rule of the plurality of rules, based on the time proximity (e.g., as included in the action sequence) and natural affinity that may be logically inferred between the performed actions in the action sequence 308. For example, the modification of a file or a registry key value for the computing system 100 upon the opening of a document (e.g., PDF, Excel, PowerPoint, Word, etc.) attached to an e-mail without any user intervention may not be a natural progression for an action sequence, and may therefore indicate a significant runtime risk.

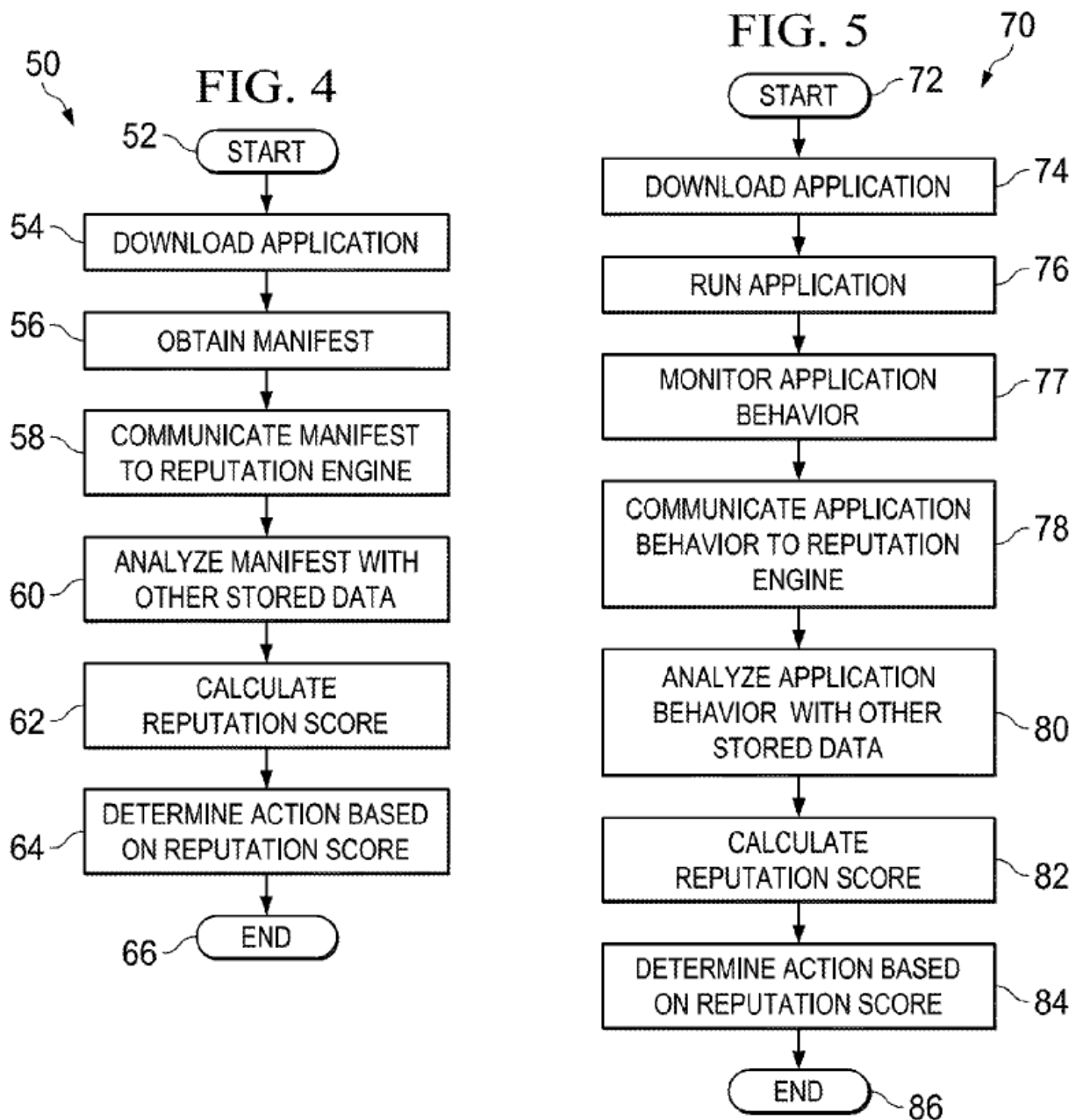
Id. at 8:10-12.

During prosecution, the claims of the '517 Patent were rejected over U.S. Patent App. Pub. No. 2013/0096980 to Basavapatna et al. ("Basavapatna"). Ex. 1002, 54-82, 106-128. The applicant was able to overcome this rejection by amending the claims to emphasize that "Basavapatna does not identify action sequences as part of the risk assessment, but instead uses countermeasures that have been deployed. Basavapatna also does not identify a risk or threat of the identified action sequence of the application, but instead assesses risk associated with known vulnerabilities." *Id.*, 140-141.

III. THE ALLEGED PRIOR ART

A. Alperovitch

Alperovitch "relates in general to the field of computer networks and, more particularly, to a system and a method for crowdsourcing of mobile application reputations." Ex. 1004, [0001]. Specifically the systems and methods of Alperovitch "obtain[] a collection of attributes of a mobile application, compar[e] one or more of the attributes with crowdsourced data associated with other mobile applications to determine one or more trustworthiness indicators, and calculate[e] a reputation score based on the one or more trustworthiness indicators." *Id.* at [0010].



