



PTAB Relies on Priority Analysis in a Related Proceeding in Denying IPR

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ESET argued that the claims of the '086 Patent are obvious in view of several combinations of prior art references, primarily relying on a reference titled *Proof-Carrying Code* ("Necula"). In the 01444 proceeding, Finjan argued that FireEye had failed to establish that Necula antedated the priority date of the '086 Patent. ESET argued that the '086 Patent was not entitled to a priority date antedating Necula because none of the patents or patent applications from which the '086 Patent claimed benefit disclosed the specific limitations claimed by the '086 Patent. The PTAB stated that it had analyzed the claims of the '926 Patent in the 00145 proceeding and sided with the patent owner, finding that the disclosure provided sufficient written-description support. The PTAB noted that the claims of the '086 Patent at issue contained limitations that were nearly identical to those of the '926 Patent. For example, Claim 1 of the '926 Patent recites "appending a representation of the retrieved Downloadable security profile data to the incoming Downloadable, to generate and appended Downloadable," and Claim 1 of the '086 Patent recites the same limitation without the words "retrieved" and "incoming".

Given that the claim language of the '926 Patent was nearly identical to that of the '086 Patent, the PTAB held that the '086 Patent shares essentially the same disclosure as the '926 Patent. The PTAB also noted that the '086 Patent incorporates the '926 Patent by reference. The PTAB therefore denied ESET's petition and joinder motion.

ESET, LLC v. Finjan, Inc., IPR2017-01969, Paper No. 8 (PTAB January 9, 2018).

Categories

Patent Trial & Appeal Board

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