

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZSCALER INC.,
Petitioner,

v.

SYMANTEC CORPORATION,
Patent Owner.

Case 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.*

DECISION
Instituting *Inter Partes* Review
35 U.S.C. § 314

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 relies on the testimony of Dr. Erez Zadok. Ex. 1003. Symantec Corporation (“Patent Owner”) filed a preliminary response. Paper 10 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that 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); *see* 37 C.F.R. § 42.108. Upon consideration of the Petition and Preliminary Response, we conclude the information presented shows there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1–2, 5–9, 12–17, 20 and 22 of the ’249 patent.

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, 3.

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

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. Asserted Grounds of Unpatentability

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

Reference(s)	Basis	Claims challenged
AppletTrap ¹	§ 103	1–2, 5–9, 12, 16–17, 20, and 22
AppletTrap and Wells ²	§ 103	13–15

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). 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,

¹ TREND MICRO INTERSCAN APPLETRAP GETTING STARTED GUIDE, archived at Wayback machine on May 4, 2003 (“AppletTrap,” Ex. 1005).

² US Patent Application Pub. No. 6,338,141, filed Sep. 30, 1998, published Jan. 8, 2002. (“Wells,” Ex. 1007).

failure of others, and unexpected results.³ *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 Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (Fed. Cir. 2007); *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1259 (Fed. Cir. 2007).

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 (citing Ex. 1003, ¶¶ 34–37). Patent Owner’s proposed level of skill does not differ, in any way relevant to determinations made in this decision, from Petitioner’s statement nor does Patent Owner argue that there is any

³ Patent Owner does not put forth evidence it alleges tends to show secondary considerations of non-obviousness in its Preliminary Response.

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