Id. at Figs. 4, 5.

Alperovitch obtains a collection of attributes of a mobile application in an application manifest database that aggregates application information. *Id.* at [0042] (“Reputation engine 20 may comprise application manifest database 32, which may

aggregate and store an inventory of application manifest information crowdsourced from a plurality of mobile devices (*e.g.*, mobile device 14)”; “Reputation engine 20 may aggregate application information in application manifest database 32”). Petitioner points out that examples of monitored application behavior could be “application actions (*e.g.*, actions initiated by the application, such as turning on the mobile device microphone and camera, initiating a network connection with a rogue IP address, starting a virtual game of cards, etc.)” *Id.* at [0054]. Alperovitch compares a current action to stored actions in its database to “determine if similar actions have been requested in the past.” *Id.* at [0055]. For example, such actions could be if “a mobile application that automatically, and without authorization, turns on a camera and a microphone (or other recording device) of a mobile device may be deemed to be malicious” *Id.* at [0013].

Alperovitch identifies a policies database that is directed to all stored application behaviors to “identify *a suitable action* that may be taken *with respect to the mobile application* based on its reputation score.” *Id.* at [0018]. In other words, any risk or “reputation score” is based on the application or device as a whole. *See, e.g., id.* at [0014] (“Agents 24a-c may also access *policies stored on respective mobile devices* 14a-c to determine if mobile applications 22a-c violate any policy.”), [0040], [0046] (“[R]eputation engine 20 may update a *reputation score for the application*. If the application is one of applications 22 in mobile device 14, agent

24 may access the updated reputation score, and take appropriate action against the application on mobile device 14.”), [0048] (“Reputation engines 20a-c may aggregate mobile application information and calculate *respective reputation scores for mobile applications* 22 installed on the respective mobile devices 14a-c.”), [0053] (“Embodiments of the present disclosure can *calculate reputation scores for mobile applications from real-time activities and requests for resources of the mobile applications.*”) (emphasis added).

B. Yeh

Yeh “relates generally to malware detection. More specifically, the present invention relates to cross-referencing host data on a trusted enterprise host computer to compare to a suspect computer.” Ex. 1005, 1:6-9. Yeh seeks to rectify the restrictiveness of white list and black list combinations, or inefficiency of avoiding zero-day attacks by waiting for a length period of time before upgrading to a new version of software. *Id.* at 1:42-58.

Given the importance of early threat detection without the use of pattern files, and the various drawbacks of prior art approaches, and improved technique is desired to detect zero-day malicious activities on enterprise host computers.

Id. at 1:59-62.

“To achieve the foregoing, and in accordance with the purpose of the present invention, a computer system is disclosed that includes a known, trusted host

computer whose activities, behaviors and features may be compared against suspect behaviors of a user computer.” *Id.* at 1:65-2:3. Such a computer system and its corresponding activities are illustrated below:

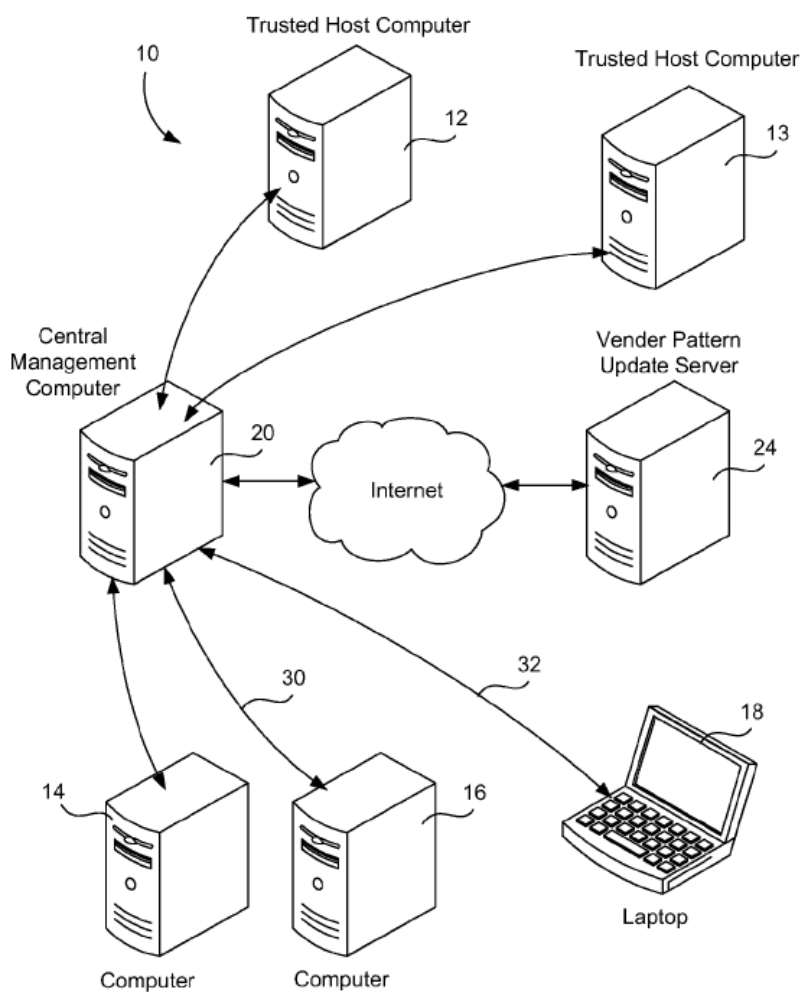


FIG. 1

Id. at Fig. 1.

