

1 NICOLA A. PISANO, CA Bar No. 151282
NicolaPisano@eversheds-sutherland.com
2 JOSE L. PATIÑO, CA Bar No. 149568
JosePatino@eversheds-sutherland.com
3 JUSTIN E. GRAY, CA Bar No. 282452
JustinGray@eversheds-sutherland.com
4 SCOTT A. PENNER, CA Bar No. 253716
ScottPenner@eversheds-sutherland.com
5

6 **EVERSHEDS SUTHERLAND (US) LLP**
12255 EL CAMINO REAL, SUITE 100
7 SAN DIEGO, CALIFORNIA 92130
TELEPHONE: 858.252.6502
8 FACSIMILE: 858.252.6503

9 Attorneys for Defendants and Counter-Plaintiffs
ESET, LLC and ESET, SPOL. S.R.O.
10

11 **UNITED STATES DISTRICT COURT**
12 **SOUTHERN DISTRICT OF CALIFORNIA**

13 FINJAN, INC.,
14 Plaintiff,
15 v.
16 ESET, LLC, et al.,
17 Defendants.
18

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 PROSECUTION
HISTORY DISCLAIMER FOR U.S.
PATENT NO. 6,154,844**

Judge: Hon. Cathy Ann Bencivengo

19 AND RELATED COUNTERCLAIMS.
20
21
22
23
24
25
26
27
28

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

1 **I. OVERVIEW**

2 Finjan's Opposition argues that this Court did not intend to permit ESET to renew
3 its motion for a determination that, in view of the prosecution history of the '844 patent,
4 the term "web server" in that patent's claims cannot be read on a network gateway. Yet
5 Finjan's Opposition argues that the Court only granted leave to file a motion on
6 "prosecution history estoppel" relating to doctrine of equivalents, not prosecution history
7 disclaimer. ESET's prior motion (D.I. 481-1), the sidebar of colloquy during Dr. Cole's
8 cross-examination (D.I. 809-2), and ESET's opening brief (D.I. 807-1) all were directed
9 to the foregoing determination, which makes no mention of equivalents. The Court well
10 knows what it authorized. Finjan's contention is so fundamentally dishonest that the
11 Court could grant ESET's motion for that reason alone.

12 Finjan's Opposition devotes little effort to countering the arguments advanced in
13 ESET's opening brief. Instead, the Opposition presents myriad arguments why Finjan's
14 bad-faith assertion of the '844 patent should continue to trial. None is credible, much
15 less persuasive. And Finjan's arguments are notably free of citation to the record in this
16 case. For example, Finjan urges this Court to abdicate its role as Judge in this case and
17 defer to the determinations of other Judges in courts outside this District who lack this
18 Court's extensive background and understanding of Patent Law. Finjan also argues that
19 this Court already decided a claim construction for the term "web server," but at trial this
20 Court specifically remarked that this issue was not decided as part of claim construction.
21 *See* D.I. 809-2.

22 Finjan repeatedly argues that the statements during prosecution of the '844 patent
23 were not binding because they "were not clear and unequivocal." But it is hard to
24 imagine a more binding disclaimer: Finjan distinguished Ji by arguing that in Ji's
25 network gateway, Downloadable inspection "must be done every time." Opp. at 2:22-
26 23. Yet Finjan accuses the stand-alone software on ESET's network gateway products
27 of infringement, even though ESET's products scan incoming files "every time"!
28 Notwithstanding the mistrial, Finjan's infringement case on the '844 patent was

1 complete; Finjan made its record, and it is woefully deficient.

2 Finjan's Opposition also presents novel arguments why Ji does not invalidate the
3 claims of the '844 patent, but such arguments are misplaced. Finjan's *ex post facto*
4 arguments cannot change what it *actually told* the Patent Office and *how it amended its*
5 *claims* to differentiate from Ji. The public is entitled to rely on the applicant's
6 amendments and arguments, as set forth in the prosecution history, to determine what
7 the patent terms mean. As in contract interpretation, where parole evidence plays no
8 role in interpretation absent ambiguity, the arguments (that Ji is a network gateway) and
9 amendments (that the claimed elements all are present at the inspector, and not the
10 network gateway) made by Finjan to secure allowance of the '844 patent cannot be
11 ignored to read the claims on that which Finjan disclaimed.

12 Finjan's prior success in obscuring from other courts its clear and unmistakable
13 intent to disclaim coverage by claims 1 to 21 of a network gateway is entitled to no
14 weight here. ESET's motion for summary judgment that the "web server" of the '844
15 patent cannot be met by a network gateway should be granted.

