

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYMANTEC CORP.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2015-01895
Patent 7,613,926 B2

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

YANG, *Administrative Patent Judge*.

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

INTRODUCTION

Symantec Corp. (“Petitioner”) filed a Petition for an *inter partes* review of claims 15, 18–20, 22, 25–27, and 30 of U.S. Patent No. 7,613,926 B2 (Ex. 1001, “the ’926 patent”). Paper 1 (“Pet.”). Finjan, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

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

Related Proceedings

According to the parties, Patent Owner previously asserted the ’926 patent against Petitioner in *Finjan, Inc. v. Symantec Corp.*, 3:14-cv-02998 (N.D. Cal.). Pet. 1; Paper 5, 1. Petitioner has filed IPR2015-01893, concurrently seeking an *inter partes* review of the ’926 patent on different grounds. Pet. 1; Paper 5, 1.

The ’926 patent was the subject of IPR2015-00907, filed by Sophos Inc., which we previously denied. *Sophos, Inc. v. Finjan, Inc.*, IPR2015-00907, Paper 8. We also denied Sophos’ request for rehearing in that case. *Id.*, Paper 10. In addition, the ’926 patent is the subject of IPR2016-00145, filed by Palo Alto Networks, Inc., which remains pending.

Further, the ’926 patent is the subject of *Finjan, Inc. v. Sophos, Inc.*, 3:14-cv-01197 (N.D. Cal.), and *Finjan, Inc. v. Palo Alto Networks, Inc.*, 3:14-cv-04908 (N.D. Cal.). Paper 5, 1. Petitioner also has requested *inter partes* reviews of several patents related to the ’926 patent. Pet. 1.

The '926 Patent

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

Illustrative Claim

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

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

suspicious computer operations that may be attempted by the Downloadable; and

transmitting the incoming Downloadable and a representation of the retrieved Downloadable security profile data to a destination computer, via a transport protocol transmission.

Asserted Grounds of Unpatentability

Petitioner asserts the following grounds, each of which challenges the patentability of claims 15, 18–20, 22, 25–27, and 30:

Basis	References
§ 103	Touboul I ¹ and Touboul II ²
§ 103	Touboul I and Dan ³

In support of its patentability challenge, Petitioner relies on the Declaration of Jack W. Davidson, Ph.D. Ex. 1019.

ANALYSIS

Claim Construction

In an *inter partes* review, the Board interprets a claim term in an unexpired patent according to its broadest reasonable construction in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 778 F.3d 1271, 1278–81 (Fed. Cir. 2015),

¹ Shlomo Touboul, U.S. Patent No. 6,092,194, issued July 18, 2000 (Ex. 1005, “Touboul I,” or “the ’194 patent”).

² Shlomo Touboul and Nachshon Gal, U.S. Patent No. 6,154,844, issued Nov. 28, 2000 (Ex. 1012, “Touboul II”).

³ Asit Dan et al., U.S. Patent No. 5,825,877, issued October 20, 1998 (Ex. 1013, “Dan”).

cert. granted sub nom. Cuozzo Speed Techs. LLC v. Lee, 136 S. Ct. 890 (2016). On this record and for purposes of this Decision, we determine that no claim terms require express construction.

Discussion

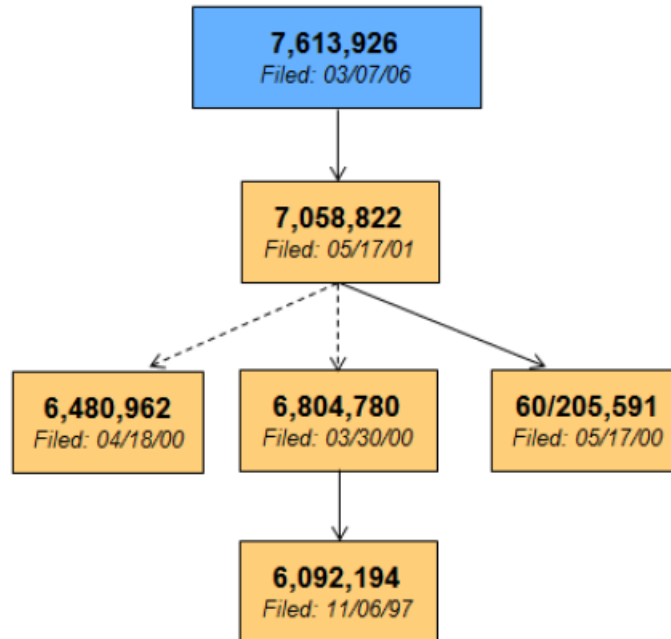
Petitioner contends that the combination of Touboul I and Touboul II renders the challenged claims obvious. Pet. 32–41. In addition, Petitioner argues that the combination of Touboul I and Dan also renders the challenged claims obvious. *Id.* at 42–52. According to Petitioner, Touboul I and Touboul II qualify as prior art because the challenged claims are entitled to, at the earliest, a March 7, 2006 priority date. *Id.* at 22–23. Based on the record before us, and for the following reasons, we are not persuaded.

