

EXHIBIT 1

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13 *Attorneys for Defendant*
14 QUALYS INC.

15 **IN THE UNITED STATES DISTRICT COURT**
16 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**
17 **OAKLAND DIVISION**

19 FINJAN, INC., a Delaware Corporation,) CASE NO.: 4:18-cv-07229-YGR
20)
21 Plaintiff,) **DEFENDANT QUALYS INC.'S**
22) **PATENT L.R. 3-3, 3-4**
v.) **DISCLOSURES**
23) **DEMAND FOR JURY TRIAL**
24 QUALYS INC., a Delaware Corporation,)
25)
26 Defendant.)
27)
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QUALYS’S INVALIDITY CONTENTIONS

Defendant Qualys, Inc. (“Qualys”) provides its L.R. 3-3 and 3-4 disclosures to Plaintiff Finjan, Inc. (“Finjan”) with respect to the asserted claims identified by Finjan in its Initial Disclosure of Asserted Claims and Infringement Contentions¹ served on April 19, 2019 (“Asserted Claims”). The Asserted Claims are as follows:

- Claims 1-9, 11, 15-17, 21-23, 32, and 41-44 of U.S. Patent No. 6,154,844 (“the ’844 Patent”);
- Claims 1, 6-7, 9-11, 13-15, 23, 26 and 32-33 of U.S. Patent No. 6,965,968 (“the ’968 Patent”);
- Claims 1-2, 14-15 and 17 of U.S. Patent No. 7,418,731 (“the ’731 Patent”);
- Claims 1-2, 5-15, and 17-25 of U.S. Patent No. 7,975,305 (“the ’305 Patent”);²
- Claims 1-2 and 4 of U.S. Patent No. 8,141,154 (“the ’154 Patent”); and
- Claims 1, 3-8, 22-23, 29, and 35 of U.S. Patent No. 8,225,408 (“the ’408 Patent”).
- Claims 10-16 and 18 of U.S. Patent No. 8,677,494 (“the ’494 Patent”);

With respect to each Asserted Claim, Qualys identifies in compliance with Patent L.R. 3-3: (a) the identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious; (b) whether each item of prior art anticipates each asserted claim or renders it obvious; (c) a chart identifying specifically where and how in each alleged item of prior art each limitation of each asserted claim is found; and (d) any grounds of invalidity under 35 U.S.C. §101, indefiniteness under 35 U.S.C. § 112(2), or enablement or written description 35 U.S.C. § 112(1) of any of the Asserted Claims. This identification is based on information presently known to Qualys and is subject to its ongoing investigation. Qualys reserves the right to

¹ Qualys expressly reserves the right to object to the sufficiency of Plaintiff’s Infringement Contentions and/or to move to strike the contentions, in whole or in part.

² Finjan has not identified any accused products or provided any infringement contention claim charts for Claim 15 of the ’305 Patent.

1 supplement and/or amend these Invalidity Contentions in accordance with the rules and orders of
2 this Court.

3 Qualys makes these disclosures without waiving or contradicting any position that
4 Finjan's Disclosure of Infringement Contentions is deficient for failing to comply with the Patent
5 Local Rules and applicable case law.

6 **I. GENERAL RESERVATIONS**

7 The following contentions are subject to the reservations stated above and subject to
8 amendment pursuant to at least Patent L.R. 3-6, Rule 26(e) of the Federal Rules of Civil
9 Procedure to the extent appropriate in light of, for example, ongoing investigation and discovery
10 regarding the defenses asserted by Qualys, any Court-ordered claim construction related to any
11 asserted claim, and the review and analysis of expert discovery.

12 The information and documents that Qualys produces are provisional and subject to
13 further revision as follows: Qualys expressly reserves the right to amend the disclosures and
14 document production herein should Finjan provide any information that it failed to provide in its
15 Infringement Contentions, has not produced in discovery, and/or should Finjan amend its
16 Infringement Contentions. Further, because discovery is not yet complete and because Qualys's
17 search for, and analysis of, relevant prior art is ongoing, Qualys reserves the right to amend the
18 information provided herein, including identifying, charting, and relying on additional prior art,
19 should Qualys's further search and analysis yield additional information or references (or based
20 on information and documents Finjan produced in discovery), consistent with the Local Patent
21 Rules for the Northern District of California and the Federal Rules of Civil Procedure.
22 Moreover, Qualys reserves the right to revise any contentions concerning the invalidity of the
23 Asserted Claims, which may change depending upon any findings as to the priority or invention
24 date of the Asserted Claims, and/or positions that Finjan or expert witness(es) may take
25 concerning claim construction, infringement, and/or invalidity issues.

26 Prior art not included in these contentions, whether known or not known to Qualys, may
27 become relevant. In particular, Qualys is currently unaware of the extent, if any, to which Finjan
28 will contend that limitations of the Asserted Claims are not disclosed in the prior art identified by

1 Qualys. To the extent that such an issue arises, Qualys reserves the right to identify other prior
2 art that would render obvious the allegedly missing limitation(s) of the disclosed system or
3 method.

4 To the extent the following contentions reflect constructions of claim limitations
5 consistent with or implicit in Finjan's Infringement Contentions, no inference is intended nor
6 should any be drawn that Qualys agrees with Finjan's interpretation or understanding of any
7 claim limitation accused of being present literally or under the doctrine of equivalents, and
8 Qualys expressly reserves the right to contest Finjan's understanding or interpretation of such
9 claim limitations. Qualys offers the following invalidity contentions in response to Finjan's
10 Infringement Contentions. Qualys offers the following invalidity contentions without prejudice
11 as to (a) any position Qualys may ultimately take regarding any claim construction issues, and
12 (b) Qualys's understanding or interpretation of any claim limitation accused of being present
13 literally or under the doctrine of equivalents.

14 Qualys further intends to rely on inventor admissions concerning the scope of the prior
15 art relevant to the asserted patents found in, *inter alia*: the patent prosecution history
16 corresponding to each of the asserted patents and any patents or patent applications related to the
17 asserted patents; any deposition testimony of any named inventor on any of the asserted patents
18 and any patents or patent applications related to the asserted patents in this action or any other
19 action; and the papers filed and any evidence submitted by Finjan in connection with this action.

20 Qualys's claim charts in Exhibits A-G cite to particular teachings and disclosures of the
21 prior art as applied to features of the Asserted Claims. However, persons having ordinary skill in
22 the art generally may view an item of prior art in the context of other publications, literature,
23 products, and understanding. As such, the cited portions are only examples, and Qualys reserves
24 the right to rely on uncited portions of the prior art (including any information incorporated by
25 reference); and on other publications, expert testimony, and other evidence as aids in
26 understanding and interpreting the cited portions, as providing context thereto, and as additional
27 evidence that the prior art discloses a claim limitation or an asserted claim as a whole. Qualys
28 further reserves the right to rely on uncited portions of the prior art references (including any

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