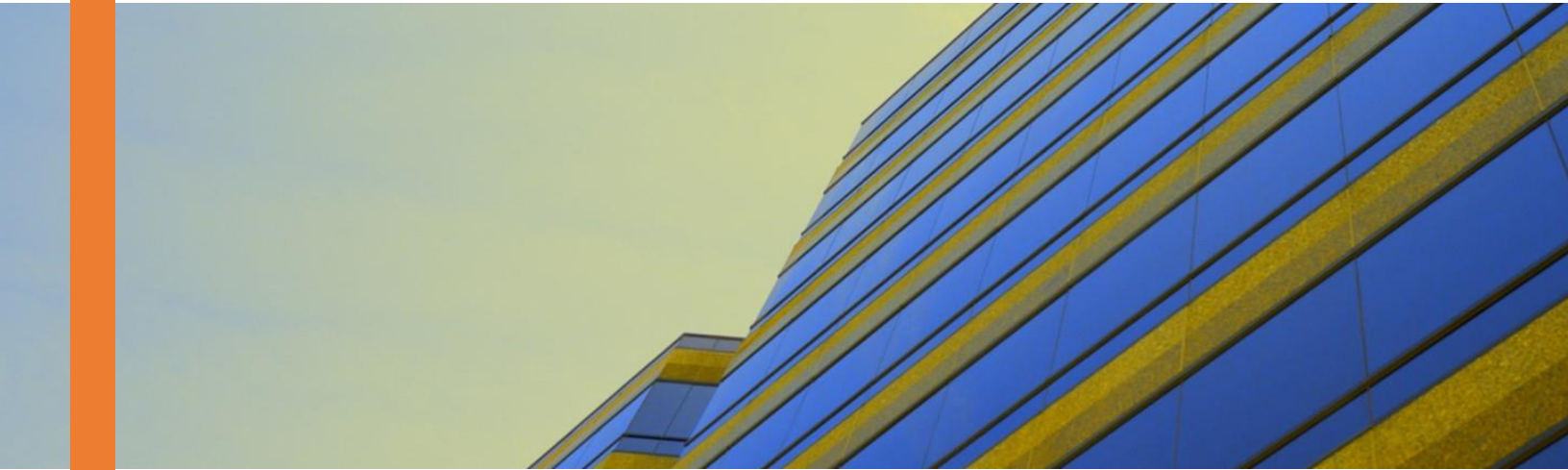




FINJAN, INC. V. BLUE COAT SYSTEMS, INC.



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Finjan, Inc. v. Blue Coat Systems, Inc.

In *Finjan, Inc. v. Blue Coat Systems, Inc.*, 2016-2520 (Fed. Cir. Jan. 10, 2018), the Federal Circuit found that claims of U.S. Patent No. 6,154,844 ('844 patent) were directed to patent eligible subject matter under 35 U.S.C. § 101 ("101"). This opinion provides insight on how the first step of *Alice*'s two-step test is applied and provides an example of claims that are not "directed to" an abstract idea under Step 1 of the *Alice* test.

A jury found Blue Coat infringed the '844 patent owned by Finjan and the District Court held, as a matter of law, that the '844 patent was patent eligible under 101. Blue Coat appealed the subject-matter eligibility decision under 101 to the Federal Circuit.

The '844 patent recites a system and method for providing computer security by attaching a security profile to a downloadable (i.e., an executable application program). Representative claim 1 of the '844 patent reads:

1. 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.

The Federal Circuit applied *Alice*'s two-step test and reiterated that under Step 1, the court determines whether the claims at issue are "directed to" a patent-ineligible concept, such as an abstract idea. If they are, the court proceeds to Step 2 and determines whether the additional elements of the claims transform the nature of the claim into a patent-eligible application.

Starting at Step 1, the Federal Circuit first examined the '844 patent's "claimed advance" to determine whether the claims are directed to an abstract idea or whether the claims focus on a specific asserted improvement in computer capabilities. During claim construction, the "identif[y] suspicious code" feature was construed to be only 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.'" Importantly, the Federal Circuit further stated that "[t]he security profile must include the information about potentially hostile operations produced by a 'behavior-based' virus scan," as opposed to "code-matching" virus scans. The question under Step 1 then became whether this behavior-based virus scan in the '844 patent constitutes an improvement in computer functionality.

The Federal Circuit determined the behavior-based virus scan was in fact an improvement to computer functionality. Behavior-based scans are not limited to recognizing the presence of previously-identified viruses like code-matching scans. Accordingly, the behavior-based scans can be used to protect against previously unknown viruses as well as "obfuscated code" known virus that attempt to avoid detection by code-matching scans. Moreover, the Federal Circuit found that claim 1 "employs a new kind of file that enables a computer security system to do things it could not do before." For example, the security profile approach allows administrators to tailor access for different users and ensures potential threats do not reach a user's computer.

The Federal Circuit distinguished this case from *Intellectual Ventures v. Symantec Corp.*, which held virus screening by itself constitutes an abstract idea, because the claimed method in the '844 patent "does a good deal more" than conventional approaches to virus screening. The Federal Circuit also distinguished the '844 patent from other cases that have held a result, even an innovative result, is not itself patentable because the

'844 claims recite more than just the desired result. Instead, the claims recite specific steps to accomplish the desired results, such as generating a security profile that identifies suspicious code and linking it to a downloadable.

Accordingly, the Federal Circuit found the claims of the '844 patent not to be abstract and affirmed the District Court. Because the claims were not abstract, the Federal Circuit found no need to proceed to Step 2 of *Alice*.

This opinion illustrates the importance to subject matter eligibility under 101 of tying the claims to the asserted technical advance. In this case, the advance was a new type of file that enabled new capabilities in a computer that could not be performed before. This opinion also shows that claims should be drafted to do more than simply recite the desired result of the invention, but actually recite specific steps to accomplish that result. This opinion further illustrates the importance of claim construction because even though the claims did not recite "behavior-based" virus scanning, this feature was read into the claims and became an important factor in determining whether the claims constituted an improvement to computers. Rather than relying on a court's hopefully beneficial claim construction, patent applicants should carefully draft claims to capture necessary features to illustrate the technical improvement or advance.