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**UNITED STATES DISTRICT COURT**  
**NORTHERN DISTRICT OF CALIFORNIA**  
**SAN JOSE DIVISION**

FINJAN LLC., a Delaware Limited Liability  
Company,

Plaintiff,

vs.

SONICWALL, INC., a Delaware  
Corporation

Defendant.

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

**DEFENDANT SONICWALL INC.'S  
RESPONSE TO FINJAN'S MOTION IN  
LIMINE NO. 1 TO PRELUDE TESTIMONY  
ON WRITTEN DESCRIPTION FROM  
SONICWALL'S TECHNICAL EXPERTS**

Date: March 18, 2021  
Time: 1:30 PM  
Courtroom: 3, 5<sup>th</sup> Floor  
Judge: Hon. Beth Labson Freeman

**TABLE OF REFERENCED EXHIBITS<sup>1</sup>**

September 4, 2020 Expert Report of Dr. Avi Rubin Regarding Invalidity of U.S. Patent No. 8,225,408, U.S. Patent No. 7,975,305, U.S. Patent No. 7,613,926, and U.S. Patent No. 6,965,968	Ex. 42
September 4, 2020 Expert Report of Dr. Kevin Almeroth on Invalidity of U.S. Patent Nos. 6,154,844 and 8,141,154	Ex. 43
September 4, 2020 Expert Report of Patrick McDaniel Regarding the Invalidity of the '494 and '780 Patents	Ex. 44

<sup>1</sup> All exhibits are attached to the Declaration of Jarrad M. Gunther.

## I. INTRODUCTION

The Federal Circuit and district courts have confirmed that, in conducting a written description analysis, it is appropriate to use the scope of the claims necessary for the plaintiff's infringement case. Finjan ignores this law and mischaracterizes the written description analyses of SonicWall's experts. In reality, Finjan is attempting a late summary judgment motion because Finjan disagrees with the opinions of SonicWall's experts. That challenge would have failed even if timely, but the question here is simply whether SonicWall's experts used a legally improper methodology. They did not.

## II. ARGUMENT

### A. Legal Standard

#### 1. Standard for Written Description

Compliance with the written description requirement is a question of fact. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1355 (Fed. Cir. 2010). “[T]he purpose of the written description requirement is to ‘ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.’” *Id.* at 1353-54 (citations omitted). In determining whether the written description requirement is met, courts analyze “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* at 1351. “[T]he purpose of the written description requirement is to ‘ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.’” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 920 (Fed. Cir. 2004) (citation omitted). Even a claim term that has been construed by the Court can render a claim invalid under 35 U.S.C. § 112. *See, e.g., Auto. Techs. Int’l, Inc. v. BMW of N. Am., Inc.*, 501 F.3d 1274, 1285 (Fed. Cir. 2007) (“ATI sought [during claim construction] to have the scope of the claims . . . include both mechanical and electronic side impact sensors. It succeeded, but then was unable to demonstrate that the claim was fully enabled.”).

#### 2. Plaintiff’s Infringement Theory Is Highly Relevant To The Written Description Inquiry

1 As a threshold issue, the written description requirement is dependent on the scope of the  
2 claims. The written description analysis thus requires both “an inquiry into the specification,” and  
3 “an inquiry into the scope of the invention.” *Verinata Health, Inc. v. Ariosa Diagnostics, Inc.*, C.A.  
4 No. C 12-05501 SI, 2014 U.S. Dist. LEXIS 57519, at \*7 (N.D. Cal. Apr. 23, 2014); *see also*  
5 *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1346 (Fed. Cir. 2005) (“Although  
6 the specification would meet the requirements of section 112 with respect to a claim directed to that  
7 particular engine, it would not necessarily support a broad claim to every possible type of fuel-  
8 efficient engine, no matter how different in structure or operation from the inventor’s engine.”).

9 In view of this required framework, it is permissible for an expert to consider the plaintiff’s  
10 infringement allegations regarding a given claim element to determine the scope of the claim  
11 necessarily encompassed by those allegations. This is because infringement contentions describe  
12 “the scope of what [a plaintiff] asserts is claimed by the patents” and therefore impact a defendant’s  
13 written description defenses. *Verinata Health*, 2014 U.S. Dist. LEXIS 57519, at \*7 (allowing  
14 defendant to amend its written description defenses in invalidity contentions after plaintiff amended  
15 its infringement contentions to expand the asserted scope of its claims).

