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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)

CLAIM CONSTRUCTION ORDER

On September 25 and 26, 2017, the Court held a hearing to construe certain terms and phrases of the following patents: U.S. Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; 9,219,755; and 7,975,305. The parties submitted briefing in accordance with this District’s local patent rules and the case management order. A tutorial was presented by both sides to assist the Court with the history and background of the patents.

The Court requested further briefing regarding certain terms. Having now considered all the submissions of the parties, the arguments of counsel and for the reasons set forth at the hearing and herein, the Court hereby enters the claim constructions set forth below.

1 **A. “Downloadable” in U.S. Patent Nos. 6,154,844; 6,804,780; 8,079,086;**
2 **9,189,621 and 9,219,755**

3 The parties seek construction of the term **Downloadable** as it is used in five of the
4 patents at issue. This claim term can be traced through two branches of the family tree of
5 this patent (*see* Attachment A) with somewhat differing definitions. The Court however
6 concludes that the variations between the definitions can be reconciled and the
7 specifications in their entirety give notice of what is encompassed by the claim term
8 **Downloadable** to one of skill in the art.

9 **Downloadable** initially appears as a defined term in the specification of the
10 6,167,520 patent, and its continuation the 6,480,962 patent, as *a small executable or*
11 *interpretable application program which is downloaded from a source computer and run*
12 *on a destination computer.*

13 The specification of the 6,092,194 patent, and its continuation the ‘780 patent (which
14 is at issue in this litigation), define **Downloadable** *as an executable application program*
15 *which is downloadable from a source computer and run on the destination computer.* The
16 specification however provides as examples of a **Downloadable**, application programs
17 such as Java™ applets, known as little application programs in machine language, and
18 JavaScripts™ scripts, an interpretable application program. These examples are in accord
19 with the definition, incorporated by reference, set forth in the ‘520 patent. The ‘194 patent
20 and its progeny therefore conform to the ‘520 patent’s definition of **Downloadable** as *small*
21 *executable or interpretable application programs* through the use of the examples in the
22 specifications. The Court finds that one of skill in the art would be able to ascertain what
23 is claimed as a **Downloadable** in the context of these patents, and that in light of the
24 examples provided in the ‘194 patent specification, concludes that the meaning of
25 **Downloadable** is consistent with the definition provided in the ‘520 patent.

26 The ‘844 patent (which is at issue in this litigation) defines **Downloadable** *as an*
27 *executable application program which is downloadable from a source computer and run*
28 *on the destination computer* and also includes references to small executable and

1 interpretable application programs as examples of a **Downloadable**. The '844 patent
2 incorporates by reference the '520 patent and '194 patent. The Court finds that the
3 definition of **Downloadable** based on the '844 patent specification, the examples provided
4 therein and the incorporation of the '520 patent and the '194 patent, informs one of skill in
5 the art with reasonable certainty the scope of the invention. The entirety of the
6 specification's description would inform that **Downloadable** includes executable and
7 interpretable application programs, in accordance with the examples and incorporated
8 references.

9 The '822 patent is a Continuation in Part of both the '962 patent and '780 patent and
10 incorporates those patents by reference. Its continuation patents, including the '086 patent,
11 '621 patent and '755 patent, which are at issue in this litigation, do not include a definition
12 of **Downloadable** in the specification but incorporate by reference the '962 patent and the
13 '780 patent, and their definitions and examples of a **Downloadable**.

14 The Court finds that the two branches of the family tree of the patents at issue inform
15 that a **Downloadable** in the context of these patents means a *small executable or*
16 *interpretable application program which is downloaded from a source computer and run*
17 *on a destination computer*. This construction comports with the plain definition set forth
18 in the '520 patent and the '962 patent, and is supported by the written description including
19 the definition and the examples set forth in the '194 patent and its progeny, and in the
20 entirety of specification of the '844 patent.

21 The Court therefore construes the term **Downloadable** in all five patents as *a small*
22 *executable or interpretable application program which is downloaded from a source*
23 *computer and run on a destination computer*.

1 **B. U.S. Patent No. 6,154,844**

2 The parties sought construction of the following phrase appearing in various claims of
3 the '844 patent: **before the web server makes the Downloadable available to web**
4 **clients**. The Court's construction for this term is: *Before the Downloadable is available*
5 *on a web server to be called up or forwarded to a web client*. ('844 @ Col. 3:32-52; Col.
6 4:65 - Col. 5:13; Figure 1.)

7 **C. U.S. Patent No. 6,804,780**

8 The parties sought construction of the following terms and phrases appearing in
9 various claims of the '780 patent. The Court's constructions for these terms are:

Claim Term	COURT'S CONSTRUCTION
software components required to be executed by the Downloadable	<i>components of code that the Downloadable is required to execute</i> (agreed construction)
ID generator	Defendant's request for application of 112 ¶6 denied. "ID generator" is not a nonce term as advocated by Defendant. It is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier.
performing a hashing function on the Downloadable and the fetched software components to generate a Downloadable ID	<i>performing a hashing function on the Downloadable together with its fetched software components</i> (Adopting PTO Construction from the IPR of the '780 patent April, 2016.)

1 **D. U.S. Patent No. 7,975,305**

2 The parties sought construction of the following phrase appearing in various claims
3 of the '305 patent, **network interface, housed within a computer**. Defendant's proposed
4 construction that "housed within a computer" necessarily limits the structure of the network
5 interface to a hardware component is declined. The specification includes software
6 interface examples. The Court therefore finds in the context of the patent, the use of
7 "housed" in contrast to "stored" does not dictate that the claim be limited to hardware
8 components. To the extent clarification is required the Court construes this phrase as
9 *network interface, contained within the computer*.

10 The parties agreed construction for **database, a collection of interrelated data**
11 *organized according to a database schema to serve one or more applications*, is adopted.

12 **E. U.S. Patent No. 8,079,086**

13 The parties sought construction of the following terms appearing in various claims
14 of the '086 patent. The Court's constructions for these terms are:

Claim Term	COURT'S CONSTRUCTION
<p>15 appended Downloadable</p> <p>16</p> <p>17</p> <p>18</p> <p>19</p> <p>20</p> <p>21</p> <p>22</p> <p>23</p> <p>24</p> <p>25</p>	<p>15 <i>a Downloadable with a representation of the</i></p> <p>16 <i>DSP data attached to the end of the</i></p> <p>17 <i>Downloadable</i></p> <p>18 Declaration of Dr. Spafford, ¶¶36-39, and</p> <p>19 references cited therein, that one skilled in the</p> <p>20 art at the time would understand "append" to</p> <p>21 mean attach or add to the end of the existing file.</p> <p>22 The claim recites appending a representations of</p> <p>23 the DSP data to the Downloadable indicating an</p> <p>24 order.</p>
<p>26 destination computer</p> <p>27</p> <p>28</p>	<p>26 <i>Separate computer receiving the appended</i></p> <p>27 <i>Downloadable</i></p>

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