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15 **FINJAN, LLC**

16 UNITED STATES DISTRICT COURT  
17 NORTHERN DISTRICT OF CALIFORNIA  
18 (OAKLAND DIVISION)

19 FINJAN, LLC, a Delaware Limited Liability  
20 Company,

21 Plaintiff,

22 v.

23 QUALYS INC., a Delaware Corporation,

24 Defendant.  
25  
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28

Case No. 4:18-cv-07229-YGR (TSH)

**LETTER TO THE HONORABLE  
YVONNE GONZALEZ ROGERS FROM  
FINJAN LLC REGARDING QUALYS  
INC.'S LETTER REQUESTING A PRE-  
FILING CONFERENCE FOR ITS  
SUMMARY JUDGMENT MOTION**



FISH &amp; RICHARDSON

1 March 22, 2021

2 **VIA CM/ECF**

3 The Honorable Yvonne Gonzalez Rogers  
 4 United States District Court  
 5 for the Northern District of California  
 6 1301 Clay Street  
 7 Oakland, CA 94612

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8 Re: *Finjan LLC v. Qualys Inc.*,  
 9 CAND Case No. 4:18-cv-07229-YGR

10 Dear Judge Gonzalez Rogers:

11 Plaintiff Finjan LLC (“Finjan”) respectfully submits this letter brief in response to Qualys Inc.’s  
 12 Letter Requesting a Pre-Filing Conference for its Summary Judgment Motion as filed with the  
 13 court on March 17, 2021 (Dkt. 172).

14 **Liability—’408 Patent.** The relevant limitations of the ’408 Patent describe how a system scans  
 15 content (such as a website), builds a “parse tree” based on that scan (including, for example, the  
 16 content that has been scanned), and then detects issues in what it has scanned (such as potential  
 17 malware). Qualys asks the Court to resolve factual disputes relating to these limitations.

18 For the “dynamically building” a parse tree “while said receiving receives the incoming stream”  
 19 limitation, Finjan’s expert (Dr. Medvidovic) analyzed source code, Qualys documentation, and  
 20 deposition testimony to identify a parse tree structure (here, scan results stored in XML, or  
 21 alternatively, the data that is used to create that XML) that is built *during* a scan.<sup>1</sup> E.g., Med. Rep.  
 22 ¶¶ 276-283; 296-299. Qualys’s expert disagrees, stating that the data structure is built *after* the  
 23 incoming stream is scanned. Qualys’s expert (Dr. Rubin) cites no evidence to support his  
 24 conclusion, but even if he did, this is a classic dispute of fact—and not appropriate for summary  
 25 judgment. Rubin Tr. 211:2-24 (when asked if he could point to any “source code or technical  
 26 documentation to corroborate” his opinion, identifying only “[deposition] transcripts of the  
 27 engineers, as well my conversations with them.”)

28 Qualys’s argument for the “dynamically detecting” limitation is similarly flawed. Although  
 Qualys now says that the accused products do not perform “detection” *while* “building” a data  
 structure from the scan results, the evidence shows otherwise. Med. Rep. ¶ 303 (emphasizing the  
 “real time” nature of Qualys’s products). In fact, Qualys’s documentation states that crawling (i.e.,

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<sup>1</sup> Qualys incorrectly states that Finjan did not timely disclose its infringement theory. Finjan disclosed all of its infringement theories. *See generally* Finjan Opp. re Qualys Mtn to Strike (ECF No. 163-3). Undercutting Qualys’s argument is the fact that its own expert analyzed Finjan’s contentions and expert report and identified only two places where he contended that Finjan’s expert opined on theories not disclosed in Finjan’s contentions—neither of which is at issue for this limitation. Rubin Tr. 200:14-205:19 (as an example: “[Q] But at least upon the analysis you conducted in preparing your report, you didn’t identify any other theories, correct, that were outside of Finjan’s infringement contentions, and in Dr. Medvidovic’s report? A. I don’t recall any



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1 scanning, which results in the claimed “building”) and testing (i.e., the claimed “detecting”) occur  
2 in parallel: “As compared to the other levels, more crawling and testing requests are run in parallel  
3 and the delay between requests sent to the web application is shorter.” Med. Rep. ¶ 319 (citing  
4 Scan Bandwidth (Web Application Scan) [QUALYS00534616]). On this record, there is at least a  
5 dispute of material fact and Qualys’s argument and motion is futile.

