

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORCEPOINT LLC,
Petitioner

v.

OPEN TEXT INC.,
Patent Owner

U.S. PATENT NO. 10,025,928

Case IPR2023-00786

PETITIONER'S REQUEST FOR REHEARING

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Pursuant to 37 C.F.R. § 42.71(d), Forcepoint LLC (“Petitioner”) submits this Request for Rehearing of the Board’s Decision Denying Institution of Inter Partes Review of U.S. Patent No. 10,025,928 (Paper 15) (“Decision”). This is Petitioner’s first rehearing request. See 37 C.F.R. § 42.71(d).

I. INTRODUCTION

Petitioner respectfully requests that the Board grant rehearing of the Decision and institute an IPR trial for two reasons. First, in reaching its conclusion that the claim limitation “determining . . . whether the request is associated with known malicious content” does not encompass determining whether the request itself is malicious, the Board overlooked the prosecution history of the ’928 patent (Exhibit 1003, 138-140). Decision at 14. Second, the Board misapprehends the teachings of the primary reference Devarajan. That misapprehension undermines the Decision’s claim construction and thus also warrants granting this request and instituting an IPR trial on all Challenged Claims of the ’928 patent.

II. LEGAL STANDARD

When rehearing a decision, the Board “review[s] the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c) (2021). An abuse of discretion may arise if the decision is based on an erroneous interpretation of law, if substantial evidence does not support a factual finding, or if an unreasonable judgment is made in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005);

Arnold P'ship v. Dudas, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

And, when construing claim terms, Rule 42.100(b) instructs that:

In an inter partes review proceeding, a claim of a patent, or a claim proposed in a motion to amend under § 42.121, shall be construed using 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.

Specific to the issues raised in this Request, the Decision failed to consider the admission made by Patent Owner's during prosecution (Ex. 1003, 139) that "the embodiment recited in claim 1" "provides for checking both the request and the response for malicious content." *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995) (concluding "[a]rguments and amendments made during the prosecution of a patent application and other aspects of the prosecution history, as well as the specification and other claims, must be examined to determine the meaning of terms in the claims") (citing *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430 (Fed. Cir. 1988)).

III. ARGUMENT

A. The Decision Did Not Consider the '928 File History When Construing "determining . . . whether the request is associated with known malicious content"

The claims of the '928 patent require, *inter alia*, that a “protection agent” determine “whether [a] request is associated with known malicious content....” Although no express claim construction is provided in the Petition, the Petition explains that “no terms need construction because the claims read on the prior art under any construction consistent with *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).” And, when discussing the '928 prosecution history, Petitioner points out that Patent Owner amended claims 1 and 11 to recite, *inter alia*, “determining, by a protection agent, whether the request is associated with known malicious content” and provides a citation to pages 138 to 140 of the '928 file history, Exhibit 1003. Petition at 7.

In reaching its claim construction, the Decision overlooks pages 138 to 140 of the '928 file history, even though the file history was placed into evidence and those specific pages of the file history were cited in the Petition. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996) (concluding “the court may also consider the prosecution history of the patent, if in evidence (citations omitted). This history contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims”).

The Decision’s oversight of the '928 file history is in error. As discussed below, the '928 file history is wholly inconsistent with the claim construction

position taken by Patent Owner and adopted by the Decision. Patent Owner argues in its Preliminary Response (pages 24 and 25) that the limitation “whether [a] request is associated with known malicious content should be given its “plain and ordinary meaning, which does not include determining whether the request itself is malicious.” During prosecution though, Patent Owner made clear in its June 11, 2014 Amendment that claim 1 is not so limited, characterizing claim 1 as encompassing “checking both the request and the response for malicious content.” Ex. 1003, 139. In addition to this clear concession that claim 1 does not exclude determining whether the request itself is malicious, the Examiner responded to Patent Owner’s argument concluding that the prior art discloses checking both the request and the response for malicious content. *Id.* at 181 (“The examiner respectfully disagrees and notes that the prior art discloses checking both the request (e.g. Scott; sect. 3.4, par. 1 - if the request is malformed, it is not propagated to the web server) and the response....”).

In support of its claim construction position, Patent Owner cites the ’928 specification, Ex. 1001 at 4:56-57, 5:47-51, 5:63-67, and 6:17-23. POPR, 23-28. Notably, the Decision (pages 12 and 13) does not rely on only the passages cited by Patent Owner, but *sua sponte* cites additional passages from the ’928 specification it considered in rendering the Decision:

Other portions of the Specification likewise refer to content (which may be malicious) as distinct from a request for content. *See, e.g., id.* at col. 2, ll. 24–29 (“the protection module receives content from a web server”), col. 3, ll. 21–24 (“malware source 106 generally represents a source of malware that ends up or is strategically placed at the web server 108, which may or may not be suspected of hosting malware”), col. 4, ll. 56–61 (“protection agent 116 receives content from the web server 108”), col. 5, ll. 47–51 (“agent processes 220 enable all content that is requested by an application 222 (e.g., a browser) and received by the browser engine 218 to be intercepted”), 52–61 (“a user initiates a request via the application 222 (e.g., web browser or other application that requests web content)”).

Although the Board voluntarily reviewed the ’928 specification to inform its claim construction analysis (*Id.* at 13 (“Petitioner does not point to, and we do not find, anything in the Specification describing determining whether a request itself is malicious.”)), the Decision fails to reflect that the ’928 file history was reviewed to any extent for that same purpose.

In conclusion, although the Board reviewed the ’928 specification and relied on passages not relied on by the Patent Owner to reach its outcome determinative claim construction, the Board overlooked portions of the ’928 file history inconsistent with Patent Owner’s arguments. For at least this reason, trial should be granted to determine whether Petitioner has met its burden under a construction of

the '928 claims that does not exclude determining whether a request itself is malicious.

B. The Decision Misapprehends How Devarajan Determines Whether to Allow a Request to Proceed

In addition to its reliance on the '928 specification to the exclusion of the '928 file history, the Decision (page 13) agrees with Patent Owner that there is a significant difference between determining whether a request is “associated with known malicious content” and determining whether the request itself is malicious. However, Patent Owner’s argument and hence the Decision misapprehend the teachings of Devarajan. In particular, Patent Owner argues (pages 27 and 28) that, in contrast to the approach claimed in the '928 patent, when Devarajan determines that its request is legitimate, it will “allow the request to proceed.” That is simply not true.

Like the '928 patent that compares the URL request to a blacklist of URLs associated with known malicious web pages, Devarajan determines whether the “hosting server’s 903 network resource address 904 is stored in the second malicious network resource address database” before transmitting requested content to the client. Petition at 31. That is, Devarajan includes an extra level of protection not afforded by the '928 patent’s approach. Devarajan checks (i) whether the request itself is legitimate (step 1020) and (ii) whether the URL of the web server is associated with known malicious web pages (step 1070) before allowing the request

to proceed (step 1080). Petition at 31 and 38. Notwithstanding Deverajan's additional layer of protection, any differences in approach between Deverajan and the '928 patent is insignificant because both methods return the same results—preventing the request from proceeding so that malware doesn't reach the client in response to a request originating at the client.

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that this Board reconsider its Decision and institute trial.

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CERTIFICATE OF SERVICE

In compliance with 37 C.F.R. § 42.6(e), the undersigned hereby certifies that a copy of the foregoing document was served on November 22, 2023, via electronic mail to OpenText_Webroot@kslaw.com and the attorneys of record below:

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