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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

FINJAN, INC., a Delaware Corporation, Plaintiff, vs. JUNIPER NETWORKS, INC., a Delaware Corporation, Defendant.	Case No. 3:17-cv-05659-WHA **DEFENDANT JUNIPER NETWORKS, INC.'S RESPONSE RE EARLY MOTION FOR SUMMARY JUDGMENT RE '494 PATENT**

I. QUESTION 1

A. Part 1: Regarding Juniper's "database" construction, did the PTAB actually rely upon Finjan's distinction between "flat file" and "flat file database?"

The PTAB did not rely upon Finjan's distinction between "flat file" and "flat file database" in upholding the validity of claim 10 in IPR2015-01892 because the PTAB found that the Swimmer reference disclosed a "database" even under Finjan's narrower proposed construction. Ex. 1 (Final Written Decision, Paper 58) at 16-17, 39-41.

B. Part 2: If not, on what authority can Juniper argue that Finjan's distinction amounts to a true disclaimer?

Although the PTAB distinguished claim 10 from Swimmer on grounds other than Finjan's "database" argument, Finjan's statements about the meaning of "database" nevertheless limit the meaning of the term. The Federal Circuit has made clear that "[b]ecause an IPR proceeding involves reexamination of an earlier administrative grant of a patent, it follows that statements made by a patent owner during an IPR proceeding can be considered during claim construction and relied upon to support a finding of prosecution disclaimer." *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1361 (Fed. Cir. 2017). This rule follows from the well-settled principle that, "[a]n applicant's argument made during prosecution may lead to a disavowal of claim scope ***even if the Examiner did not rely on the argument***." *Seachange Intern., Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1374 (Fed. Cir. 2005) ("The fact that the Examiner did not indicate reliance on the point-to-point distinction is of no consequence."); *Microsoft Corp. v. Multi–Tech Sys.*, 357 F.3d 1340, 1350 (Fed.Cir.2004) ("We have stated on numerous occasions that a patentee's statements during prosecution, whether relied on by the examiner or not, are relevant to claim interpretation."); *Barnes & Noble, Inc. v. LSI Corp.*, 2014 WL 1365422 at *12 n. 2 (N.D. Cal. April 7, 2014) (citing *Anderson Corp. v. Fiber Composites, LLC*, 474 F.3d 1361, 1374 (Fed. Cir. 2007) (fact that applicant amended claims and distinguished reference on other grounds did "not change the fact that the applicants advanced an express definition of the term 'time stamp' before the PTO in an attempt to distinguish prior art").

The Federal Circuit's decision in *American Piledriving Equip., Inc. v. Geoquip, Inc.*, 637 F.3d 1324 (Fed. Cir. 2011) is instructive. In that case, the patentee attempted to distinguish a

reference during a reexamination proceeding by arguing that the term "integral" meant that two components were "one-piece." *Id*. at 1336. The patentee later argued that "integral" should not mean "formed or cast of one piece" on the grounds that its statement during reexamination was not a disavowal because it "was unnecessary to overcome the reference and that the examiner explicitly disagreed with it." *Id*. The Federal Circuit squarely rejected this argument, explaining that "American Piledriving unambiguously argued that 'integral' meant 'one-piece' during reexamination and cannot attempt to distance itself from the disavowal of broader claim scope." *Id*.

Here, Finjan unambiguously argued during post-grant proceedings that a "database schema" is defined as a "description of a database to a database management system (DBMS) in the language provided by the DBMS" and that Swimmer did not satisfy the "database" element because it did not store the data "in the form of a table, where only one table can be used for each database." Ex. 2 (Patent Owner's Response, Paper 27) at 37-39. Just as in *American Piledriving*, these statements constitute a disavowal of any broader meaning of "database" and support the adoption of Juniper's construction.

II. QUESTION 2

A. Part 1: A WRITE command is a legitimate command, but it is disclosed as a suspicious computer operation in the '194 patent at column 5 line 59. Where in the '194 patent does it explain how to distinguish between a suspicious versus non-suspicious operation?

The '194 Patent does not explain how to distinguish between suspicious versus non-suspicious operations. As the Court correctly notes, the '194 Patent identifies a WRITE command as an example of a "suspicious computer operation," even though a WRITE command, by itself is a legitimate command. The patent provides no teaching or explanation of how to distinguish between which legitimate commands are "suspicious" and which ones are not. Indeed, other than the "Example List of Operations Deemed Potentially Hostile," the '194 Patent's only explanation of what constitutes "suspicious" is an almost unbounded description of computer operations:

> It will be further appreciated that a Downloadable is deemed suspicious if it performs or may perform any undesirable operation, or if it threatens or may threaten the integrity of an internal computer network 115

> component. ***It is to be understood that the term "Suspicious" includes hostile, potentially hostile, undesirable, potentially undesirable, etc***.

