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13 Attorneys for Plaintiff
 14 FINJAN LLC

15 UNITED STATES DISTRICT COURT
 16 NORTHERN DISTRICT OF CALIFORNIA
 17 (SAN JOSE DIVISION)

18 FINJAN LLC., a Delaware Limited Liability
 19 Company,

20 Plaintiff,

21 v.

22 SONICWALL, INC., a Delaware Corporation,

23 Defendant.
 24
 25

Case No. 5:17-cv-04467-BLF (VKD)

**PLAINTIFF FINJAN LLC'S MOTION IN
 LIMINE NO. 1 TO PRECLUDE
 TESTIMONY ON WRITTEN
 DESCRIPTION FROM SONICWALL'S
 TECHNICAL EXPERTS**

Date: March 18, 2021
 Time: 1:30 PM
 Hon. Beth Labson Freeman
 Ctrm: 3, 5th Floor

26
 27 **UNREDACTED VERSION OF DOCUMENT SOUGHT TO BE SEALED**
 28

1 **I. INTRODUCTION**

2 Pursuant to Federal Rules of Evidence 401, 402, 403, and 702, Finjan LLC (“Finjan”)
3 respectfully requests that the Court exclude from presentation at trial any testimonial opinions that
4 any asserted patent claim lacks sufficient written description, and/or is invalid for that reason.

5 **II. ARGUMENT**

6 SonicWall proposes to present the jury with technical opinions concerning the sufficiency
7 of the written description supporting Finjan’s patent claims. SonicWall’s technical experts did not
8 base these opinions on the Court’s claim constructions, but used improper alternative claim
9 constructions the experts invented themselves. Such opinions are improper, and the Court should
10 preclude SonicWall from presenting them to the jury.

11 **A. For Written Description, SonicWall’s Technical Experts Relied on Alternative**
12 **Constructions Not Adopted by the Court**

13 Each of SonicWall’s technical experts, Aviel Rubin, Ph.D; Kevin Almeroth, Ph.D.; and
14 Patrick McDaniel, Ph.D., applied the same methodology opining on written description:

- 15 1. Identifying a Finjan infringement contention against a SonicWall product;
- 16 2. Based on the contention, forming an alternative construction of a claim
17 limitation(s);
- 18 3. Reasoning that Finjan would have adopted this alternative construction; then
- 19 4. Opining that the patent’s written description fails to teach or suggest an
20 embodiment conforming to the alternative claim construction.

21 The written description opinions of all four experts use this approach. (See Exh. 1 at 212–
22 40; Exh. 2 at 253–86; Exh. 3 at 128–41.) The Opening Rubin report is illustrative. It begins by
23 analyzing Finjan’s infringement contentions. (Exh. 1 at 212 (“Finjan contends this claim language
24 is met”)) It then hypothesizes that Finjan’s basis for those contentions might have been an
alternative interpretation of some claim term (here, the 2408 claim term “an incoming stream of

1 programming code”) such that the term would cover the limitation in question (here, [REDACTED]
2 [REDACTED] (*Id.* at 213.) The Report assigns this hypothetical
3 construction to Finjan, though it cites neither any filing by Finjan adopting that construction, nor
4 the Court’s claim construction order. (*Id.*) Finally, the Report compares its alternative
5 construction to the specification of the ’408 patent to look for disclosure of the exact alleged
6 functionality and, finding none, opines that a skilled artisan would not find support for the claim
7 under this alternative, hypothetical construction never adopted by (or even submitted to) the Court.
8 (*Id.* at 213–14.)

9 **B. Depositions Confirmed The Experts’ Reliance on Alternative Constructions**

10 When challenged at deposition, the SonicWall Technical Experts confirmed that their
11 analysis of written description primarily relied on Finjan’s infringement contentions, and not on
12 the Court’s Claim Construction Order or the terms’ ordinary meaning to one of skill in the art.

13 Dr. Rubin confirmed that under the proper construction of the claims, he was “not
14 challenging” written description. (Exh. 4 50:11–18 (“ [REDACTED]
15 [REDACTED]
16 [REDACTED]
17 [REDACTED]” (objection omitted)).) He confirmed that his written
18 description opinions were based entirely on constructions that the Court has not adopted, and
19 would apply only if the Court “[REDACTED]
20 [REDACTED]” (*Id.* at 46:9–47:1.)