Priority Date

The '926 patent issued from Application No. 11/370,114 (“the '114 application”), filed on March 7, 2006. Ex. 1001, (21), (22). According to the '926 patent, the '114 application is a continuation of Application No. 09/861,229 (“the '229 application”), filed on May 17, 2001, now U.S. Patent No. 7,058,822 B2 (“the '822 patent”), which is a continuation-in-part of Application No. 09/551,302 (“the '302 application”), filed on April 18, 2000, now U.S. Patent No. 6,480,962 B1 (“the '962 patent”). *Id.* at 1:8–32. In addition, the '229 application claims benefit of provisional Application No. 60/205,591 (“the '591 provisional”), filed May 17, 2000. *Id.* Further, the '229 application is a continuation-in-part of Application No. 09/539,667 (“the '667 application”), filed on March 30, 2000, now U.S. Patent

No. 6,804,780 B1 (“the ’780 patent”), which is a continuation of Application No. 08/964,388 (“the ’388 application”), filed on November 6, 1997, and issued as the ’194 patent, i.e., Touboul I. *Id.*

For illustration, we reproduce below a chart of the claimed priority chain in the ’926 patent prepared by Petitioner:



The chart above provides “a graphical depiction of the claimed priority chain in the ’926 patent (with dashed arrows indicating that the later application is a continuation-in-part of the earlier application).” Pet. 3–4. On its face, the earliest claimed priority date for ’926 patent is November 6, 1997.

According to Petitioner, however, because the priority claims in the ’926 patent are defective, the challenged claims are not entitled to the priority based on any of the priority applications. Pet. 4. Specifically, Petitioner argues that (1) the priority applications lack continuity of disclosure necessary to support the challenged claims; and (2) when issued,

the '822 patent failed to include a priority claim or any specific reference to the '194 patent or to name any inventor in common with the '194 and '780 patents. *Id.* at 5. As a result, Petitioner asserts, “the earliest possible priority date of the challenged claims is the filing date of the '926 patent, *i.e.*, March 7, 2006.” *Id.* at 16. We are not persuaded.

Continuity of Disclosure

Petitioner argues that because the priority applications fail to meet the continuity-of-disclosure requirement, the '926 patent is not entitled to priority from those applications. Pet. 7–16.

To claim priority from an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112. *Zenon Envtl., Inc. v. U.S. Filter Corp.*, 506 F.3d 1370, 1378 (Fed. Cir. 2007); *see also In re Hogan*, 559 F.2d 595, 609 (CCPA 1977) (“[T]here has to be a continuous chain of copending applications each of which satisfies the requirements of § 112 with respect to the subject matter presently claimed.”). If any application in the priority chain fails to make the requisite disclosure, the later-filed application is not entitled to the benefit of the filing date of applications preceding the break in the priority chain. *Lockwood v. Am. Airlines Inc.*, 107 F.3d 1565, 1571–72 (Fed. Cir. 1997).

Petitioner asserts that the '822 patent lacks written description support for virtually all of the limitations recited in the challenged claims. Pet. 9–16. According to Petitioner, the '822 patent, a continuation-in-part of the '780 patent, “has an entirely different specification from the earlier-filed

applications.” *Id.* at 11. Thus, while the ’780 and ’194 patents describe some of the limitations of the challenged claims, Petitioner argues, the specification of the ’822 patent does not include those disclosures. *Id.* at 10–11. Petitioner concludes that the ’822 patent constitutes a break in the priority chain of the ’926 patent. *Id.* at 12.

Patent Owner counters that the ’822 patent incorporates by reference the ’962 and ’780 patents in their entirety. Prelim. Resp. 15. In addition, because the disclosure of the ’780 patent is substantially identical to the disclosure of the ’194 patent, Patent Owner argues, continuity of disclosure exists between the ’194 and ’926 patents. *Id.* at 19–20.

Petitioner contends that the ’822 patent fails to incorporate the disclosures of the earlier patents by reference. *Id.* at 12–14. Petitioner argues that “for material to be deemed incorporated by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the referenced documents.” *Id.* at 13 (quotation marks and alteration marks omitted). According to Petitioner, the ’822 patent merely includes generic statements to incorporate the earlier applications. *Id.* at 12. “Such boilerplate language alone is plainly insufficient to meet the particularity required for material to be deemed incorporated by reference.” *Id.* at 14. As a result, Petitioner concludes, the ’822 patent lacks continuity of disclosure for most of the limitations required by the challenged claims. *Id.* at 15.