'194 Patent at 3:12-16 (emphasis added). The patent offers no objective criteria for how one would determine whether something satisfies one of these sub-categories; for example, there is no explanation as to how one would objectively determine whether something is, *e.g.*, "undesirable" or "potentially undesirable." Without more, this statement is meaningless, as what constitutes an "undesirable" operation to one user may be very different than what is "undesirable" to another. Even Finjan's expert Dr. Cole admitted that what is "suspicious" depends on the person making the evaluation, as well as the particular requirements of the network. Dkt. No. 126-8 (Cole Depo. Tr.) at 83:1-11 (whether something is suspicious "could depend on either the – the evaluation that's performed, the ***level of sensitivity***. For example, ***on highly sensitive government systems, you might have less tolerance for certain operations than in other environments*** and could also be deemed based on the code that was written to look for what is or is not suspicious"). Thus, what is "undesirable" differs depending on the personal opinions and subjective preferences of the particular user, and the patent does not provide a POSITA with any way to distinguish which operations are within the scope of the patent and which are outside the scope.[1]

In the past, Finjan has identified Column 9, lines 24-29 of the '194 Patent as providing evidence about how one would derive a list of suspicious operations. That passage states:

> The code Scanner 325 in step 710 resolves a respective command in the machine code, and in step 715 determines whether the resolved command is Suspicious (e.g., ***whether the command is one of the operations identified in the list described above with reference to FIG.3***).

But this passage merely refers back to the "Example List" without explaining how operations like WRITE got on that list in the first place.

Finjan has previously admitted that the '194 Patent does not set forth rules to explain how to distinguish between a suspicious versus non-suspicious operation or when a legitimate command like WRITE should be considered "suspicious." Specifically, in IPR2015-01892,

[1] As noted in Juniper's Opposition Brief, Dr. Cole admitted that the definition of "suspicious" differs from network security professional to network security professional. Dkt. No. 126-8 (Cole Depo. Tr.) at 79:1-11.

Finjan stated: "***there is no a priori understanding of what constitutes a 'suspicious computer operation***.'" Ex. 2 at 11. No "a priori" understanding means that a "suspicious computer operation" cannot be determined from any general rule and can only be confirmed on subjective observation. If the '194 Patent provided any real explanation as to what makes an operation "suspicious," then one would be able to deduce in advance whether or not an operation was suspicious. Finjan thus admits that the '194 Patent does not teach how to do that, including how to determine whether a WRITE command is legitimate or not.

Finjan's representations to the Federal Circuit further confirm that the '194 Patent does not explain how to distinguish between a suspicious and non-suspicious operations. In particular, Finjan argued that "***computer operations are only 'suspicious' to the extent that they have been deemed so***." *Symantec Corp. v. Finjan, Inc.*, Appeal No. 17-2034, ECF 36 (Finjan's Principal and Response Brief) at 28 (Fed. Cir. Feb. 7, 2018). Finjan's position makes clear that operations are not "suspicious" because they meet some objective criteria set forth in the '194 Patent; rather, they are "suspicious" ***only*** because someone deemed them as suspicious. Thus, Finjan's argument is entirely circular.

Notwithstanding the circular nature of its argument, Finjan argues that "a list of suspicious computer operations" should be construed as "a list of computer operations that are ***deemed*** hostile or potentially hostile." *See* Dkt. No. 154 at 4. This construction fails to eliminate the subjectivity of the claim scope because it provides no objective criteria for how to "deem" something suspicious or not. In fact, Finjan's proposed construction creates more uncertainty because it does not identify who is doing the "deeming" or place any restrictions on their determination. It is well-settled law that a patent is indefinite when its scope depends on the "unpredictable vagaries of any one person's opinion." *See Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350 (Fed. Cir. 2005). The subjective nature of Finjan's proposed construction is further evidenced in provisional application no. 60/030,639, which the '194 Patent incorporates by reference. In this application, Finjan concedes that the determination of which operations are "potentially hostile" hinge on what "a user" thinks is "potentially hostile": "potentially hostile operations may include READ/WRITE operations on a system configuration file, READ/WRITE

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