

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYMANTEC CORP.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2015-01897
Patent 8,677,494 B2

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

BOUDREAU, *Administrative Patent Judge*.

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

I. INTRODUCTION

Symantec Corp. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review pursuant to 35 U.S.C. § 311 of claims 1, 2, 5, 6, 10, 11, 14, and 15 of U.S. Patent No. 8,677,494 B2 to Ebery *et al.* (Ex. 1001, “the ’494 patent”). Pet. 1. Finjan, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We review the Petition under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

For the reasons that follow and on this record, we are not persuaded that Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of any of the challenged claims on the asserted grounds. Accordingly, we *deny* Petitioner’s request to institute an *inter partes* review.

A. The ’494 Patent

The ’494 patent, entitled “Malicious Mobile Code Runtime Monitoring System and Methods,” issued March 18, 2014, from U.S. Patent Application No. 13/290,708 (“the ’708 application”), filed November 7, 2011. Ex. 1001, [21], [22], [45], [54]. On its face, the ’494 patent purports to claim priority from nine earlier applications, including U.S. Patent Application No. 08,964,388 (“the ’388 application”), filed November 6, 1997, which issued July 18, 2000, as U.S. Patent No. 6,092,194 (Ex. 1007, “the ’194 patent” or “Touboul I”). Ex. 1001, [60], [63], col. 1, ll. 7–55. For reasons stated below, we determine on this record that the challenged claims are entitled at least to the benefit of the November 6, 1997 filing date of the ’388 application.

B. Related Proceedings

The '494 patent is the subject of a district court action between the parties, *Finjan, Inc. v. Symantec Corp.*, 3:14-cv-02998 (N.D. Cal.), and has also been asserted in three other district court actions, *Finjan, Inc. v. Sophos, Inc.*, 3:14-cv-01197 (N.D. Cal.), *Finjan, Inc. v. Palo Alto Networks, Inc.*, 3:14-cv-04908 (N.D. Cal.), and *Finjan, Inc. v. Blue Coat Systems, Inc.*, 5:15-cv-03295 (N.D. Cal.). Pet. 1; Paper 5, 1. Petitioner also has filed another petition seeking *inter partes* review of the '494 patent, a petition seeking *inter partes* review of related U.S. Patent No. 6,154,844 (hereinafter "Touboul II"), and two petitions seeking *inter partes* review of related U.S. Patent No. 7,613,926, in Cases IPR2015-01892, IPR2015-01894, IPR2015-01893, and IPR2015-01895, respectively. Pet. 1. Palo Alto Networks, Inc. also has filed a petition seeking *inter partes* review of the '494 patent (Case IPR2016-00159, Paper 2), and a petition filed by Sophos Inc. seeking *inter partes* review of the '494 patent was denied on September 24, 2015 (Case IPR2015-01022, Paper 7).

C. References Relied Upon

Petitioner relies on the following references:

Exhibit	Reference
1007	US 6,092,194, issued July 18, 2000 ("Touboul I")
1016	US 6,154,844, issued Nov. 28, 2000 ("Touboul II")

Pet. 23–24. Petitioner also relies on the Declaration of Jack W. Davidson (Ex. 1021).

D. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of the challenged claims on the following four grounds:

Reference	Basis	Claims Challenged
Touboul I	§ 102(b)	1, 5, 6, 10, 14, and 15
Touboul I	§ 103(a)	2 and 11
Touboul II	§ 102(b)	1, 5, 6, 10, 14, and 15
Touboul II	§ 103(a)	2 and 11

Pet. 24.

II. DISCUSSION

A. Claim Interpretation

In an *inter partes* review proceeding, claims of an unexpired patent are given their broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1275–79 (Fed. Cir. 2015), *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.

B. Priority Date

1. Background

As filed, the '708 application from which the '494 patent issued claimed priority from the following seven earlier-filed applications:

1) U.S. Patent Application No. 08/964,388 (“the '388 application”) to Shlomo Touboul, which, as indicated in Section I.A. above, was filed on November 6, 1997, and issued as Touboul I on July 18, 2000;

2) U.S. Patent Application No. 09/539,667 (“the '667 application”) to Mr. Touboul, filed March 30, 2000, as a continuation of the '388 application; the '667 application issued October 12, 2004, as U.S. Patent No. 6,804,780 B1 (Ex. 1006, “the '780 patent”);

3) U.S. Patent Application No. 09/551,302 (“the '302 application”) to Mr. Touboul, filed April 18, 2000; the '302 application issued November 12, 2002, as U.S. Patent No. 6,480,962 B1 (Ex. 1009, “the '962 patent”);