6 Finally, Qualys’s last argument for the ’408 Patent appears to be the following: (1) those of skill in  
7 the art make a categorical distinction between vulnerabilities in code and an “indicator” of a  
8 “potential exploit”; and (2) Qualys’s products identify the former and not the latter. For one thing,  
9 even Qualys’s expert disagrees with Qualys’s premise, referring to the two as “intertwined” and  
10 stating that “[i]n some respects, the only difference between a code quality problem and a  
11 vulnerability to a malicious virus is the intent of the person who creates or exploits the problem.”  
12 Decl. of Dr. Rubin, Ex. 1002 to IPR2016-0967 ¶¶ 103-104. Additionally, both sides’ experts cited  
13 actions that the Qualys products take to identify potential exploits. *See* Med. Rep. ¶ 237 (“Forty-  
14 five percent of the vulnerabilities tracked are designated the highest level of severity by their  
15 vendors in terms of potential destruction, complexity, and liability to customers’ networks. Attacks  
16 that exploit vulnerabilities at these levels allow intruders to easily gain control of the host, which  
17 may lead to compromising security of the entire network”); *e.g.*, Rubin Reb. at 1072 (identifying  
18 the “exploitability” of a particular vulnerability and the specific types of exploits, such as  
19 malware, that take advantage of those exploits). Qualys now appears to disagree with these facts,  
20 but the Court cannot resolve this disagreement at summary judgment.

21 **Liability—’844 and ’494 Patents.** Qualys ignores ample evidence of “Downloadables” and a  
22 “destination computer” in the accused product. To the extent Qualys is arguing that what Finjan’s  
23 expert has identified with respect to each limitation is insufficient, that is squarely a dispute of  
24 fact. Dr. Cole gives a clear example of a Downloadable: “For something to be a downloadable, if  
25 we go back to the Court’s claim construction, it’s an executable application program which is  
26 downloaded from a source computer and run on a destination [computer]. So if the clients are  
27 accessing a server, and they’re downloading it, it becomes a downloadable.” Cole Tr. at 67:18-24.  
28 And Dr. Cole identifies numerous types of files in his report that qualify as Downloadables in the  
29 Qualys system. *See, e.g.*, Cole Rep. at ¶ 421 (Internet Explorer), ¶ 433 (Cross-Site Scripting  
30 (XSS)), ¶ 652 (SQL Injections), and ¶ 405 (Windows TCP/IP Remote Code Execution and Denial  
31 of Service). That Qualys’s expert disagrees that these are Downloadables is insufficient for  
32 summary judgment. Qualys’s argument that executable applications are not downloaded or run on  
33 Qualys scanners misses the mark, because there is no requirement in the claims that this occurs:  
34 “when the [Qualys] scanner connects to the asset it’s scanning, when it makes that request, that  
35 request is that act of receiving that downloadable to perform the analysis.” Cole Tr. at 128:9-18.  
36 As to the destination computer, Finjan’s expert opines that it “would be any of the clients that  
37 would be accessing that server typically after a vulnerability scan is performed.” *Id.* at 68:9-18.  
38 Again, that Qualys’s expert disagrees (*see, e.g.*, Stubblebine Reb. at ¶ 159) is insufficient for  
39 summary judgment.