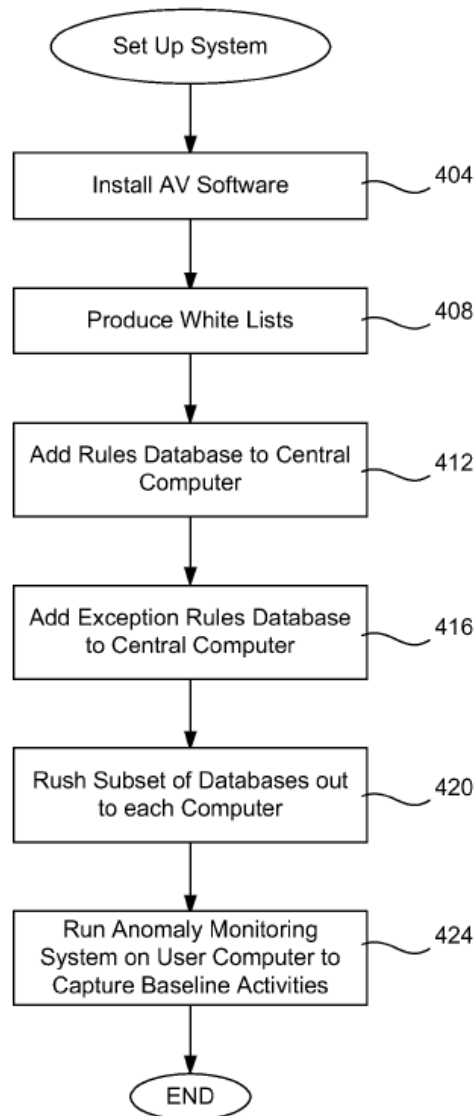


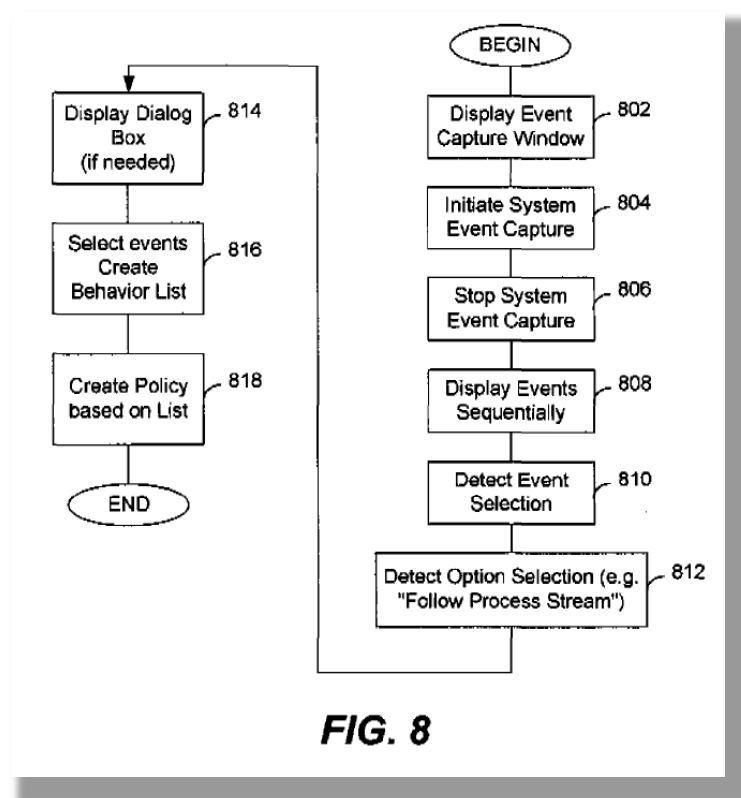
FIG. 11

Id. at Fig. 11.

C. Chien

Chien relates to “creating a policy to be used by a malware prevention system [that] uses multiple events triggered by malware.” Ex. 1006, at Abstract.

Chien notes that conventional systems use a white list to determine which events are acceptable and the white list, in turn, is determined by the policy. If the policy is not precise, then there is a high occurrence of false positives using the white list.” *Id.* at 1:33-43. Chien is directed to achieving a “more precise process and system for making malware detection/prevention policies.” *Id.* More specifically, Chien provides a more precise process by creating behavior lists that utilize multiple events and then derives policies for those behavior lists. *Id.* at 1:47-59.



Id. at Fig. 8.

IV. CLAIM CONSTRUCTION

For the purposes of this Preliminary Response only, Patent Owner believes

that claim construction is not required to resolve any issues.

While Petitioner notes that it believes that claim construction is not otherwise warranted, Patent Owner notes that both Petitioner and Patent Owner agreed to construe the term “runtime” in Claims 1, 10, 13, and 22 of the ’517 Patent as “the time the application is running.” *See* Pet. at 10; Ex. 2003 at 2. This, in addition to the plethora of other outstanding issues that affect validity, weighs in favor of the Board using its discretion to deny institution of this Petition so that all validity issues could be resolved in the District Court Litigation.

