

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORESCOUT TECHNOLOGIES, INC.,
Petitioner,

v.

FORTINET, INC.,
Patent Owner.

IPR2021-01328
Patent 9,503,421 B2

Before MICHAEL R. ZECHER, THOMAS L. GIANNETTI, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

OGDEN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioner Forescout Technologies, Inc. (“Forescout”)¹ filed a Petition (Paper 1, “Pet.”) under 35 U.S.C. §§ 311–319 requesting *inter partes* review of claims 1, 4–10, 15, and 18–24 of U.S. Patent No. 9,503,421 B2 (Ex. 1001, “the ’421 patent”). Patent Owner Fortinet, Inc. (“Fortinet”)² filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

Under the authority delegated to us by the Director under 37 C.F.R. § 42.4(a), we may only institute an *inter partes* review 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 also* 37 C.F.R. § 42.108(c) (2020). Applying that standard, we do not institute an *inter partes* review, for the reasons explained below.

II. BACKGROUND

A. THE ’421 PATENT (EX. 1001)

The ’421 patent relates to systems and methods operable in a security information and management (SIEM) system. Ex. 1001, 1:18–19. It describes a system and method “for conducting work flows by an SIEM device to carry out a complex task automatically.” Ex. 1001, code (57). In at least one embodiment, a “work flow” defines a “task that contains a group of tasks that may be sequentially or concurrently conducted by one or more

¹ Forescout identifies itself as the only real party in interest. Pet. 63.

² Fortinet identifies itself as the only real party in interest. Paper 5, 2.

security devices so that a complex function may be accomplished automatically by [a] SIEM device.” *Id.* at 8:19–23.

According to the ’421 patent, in existing SIEM systems, “tasks that can be conducted by security devices of the network are independent and results of such tasks cannot be transferred to another task.” Ex. 1001, 1:37–39. Also, “tasks conducted by different security devices may require different parameters,” and “[e]ven the same task may require different parameters when it is conducted by security devices from different manufacturers.” *Id.* at 1:39–43. Thus, the inventors suggested “a need for improved SIEM devices that may schedule multiple tasks of various security devices to automatically achieve comprehensive management.” *Id.* at 1:43–46.

Forescout asserts that the effective filing date of the ’421 patent is March 17, 2014 because that is the filing date of its parent application, and the ’421 patent “does not claim the benefit of any earlier filing date.” Pet. 4 (citing Ex. 1001, cover). Fortinet does not dispute this, and we agree. Prelim. Resp. 10.

B. CHALLENGED CLAIMS AND ASSERTED GROUNDS OF
UNPATENTABILITY

Claim 1, representative of the challenged claims, is as follows:

1. A method comprising:

creating, by a security information and event management (SIEM) device associated with a private network, a work flow, said work flow including information defining a plurality of security tasks that are to be performed by one or more security devices associated with the private network and managed by the SIEM device, wherein the plurality of security tasks include operations that are intended to protect the private network against attacks;

starting, by the SIEM device, the work flow by scheduling the one or more security devices to perform the plurality of security tasks defined in the work flow; and

collecting, by the SIEM device, results of the plurality of security tasks after they are performed by the one or more security devices.

Ex. 1001, 18:18–33. Claim 15, the only other independent claim, is directed to “[a] security information and event management (SIEM) system comprising” components to perform a method similar to the method of claim 1. *See id.* at 19:21–40.

Forescout argues two grounds for *inter partes* review, as summarized in the following table:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1, 4–10, 15, 18–24	103 ³	Thomas ⁴
4–8, 18–22	103	Thomas, Gill ⁵

Pet. 7–8.

C. DECLARATORY TESTIMONY

For its Petition, Forescout relies on the declaration of Eric Cole, Ph.D. Ex. 1002. Patent Owner Fortinet does not challenge Dr. Cole’s qualifications to provide expert testimony on the subject matter of his declaration, and does not submit rebuttal testimony at this stage.

III. GROUNDS OF THE PETITION

For the reasons below, we determine that Forescout has not shown that there is a reasonable likelihood that it would prevail in showing that at least one of the challenged claims of the ’421 patent is unpatentable.

