NICOLA A. PISANO, CA Bar No. 151282
NicolaPisano@eversheds-sutherland.com
JOSE L. PATIÑO, CA Bar No. 149568
JosePatino@eversheds-sutherland.com
JUSTIN E. GRAY, CA Bar No. 282452
JustinGray@eversheds-sutherland.com
SCOTT A. PENNER, CA Bar No. 253716
ScottPenner@eversheds-sutherland.com
EVERSHEDS SUTHERLAND (US) LLP
12255 EL CAMINO REAL, SUITE 100
SAN DIEGO, CALIFORNIA 92130
TELEPHONE: 858.252.6502
FACSIMILE: 858.252.6503

Attorneys for Defendants and Counter-Plaintiffs
ESET, LLC and ESET, SPOL. S.R.O.

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,

Plaintiff,

v.

ESET, LLC, et al.,

Defendants.

AND RELATED COUNTERCLAIMS.

Case No. 3:17-cv-0183-CAB-BGS

ESET, LLC AND ESET, SPOL. S.R.O.'S REPLY BRIEF IN SUPPORT OF RENEWED MOTION FOR SUMMARY JUDGMENT OF INVALIDITY BASED ON INDEFINITENESS OF THE TERM "DOWNLOADABLE"

Judge: Hon. Cathy Ann Bencivengo

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

I. INTRODUCTION

Finjan's Opposition rewrites this Court's claim construction for "Downloadable," mischaracterizes the irreconcilable testimony of Finjan's expert witnesses and luxuriates in *non sequiturs*. ESET's renewed motion on indefiniteness of "Downloadable" demonstrated that Finjan's experts are hopelessly unable to assign ***any*** upper bound to the term. D.I. 806-1. At trial, Dr. Cole sidestepped the indefiniteness issue by testifying that the term "small" in the Court's construction is ***unrelated*** to size, but instead hinges on "installability" of the Downloadable. Ignoring this Court's claim construction, Finjan proclaims that "Downloadable" is properly construed as "a ~~small~~ ***non-installed*** executable or interpretable application program which is downloaded from a source computer and run on a destination computer." Finjan argues that its new definition is totally consistent with its experts' prior testimony. It plainly is not.

Finjan's Opposition also is at war with itself. Finjan first argues that the Court cannot decide ESET's motion without hearing from Dr. Spafford. But Finjan then contends that Dr. Spafford did not opine on "small," and thus should not be permitted opinions at trial "that were not in his expert report." So, the Court need not wait for Dr. Spafford's testimony after all. Finjan also argues that fact issues require the Court to hear testimony from Finjan's other experts. Yet none of those other experts – Drs. Medvidovic, Mitzenmacher, Goodrich, or Jaeger – opined on "small" in their expert reports, and should not be permitted to testify at trial inconsistently with their reports or deposition testimony. Finjan cannot create a triable issue relying on disagreements between ***its own experts***.[1]

Finjan's Opposition fails to identify a meaningful upper bound for its asserted claims that is consistent with this Court's formulation. The evidence is abundant, clear, and convincing that the term "Downloadable" is indefinite.

[1] Finjan wrongly contends that Dr. Spafford never opined that the term "Downloadable" was indefinite. But Dr. Spafford testified that Downloadable is indefinite even without the word "small" because it encompasses interpretable and executable programs, which

II. ARGUMENT

A. "Downloadable" As Construed from the Intrinsic Record

Dr. Cole's novel construction of "Downloadable" proffered at trial is utterly at odds with the intrinsic evidence. As set forth in this Court's claim construction analysis for "Downloadable," the concept of "*a **small** executable or interpretable application program*" is introduced in the definition provided in the '520 patent and the '962 patent. D.I. 195 at 2 (italics in original). The Court noted that the '194 and '780 patents define "Downloadable" without the "*small*" or "*interpretable application program*" limitations. *Id.* (italics is original). The '844 patent incorporates by reference the '520 and '194 patents, and is a continuation-in-part of the '962 and '780 patents. *Id.* at 3. The '086, '621, and '755 patents are continuations of the '844 patent; none includes a definition of "Downloadable", but incorporates by reference both the '962 and '780 patents. *Id.*

At the *Markman* Hearing on September 25-26, 2017, the Court noted the asserted patents are continuations of earlier patents that include different definitions of the term Downloadable; thus, there is no principled way to conclude that Downloadable covers both executable and interpretable programs (as Finjan urged) without including "small" – an adjective integral to the inventors' explicit definition. Based on the record, this Court concluded that "Downloadable" should be consistently construed for all five asserted patents as "a ***small*** executable or interpretable application program which is downloaded from a source computer and run on a destination computer." D.I. 195 at 2.

