

# Exhibit A

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UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,  
  
Plaintiff,  
  
v.  
  
ESET, LLC, a California Limited Liability  
and ESET SPOL. S.R.O., a Slovak  
Republic Corporation,  
  
Defendants.

Case No.: 3:17-cv-0183-CAB-BGS

**ORDER ON DEFENDANTS’  
RENEWED MOTION FOR  
SUMMARY JUDGMENT OF  
INDEFINITENESS  
[Doc. No. 806]**

Before the Court is the renewed motion of Defendants ESET, LLC and ESET spol. s.r.o (collectively “ESET”) for summary judgment to invalidate Plaintiff Finjan’s United States Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 (“the patents at-issue”) as indefinite pursuant to 35 U.S.C. § 112 based on this Court’s construction of the claim term “Downloadable.” The motion is fully briefed, and the Court deems it suitable for submission without oral argument.

**I. Background**

This motion has an unusual history. ESET filed a motion for summary judgment asserting that the patents at-issue are indefinite at the close of fact discovery in this case, and the Court held argument on September 26, 2019. Finding that there were factual disputes regarding what a skilled artisan in 1997 would have understood constituted a

1 “Downloadable” based on the Court’s construction of that term, the Court denied the  
2 motion without prejudice. [Doc. No. 699.] It was anticipated that trial testimony would  
3 establish what was generally understood in the art in 1997 as a “Downloadable” and such  
4 testimony would inform the scope of infringement. [Doc. No. 697, at 22:3-15.]

5 A jury trial commenced in this case on March 10, 2020. After three trial days the  
6 Court was forced to vacate the remainder of the trial, excuse the jury and declare a mistrial  
7 due to the COVID-19 pandemic and the issuance of the State of California’s stay-home  
8 order. [Doc. No. 783.] This District’s continuing moratorium on civil jury trials and  
9 backlog of criminal jury trials currently precludes scheduling a new trial in this matter.

10 Having heard testimony from Finjan’s expert during the vacated trial on this issue,  
11 however, the Court permitted ESET to renew this motion in consideration of the testimony  
12 that was taken. Although Finjan’s patents have been the subject of much litigation, and  
13 the term “Downloadable” has been construed by other courts, the issue raised in ESET’s  
14 current motion does not appear to have been addressed by any prior constructions.

15 Finjan is the owner of a large family tree of patents for security systems and methods  
16 of detecting malware in computer programs. Finjan has litigated many of their patents,  
17 including some of the patents at-issue in this motion, in other district courts. Many have  
18 also been subject to *inter partes* review by the Patent and Trademark Office (PTO). The  
19 Federal Circuit has issued at least nine opinions, precedential and non-precedential, on  
20 appeals from district courts and the PTO regarding Finjan patents. Yet none of these orders  
21 or opinions discuss how earlier references incorporated into the patents at-issue inform the  
22 construction of the term “Downloadable.”

## 23 II. The Construction of “Downloadable”

24 In 2017, Finjan filed this litigation against defendants ESET asserting infringement  
25 of the patents at-issue, and United States Patent No. 7,975,305.<sup>1</sup> Finjan claims priority for  
26

27  
28 <sup>1</sup> The ‘305 patent is not subject to this motion as it does not include the claim term “Downloadable.”

1 the patents at-issue back to an application filed on November 8, 1996, Provisional  
2 Application 60/030639. [Doc. No. 139-24.] The application is directed at “a system and  
3 method for protecting computers from hostile Downloadables,” described as executable  
4 application programs automatically downloaded from a source computer and run on the  
5 destination computer that might carry computer “viruses.” [Id., at 5-6.] The claim term  
6 “Downloadable” is presented as a capitalized term in the provisional application and all the  
7 patents at-issue, signaling it is a specifically defined term. The definition of  
8 “Downloadables,” however, is not consistent throughout Finjan’s subsequently issued  
9 patents. The explicit definitions include:

- 10 • “applets” (little applications) described in the 1990s as small interpreted or  
11 executable programs. *See* Provisional Application 60/030639 (filed  
12 November 8, 1996) [*Id.* at 5-6.]
- 13 • “Downloadables (i.e., applets)” as “a small executable or interpretable  
14 application program which is downloaded from a source computer and run  
15 on a destination computer,” in conformity with the original provisional  
16 application. *See* U.S. Patent No. 6,167,520, at Col. 1:31-34 (application filed  
17 January 29, 1997); U.S. Patent No. 6,480,962, at Col. 1:38-41 (filed April 18,  
18 2000).
- 19 • “an executable application program which is downloaded from a source  
20 computer and run on a destination computer” (without “i.e., applet,” “small”  
21 or “interpretable” included in the definition but using applets and  
22 interpretable programs as examples of a “Downloadable” and incorporating  
23 the earlier definition by reference). *See* U.S. Patent No. 6,092,194, at Col.  
24 1:44-55 (filed November 6, 1997); U.S. Patent No. 6,804,780 at Col. 1:50-60  
25 (filed March 30, 2000).

26 Other district courts have determined that “Downloadable” lacked ordinary meaning  
27 when the patents were filed and construed it as “an executable application program which  
28 is downloaded from a source computer and run on a destination computer,” applying the

1 explicit definition from the ‘194 patent. [Doc. No. 139-10, at 3; Doc. No. 138-4, at 2-5 (the  
2 term was not amenable to plain and ordinary meaning and the patent applicant intended to  
3 act as the lexicographer of this term, therefore the specification definition controls).] None  
4 of these orders, however, discussed the significance of the ‘520 patent’s definition  
5 incorporated into the ‘194 patent and its continuations. One district court, without  
6 explanation, applied the broader definition from the ‘194 patent specification to the  
7 construction of the term “Downloadable” in the ‘962 patent as “the same” definition [id.,  
8 at 3, fn. 4], disregarding the fact the ‘962 patent explicitly defines “Downloadable” as “a  
9 *small* executable or interpretable application program which is downloaded from a source  
10 computer and run on a destination computer.” See U.S. Patent No. 6,480,962, at Col. 1:39-  
11 41 (*emphasis* added).

12 Incorporation by reference provides a method for integrating material from various  
13 documents into a host document by citing such material in a manner that makes clear that  
14 the material is effectively part of the host document as if it were explicitly contained  
15 therein. See *Trustees of Columbia Univ. v. Symantec*, 811 F.3d 1359, 1365-66 (Fed. Cir.  
16 2016) (*citing Advanced Display Sys. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir.  
17 2000) (provisional applications incorporated by reference are effectively part of the  
18 specification as though it was explicitly contained therein.)). By incorporating the earlier  
19 definition of “Downloadable” from the ‘520 Patent into the ‘194 Patent and subsequent  
20 continuations (including the patents at-issue), the scope of the term is limited to “*small*  
21 executable or interpretable application programs,” and not *all* executable application  
22 programs (*emphasis* added). See *Symantec*, 811 F.3d at 1365 (rejecting a broad  
23 interpretation of a claim term in part because a provisional application incorporated by  
24 reference the same term more narrowly defined.) Inconsistent language used later cannot  
25 support a broad claim construction when the explicit definition is incorporated from earlier  
26 patents in the family tree.

27 In this case, the Court concluded that based on its incorporation by reference in all  
28 the patents at-issue, the explicit definition of “Downloadables” from the ‘520 patent and

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