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Paper 25
Entered: January 5, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYMANTEC CORPORATION,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case IPR2016-01433
Patent 7,757,298 B2

Before THOMAS L. GIANNETTI, HYUN J. JUNG, and GREGG I. ANDERSON, *Administrative Patent Judges.*

JUNG, *Administrative Patent Judge.*

DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Symantec Corporation ("Petitioner") filed a Petition (Paper 2, "Pet."), requesting institution of an *inter partes* review of claims 1–16 of U.S. Patent No. 7,757,298 B2 (Ex. 1001, "the '298 patent"). Intellectual Ventures I LLC ("Patent Owner") filed a Preliminary Response (Paper 5, "Prelim. Resp."). Upon considering the Petition and the Preliminary Response, we instituted *inter partes* review of claims 1–4, 6–14, and 16 of the '298 patent. Paper 6 ("Dec. on Inst.").

After institution, Patent Owner filed a Response (Paper 11, "PO Resp."), and Petitioner filed a Reply (Paper 16, "Pet. Reply")[1]. Petitioner proffered a Declaration of Jack W. Davidson, Ph.D. (Ex. 1011, "Davidson Declaration" or "Davidson Decl.") with its Petition, and Patent Owner proffered a Declaration of David M. Goldschlag, Ph.D. (Ex. 2006, "Goldschlag Declaration" or "Goldschlag Decl.") with its Response. Deposition transcripts for Dr. Goldschlag (Ex. 1035) and Dr. Davidson (Ex. 2010) were filed.

An oral hearing in this proceeding was held on October 12, 2017; a transcript of the hearing is included in the record (Paper 24, "Tr.").

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–4, 6–14, and 16 of the '298 patent are unpatentable.

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[1] We granted Petitioner's unopposed motion to excuse the late filing of its Reply to the Patent Owner Response. Paper 19.

A. Grounds of Unpatentability at Issue

We instituted *inter partes* review on the grounds that, under 35 U.S.C. § 103(a):

(1) claims 1, 3, 6–10, 12, 13, and 16 are unpatentable over De Souza[2] and Hoffman[3],

(2) claims 2 and 11 are unpatentable over De Souza, Hoffman, and Martins[4],

(3) claims 4 and 14 are unpatentable over De Souza, Hoffman, and Farber[5],

(4) claims 1–3, 6–11, 13, and 16 are unpatentable over Hyppönen[6] and Johnson[7],

(5) claims 4 and 14 are unpatentable over Hyppönen, Johnson, and Farber, and

(6) claim 12 is unpatentable over Hyppönen, Johnson, and Nachenberg[8]. Dec. on Inst. 10, 11–12, 13, 18–19, 20, 28.

B. Related Proceedings

The parties indicate that the '298 patent has been asserted in *Intellectual Ventures I LLC v. HCC Insurance Holdings, Inc.*, Case No. 6:15-cv-00660-JRG (E.D. Tex.); *Intellectual Venture I LLC v. PNC Financial Services Group, Inc.*, Case No. 2:13-cv-00740-AJS (W.D. Pa.);

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[2] U.S. Pat. No. 5,848,418, iss. Dec. 8, 1998 (Ex. 1002).
[3] U.S. Pat. No. 6,122,657, iss. Sept. 19, 2000 (Ex. 1005).
[4] U.S. Pat. No. 5,649,205, iss. July 15, 1997 (Ex. 1010).
[5] U.S. Pat. No. 5,978,791, iss. Nov. 2, 1999 (Ex. 1009).
[6] U.S. Pat. No. 6,577,920 B1, iss. June 10, 2003 (Ex. 1003).
[7] Alan Johnson, *Steganography for DOS Programmers*, Dr. Dobb's J., (1997) (Ex. 1006).
[8] U.S. Pat. No. 5,696,822, iss. Dec. 9, 1997 (Ex. 1008).

