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 14 FINJAN, INC.

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

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

21 v.

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

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

32 v.

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

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

**MEMORANDUM OF POINTS AND
 AUTHORITIES IN SUPPORT OF
 PLAINTIFF FINJAN, INC.’S
 OPPOSITION TO DEFENDANT’S
 RENEWED MOTION FOR
 SUMMARY JUDGMENT OF
 PROSECUTION HISTORY
 DISCLAIMER FOR U.S. PATENT NO.
 6,154,844**

Judge: Hon. Cathy Ann Bencivengo

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

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I. INTRODUCTION

Eset’s “Renewed Motion for Summary Judgment of Prosecution History Disclaimer For U.S. Patent No. 6,154,844” (“Motion”) should be denied because Eset’s Motion is both substantively without merit and procedurally improper.

Eset’s untimely “disclaimer” argument is baseless because Finjan never made the “clear and unmistakable disavowal” of claim scope of the term “before a web server makes the Downloadable available to web clients,” which is necessary to find disclaimer of this term. Indeed, Finjan never limited the invention to a specific location or device in a network or excluded network gateway devices as being covered, let alone an “unmistakable disavowal” for these. The fact that multiple judges have interpreted applicant’s statements to find no disclaimer shows that the statements that Finjan made during prosecution are, at a minimum, subject to other “reasonable interpretations,” which precludes a finding of disclaimer under the law. *See Mass. Inst. of Tech. v. Shire Pharm., Inc.*, 839 F.3d 1111, 1119 (Fed. Cir. 2016) (“Where the alleged disavowal is ambiguous, or even ‘amenable to multiple reasonable interpretations,’ we have declined to find prosecution disclaimer.”).

Additionally, there is nothing to renew, as the Court ordered that the only open issue was that it would review the infringement case that Finjan would present at trial to determine whether Finjan had applied the Court’s claim construction. Doc. No. 702 at 2. Since the trial ended before the close of evidence, this issue is not properly before the Court. Additionally, Eset’s Motion is procedurally improper because it raises the claim construction issue of “disclaimer,” as opposed to the “prosecution history estoppel” issue it sought leave to raise (which relates only to infringement under the doctrine of equivalents). Eset was not given permission to file a brief on this completely different legal doctrine of disclaimer, or to propose new constructions at this late stage in the case for terms the Court already construed after extensive consideration. To do so now after

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