4) U.S. Provisional Patent Application No. 60/205,591 (Ex. 1005, “the '591 provisional”) to Nimrod Itzhak Vered, Yigal Mordechai Edery, and David R. Kroll, filed May 17, 2000;

5) U.S. Patent Application No. 09/861,229 (“the '229 application”) to Messrs. Edery, Vered, Kroll, and Touboul,¹ filed May 17, 2001, as a

¹ The '229 application, as filed, named only Messrs. Vered, Edery, and Kroll as inventors. However, a Request to Correct Inventorship, requesting to add Mr. Touboul as an inventor, 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

continuation-in-part of the '667 and '302 applications and claiming the benefit of the '591 provisional; the '229 application issued June 6, 2006, as U.S. Patent No. 7,058,822 B2 (Ex. 1004, "the '822 patent");

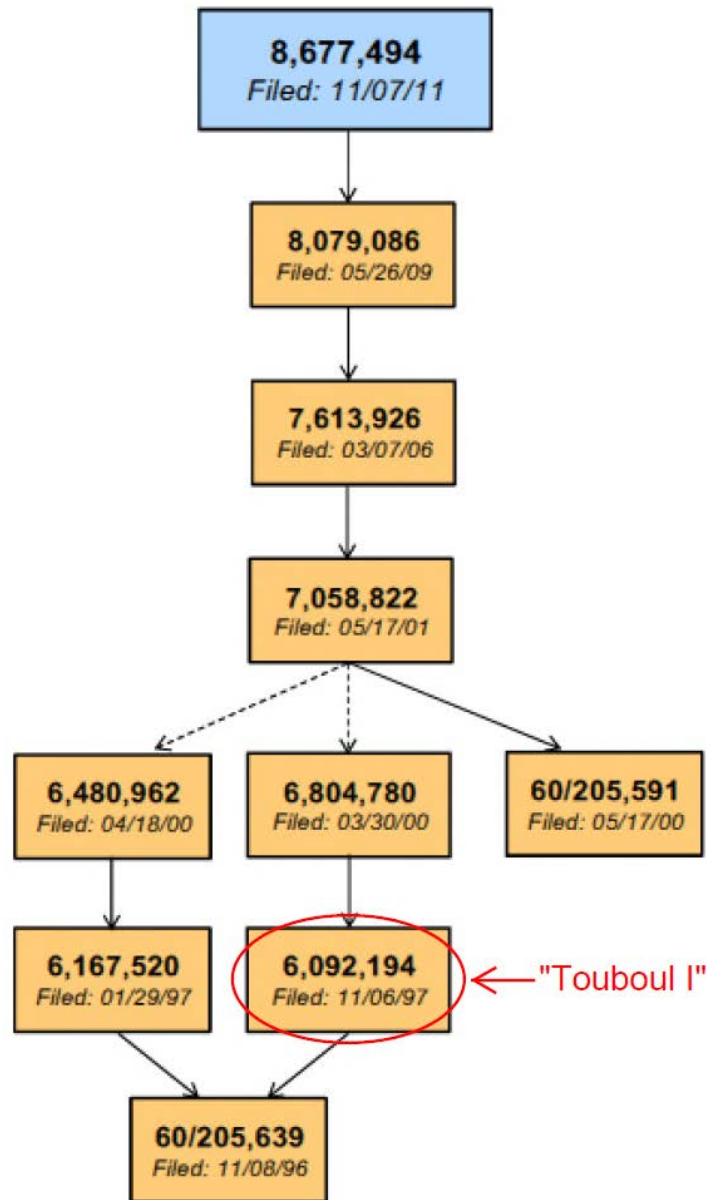
6) U.S. Patent Application No. 11/370,114 ("the '114 application") to Messrs. Edery, Vered, Kroll, and Touboul, filed March 7, 2006, as a continuation of the '229 application; the '114 application issued November 3, 2009, as U.S. Patent No. 7,613,926 B2 (Ex. 1003, "the '926 patent"); and

7) U.S. Patent Application No. 12/471,942 ("the '942 application") to Messrs. Edery, Vered, Kroll, and Touboul, filed May 26, 2009, as a continuation of the '114 application; the '942 application issued December 13, 2011, as U.S. Patent No. 8,079,086 B1 (Ex. 1002, "the '086 patent").
Ex. 3002, 1.

