

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZSCALER INC.,
Petitioner,

v.

SYMANTEC CORPORATION,
Patent Owner.

IPR2018-00916
Patent 7,360,249 B1

Before JEFFREY S. SMITH, BRYAN F. MOORE, and NEIL T. POWELL,
Administrative Patent Judges.

MOORE, *Administrative Patent Judge.*

TERMINATION
Dismissal After Institution of Trial
37 C.F.R. § 42.72

I. INTRODUCTION

Zscaler Inc. (“Petitioner”) requests *inter partes* review of claims 1, 2, 5–9, 12–17, 20, and 22 of U.S. Patent No. 7,360,249 B1 (“the ’249 patent,” Ex. 1001) pursuant to 35 U.S.C. §§ 311 *et seq.* Paper 1 (“Pet.”). Petitioner

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relies on the testimony of Dr. Erez Zadok. Ex. 1003. Symantec Corporation (“Patent Owner”) filed a Preliminary Response. Paper 10 (“Prelim. Resp.”). On November 15, 2018, the Board instituted trial on claims 1, 2, 5–9, 12–17, 20, and 22 of the ’249 patent based on all grounds of unpatentability alleged in the Petition. Paper 15. The Board has jurisdiction under 35 U.S.C. § 6(c).

After institution of trial, Patent Owner, filed a Patent Owner Response (“PO Resp.”). Paper 21. Petitioner filed a Reply. Paper 26. Patent Owner filed a Sur-reply. Paper 33. An oral hearing was held on August 8, 2019. A transcript of the oral hearing is included in the record as Paper 40. Paper 40 (“Tr.”).

For the reasons discussed below, we are unable to reach a determination on the alleged grounds of unpatentability over prior art. Accordingly, we terminate this proceeding under 37 C.F.R. § 42.72.

A. Related Matters

A decision in this proceeding could affect or be affected by the following case pending in the United States District Court for the Central District of California and involving the ’249 patent: *Symantec Corp. and Symantec Ltd. v. Zscaler, Inc.*, Case No. 17-cv-04414 (N.D. Cal.). Pet. 3; Paper 5, 2.

B. The ’249 patent

The ’249 patent is directed to “computer security, and in particular, to detecting and blocking malicious code propagation on computer systems.” Ex. 1001, 1:6–8. The ’249 patent provides that “[c]omputer systems face a threat of attack by malicious computer code, such as worms, viruses, and Trojan horses.” *Id.*, 1:12–13.

C. Illustrative Claim

Claims 1, 12, 16, and 20 are independent claims. Independent claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A computer implemented method for preventing malicious code from propagating in a computer, the method comprising the steps of:

a blocking-scanning manager detecting attempted malicious behavior of running code;

responsive to the detection, the blocking-scanning manager blocking the attempted malicious behavior;

the blocking-scanning manager generating a signature to identify the code that attempted the malicious behavior;

the blocking-scanning manager detecting code identified by the signature, wherein detecting code identified by the signature comprises;

the blocking-scanning manager alerting a user of the detection; and the blocking-scanning manager allowing the user to choose whether or not to block the execution of the identified code;

the blocking-scanning manager overriding the user's choice responsive to the user incorrectly choosing to block non-malicious behavior or incorrectly choosing not to block malicious behavior; and

the blocking-scanning manager blocking the execution of the identified code.

Ex. 1001, 11:5–27.

D. References

Petitioner relies on the following references. Pet. 14–27.

Name	Reference	Exhibit
AppletTrap	TREND MICRO INTERSCAN APPLETTRAP GETTING STARTED GUIDE, archived at Wayback machine on May 4, 2003	1005
Wells	U.S. Patent No. 6,338,141 B1, filed Sept. 30, 1998, issued Jan. 8, 2002	1007

E. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1, 2, 5–9, 12–17, 20, and 22 are unpatentable based on the following grounds:

Claims Challenged	35 U.S.C. §	Reference(s)
1, 2, 5–9, 12, 16, 17, 20, 22	103	AppletTrap
13–15	103	AppletTrap and Wells

Pet. 4.

II. DISCUSSION

A. Relevant Law

1. Obviousness

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (“*KSR*”). 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) where in evidence, so-called secondary considerations, including commercial success, long-felt but unsolved needs, failure of others, and unexpected results.¹ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966) (“the *Graham* factors”).

2. *Level of Skill*

For an obviousness analysis, prior art references must be “considered together with the knowledge of one of ordinary skill in the pertinent art.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (quoting *In re Samour*, 571 F.2d 559, 562 (CCPA 1978)). Moreover, “it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” *In re Preda*, 401 F.2d 825, 826 (CCPA 1968). That is because an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418; *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1259 (Fed. Cir. 2007) (“*Translogic*”).

Petitioner asserts a person of ordinary skill in the art of the subject matter of the ’249 patent would have had a “Bachelor of Science degree in computer science, computer engineering, or a similar degree, along with at least 2-3 years of experience in software development, preferably related to cyber-security or information assurance [and a] higher level of education may substitute for a lesser amount of experience, and vice versa.” Pet. 14

¹ Patent Owner does not put forth evidence it alleges tends to show secondary considerations of non-obviousness in its Patent Owner Response.

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