V. LEVEL OF ORDINARY SKILL IN THE ART

For the purposes of this Preliminary Response only, Patent Owner utilizes Petitioner’s proposed level of skill in the art: “a bachelor’s degree in computer science or computer engineering, or an equivalent field and at least two to three years of experience in computer and network security. Someone with less or different technical education but more relevant practical experience, or more relevant education but less practical experience, could also be considered a POSITA.” Pet. at 3-4 (citations omitted).

**VI. PETITIONER HAS NOT DEMONSTRATED A REASONABLE
LIKELIHOOD OF SUCCESS FOR THE GROUNDS
ADVANCED IN THE PETITION, AND THE PETITION
SHOULD BE DENIED**

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) so-called secondary considerations where in evidence. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983).

The Board has held that a failure to identify the differences between the claimed subject matter and the prior art is fatal to an obviousness challenge. *See, Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00355, Decision Denying Institution of *Inter Partes* Review, Paper 9 at 9-10 (P.T.A.B. June 26, 2015) (denying institution for failure to identify the differences between the claimed subject matter and the prior art).

In arriving at an obviousness determination, the Board must sufficiently explain and support the conclusions that the prior-art references disclose all the

elements recited in the Challenged Claims and a relevant, skilled artisan not only could have made, but would have been motivated to combine all the prior art references in the way the patent claims and reasonably expected success. *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). That is, even if all the claim elements are found across a number of references, an obviousness determination must consider whether a person of ordinary skill in the art would have the motivation to combine those references. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical Rsch. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.*, 849 F.3d 1049, 1067 (Fed. Cir. 2017) (vacating and remanding an obviousness determination, in part, because the Board did not make factual finding as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a person of skill in the art would have had a reasonable expectation of success from such a combination). This combinability determination, as supported by an articulated motivation to combine, requires a plausible rationale as to why those prior art references would have worked together. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013). Absent some articulated rationale, a “common sense” finding is no different than the conclusory statement “would have been obvious.” *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017). Of additional importance, “knowledge of a problem and motivation to solve it are entirely different

from motivation to combine particular references. . . .” *Innogenetics, N.V. v. Abbott Lab’ys.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

A. Ground 1: Claims 1-24 are Not Obvious Over Alperovitch

1. Alperovitch Does Not Disclose “storing, in a rules database, a plurality of rules, wherein each rule identifies an action sequence...wherein the action sequence is a sequence of at least two performed actions,” as Required by Claim 1

Claim 1 of the ’517 Patent recites “storing, in a rules database, a plurality of rules, wherein each rule identifies an action sequence. . . wherein the action sequence is a sequence of at least two performed actions.” Alperovitch does not render this claim limitation obvious, as Petitioner incorrectly asserts.¹ Pet. at 19-23, 30.²

Alperovitch does not even mention the word “rule,” nor does it describe a database of rules that each identify an action sequence. Petitioner alleges Alperovitch’s application manifest database as meeting the claimed “rule database” limitation. However, the application manifest database is inapposite because it merely aggregates application information. *Id.* at [0042] (“Reputation engine 20 may

¹ Petitioner strangely cites to Yeh (Ex. 1005) twice in its discussion purporting to show that Alperovitch renders obvious this claim limitation. *See* Pet. at 20, 21. These citations and arguments stemming from these citations should be disregarded in this section.

² The Petition cites the expert Declaration of Dr. Jeffay (Ex. 1003, ¶¶ 63-68, 80-82) for its assertion that this disclosure in Alperovitch meets the limitation, but the Jeffay Declaration is almost entirely repetitive of the Petition and does not provide any analysis and should, therefore, be given no weight. *See infra* Sec. VIII; Ex. 2004, ¶¶ 63-68, 80-82.

comprise application manifest database 32, which may aggregate and store an inventory of application manifest information crowdsourced from a plurality of mobile devices (*e.g.*, mobile device 14)”; “Reputation engine 20 may aggregate application information in application manifest database 32”). Petitioner points out that examples of monitored application behavior could be “application actions (*e.g.*, actions initiated by the application, such as turning on the mobile device microphone and camera, initiating a network connection with a rogue IP address, starting a virtual game of cards, etc.)” *Id.* at [0054].

While application actions could be aggregated into an application manifest database, Alperovitch’s database does not identify that there are rules that correspond with and identify specific action sequences, as required by the claim. Alperovitch merely compares a current action to stored actions in its database to “determine if similar actions have been requested in the past.” *Id.* at [0055]. Comparing a current action to all the stored actions in a database to calculate a reputation for an application is not a “rule identif[ying] an action sequence” at least because (i) the individual application actions of Alperovitch are the entries of the database themselves (instead of rules that identify action sequences); and (ii) stored individual actions are not action sequences of at least two performed actions. Petitioner can cite to no part of Alperovitch where an *action sequence* is evaluated collectively.

Alperovitch summarily states that “a mobile application that automatically, and without authorization, turns on a camera and a microphone (or other recording device) of a mobile device may be deemed to be malicious” but that tells a POSITA nothing about whether there is one rule in a database that identifies both of those two actions (turning on the camera and turning on the microphone). Pet. at 21; *id.* at [0013].

Petitioner fails to show that Alperovitch renders this limitation obvious.

