



PTAB Denies Institution of IPR Review of Computer Security Patents

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Symantec argued that the two patents at issue did not properly establish priority with the earlier Finjan patents since the shared specification of the '926 and '494 differs from that of their parent applications, and the claims at issue relate to the disclosures of the earlier Finjan patents. Symantec acknowledged that the specification of both patents at issue stated that they incorporated by reference the entirety of the parent specifications, but argued that such “boilerplate” statements were not proper incorporation by reference. In addition to the priority issues, Symantec raised arguments that the patents did not have proper unity of inventorship and/or unreasonable delays in recording the assignment of the patents to Finjan.

PTAB denied institution of all of Symantec’s IPRs. Citing Federal Circuit precedent, PTAB ruled that the statements of incorporation by reference in the '926 and '494 Patents was proper to establish continuity of disclosure between the parent application and the specification of the patents at issue. Finding that the disclosure of the prior Finjan patents described the claimed inventions, PTAB ruled that the prior Finjan patents asserted by Symantec were not prior art and that Symantec, therefore, had not demonstrated a reasonable likelihood of success on its challenges. PTAB also ruled that Symantec’s arguments regarding inventorship and assignment were beyond the scope of IPR review.

Symantec Corp. v. Finjan, Inc., IPR2015-01895, IPR2015-01897 (PTAB Feb. 26, 2016).

Categories

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