On December 6, 2013, during original prosecution of the '708 application, Applicants filed a petition to amend the application to include references to priority claims from two additional applications, namely, U.S. Patent Application No. 08/790,097 ("the '097 application") to Mr. Touboul, filed January 29, 1997, which issued as U.S. Patent No. 6,167,520 (Ex. 1010, "the '520 patent"), and of which the '302 application was a continuation; and U.S. Provisional Application No. 60/030,639 (Ex. 1008, "the '639 provisional") to Mr. Touboul, filed November 8, 1996, from which the '388 and '097 applications had both claimed priority. Ex. 3003. The Office granted the Applicants' petition on December 24, 2013. Ex. 3004.

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. 1004, [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.

To better understand Patent Owner's claims to priority for the '494 patent, Petitioner prepared a chart, which we have reproduced below with an annotation to identify the '194 patent as Touboul I:



Petitioner's chart provides "a graphical depiction of the claimed priority chain in the '494 patent (with dashed arrows indicating that the later application is a continuation-in-part of the earlier application)." Pet. 4.

As set forth in Section I.D. above, Petitioner contends that claims 1, 5, 6, 10, 14, and 15 of the '494 patent are anticipated—and claims 2 and 11 of the '494 patent are rendered obvious—by each of Touboul I and Touboul II. Pet. 24. Although neither Touboul I nor Touboul II issued until 2000, Petitioner contends that the priority claims in the '494 patent are “defective for a number of reasons and, therefore, the challenged claims are not entitled to earlier priority based on any of the Priority Applications.” Pet. 5. In particular, according to Petitioner,

It is well settled that, in order for a later-filed application to be entitled to the benefit of the filing dates of earlier-filed applications, **each application in the priority chain** must, *inter alia*: (i) satisfy the written description requirement of § 112 for the claims of the later-filed application; and (ii) include specific references to each of the earlier-filed applications in the chain.

Here, the priority chain of the '494 patent fails to meet either requirement. The Priority Applications lack the continuing disclosure throughout the chain that is necessary to support the challenged claims of the '494 patent. In particular, each of the '086, '926, and '822 patents lacks sufficient disclosure under § 112 for virtually all of the elements recited in the challenged claims. Thus, each of these patents constitutes a break in the priority chain and, therefore, the challenged claims are not entitled to earlier priority. Moreover, neither the '086 patent, nor the '926 patent, include a priority claim or any reference whatsoever to a number of earlier-filed applications (*i.e.*, the '194 patent, '520 patent and '639 provisional) that are included in the priority chain of the '494 patent. Thus, the '086 and '926 patents both fail to satisfy the specific-reference requirement under § 120 and, for this additional reason, these patents constitute a break in the priority chain.

Additionally, when it issued in 2006, the '822 patent also lacked any priority claim or any reference whatsoever to these earlier-filed applications (nor did it even share any inventors in common with the many of the earlier-filed applications). This remained the case until 2014 . . . when Patent Owner amended

the priority claims during an *ex parte* reexamination of the '822 patent.

Id. at 5–6 (internal citations omitted). Accordingly, Petitioner contends, “the earliest possible priority date of the challenged claims is the filing date of the '494 patent, *i.e.*, November 7, 2011,” and both Touboul I and Touboul II are “prior art to the '494 patent under pre-AIA 35 U.S.C. § 102(b).” *Id.* at 8, 23, 24.

Patent Owner counters, *inter alia*, that the '494 patent properly claims priority back to Touboul I, rendering both Touboul I and Touboul II “inoperative as prior art.” Prelim. Resp. 1. For the reasons that follow, we agree with Patent Owner.

2. *Continuity of Disclosure*

To claim priority from an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earliest 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 contends that the priority chain of the '494 patent does not satisfy the requirement set forth by the Federal Circuit and the Board that each application must include sufficient disclosure to satisfy the written

description requirements of 35 U.S.C. § 112 for the claims at issue to secure the benefit of the earliest claimed priority date. Pet. 8 (citing *Holmer v. Harari*, 681 F.3d 1351, 1355 (Fed. Cir. 2012); *Hyatt v. Boone*, 146 F.3d 1348, 1354–55 (Fed. Cir. 1998); *In re Hogan*, 559 F.2d at 609; *Polaris Wireless, Inc. v. TruePosition, Inc.*, Case IPR2013-00323, Paper 62, slip op. at 22 (PTAB Nov. 3, 2014); *Focal Therapeutics, Inc. v. Senorx, Inc.*, Case IPR2014-00116, Paper 8, slip op. at 12 (PTAB Apr. 22, 2014)). According to Petitioner, claim elements and features such as “deriving security profile data for [a] Downloadable,” Downloadable security profile (“DSP”) data “including a list of suspicious computer operations that may be attempted by the Downloadable,” and “storing the [DSP] data in a database,” as recited in challenged independent claims 1 and 10; “stor[ing] a date & time when the [DSP] data was derived [by said Downloadable scanner], in the database,” as recited in dependent claims 2 and 11; and “suspicious computer operations includ[ing] calls made to an operating system, a file system, a network system, and to memory,” as recited in dependent claims 6 and 15, “are described in some of the earliest-filed applications in the priority chain, namely: the ’780 patent, the ’194 patent, and the ’639 provisional.” Pet. 9. Petitioner asserts that, “[i]mportantly, however, none of this same disclosure corresponding to these claim elements is included in the specifications of the ’086, ’926, or ’822 patents. Nor are these claim elements described anywhere in the ’086, ’926, or ’822 patents.” *Id.* at 9–10 (citations omitted). Further, Petitioner asserts, “[a]lthough the ’822 patent is characterized as a ‘continuation-in-part’ of the ’780 patent, the ’822 patent specification is directed to completely new subject matter and is missing the vast majority of the disclosure in the ’780 patent.” *Id.* at 10.

