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Finjan Your Claims into Patent Eligibility

Finjan v. Blue Coat Systems, Inc.
(case no. 2016-2520; January 2018)

Presented by Jens Jenkins, 09 March 2018

Background

- Finjan is a cybersecurity company that provides various security services, including mobile VPN and virus screening services. Finjan owns several patents related to cybersecurity.

- Blue Coat is a software company that is owned by Symantec. Blue Coat has various web security products, including WebPulse and ProxySG that performing virus and malware screening.

- On August 28, 2013, Finjan brought suit against Blue Coat in the Northern District of California for infringement of U.S. Patent 6,154,844 (the '844 patent), entitled *System and Method for Attaching a Downloadable Security Profile to a Downloadable),* as well as other Finjan patents.

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Background

- The district court found that the Blue Coat products did infringe the ‘844 patent and three other Finjan patents. The total reasonable royalty damages award was about $40 million, of which $24 million was attributed to infringement of the ‘844 patent.

- Blue Coat appealed the district court's rulings on subject matter eligibility of the '844 patent. Blue Coat also appealed the findings of infringement of the ‘844 patent and two other patents, as well as the awarded damages.

Finjan Patent Claim: US 6,154,844

A method comprising:

receiving by an inspector a Downloadable;

generating by the inspector a first Downloadable security profile that identifies suspicious code in the received Downloadable; and

linking by the inspector the first Downloadable security profile to the Downloadable before a web server makes the Downloadable available to web clients.

Additional Background / Context

- Finjan was Decided by CAFC on January 10, 2018.
  Circuit Judges: Dyk, Linn and Hughes.

- Prior to Finjan, virus screening claims were found to be patent ineligible for being directed to a well-known and abstract idea. (e.g., Intellectual Ventures I LLC v. Symantec Corp., 838 F. 3d 1307, Court of Appeals, Federal Circuit 2016
  - We agree with the district court that receiving e-mail (and other data file) identifiers, characterizing e-mail based on the identifiers, and communicating the characterization - in other words, filtering files/e-mail - is an abstract idea.

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IV Patent Claim: US 6,460,050

A method for identifying characteristics of data files, comprising:

receiving, on a processing system, file content identifiers for data files from a plurality of file content identifier generator agents, each agent provided on a source system and creating file content IDs using a mathematical algorithm, via a network;

determining, on the processing system, whether each received content identifier matches a characteristic of other identifiers; and

outputting, to at least one of the source systems responsive to a request from said source system, an indication of the characteristic of the data file based on said step of determining.

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Juxtapose

Finjan Claim (Patent Eligible)

A method comprising:

receiving by an inspector a Downloadable;

generating by the inspector a first Downloadable security profile that identifies suspicious code in the received Downloadable; and

linking by the inspector the first Downloadable security profile to the Downloadable before a web server makes the Downloadable available to web clients.

IV Claim (Patent Ineligible)

A method for identifying characteristics of data files, comprising:

receiving, on a processing system, file content identifiers for data files from a plurality of file content identifier generator agents, each agent provided on a source system and creating file content IDs using a mathematical algorithm, via a network;

determining, on the processing system, whether each received content identifier matches a characteristic of other identifiers; and

outputting, to at least one of the source systems responsive to a request from said source system, an indication of the characteristic of the data file based on said step of determining.

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Analysis:
Improvements To A Computer are Patent-Eligible

- We determined in Intellectual Ventures I LLC v. Symantec Corp., 838 F.3d 1307, 1319 (Fed. Cir. 2016), that "[b]y itself, virus screening is well-known and constitutes an abstract idea." We also found that performing the virus scan on an intermediary computer—so as to ensure that files are scanned before they can reach a user's computer—is a "perfectly conventional" approach and is also abstract. Id. at 1321. Here the claimed method does a good deal more.

- Our cases confirm that software-based innovations can make "*non-abstract improvements* to computer technology" and be deemed patent-eligible subject matter at step 1. Enfish, 822 F.3d at 1335–36.