B. No Finjan Expert Could Determine the Scope of "Small."

As demonstrated in ESET's original motion for summary judgment of indefiniteness (D.I. 478-1), ESET sought clarification from Finjan's experts during expert discovery on what one of skill in the art would have understood as the upper boundary of a "Downloadable" to qualify as "small." If no such upper bound can be identified, the claim is indefinite for failing to fulfill the "public notice" function of claims. That is, the public, based on the intrinsic evidence, must be able to determine what infringes and what does not.

Finjan's experts are all over the proverbial lot, and do not agree whether there is an upper bound to size within six to nine orders of magnitude, or whether small is static or changes as technology develops. Like the test for obscenity in *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964) ("I know it when I see it"), Finjan's experts' upper bound for "small" was "contextual": every file capable of being processed by ESET's software qualified as "small" for infringement of the asserted patents, even if none could identify a file that was "not small." Finjan's definition of small is infinitely malleable and subjective; Finjan's citations to its experts' testimony provide no clarity: "***reasonable*** size" (Dr. Cole); "***part*** of a ***piece*** of content you're downloading as ***part*** of a web page" (Dr. Medvidovic); "would say ***there's a range somewhere***" (Dr. Mitzenmacher); and "small is ***a relative term***" (Dr. Goodrich). Opp. at 4:19-20.

C. Finjan's Epiphany Regarding Installability

Forewarned by ESET's initial motion for summary judgment, Finjan arrived at trial with a brand spanking new definition of "small" found nowhere in its experts' reports and unuttered during expert deposition. Not wishing to concede to any upper bound, Dr. Cole reluctantly testified at trial that a two ***terabyte*** file meets his definition of "small" – because "small" has ***nothing to do with size***![2] Dr. Cole disavowed his deposition testimony that, for the '844 patent, a small file "wouldn't be multiple gigs," and instead pushed Finjan's new construction that "small" depends only upon whether or not the Downloadable is ***installed*** on the user's computer. *See, e.g.*, D.I. 805 (Trial Testimony Day 3 – Dr. Cole) at 397:12-400:6; 403:11-404:2. Thus, as Dr. Cole opined, "the definition of ***small is not based on a number***. ***It's based on whether it requires installation or not*** …" *Id.* at 408:2-11 (emphasis added).

Apart from rewriting this Court's construction of Downloadable (which construction is based on the intrinsic materials), Dr. Cole's new construction creates further chaos and ambiguity because it (1) is untethered from the intrinsic evidence; (2) was not understood or apparent to any of Finjan's experts or Dr. Spafford during the

expert testimony period; and (3) creates further confusion as to what constitutes a Downloadable. More particularly, under Dr. Cole's substitute construction, the very same "***file could be small if it doesn't require installation, [but] it won't be small if it requires installation***" and thus "***small depends on the function***." *Id.* at 414:8-14; 415:7-15. If the word "small" (the definition of which specifically references size) actually means "non-installed," then size just doesn't matter and the common every day understanding of the word "small" has lost all meaning. If it doesn't mean non-installed, then the upper bound of "small" remains undefined, and a further definition is required regarding what "installed" means. Indeed, an executable program may be either installed or not, so under Finjan's new construction, the ***same file*** could infringe if installed, but not infringe if not installed! Rather than offering clarity, Dr. Cole's trial definition only descends further down the rabbit hole. This Court need not, and should not, follow.

D. <u>The Arguments in Finjan's Opposition Fail.</u>

Finjan's brief proffers three points of opposition to ESET's motion: (1)(a) Dr. Cole's trial testimony "confirmed" the definiteness of the term small; (1)(b) Dr. Spafford did not opine that the term "small" was indefinite; (2) the Court should revise its construction of Downloadable to preserve validity by ignoring the word "small" (as other courts have done); and (3) decision of ESET's motion should await creation of a "complete" record. None of Finjan's arguments is credible, much less persuasive.

1. <u>Dr. Cole's New Construction Is Confirmed by Nothing.</u>

As discussed *supra*, Finjan's newfound construction of "small" as "installed" did not occur, even to Finjan, until it was confronted with the stark reality that Finjan's experts could not answer the simple question: "how big is not small"? Finjan's experts' answers diverged from between six to nine orders of magnitude, thus clearly and convincingly establishing indefiniteness of the term "Downloadable." *See generally*, D.I. 478-1; D.I. 623 at 4:11-20; D.I. 806-1 at 4-11, 16:12-11. Dr. Cole's revised construction at trial tried to sidestep entirely the issue of relative size. D.I. 806-1 at

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