Petitioner's assertions are not persuasive. As Patent Owner points out, the '822 patent incorporates by reference the '780 and '962 patents; the '926 patent incorporates by reference the '194, '780, '962, and '822 patents; the '086 patent incorporates by reference the '194, '780, '962, '822, and '926 patents; and the '494 patent incorporates by reference the '822, '926, and '086 patents. Prelim. Resp. 17. The '494 patent also incorporates by reference the '194, '780, and '962 patents. Ex. 1001, 1:31–32, 35–38, 47–48.

As Patent Owner correctly explains (Prelim. Resp. 17–18), material necessary to provide a written description of a claimed invention as required by 35 U.S.C. § 112 may be incorporated into a patent application by reference, provided that the incorporated reference is a U.S. patent or U.S. patent application publication that does not itself incorporate such “essential material” by reference, by “[e]xpress[ing] a clear intent to incorporate by reference by using the words ‘incorporat(e)’ and ‘reference’” and “[c]learly identify[ing] the referenced patent [or] application.” 37 C.F.R. § 1.57(c), (d). Moreover, the Federal Circuit has explained that “incorporated patents are ‘effectively part of the host [patents] as if [they] were explicitly contained therein.’” *X2Y Attenuators, LLC v. U.S. Int’l Trade Comm’n*, 757 F.3d 1358, 1362–63 (Fed. Cir. 2014) (alterations in original) (quoting *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1329 (Fed. Cir. 2001)). Contrary to Petitioner’s contentions (Pet. 11–15), the “boilerplate language” used in the '822, '926, '086, and '494 patents, broadly stating without further qualification that the earlier-filed patents are “incorporated by reference,” is sufficient in view of Federal Circuit

precedent to incorporate the disclosure of at least the '780 patent² into each later-filed patent. *See, e.g., Harari v. Lee*, 656 F.3d 1331, 1335 (Fed. Cir. 2011) (finding “entire . . . application disclosure was incorporated by the broad and unequivocal language: ‘The disclosures of the two applications are hereby incorporate[d] by reference’”). We agree with Patent Owner that the facts here are distinguishable from those in cases on which Petitioner relies. Prelim. Resp. 23–24. For example, in *Zenon*, as 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.*

On this record, and particularly in view of Petitioner’s statement that the specification of the '780 patent, among others, describes the “claim elements and features” not otherwise included in the specifications of the '822, '926, '086, and '494 patents (Pet. 10)—and, thus, does not itself incorporate such “essential material” by reference (*see* 37 C.F.R. §1.57(d))—we agree with Patent Owner’s conclusion that “each application in the priority chain contains written description support for the challenged claims, and continuity of disclosure exists up to and including the '494 [p]atent without interruption.” Prelim. Resp. 16.³

² We note that, although the '822 patent does not expressly incorporate by reference the '194 patent, the '667 application from which the '780 patent issued was a *continuation* of the '388 patent from which the '194 patent issued, and the '194 and '780 patents share essentially the same disclosure. *Compare* Ex. 1006 *with* Ex. 1007.

³ Petitioner also asserts that “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. 10. As explained in note 1 *supra*, however, the inventorship of the '229

3. *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.

Contrary to Petitioner's assertion that "neither the '086 patent, nor the '926 patent, include a priority claim or any reference whatsoever to a number of earlier-filed applications (*i.e.*, the '194 patent, '520 patent and '639 provisional) that are included in the priority chain of the '494 patent" (Pet. 6), the '086 and '926 patents both include priority claims to the '194 patent and incorporate the '194 patent by reference in its entirety. Ex. 1002, [63], 1:26–30; Ex. 1003, [63], 1:23–27. Moreover, as Patent Owner points out, the '520 patent and '639 provisional are not within the priority chain from the '494 patent to the '194 patent, and the failure of the '926 and '086 patents to include a priority claim or reference to the '520 patent and '639 provisional does not affect the '494 patent's entitlement to the benefit of the November 6, 1997 filing date of the '388 application that matured into the '194 patent (*i.e.*, Touboul I).