2. Alperovitch Does Not Disclose “storing, in a policy database, a plurality of assessment policies, wherein each assessment policy includes at least one rule of the plurality of rules,” as Required by Claim 1

Claim 1 of the ’517 Patent recites “storing, in a policy database, a plurality of assessment policies, wherein each assessment policy includes at least one rule of the plurality of rules.” Alperovitch does not render this claim limitation obvious, as Petitioner asserts. Pet. at 23-25.³

Since Petitioner fails to show how Alperovitch discloses, teaches, or suggests “a rules database, a plurality of rules, wherein each rule identifies an action

³ The Petition cites the expert Declaration of Dr. Jeffay (Ex. 1003, ¶¶ 69-72) for its assertion that this disclosure in Alperovitch meets the limitation, but the Jeffay Declaration is almost entirely repetitive of the Petition and does not provide any analysis and should, therefore, be given no weight. *See infra* Sec. VIII; Ex. 2004, ¶¶ 69-72.

sequence,” it cannot now disclose, teach, or suggest “wherein each assessment policy includes at least one rule of the plurality of rules.” *See supra* Section VI.A.1.

The '517 Patent is clear about the relationship between rules, policies, and a policy database.

The runtime risk may be identified using at least one assessment policy stored in the policy database 112. Each assessment policy may comprise one or more rules stored in the rules database 110 and may identify the runtime risk based on matching rules and probabilistic weights and scores.

Ex. 1001, 6:14-19.

The runtime monitor 108 may authenticate an action sequence 308 and determine the runtime risk using at least one assessment policy, which in turn includes at least one rule of the plurality of rules, based on the time proximity (e.g., as included in the action sequence) and natural affinity that may be logically inferred between the performed actions in the action sequence 308. For example, the modification of a file or a registry key value for the computing system 100 upon the opening of a document (e.g., PDF, Excel, PowerPoint, Word, etc.) attached to an e-mail without any user intervention **may not be a natural progression for an action sequence, and may therefore indicate a significant runtime risk.**

Id. at 8:10-12.

The purpose of the policy in the claimed invention is determining the runtime risk of a given action sequence based on matching a policy's underlying rules and probabilistic weights and scores. No such relationship exists in Alperovitch because

the Petitioner's identified policies database of Alperovitch is directed to all stored application behaviors to "identify *a suitable action* that may be taken *with respect to the mobile application* based on its reputation score." Ex. 1004, [0018]. In other words, any risk or "reputation score" is based on the application as a whole, not on a specific action sequence, as in the claimed limitation.

Therefore, Petitioner cannot show that Alperovitch discloses, teaches, or suggests the claimed "storing, in a policy database, a plurality of assessment policies, wherein each assessment policy includes at least one rule of the plurality of rules" and fails to show that Alperovitch renders this limitation obvious.

3. Alperovitch Does Not Disclose "identifying, using at least one assessment policy, a runtime risk for an application program that executes on a device, wherein the identified runtime risk indicates a risk or threat of the identified action sequence of the application," as Required by Claim 1

Claim 1 of the '517 Patent recites "identifying, using at least one assessment policy, a runtime risk for an application program that executes on a device, wherein the identified runtime risk indicates a risk or threat of the identified action sequence of the application." Alperovitch does not render this claim limitation obvious, as Petitioner asserts. Pet. at 25-27.⁴

⁴ The Petition cites the expert Declaration of Dr. Jeffay (Ex. 1003, ¶¶ 73-75) for its assertion that this disclosure in Alperovitch meets the limitation, but the Jeffay Declaration is almost entirely repetitive of the Petition and does not provide any

Since Petitioner fails to show how Alperovitch discloses, teaches, or suggests “a plurality of assessment policies, wherein each assessment policy includes at least one rule,” it cannot now disclose, teach, or suggest “identifying, using at least one assessment policy, a runtime risk for an application program that executes on a device.” *See supra* Section VI.A.2.

As noted above in Section VI.A.2, the purpose of the policy in the claimed invention is determining the runtime risk *of a given action sequence*. Ex. 1001, 6:14-19, 8:10-12. This is confirmed by the language of this claim, which states that “runtime risk indicates a risk or threat of the identified action sequence of the application.” Alperovitch merely bases any risk or “reputation score” on the application as a whole, not on a specific action sequence, as in the claimed limitation. Ex. 1004, [0018]. Petitioner and Alperovitch are altogether silent on the relationship between policies, rules, and their underlying action sequences because there are none. The “policies” of Alperovitch are for the device or application as a whole. *See, e.g., id.* at [0014] (“Agents 24a-c may also access *policies stored on respective mobile devices* 14a-c to determine if mobile applications 22a-c violate any policy.”), [0040]. In contrast, the ’517 Patent describes that runtime risk can be identified based on matching multiple rules noted in a given policy.

analysis and should, therefore, be given no weight. *See infra* Sec. VIII; Ex. 2004, ¶¶ 73-75.

The runtime risk may be identified using at least one assessment policy stored in the policy database 112. Each assessment policy may comprise one or more rules stored in the rules database 110 and may identify the runtime risk based on matching rules and probabilistic weights and scores.

Ex. 1001, 6:14-19.

Therefore, Petitioner cannot show that Alperovitch discloses, teaches, or suggests the claimed “identifying, using at least one assessment policy, a runtime risk for an application program that executes on a device, wherein the identified runtime risk indicates a risk or threat of the identified action sequence of the application” and fails to show that Alperovitch renders this limitation obvious.

