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14 **IN THE UNITED STATES DISTRICT COURT**
 15 **FOR THE SOUTHERN DISTRICT OF CALIFORNIA**
 16 **SAN DIEGO DIVISION**

17 FINJAN, INC., a Delaware Corporation,
 18
 19 Plaintiff,
 20 v.

21 ESET, LLC, a California Limited
 22 Liability Corporation, and ESET SPOL.
 23 S.R.O., a Slovak Republic Corporation,
 24
 25 Defendants.

26 ESET, LLC, a California Limited
 27 Liability Corporation, and ESET SPOL.
 28 S.R.O., a Slovak Republic Corporation,
 29
 30 Counterclaim-Plaintiffs,
 31 v.

32 FINJAN, INC., a Delaware Corporation,
 33
 34 Counterclaim-Defendant.

Case No. 3:17-cv-00183-CAB-BGS

[REDACTED]

**MEMORANDUM OF POINTS AND
 AUTHORITIES IN SUPPORT OF
 PLAINTIFF FINJAN, INC.’S
 OPPOSITION TO DEFENDANTS ESET,
 LLC AND ESET, SPOL. S.R.O.’S
 MOTION FOR SUMMARY
 JUDGMENT OF UNENFORCEABILITY
 OF THE ‘621, ‘755, AND ‘086 PATENTS,
 AND OF INVALIDITY OF CLAIMS 1, 5,
 6, 7, 10, 11, 13, AND 14 OF THE ‘6321
 PATENT ON THE BASIS OF
 COLLATERAL ESTOPPEL**

Date: May 28, 2019

Dept.: 4C

Judge: Cathy Ann Bencivengo

PER CHAMBERS RULES, NO ORAL
 ARGUMENT UNLESS ORDERED BY
 THE COURT

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1 **I. INTRODUCTION**

2 Defendants Eset, LLC and Eset spol. s.r.o.'s (collectively, "Eset") Motion for
3 Summary of Judgment of Unenforceability of the '621, '755 and '086 Patents and
4 Invalidity of the '621 Patent on the Basis of Collateral Estoppel ("Motion") should be
5 denied because (1) Finjan was forthcoming during prosecution of its patents and made
6 no misrepresentations or omissions, let alone material misrepresentations or omissions,
7 and, (2) at a minimum, Eset offers no evidence that the single most reasonable inference
8 from Finjan and its prosecution counsel's conduct was to intentionally deceive the
9 patent examiner. Further, the claims of the '621 and '962 Patent are materially different
10 thus precluding a finding of collateral estoppel. Thus, Eset's Motion be denied and
11 Finjan's Motion for Summary Judgment of No Inequitable Conduct (Doc. No. 509,
12 "Finjan's Motion") should be granted.

13 **II. FACTUAL BACKGROUND**

14 Finjan disagrees with Eset's improperly argumentative purported "Summary of
15 Undisputed Facts." The relevant facts are set forth in Finjan's Argument below.

16 **III. ARGUMENT**

17 **A. Eset Is Not Entitled to Summary Judgment of Unenforceability Based**
18 **on Inequitable Conduct**

19 **1. There Is No Evidence of Inequitable Conduct During**
20 **Prosecution of the '086 Patent**

21 Eset cannot demonstrate by clear and convincing evidence each of the elements
22 of inequitable conduct are present.¹

23 **No Evidence of a Misrepresentation or Omission.** Eset cannot demonstrate by
24 clear and convincing evidence a misrepresentation or omission during the prosecution of

25 _____
26 ¹ Inequitable conduct requires that (1) an individual associated with the filing and
27 prosecution of a patent application made an affirmative misrepresentation of a material
28 fact, failed to disclose material information, or submitted false material information; and
(2) the individual did so with a specific intent to deceive the PTO. *Exergen Corp. v.*
Wal-Mart Stores, Inc., 575 F.3d 1312, 1327 n.3 (Fed. Cir. 2009).

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