A. OVERVIEW OF THOMAS

Thomas describes “a cyber-security system that is configured to aggregate and unify data from multiple components and platforms on a network,” where “security administrators can . . . design and implement a

³ 35 U.S.C. § 103 (2018).

⁴ Thomas et al., US 10,129,290 B2 (issued Nov. 13, 2018) (Ex. 1004, “Thomas”). Forescout argues that Thomas is prior art under 35 U.S.C. § 102(a)(2). Pet. 8.

⁵ Gill et al., US 2012/0224057 A1 (published Sept. 6, 2012) (Ex. 1006, “Gill”). Forescout argues that Gill is prior art under 35 U.S.C. § 102(a)(1) and (2). Pet. 8.

workflow of device-actions taken by security individuals in response to a security incident.” Ex. 1004, code (57). Figure 15A of Thomas is reproduced below:

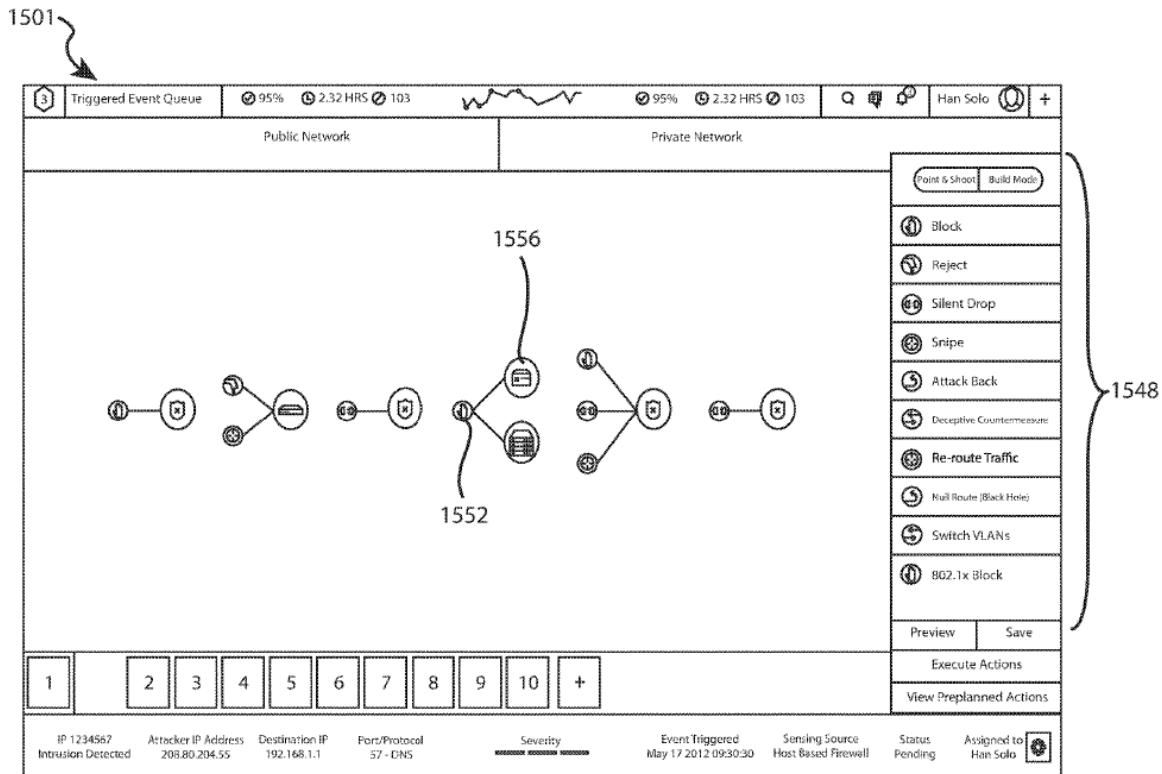


FIG. 15A

Figure 15A, reproduced above, depicts a screen shot of an interactive network map that security personnel may use in responding to an ongoing security threat. Ex. 1004, 27:23–28. The screen shot includes “sequencing diagram 1501 that shows several actions 1552 being associated with certain network elements 1556.” *Id.* at 27:34–36. The system runs actions (e.g., 1552) in sequence from left to right, and may run some of the actions (e.g., those stacked vertically) in parallel as a group. *See id.* at 27:36–42.