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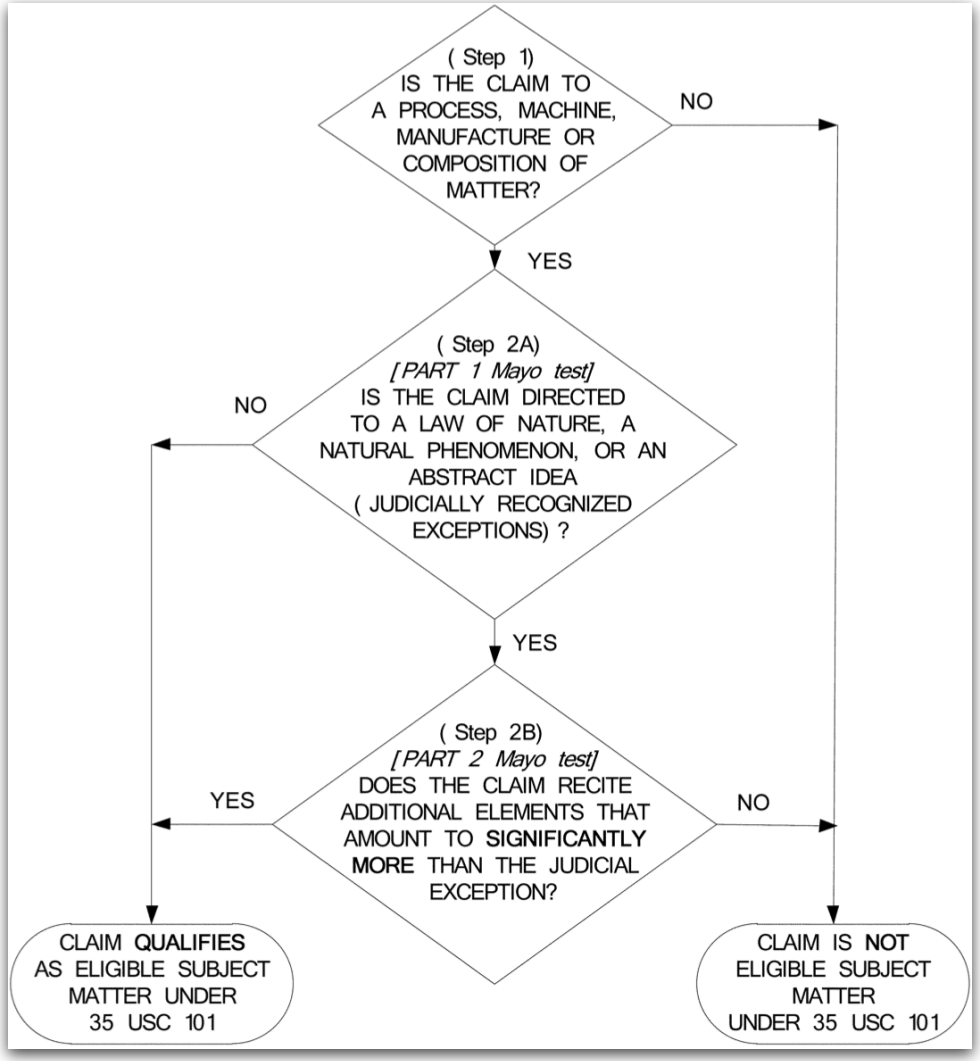
Alice/Mayo Analysis: Quick Review



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How do you define Improvement? (Is it just something New/Different? *POSSIBLY)*

- The question, then, is whether this behavior-based virus scan in the '844 patent constitutes an improvement in computer functionality. We think it does.
- Claim 1 of the '844 patent scans a downloadable and attaches the virus scan results to the downloadable in the form of a newly generated file: a "security profile that identifies suspicious code in the received Downloadable." The district court's claim construction decision emphasizes that this "identif[y] suspicious code" limitation can only be satisfied if the security profile includes "details about the suspicious code in the received downloadable, such as . 'all potentially hostile or suspicious code operations that may be attempted by the Downloadable.'" … The security profile must include the information about potentially hostile operations produced by a "behavior-based" virus scan. This ***operation is distinguished from traditional, "code-matching" virus scans*** that are limited to recognizing the presence of previously-identified viruses, typically by comparing the code in a downloadable to a database of known suspicious code.
- The "behavior-based" approach to virus scanning was pioneered by Finjan and is disclosed in the '844 patent's specification. ***In contrast to traditional "code-matching" systems***, which simply look for the presence of known viruses, "behavior-based" scans can analyze a downloadable's code and determine whether it performs potentially dangerous or unwanted operations.
- Similarly, the method of *claim 1 employs a **new** kind of file that **enables a computer security system to do things it could not do before.*** The security profile approach allows access to be tailored for different users and ensures that threats are identified before a file reaches a user's computer. The fact that the security profile "identifies suspicious code" allows the system to accumulate and utilize newly available, behavior-based information about potential threats. ***The asserted claims are therefore directed to a non-abstract improvement in computer functionality, rather than the abstract idea of computer security writ large.***

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Characterization of Improvements Can Help

- "The security profile approach also ***enables more flexible and nuanced virus filtering***."

Say all the WORDS

- **Improve/Improving**
- **Reduce/Reducing**
- **Enable/Enabling**
- **Facilitate/Facilitating**

…

USPTO Eligibility Reference Guide

https://www.uspto.gov/sites/default/files/documents/ieg-qrs.pdf (page 3/3)

February 2018: Eligibility Quick Reference Sheet
Decisions Holding Claims Eligible

Claims eligible in Step 2A

Claim is not directed to an abstract idea

See MPEP 2106.04(a), 2106.04(a)(1) and 2106.06(b)

- *Core Wireless*
  (GUI for mobile devices that displays commonly accessed data on main menu)
- *DDR Holdings*
  (matching website "look and feel")
  see Example 2
- *Enfish*
  (self-referential data table)
- *Finjan v. Blue Coat Sys.*
  (virus scan that generates a security profile identifying both hostile and potentially hostile operations)
- *McRO*
  (rules for lip sync and facial expression animation)
- *Thales Visionix*
  (using sensors to more efficiently track an object on a moving platform)
- *Trading Tech. v. CQG* †
  (GUI that prevents order entry at a changed price)
- *Visual Memory*
  (enhanced computer memory system)

Look

Claim is not directed to a law of nature or natural phenomenon

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See MPEP 2106.04(b)

- *Eibel Process*
  (gravity-fed paper machine)
  see Example 32
- *Rapid Lit. Mgmt. v. CellzDirect*
  (cryopreserving liver cells)
- *Tilghman*
  (method of hydrolyzing fat)
  see Example 33

Claim is not directed to a product of nature (because the claimed nature-based product has markedly different characteristics)

See MPEP 2106.04(c)

- *Chakrabarty*
  (genetically modified bacterium)
  see Example 13 (NBP-5)
- *Myriad*
  (cDNA with modified nucleotide sequence)
  see Example 15 (NBP-7)

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Takeaways

- Frame it

- State / Characterize the improvement(s) with 'all the words' to identify <u>how specific limitations improve functioning</u> of computer system
- Be proactive (initiate discussions with Examiner)

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Discussion?