Patent Owner responds that the facts here are distinguishable from those in cases Petitioner relies on. Prelim. Resp. 18. For example, in *Zenon*, Patent Owner asserts, there was a lack of continuity of disclosure in a

priority chain because the priority references were not incorporated in their entirety, but only with respect to specific portions. *Id.* at 19. More importantly, according to Patent Owner, the Federal Circuit has held that broad language similar to the alleged “boilerplate” incorporation statements in the ’822 patent is effective to incorporate the entire disclosures of the references. *Id.* at 17. We find Patent Owner’s arguments more persuasive.

Incorporation by reference “provides a method for integrating material from various documents into a host document . . . by citing such material in a manner that makes clear that the material is effectively part of the host document as if it were explicitly contained therein.” *Zenon*, 506 F.3d at 1378 (quotation marks omitted). Incorporation by reference must be set forth in the specification and must (1) express a clear intent to incorporate by reference by using the root words “incorporate” and “reference” (e.g., “incorporate by reference”); and (2) clearly identify the referenced patent, application, or publication. 37 C.F.R. § 1.57(c). “Essential material,” such as material necessary to provide a written description of a claimed invention, may be incorporated by reference by reference to a U.S. patent or U.S. patent application publication, as long as the referenced patent or patent application publication does not itself incorporate such essential material by reference. *Id.* § 1.57(d).

In *Harari v. Lee*, 656 F.3d 1331 (Fed. Cir. 2011), the Federal Circuit concluded that the broad and unequivocal language “[t]he disclosures of the two applications are hereby incorporated by reference” incorporates the entire disclosures of the two applications. *Id.* at 1335. The incorporation statement in the ’822 patent is similar:

This application is also a Continuation-In-Part of and hereby incorporates by reference patent application Ser. No. 09/539,667, now U.S. Pat. No. 6,804,780 This application is also a Continuation-In-Part of and hereby incorporates by reference patent application Ser. No. 09/551,302, now U.S. Pat. No. 6,480,962

Ex. 1002, 1:11–19. Petitioner acknowledges that the '780 patent provides written support for the limitations of the challenged claims. Pet. 10. In other words, the '780 patent does not itself incorporate such “essential material” by reference. *See* 37 C.F.R. § 1.57(d). Thus, the holding of *Harari* informs our conclusion that the '822 patent incorporates by reference the '780 patent in its entirety. Because the '194 and '780 patents share essentially the same disclosure (*compare* Ex. 1004 *with* Ex. 1005), we agree with Patent Owner that continuity of disclosure exists between the '194 and '926 patents.

Written Description Support for the “Transmitting” Limitation

Petitioner also contends that none of the priority applications discloses the limitation “transmitting . . . a representation of the retrieved Downloadable security profile data to a destination computer,” recited in the challenged claims. Pet. 8–9. Patent Owner responds that “the '194 and '780 patents disclose[] that the DSP data and the Downloadable can be transmitted to various destination computers, including the ACL comparator component.” Prelim. Resp. 20. Indeed, according to the '194 and '780 patents, “[t]he code scanner **325** then stores the DSP data into DSP data **310** (corresponding to its Downloadable ID), and sends the Downloadable, the

DSP data to the ACL comparator **330** for comparison with the security policy **305.**” Ex. 1004, 6:21–24; Ex. 1005, 6:9–12. Patent Owner further points out that the ’194 and ’780 patents disclose that “any component of the invention may be implemented as network connected computer such as a network of interconnected conventional components.” Prelim. Resp. 20–21 n.3 (citing Ex. 1004, 3:22–26, 10:13–16; Ex. 1005, 9:65–10:1).

Based on the record, we are persuaded by Patent Owner that both the ’194 and ’780 patents provide written description support for “transmitting . . . a representation of the retrieved Downloadable security profile data to a destination computer.” *See id.* at 21. Because the ’822 patent and the ’926 patent each incorporates the ’780 patent by reference, and the ’194 and ’780 patents share essentially the same disclosure, every application in the priority chain of the ’926 patent provides written description support for this limitation. *See id.* at 21–22.

Specific Reference to Earlier-Filed Applications

A patent is entitled to the priority date of an earlier filed application if, among others, it contains or is amended to contain a specific reference to the earlier filed application. 35 U.S.C. § 120. Petitioner asserts that the ’926 patent is not entitled to the November 6, 1997 priority date also because, when issued in 2006, the ’822 patent did not meet the specific-reference requirement under § 120. Again, we are not persuaded.