Thomas issued from an application filed on April 1, 2016, which is after the effective filing date of the ’421 patent. Ex. 1004, codes (21), (22); *see supra* part II.B. However, Thomas claims priority, among other

applications, to U.S. Provisional App. No. 61/944,019, filed on February 24, 2014 (Ex. 1005, “the Thomas Provisional”). Ex. 1004, code (60).

B. WHETHER THOMAS IS PRIOR ART TO THE CHALLENGED CLAIMS

Both of the Petition grounds rely primarily on Thomas as alleged prior art. *See* Pet. 7–8, 14–62. Forescout alleges that “Thomas is prior art under post-AIA^[6] 35 U.S.C. § 102(a)(2) because its effective filing date is at least as early as February 24, 2014, the filing date of [the Thomas Provisional], which precedes the effective filing date of the ’421 patent.” Pet. 8 (citing Ex. 1004, code (60)). Forescout also contends that Thomas “contains a priority claim to the Thomas Provisional, was filed within the applicable filing period, and has a common inventor (Messrs. Thomas and Scott).” Pet. 14 (citing Manual of Patent Examining Procedure (“MPEP”) § 2154.01(b) (9th ed. June 2020)).

Forescout argues that, under the post-AIA version of § 102, “no need exists to evaluate whether Thomas is [actually] entitled to . . . priority to the Thomas Provisional.” Pet. 15. Nevertheless, Forescout proceeds to show why it believes that the Thomas Provisional provides written description support for at least one claim of Thomas. *See* Pet. 14–21. For its two obviousness grounds, Forescout compares the challenged claims to Thomas (and Gill, for the second ground) but not to the Thomas Provisional. *See* Pet. 9–62.

⁶ Leahy–Smith America Invents Act, Pub. L. No. 112-29 § 102, sec. (n)(1), 125 Stat. 284, 287, 293 (2011) (codified as 35 U.S.C. § 102) (effective Mar. 16, 2013) (“AIA”).

In response, Fortinet argues that, apart from the issue of whether Thomas is actually entitled to priority to the Thomas Provisional, Forescout has the separate burden to “show that the provisional application provides sufficient support for the subject matter relied upon for prior art purposes in the reference patent.” Prelim. Resp. 16 (citing *In re Giacomini*, 612 F.3d 1380, 1383 (Fed. Cir. 2010); *Cox Communications, Inc. v. AT&T Intellectual Property I, L.P.*, IPR2015-01227, Paper 70 at 29 (PTAB Nov. 15, 2016); *Ex parte Mann*, 2016 WL 7487271, at *5 (PTAB Dec. 21, 2016); *Comcast Cable Commc’ns, LLC v. Promptu Sys. Corp.*, IPR2018-00345, Paper 10 at 25–26 (PTAB July 2, 2018); MPEP § 2151 (9th ed. June 2020)). According to Fortinet, Forescout “fails to address (or even acknowledge)” the requirement of showing “whether the Thomas Provisional provides sufficient support for the subject matter relied upon for prior art purposes in Thomas.” *Id.* at 18.

Fortinet also points out that the Petition relies on certain disclosures of Thomas that are not present in the Thomas Provisional, such as Thomas’s Figures 10 and 15A,⁷ and “disclosures in columns 20–22 and 27 of Thomas.” Prelim. Resp. 18–21. According to Fortinet, “Petitioner’s approach essentially requires Patent Owner (and the Board) to guess as to what Petitioner might have argued had it attempted to explain how the Thomas Provisional provides support for the alleged subject matter of Thomas relied upon in the Petition.” *Id.* at 21.