4. Alperovitch Does Not Disclose “identifying, by a runtime monitor including a processing device, a behavior score for the application program that executes on the device based on the identified runtime risk,” as Required by Claim 1

Claim 1 of the ’517 Patent recites “identifying, by a runtime monitor including a processing device, a behavior score for the application program that executes on the device based on the identified runtime risk.” Alperovitch does not render this claim limitation obvious, as Petitioner asserts. Pet. at 27-29.⁵

⁵ The Petition cites the expert Declaration of Dr. Jeffay (Ex. 1003, ¶¶ 76-79) for its assertion that this disclosure in Alperovitch meets the limitation, but the Jeffay Declaration is almost entirely repetitive of the Petition and does not provide any analysis and should, therefore, be given no weight. *See infra* Sec. VIII; Ex. 2004, ¶¶ 76-79.

Since Petitioner fails to show how Alperovitch discloses, teaches, or suggests “the identified runtime risk indicates a risk or threat of the identified action sequence of the application,” it cannot now disclose, teach, or suggest “a behavior score for the application program that executes on the device based on the identified runtime risk.” *See supra* Section VI.A.3.

None of Petitioner’s examples from the specification of Alperovitch indicate a behavior score or a score *based on a given behavior (i.e., the action sequence)*. Rather, Alperovitch describes a “reputation score” *based on the application as a whole*. *See* Ex. 1004, [0046] (“[R]eputation engine 20 may update a *reputation score for the application*. If the application is one of applications 22 in mobile device 14, agent 24 may access the updated reputation score, and take appropriate action against the application on mobile device 14.”), [0048] (“Reputation engines 20a-c may aggregate mobile application information and calculate *respective reputation scores for mobile applications* 22 installed on the respective mobile devices 14a-c.”), [0053] (“Embodiments of the present disclosure can *calculate reputation scores for mobile applications from real-time activities and requests for resources of the mobile applications*.”) (emphasis added).

The specification of the ’517 Patent is clear that its claimed behavior score identifies the authenticity of a specific action sequence, which is a greater level of

scrutiny and accuracy than the application as a whole as well as less processing required:

The runtime monitor 108 may be further configured to identify the authenticity of the action sequence 308, such that an authentic action sequence may indicate that there is a forensic chain of events or a natural progression between the performed actions. In such an instance, authenticating action sequences may enable the runtime monitor 108 to not consider action sequences that are purely circumstantial (e.g., where an application action 304 or system action 306 is not a result of the user action 302). *This may result in more accurate scoring of behaviors and runtime risk, and also result in more efficient identification of runtime risks and behavior scores due to less processing required.*

Ex. 1001, 7:57-8:1.

Therefore, Petitioner cannot show that Alperovitch discloses, teaches, or suggests the claimed “identifying, by a runtime monitor including a processing device, a behavior score for the application program that executes on the device based on the identified runtime risk” and fails to show that Alperovitch renders this limitation obvious.

5. Alperovitch Does Not Render Obvious Claims 2-10 and 13-24⁶

⁶ The Petition cites the expert Declaration of Dr. Jeffay (Ex. 1003, ¶¶ 87-170) for its assertion that this disclosure in Alperovitch meets these claims, but the Jeffay Declaration is almost entirely repetitive of the Petition and does not provide any analysis and should, therefore, be given no weight. *See infra* Sec. VIII; Ex. 2004, ¶¶ 87-170.

Claims 2-12 depend from Claim 1. Therefore, Claims 2-12 are not obvious over Alperovitch for at least the same reasons as Claim 1.

Claims 13-24 are the system claim analogues to the method claims of Claims 1-12. Therefore, Claims 13-24 are not obvious over Alperovitch for at least the same reasons as Claims 1-12, respectively.

B. Grounds 2-4: Claims 1-24 Are Not Obvious Over Alperovitch in View of Yeh and/or Chien

1. Alperovitch Alone, or in Combination With Yeh and/or Chien, Does Not Render Obvious Claim 1

Petitioner only addresses the combination of Alperovitch in combination with Yeh and/or Chien with respect to the “storing, in a rules database, a plurality of rules, wherein each rule identifies an action sequence. . . wherein the action sequence is a sequence of at least two performed actions” limitations in Claims 1 and 13. Petitioner fails to address the combination of Alperovitch with Yeh and/or Chien for any other claim limitations of Claim 1. Accordingly, Petitioner relies on Alperovitch alone to render obvious the “storing, in a policy database, a plurality of assessment policies, wherein each assessment policy includes at least one rule of the plurality of rules,” “identifying, using at least one assessment policy, a runtime risk for an application program that executes on a device, wherein the identified runtime risk indicates a risk or threat of the identified action sequence of the application,” and “identifying, by a runtime monitor including a processing device, a behavior score for the

application program that executes on the device based on the identified runtime risk” claim limitations of Claim 1. For the reasons noted above in Section VI.A, Petitioner fails to render Claim 1 obvious.

2. Alperovitch Alone, or in Combination With Yeh and Chien, Does Not Render Obvious Claims 2-10 and 13-24

Petitioner neglects to provide any analysis that utilizes the combination of Alperovitch with Yeh and/or Chien for the “storing, in a policy database, a plurality of assessment policies, wherein each assessment policy includes at least one rule of the plurality of rules,” “identifying, using at least one assessment policy, a runtime risk for an application program that executes on a device, wherein the identified runtime risk indicates a risk or threat of the identified action sequence of the application,” and “identifying, by a runtime monitor including a processing device, a behavior score for the application program that executes on the device based on the identified runtime risk” limitations in Claim 13 or any of the challenged dependent claims for Grounds 2-4. Pet. at 60-65.