Intellectual Venture I LLC v. PNC Financial Services Group, Inc., Case No. 2:14-cv-00832-AJS (W.D. Pa.); and *Intellectual Venture I LLC v. Erie Indemnity Co.*, Case No. 1:14-cv-00220-MRH (W.D. Pa.). Pet. 1; Paper 4, 1; Paper 12, 1; Exs. 2011–2013.

The '298 patent was also the subject of cases CBM2014-00032 and IPR2014-01516. Pet. 2; Paper 4 at 2.

C. The '298 Patent (Ex. 1001)

The '298 patent relates to "methods and apparatus for identifying and characterizing errant electronic files stored on computer storage devices." Ex. 1001, 1:29–31. The '298 patent states that when "users upload files that are offensive, illegal, unauthorized, or otherwise undesirable," storage resources are wasted, and thus, it provides a method "for identifying and characterizing files electronically stored on a computer storage device." *Id.* at 1:43–46, 2:49–51. Figure 1 of the '298 patent is reproduced below:

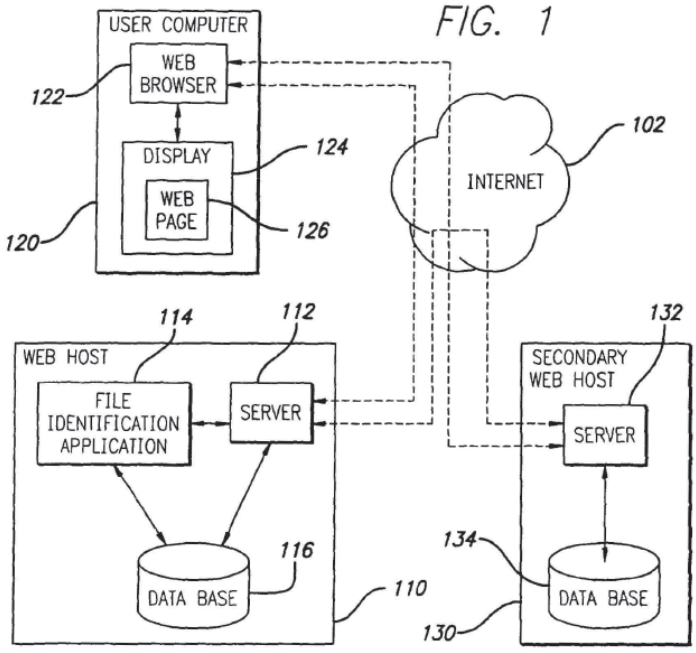

Figure 1 illustrates a wide area network in which a web host delivers web pages to users. *Id.* at 3:9–11, 36–38. User computer 120 communicates

with Web host 110 through Internet 102. *Id.* at 3:41–48. Web host 110 includes server 112 that can access data files stored in database 116, and the data files can be requested, retrieved, and viewed at user computer 120. *Id.* at 3:48–58. Web host 110 further includes file identification application 114 that analyzes data files stored on database 116 and tests various attributes of those files to determine whether they satisfy a particular profile in order to identify suspect files. *Id.* at 4:19–27, 4:48–54, Fig. 2A.

File identification application 114 can review the contents of a file to determine whether the file structure is as expected for a file of the type indicated, and if not, the file can be reported as a suspect file or marked for deletion. *Id.* at 7:4–14, Fig. 2B. File identification application 114 can also determine whether the file contains data extending past an end of data marker because any such additional data may constitute a portion of an illicit file. *Id.* at 7:26–31, Fig. 2B.

After the files within a directory have been reviewed and a list of suspect files generated, file identification application 114 compares a checksum generated from the suspect files to a library of checksum values corresponding to known illicit files. *Id.* at 7:40–45, Fig. 2C. The checksum is a unique number, generated by one of "numerous possible algorithms," based on a range of bytes in a file. *Id.* at 7:45–47, 9:10–12; Fig. 3.

D. Illustrative Claim

The '298 patent has 16 claims, and of the claims at issue, claims 1, 10, and 16 are independent. Claim 1 is reproduced below:

> 1. A computer-implemented method for identifying and characterizing stored electronic files, said method comprising:

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