16 It is well established that if a patentee seeks a broad claim scope for infringement, there must  
17 be adequate disclosure in the specification for that claim scope to be valid. *Cf. Liebel-Flarsheim Co.*  
18 *v. Medrad, Inc.*, 481 F.3d 1371, 1380 (Fed. Cir. 2007) (“The irony of this situation is that Liebel  
19 successfully pressed to have its claims include a jacketless system, but, having won that battle, it  
20 then had to show that such a claim was fully enabled, a challenge it could not meet. The motto,  
21 ‘beware of what one asks for,’ might be applicable here.”). A defendant (and its experts) need not  
22 agree with the plaintiff’s interpretation of the scope of the claim, but can opine that if plaintiff’s  
23 assertions are correct for purposes of infringement, it must also be correct for purposes of invalidity.  
24 *Amgen Inc. v. Hoechst Marion Rouse*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (“[C]laims are  
25 construed the same way for both invalidity and infringement.”).

26 The Federal Circuit has recognized the propriety of this type of analysis. For example, in  
27 *Rivera v. ITC*, 857 F.3d 1315, 1319 (Fed. Cir. 2017), the Federal Circuit noted “[b]oth parties  
28 analyze[d] the written description issue under the assumption that the asserted claims read on

1 Solofill's K2 and K3 cup-shaped containers.” 857 F.3d at 1319. It found “written description support  
2 for broad claims covering a receptacle with integrated filter such as Solofill's accused products and  
3 Rivera's Eco-Fill products is lacking.” *Id.* at 1321; *see also Auto. Techs.*, 501 F.3d 1274 at 1285.

4 Similarly, as stated in *Ware*, “[t]he issue here is whether or not the '592 specification supports  
5 claim 1 as now asserted by plaintiffs in order to sustain their charge of infringement. It is these  
6 assertions by plaintiffs that give rise to Section 112(1) issues.” *Ware v. Abercrombie & Fitch Stores*  
7 *Inc.*, C.A. No. 4:07-CV-00122 RLV, 2011 WL 13322747, at \*20 (N.D. Ga. Oct. 17, 2011), report  
8 and recommendation adopted, C.A. No. 4:07-CV-00122-RLV, 2012 U.S. Dist. LEXIS 206575, 2012  
9 WL 13134065 (N.D. Ga. Mar. 1, 2012). “If claim 1 is read broadly to capture defendants' systems,  
10 the '592 patent is invalid under Section 112(1). If claim 1 is construed to cover that which is disclosed  
11 in the '592 specification, defendants have not infringed.” *Id.* at \*28.

12 Further, in *Visteon 1*, the court denied Visteon’s motion for summary judgment on Garmin's  
13 § 112 defenses, stating that Garmin’s expert “ties his opinions both to the full scope of the claims, as  
14 interpreted by him based upon Visteon's infringement contentions, and to the time of filing.” *Visteon*  
15 *Glob. Techs., Inc. v. Garmin Int'l, LLC*, C.A. No. 10-cv-10578, 2015 U.S. Dist. LEXIS 33306, at  
16 \*31 (E.D. Mich. Mar. 18, 2015) (“*Visteon 1*”). Visteon then brought a motion *in limine* to exclude  
17 Garmin’s § 112 defenses that were allegedly directed to the accused products, and the court agreed  
18 with the Special Master’s Report and Recommendation denying that motion as well. *Visteon Glob.*  
19 *Techs., Inc. v. Garmin Int'l, Inc.*, C.A. No. 10-cv-10578, 2016 U.S. Dist. LEXIS 145316, at \*12 (E.D.  
20 Mich. Oct. 20, 2016) (“*Visteon 2*”). The Special Master stated “only at trial will the theoretical  
21 construction suggested by Dr. Michalson (based on Visteon's infringement contentions) become real  
22 or vanish. At trial, Visteon will have to take a stand, but it has not done so in the motion *in limine*,  
23 and thus its effort to block Garmin's §112 defense is still premature.” *Visteon Glob. Techs., Inc. v.*  
24 *Garmin Int'l, Inc.*, C.A. No. 2:10-cv-10578-PDB-DRG, 2016 U.S. Dist. LEXIS 145816, at \*27 (E.D.  
25 Mich. Aug. 10, 2016) (“*Visteon 2 Special Master Report*”). The Special Master also noted:

26 [W]ere Visteon to present an understanding of the '060 Patent claims that actually align with  
27 the patent disclosure, Garmin would have no need for its § 112 defenses. But if Visteon  
28

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