Claims 2-12 depend from Claim 1. Therefore, Claims 2-12 are not obvious over Alperovitch alone, or in combination with Yeh and/or Chien, for at least the same reasons as Claim 1.

Claims 13-24 are the system claim analogues to the method claims of Claims 1-12. Therefore, Claims 13-24 are not obvious over Alperovitch alone, or in

combination with Yeh and/or Chien, for at least the same reasons as Claims 1-12, respectively.

VII. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(A)

Based on Petitioner's reasons regarding § 314(a), the Board should exercise its discretion to deny this Petition.

The circumstances of the parallel District Court Litigation necessitate denial of the Petition under the Board's precedent, as every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (considering (a) "whether the petitioner and the defendant in the parallel proceeding are the same party"; (b) "overlap between issues raised in the petition and in the parallel proceeding" (c) "proximity of the court's trial date to the Board's projected statutory deadline for a final written decision"; (d) "investment in the parallel proceeding by the court and the parties"; (e) "whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted"; and (f) "other circumstances that impact the Board's exercise of discretion, including the merits.").

As set forth below, these factors collectively demonstrate that efficiency and integrity of the AIA are best served by denying review. First, the Petitioner is the Defendant in the parallel proceeding. *See infra* Section VII.A. Second, the

Challenged Claims are all at issue in the District Court Litigation, and Petitioner has raised identical arguments for invalidity there. *See infra* Section II.B. Third, trial in the District Court Litigation is set for March 15, 2024, five months earlier than the projected statutory deadline for a final written decision of this Petition in August 22, 2024. *See infra* Section VII.C. Fourth, the parties (and Taasera in particular) have invested significant resources on developing legal and factual issues of validity and infringement in the District Court Litigation and will have invested substantially more resources before any decision on this Petition. *See infra* Section VII.D. Fifth, the Court has neither granted nor denied a stay pending this Petition. *See infra* Section VII.E. Finally, no other factors favor institution. *See infra* Section VII.F.

Accordingly, the Board should exercise its discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to District Court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

**A. The Parallel District Court Proceeding and the Petition
Involve the Same Parties**

As noted in Patent Owner’s Mandatory Notice, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the ’517 Patent). *Palo Alto Networks, Inc., v. Taasera Licensing LLC*, IPR2023-00704, Paper 4 at 2-3 (P.T.A.B. Mar.31, 2023); Pet. at 67. Petitioner is a party to the District Court Litigation captioned as *In re: Taasera Licensing LLC, Patent Litigation*, No. 2:22-md-03042-JRG (E.D. Tex. Aug. 3, 2022) (the “District Court Litigation”). Accordingly, this factor weighs in favor of discretionary denial.

B. The District Court Litigation Involves Substantially the Same Claims, Grounds, Arguments, and Evidence

This Petition is co-extensive with invalidity arguments that Petitioner has already raised in the District Court Litigation. Ex. 2002, at 82, 165. “In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020). Accordingly, this fact weighs strongly in favor of discretionary denial.

Petitioner states that it “will not pursue in parallel district court proceedings the same grounds as in the Petition.” Pet. at 66. Yet, all three references used in the Petition (Alperovitch, Yeh, and Chien) and Petitioner’s corresponding arguments significantly overlap with the claims, references, arguments, and evidence in the

District Court Litigation. In fact, for each overlapping references, Petitioner explicitly incorporates by reference the grounds asserted in the PTAB and points to the same sections of each reference for each of the same claim elements. *See, e.g.*, Ex. 2002 at 82 (“Defendant incorporates by reference each of the grounds of invalidity presented in the petition for the following *inter partes* review proceeding(s) (IPRs) and any additional petitions for IPRs that may be filed challenging the patentability of the ’517 patent: IPR2023-00704 [;] IPR2023-00798”), 165 (“Defendant incorporates by reference each of the obviousness combinations and motivations to combine presented in the petition for the following *inter partes* review proceeding(s) (IPRs) and any additional petitions for IPRs that may be filed challenging the patentability of the ’517 patent: IPR2023-00704[;] IPR2023-00798”).

For this reason, denial of institution under § 314(a) is appropriate because the Petition “includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel [District Court] proceeding.” *Fintiv*, IPR2020-00019, Paper 11, at 12.

C. Proximity of The District Court’s Trial Date

The proximity of the District Court Litigation’s trial date to the Board’s projected statutory deadline for a final written decision strongly weighs in favor of discretionary denial.

The parties' trial is scheduled for March 15, 2024. Exhibit 2001 (Sixth Amended Docket Control Order, Dkt. 239, *In re: Taasera Licensing LLC, Patent Litigation*, No. 2:22-md-03042-JRG (E.D. Tex. June 27, 2023)). Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a final written decision of this Petition is October 17, 2024.⁷ As the District Court's trial will be almost ***five months before*** the projected statutory deadline, this factor weighs strongly in favor of denying institution. *See Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 10-12 (P.T.A.B. June 24, 2020) (denying institution where the jury trial was scheduled to conclude approximately ten months before the statutory deadline); *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-01479, Paper 7, at 6-13 (P.T.A.B. Feb. 26, 2020) (denying institution where jury trial would conclude more than nine months before a final decision would be due); *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019)

⁷ The statutory deadline for institution is October 17, 2023, "three months after receiving a preliminary response to the petition under section 313." *See* 35 U.S.C. § 314(b)(1). If instituted, the statutory deadline for final written decision is October 17, 2024, "not later than 1 year after the date on which the Director notices the institution of a review."