⁷ Figure 15A appears to be generally similar to Figure 7B of the Thomas Provisional. *See* Pet. 20–21 (citing Figure 7B of the Thomas Provisional in comparison to claim 11 of Thomas, but not directly comparing Figure 7b to either Figure 15A or to the challenged claims of the ’421 patent).

We agree with Fortinet that Forescout has not met its burden to particularly articulate its arguments in the Petition. To be successful in an *inter partes* review, a petition must “articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016) (citing *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007)); *see also* 35 U.S.C. § 322(a)(3); 37 C.F.R. §§ 42.22(a)(2) (2020). In this case, Forescout’s burden includes, among other things, explaining in the Petition why Thomas “was effectively filed before the effective filing date of the claimed invention.” 35 U.S.C. § 102(a)(2). On its face, Thomas does not qualify as prior art to the ’421 patent because the application was filed on April 1, 2016, after the effective filing date of the ’421 patent. Thus, when Forescout filed its Petition, it was clear that Forescout needed to rely on a prior application in Thomas’s priority chain, such as the Thomas Provisional, to establish that Thomas was prior art to the ’421 patent under § 102(a)(2).

Section 102(d)(2) of 35 U.S.C. provides that,

“[f]or purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to *any subject matter described in the patent or application . . . as of the filing date of the earliest such application that describes the subject matter.*”

35 U.S.C. § 102(d)(2) (emphases added). Without having the benefit of the provisional’s filing date, Thomas does not qualify as prior art to the ’421 patent. *See supra*. Thus, the subject matter disclosed in Thomas is only available as prior art to the ’421 patent to the extent it also is described in the earlier-filed Thomas Provisional. Thus, Forescout has an initial burden, not just to compare the challenged claims with the disclosure in Thomas, but to

show that the subject matter that Forescout relies on in Thomas is also found in the Thomas Provisional.

Because Forescout has not met that burden, we determine that Forescout has not adequately shown that it is reasonably likely to prevail on the issue of whether Thomas is prior art to the challenged claims of the '421 patent under 35 U.S.C. § 102(a)(2).

C. ALLEGED OBVIOUSNESS BASED ON THOMAS OR THOMAS AND GILL

For its first ground, Forescout alleges that claims 1, 4–10, 15, and 18–24 are unpatentable under § 103 as obvious over Thomas. Pet. 7, 9–50. For its second ground, Forescout alleges that claims 4–8 and 18–22 are unpatentable under § 103 as obvious over Thomas in view of Gill. Pet. 8, 50–62. Thus, Forescout's asserted obviousness grounds rely, in whole or in part, on Thomas.

A claim is unpatentable under § 103 for obviousness “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.” 35 U.S.C. § 103 (2018).

As discussed above, we determine that Forescout has not adequately shown that Thomas is prior art to the challenged claims. For the same reason, Forescout has also failed to adequately show that in light of Thomas alone or in combination with Gill, the claimed inventions would have been obvious to a person of ordinary skill in the art prior to March 17, 2014, the effective filing date of the '421 patent. *See supra* part III.B.

Thus, we determine that Forescout has not shown that there is a reasonable likelihood that it would prevail in proving that any of the challenged claims would have been obvious over either Thomas alone or Thomas in view of Gill.

IV. CONCLUSION

After considering the evidence and arguments on the preliminary record, we determine that Forescout has not demonstrated a reasonable likelihood that it would prevail in showing that at least one challenged claim of the '421 patent is unpatentable. Therefore, we deny the Petition.

V. ORDER

In consideration of the foregoing, it is
ORDERED that the Petition is *denied*, and no trial is instituted.

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For PETITIONER:

Katherine A. Vidal
Louis L. Campbell
WINSTON & STRAWN LLP
kvidal@winston.com
llcampbell@winston.com

For PATENT OWNER:

Patrick D. McPherson
Christopher Tyson
D. Joseph English
Patrick C. Muldoon
Tairan Wang
Paul H. Belnap
DUANE MORRIS LLP
pdmcperson@duanemorris.com
cjtyson@duanemorris.com
djenglish@duanemorris.com
pcmuldoon@duanemorris.com
twang@duanemorris.com
phbelnap@duanemorris.com