40 **Damages—Foreign Sales.** The portion of Qualys’ letter regarding overseas sales is a redux of its  
41 motion to strike (D.I. 158), and the Court should reject it for the reasons in Finjan’s opposition  
42 brief (D.I. 164). Qualys also fails to recognize that there is, at the least, a material fact question



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1 opinions from Drs. Cole and Medvidovic that domestic infringements which populate “Qualys’  
2 ‘Knowledge Base’ of security issues and vulnerabilities” with “new vulnerability signatures” are  
3 necessary for Qualys’ products to have value anywhere in the world, including overseas. The  
4 Federal Circuit has held that where domestic infringement is the cause of overseas sales, as it is  
5 here, it is “irrelevant” that some of the sales are to foreign customers. *R.R. Dynamics, Inc. v. A.*  
6 *Stucki Co.*, 727 F.2d 1506, 1519 (Fed. Cir. 1984) (holding that where domestic infringement made  
7 the overseas sales possible, “[w]hether the [goods] were sold in the U.S. or elsewhere is . . .  
8 irrelevant, and no error occurred in including [overseas sales]” in the royalty base). Qualys’  
9 statement that there is “not any factual dispute that all of these predicate domestic acts are  
10 missing” is incorrect, at least because both Dr. Cole and Dr. Medvidovic expressly identified the  
11 predicate domestic acts, and showed how they lead to overseas sales. The Court should not permit  
12 Qualys’ to seek summary judgment where such fact issues exist.

13 **Damages—’844 and ’494 Patents.** Qualys’ attack on pre-expiration notice of infringement  
14 contravenes the record and the law. Finjan wrote to Qualys on November 12, 2015, claiming  
15 infringement and inviting Qualys to take a license. Finjan wrote, “[W]e believe one or more of  
16 Finjan’s patents reads on Qualys’ Cloud Platform. We believe[,] however, a licensing arrangement  
17 can be reached.” (D.I. 1-23) It attached a table identifying which Finjan patents read on which  
18 Qualys products, which identified Qualys’ “Vulnerability Management” product as infringing both  
19 the ’844 and ’494 Patents. (*Id.* at 9.) The Federal Circuit has held this is all § 287 requires. “To  
20 serve as actual notice, a letter must be sufficiently specific to support an objective understanding  
21 that the recipient may be an infringer. The letter must *communicate a charge of infringement of*  
22 *specific patents by a specific product or group of products.*” *Funai Elec. Co. v. Daewoo Elecs.*  
23 *Corp.*, 616 F.3d 1357, 1373 (Fed. Cir. 2010) (emphasis added). Indeed, the infringement notice in  
24 *Funai*—the only controlling authority in Qualys’ letter brief—read simply “We confirmed Your  
25 [specific products] that was infringed [*sic*] at least our patents as follows: [list of six U.S. patent  
26 numbers].” *Id.* at 1372–73. The law requires no more; Qualys is unable to argue otherwise. *See*  
*also Amsted Indus. Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 187 (Fed. Cir. 1994) (actual  
notice requires only “affirmative communication of a specific charge of infringement by a specific  
accused product”); 7 Chisum on Patents § 20.03[7][c][iv] (2020 ed.) (“[T]he notice need not  
contain a detailed statement or an explication of the patent owner’s theory concerning  
infringement.”). Because pre-suit notice for the ’844 and ’494 Patents amply satisfied the  
requirements of § 287, including under the sole controlling authority Qualys cites, the Court  
should not permit Qualys to move for summary judgment.

21 **Willfulness—’731 and ’408 Patents.** Qualys errs when it states that there was no pre-suit notice  
22 to Qualys pertaining to these patents. On September 12, 2018 (i.e., before the complaint) , Finjan  
23 had a virtual meeting with Qualys to discuss Qualys’ infringement, attended by Qualys General  
24 Counsel Bruce Posey. At that meeting, Qualys presented a slide deck identifying Qualys’  
25 infringement of both the ’408 Patent and the ’731 Patent. Because Qualys’ sole basis for seeking  
26 leave to move for summary judgment is its assertion that it is “undisputed that Finjan provided no  
pre-suit notice letter or other notice to Qualys pertaining to the ’731 and ’408 patents,” Ltr. 3, and  
because that assertion is demonstrably incorrect, the Court should not permit Qualys to move for  
summary judgment on this issue.



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Respectfully Submitted,

*/s/ Jason W. Wolff*

Jason W. Wolff

cc: All Counsel of Record (via email)

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