The following facts are not in dispute. As filed, the ’229 application, which matured into the ’822 patent, included a claim of priority from, and incorporated by reference, the ’302 application that matured into the ’962

patent, the '667 application that matured into the '780 patent, and the '591 provisional. Ex. 1002, 1:7–21. It, however, did not claim priority from, or include any reference to, the '388 application, which matured into the '194 patent. During an *ex parte* reexamination of the '822 patent, Patent Owner filed a Petition to Accept Unintentionally Delayed Priority Claim Under 37 C.F.R. § 1.78, requesting amendment to include reference to the '194 patent. Ex. 1007, 7–9. The Office granted Patent Owner's Petition on July 25, 2014. *Id.* at 1–3.

Petitioner contends that, even though Patent Owner represented, and the Office agreed, that the delayed priority claim was unintentional, “publicly available information casts serious doubts as to whether this 7-year delay was, in fact, unintentional.” Pet. 5–6. Specifically, Petitioner points to the amendments of the priority claim in several other applications and patents by Patent Owner. *Id.* at 18–21. Petitioner suggests that “it appears Patent Owner has, on numerous occasions, attempted to gain extra patent term for its patents by not making certain priority claims up front, and then only doing so in certain applications when an earlier priority date is needed to avoid/disqualify intervening prior art.” *Id.* at 21.

Patent Owner responds that “Petitioner is essentially alleging inequitable conduct by questioning the veracity of Patent Owner's Statement to the USPTO.” Prelim. Resp. 24. In addition, Patent Owner asserts that “[v]alidity challenges based on inequitable conduct are improper in a petition for *Inter Partes* Review.” *Id.* We agree with Patent Owner.

The Board is not a court of general jurisdiction, but an administrative tribunal with limited jurisdiction. 35 U.S.C. § 311(b) (providing *inter partes*

review “only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications”). Based on limited and circumstantial evidence, which, according to Petitioner, casts doubts onto Patent Owner’s actions, Petitioner asks us to draw inferences against Patent Owner. Pet. 5–6, 17–21. This allegation does not satisfy the prior-art requirement. Nor does it amount to a “reasonable likelihood” for Petitioner to prevail in its patentability challenges. *See* 35 U.S.C. § 314(a). Thus, we do not make any determination with respect to Petitioner’s allegations regarding the veracity of Patent Owner’s statements to the Office in prior proceedings.

Common Inventor

Petitioner further asserts that when it issued in 2006, “the ’822 patent did not even include any inventors in common with the earlier applications until Patent Owner ‘corrected’ the inventorship more than 5 years after the ’822 patent issued.” Pet. 11; *see also id.* at 5 (arguing that between the time the ’822 patent issued and the time the inventorship was corrected, the ’822 patent failed to satisfy the common inventorship requirement under 35 U.S.C. § 120). We are not persuaded.

When filed, the ’229 application, from which the ’822 patent issued, named only Messrs. Vered, Edery, and Kroll as inventors. Ex. 1002 (75). A Request to Correct Inventorship, requesting to add Mr. Touboul as an inventor, however, was filed on June 21, 2005. Ex. 2005, 3. The Request was accompanied by supporting papers, including a statement signed by Mr. Touboul and stating that the error in inventorship occurred inadvertently and

that there was no deceptive intent on his part; an Assent of Assignee To Correction And/Or Addition of Inventor; a new Declaration signed by Messrs. Vered, Edery, Kroll, and Touboul; and an Assignment executed by Mr. Touboul. *Id.* at 4–14. The Office granted the Request on August 11, 2005, before the '822 patent issued. *Id.* at 15–17. Although Mr. Touboul's name was not printed on the '822 patent when it issued (Ex. 1002, (75)), it was later added by a Certificate of Correction (*id.* at 25) issued on a request filed under 37 C.F.R. § 1.322 (“Certification of correction of Office mistake”). Ex. 3001.

Because Mr. Touboul is the named inventor of the '194 and '780 patents, the '822 patent includes a common inventor with those earlier patents.

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

Obviousness Grounds

Petitioner contends that the combination of Touboul I and Touboul II, or the combination of Touboul I and Dan, renders the challenged claims obvious. Pet. 32–52. As explained above, the challenged claims are entitled to the benefit of the November 6, 1997 filing date. Thus, neither Touboul I (the '194 patent) nor Touboul II (issued on November 28, 2000, from an application filed December 22, 1997) constitutes prior art to those claims. We conclude, therefore, that Petitioner has not demonstrated that the

combination of Touboul I and Touboul II, or the combination of Touboul I and Dan, renders the challenged claims obvious.

CONCLUSION

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

ORDER

Accordingly, it is

ORDERED that Petitioner's request for an *inter partes* review of claims 15, 18–20, 22, 25–27, and 30 of the '926 patent is *denied*.

IPR2015-01895
Patent 7,613,926 B2

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