Petitioner also argues that the failure of the '926 and '086 patents to include a priority claim or any reference to the '520 patent and '639 provisional constitutes a break in the priority chain of the '494 patent. Pet. 17. For purposes of this Decision, however, we need not reach this issue.

application from which the '822 patent issued was corrected in 2005, prior to the issuance of the '822 patent. *See* Ex. 2005. Accordingly, Petitioner's assertion is both incorrect and unpersuasive.

4. *Delay in Correction of '822 Patent Priority Claim*

As filed, the '229 application that 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, but it did not claim priority from or include any reference to the '520 and '194 patents or the '097 and '388 applications from which those patents respectively issued. As Petitioner points out, however, Patent Owner, in the course of *ex parte* reexamination of the '822 patent in 2014, filed a Petition to Accept Unintentionally Delayed Priority Claim Under 37 C.F.R. 1.78, requesting amendment to include references to the '520 and '194 patents.

Reexamination Control No. 90/013,017, Petition dated March 6, 2014, at 1–3 (Ex. 1015, 7–9); *see also* Pet. 18. The Office granted Patent Owner's Petition on July 25, 2014. Reexamination Control No. 90/013,017, Decision dated July 25, 2014, at 1–3 (Ex. 1015, 1–3)).

Notwithstanding Patent Owner's representation that the delay in requesting correction of the priority claim was unintentional, Petitioner asserts that "the publically available information concerning the '822 patent, as well as other patents in the same family and other applications owned by Patent Owner, *cast[s] serious doubts* concerning the veracity of Patent Owner's representation that this delayed priority claim in the '822 patent was 'unintentional.'" Pet. 19 (emphasis added). In support of this assertion, Petitioner points to Patent Owner's amendment of the priority claim in the application that matured into the '494 patent; the assertions of priority claims going through the '822 patent in the applications for the '926, '086, and '494 patents; and amendments of priority claims in one other application

and one other patent, and *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 20–22.

Patent Owner responds, *inter alia*, that “Petitioner is essentially alleging inequitable conduct by questioning the veracity of Patent Owner’s Statement to the USPTO,” and “validity challenges based on inequitable conduct are improper in a petition for *Inter Partes* Review.” Prelim. Resp. 28. We agree. The Board is not a court of general jurisdiction, but an administrative tribunal whose jurisdiction is limited statutorily in the context of *inter partes* review proceedings to determinations of patentability pursuant to 35 U.S.C. §§ 102 and 103 based on prior art consisting of patents and printed publications. 35 U.S.C. § 311(b). 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. Moreover, Petitioner’s doubts and inferences regarding Patent Owner’s past actions and motives are insufficient bases for us to question Patent Owner’s candor in this proceeding. *See* 37 C.F.R. § 42.11.

C. Anticipation by and Obviousness over Touboul I and Touboul II

On this record and for the reasons stated in Section II.B. above, we are persuaded that claims 1, 2, 5, 6, 10, 11, 14, and 15 of the ’494 patent are entitled at least to the benefit of the November 6, 1997 filing date of the ’388 patent that matured into the ’194 patent, and, accordingly, that neither Touboul I (i.e., the ’194 patent) nor Touboul II, which 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 a reasonable likelihood that it would prevail at trial on any of the asserted grounds.

III. CONCLUSION

On this record, Petitioner has not shown that Touboul I and Touboul II are prior art to the challenged claims of the '494 patent. Accordingly, Petitioner has not demonstrated a reasonable likelihood of prevailing on its challenges to the patentability of those claims on the grounds asserted in the Petition.

IV. ORDER

Upon consideration of the record before us, it is, therefore,
ORDERED that the Petition is *denied*, and no *inter partes* review is instituted as to any claim of the '494 patent.

IPR2015-01897
Patent 8,677,494 B2

For PETITIONER:

Joseph J. Richetti
Daniel A. Crowe
BRYAN CAVE LLP
joe.richetti@bryancave.com
dacrowe@bryancave.com

For PATENT OWNER:

James Hannah
Jeffrey H. Price
KRAMER LEVIN NAFTALIS & FRANKEL LLP
jhannah@kramerlevin.com
jprice@kramerlevin.com

Michael Kim
FINJAN, INC.
mkim@finjan.com