(denying institution where trial was scheduled to conclude “several months,” before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 (“Because the trial date is substantially earlier than the projected statutory deadline for the Board’s final decision, this factor weighs in favor of discretionary denial.”).

Petitioner does not contest that the proximity of the trial favors denial of institution. Thus, this factor also weighs in favor of discretionary denial.

D. Significant Investment and Petitioner’s Delay in Filing the Petition

The parties’ investment in the parallel proceeding weighs in favor of discretionary denial.

In the District Court Litigation, the Court has already entered seven Docket Control Orders (Dkts. 8, 15, 46, 84, 209, 225, 239), Discovery Order (Dkt. 137), Protective Order (Dkt. 162), and E-Discovery Order (Dkt. 195). Discovery is also well under way. The parties have already exchanged initial disclosures, infringement contentions pursuant to P.R. 3-1, and invalidity contentions pursuant to P.R. 3-3. The parties have already exchanged proposed claim terms, preliminary claim constructions, intrinsic and extrinsic evidence, and expert declarations for those terms, fact discovery closes in approximately three months on October 16, 2023, and a trial date is set for March 15, 2024, which is less than eight months away. Ex. 2001.

As noted above, all three references used in the Petition (Alperovitch, Yeh, and Chien) and Petitioner's corresponding arguments significantly overlap with the claims, references, arguments, and evidence in the District Court Litigation. Petitioner further fails to offer any explanation why the Board should review the same claims on the same grounds which will already have been adjudicated by the District Court based on the parties' investment. Thus, the parties' and Court's substantial investment in this proceeding weighs in favor of denial of institution under this factor.

E. No Stay of the Parallel District Court Litigation

There is no stay of the parallel District Court Litigation. Even if the Petition was instituted and Petitioner filed a motion to stay the District Court Litigation, prejudice, tactical disadvantage to Taasera, the late stage of the litigation, and the lack of potential simplification would weigh strongly against such a motion. *See Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, 2:13-CV-00235-JRG, 2014 WL 4652117, at *1 (E.D. Tex. Sept. 18, 2014). The statutory deadline for institution is not until after the district court's claim construction hearing and the deadline to complete fact discovery,⁸ placing any motion for a stay close to trial. Ex.

⁸ As noted above, the statutory deadline for institution is October 17, 2023. *See supra* n. 1. Per Ex. 2001, the claim construction hearing is September 19, 2023, and the deadline to complete fact discovery is October 16, 2023.

2001; *see Intell. Ventures II v. FedEx Corp.*, No. 2:16-cv-00980-JRG, Dkt. 141 at 5 (E.D. Tex. Oct. 24, 2017) (“The Court agrees that the Parties have already invested substantial effort and resources during discovery and in preparing claim construction briefing. . . . These circumstances weigh against staying this case”).

Moreover, a stay would not decrease the burden on the Court and the parties since any instituted IPR would only cover three out of the eleven references that Petitioner raised in the District Court Litigation for both anticipation and at least 12 combinations of obviousness that each include 12 references, and not include Petitioner’s challenges under § 112 or § 101. Ex. 2002, at 82, 144-165, 371-374, 421-430. *Intell. Ventures II*, No. 2:16-cv-00980-JRG, Dkt. 141 at 3-4 (“[T]he instituted IPRs only cover a narrow slice of the invalidity arguments Defendants have raised in this case. For example, Defendants have argued that the ’715 Patent is invalid under § 102 with respect to at least eight references . . . under § 103 with respect to at least twenty-six combinations . . . under § 112 [], and under § 101.”).

Accordingly, it would be unlikely for the Court to hold that a stay would streamline the litigation and this factor supports denial of institution.

F. Other Factors Favor Discretionary Denial

Petitioner does not present a strong case on the merits, further supporting denial of institution. *See supra* Section VI. Petitioner also does not identify any other factors which weigh against discretionary denial. Pet. at 66.

Thus, when viewing the factors together, the Petition should be denied in the Director's discretion under 35 U.S.C. § 314(a).

VIII. PETITIONER'S EXPERT DECLARATION SHOULD NOT BE CONSIDERED

“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.” 37 C.F.R. § 42.65(a). Here, the Declaration of Dr. Jeffay is almost entirely a word-for-word recitation of the Petition, except for the Introduction, Background sections describing Dr. Jeffay's experience, and Legal Standards Used in Dr. Jeffay's analysis. *See* Ex. 2004 (redline comparison). Because Dr. Jeffay does not provide any independent analysis aside from copying the attorney arguments in the Petition and does not disclose the underlying facts or data upon which his opinions are based, his opinion should be entitled to no weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper No. 9 (P.T.A.B. Aug. 24, 2022) (designated precedential Feb. 10, 2023, Paper 12) (denying institution and rejecting a conclusory and unsupported expert declaration that repeated portions of the Petition verbatim.).

IX. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition in its entirety.

Respectfully submitted,

Dated: July 17, 2023

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 has 6,829 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

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A copy of PATENT OWNER'S PRELIMINARY RESPONSE and EXHIBITS 2001 through 2004 have been served on Petitioner's counsel of record as follows:

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