21 Dr. Almeroth described his written description argument as a “conditional” argument, and
22 that he was not providing a written description opinion under “the proper” interpretation of the
23 claims. (Exh. 5 62:22–63:2, 64:13–19.) His analysis was expressly “predicated based on a claims
24 scope” that he purportedly discerned from Finjan’s “infringement allegations.” (*Id.* at 67:8–15.)

1 Dr. McDaniel confirmed that he—like all the SonicWall experts—was applying a different
2 claim construction for written description than he applied to either infringement or other aspects of
3 invalidity. (Exh. 6 54:12–21 (describing how his written description discussion ‘ [REDACTED]
4 [REDACTED]’).) And, like the other experts, he offered
5 no written description opinion under the claim construction actually entered by the Court. (*Id.* at
6 55:16–20.)

7 **C. The Court Should Not Permit Presentation of Hypothetical, Alternative**
8 **Constructions, or Opinions Based Thereon, to the Jury**

9 The SonicWall Technical Expert’s hypothetical-construction methodology is improper as a
10 matter of law, per se unreliable, and inappropriate for the jury. Unless the Court precludes it, such
11 testimony would confuse the jury as to the meaning of claim terms, which meanings should only
12 every be set by the Court. The jury should only be presented with one set of claim constructions:
13 those in the Court’s Claim Construction Order.

14 **1. Legal Standards**

15 The Supreme Court has long held that patent claim interpretation is an issue of law, to be
16 resolved exclusively by the court. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372
17 (1996). In jury trials, the court supplies its constructions to the jury via instructions. *E.g.*, *Every*
18 *Penny Counts, Inc. v. American Express Co.*, 563 F.3d 1378, 1383 (Fed. Cir. 2009) (“[T]he court’s
19 obligation is to ensure that questions of the scope of the patent claims are not left to the jury.”)
20 Claim interpretation is not, in any sense, a jury issue. *Id.* Courts construing patent claims give
21 terms the meaning they would have to a person of ordinary skill in the art at the time of the
22 invention in view of the specification and the prosecution history. *Phillips v. AWH Corp.*, 415
23 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). As to written description, patents must contain a
24 sufficient written description “as to enable any person skilled in the art . . . to make and use the

1 ordinary skill in the art to recognize that the inventor invented what is claimed.” *Ariad Pharms.,*
2 *Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (quote marks omitted).
3 “[T]he test for sufficiency is whether the disclosure of the application relied upon reasonably
4 conveys to those skilled in the art that the inventor had possession of the claimed subject matter as
5 of the filing date.” *Id.* The sufficiency of written description is evaluated based on “the four
6 corners of the specification.” *Id.* A patent satisfies the written description requirement where its
7 specification is adequate “to support the full scope of the claims as construed [by the court].”
8 *Energy Trans. Grp. v. William Demant Holding A/S*, 697 F.3d 1342, 1350 (Fed. Cir. 2012). Fact-
9 finders evaluating the sufficiency of a patent’s written description apply a presumption that the
10 description is sufficient. A patent may be invalidated on written description grounds only upon
11 clear and convincing evidence that the full scope of the claims, using the construction assigned by
12 the court, lacks support in the written description. *Ariad*, 598 F.3d at 1354.

13 2. Opinions Based on Alternative Claim Constructions Derived From 14 Infringement Allegations are Improper

15 The written description opinions offered by Drs. Rubin, Almeroth, and McDaniel should
16 be precluded. For written description, claims must only interpreted according to their ordinary
17 meaning at the time of the invention, in view of the specification and the prosecution history.
18 *Koninklijke Philips Elecs. N.V. v. Cardiac Sci. Operating Co.*, 590 F.3d 1326, 1336 (Fed. Cir.
19 2010) (“A district court must base its analysis of written description . . . on proper claim
20 construction.”); *see also Phillips*, 415 F.3d at 1312–13. This Court properly held claim
21 construction proceedings, and issued an order. (See Claim Constr. Order (Mar. 26, 2019), D.I.
22 132.) Eliciting testimony using constructions neither Finjan nor the Court have adopted flatly
23 abridges that law.

24 Further, infringement contentions are not a recognized source for claim construction. Post-

patent documents—such as contentions—that do not help establish what claim terms meant at the

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