16 **II. ARGUMENT**

17 **A. Finjan Disclaimed Coverage of Network Gateways.**

18 As explained in ESET's opening brief, Finjan's arguments and amendments to
19 differentiate its alleged invention from Ji including explaining that Ji was a network
20 gateway, whereas the claimed invention constituted an "inspector" that performed *all* of
21 the steps of *receiving* a Downloadable, *generating* a first Downloadable security profile,
22 and *linking* the first Downloadable security profile to the Downloadable before a web
23 server makes the Downloadable available to web clients.

24 Finjan emphasizes that its inspector need only perform inspection of a
25 Downloadable once, whereas in Ji "the burden of examining a Downloadable for
26 suspicious code is always on the network gateway, and *must be done every time.*" Opp.
27 at 2:22-23 (emphasis in original). Despite this clear disclaimer that its claims do not
28 cover the prior art network gateway that inspects every incoming file, Finjan

1 nevertheless contends that the claims of the '844 patent cover ESET's standalone
2 network gateway software that does precisely that.¹ Moreover, whether Finjan could
3 have made arguments to the Patent Examiner about Ji "'instrumenting' applets" is
4 irrelevant. No such arguments were made during prosecution of the '844 patent. The
5 public is entitled to rely on what Finjan actually said in its arguments and amendments,
6 not what Finjan now says it could have argued.

7 Similarly, Finjan's argument that "at no time did Finjan ever state the inspector
8 cannot be on the network gateway" is belied by the Remarks portion of Finjan's
9 Response to the Patent Examiner, where Finjan characterized its invention as having
10 distinct components for the inspector *and* the network gateway:

11 Before discussing the rejections of the claims, a brief review of an
12 embodiment of Applicant's invention is helpful. A system *includes an*
13 *inspector* for generating and linking a Downloadable security profile to a
14 Downloadable before a web server makes the Downloadable available to
15 web clients. The system *also includes a network gateway* which examines
16 the Downloadable security profile for security policy violations if the
17 Downloadable security profile is deemed trustworthy.

18 D.I. 809-4 at 11 (emphasis added). It is nonsensical for Finjan to argue (as it does now)
19 that its system included an inspector *and also* a network gateway if those two distinct
20 elements are the same thing. Moreover, Finjan's claim amendments that require all of
21 the claim steps be performed at the inspector—to distinguish over Ji—would be
22 completely illusory if the inspector were located at the network gateway! *See* D.I. 807-1
23 at 8:17-9:23. And as explained in ESET's opening brief, there is no disclosure in the
24 '844 patent that the inspector of claims 1 and 15 could be located at a network gateway.
25 *Id.* at 2:12-4:6.

26 ¹ Dr. Cole claimed that ESET's network gateways infringe when they receive reputation
27 data from ESET's LiveGrid Reputation Server as well as based on analysis of files
28 passing through the network gateways using network gateway software alone. As this
Court's questioning of Dr. Cole at trial brought to the fore, the LiveGrid system, wherein
the analysis is conducted asynchronously abroad, cannot infringe because it is performed

1 **B. This Court Is Not Bound by Other Courts' Determinations.**

2 Finjan, as it has throughout this litigation, urges this Court to abdicate its role of
3 independently deciding the issues before it, and instead defer to the determinations of
4 District Court Judges not of this District. Opp. at 3:8-5:18. Those other courts have no
5 compunction about ignoring decisions from outside their districts, including this one.
6 See, e.g., *Finjan, Inc. vs. Cisco Sys., Inc.*, No. 17-cv-00072-BLF, 2018 U.S. Dist. LEXIS
7 122951, at *29 (“ESET’s claim construction ruling is from outside this District. ... the
8 Court gives little weight to the construction in ESET ...”). In view of Finjan’s
9 successful argument to the Northern District judge in the *Cisco* case that this Court’s
10 claim constructions should be accorded no deference, Finjan’s argument that “other
11 judicial decisions are entitled to deference to ensure uniformity in construction across
12 various lawsuits” (Opp. at. 12:16-25) rings particularly hollow.

13 Moreover, it is not at all apparent from Finjan’s citations to the decisions of courts
14 outside this District (based on different claim constructions) that those courts properly
15 considered the combined effect of the arguments *and claims amendments* in the
16 prosecution history of the ’844 patent. Given this Court’s many years of practice as a
17 patent litigator and as a Magistrate Judge, and in-depth knowledge of Patent Law, ESET
18 believes this Court will recognize that interplay, and its determination on the issue of
19 prosecution history disclaimer will be a definitive assessment.

20 **C. This Court Has Not Construed the Term “Web Server”.**

21 Finjan argues that “the parties disputed the proper construction of ... ‘web
22 server.’” Opp. at 5:20-6:21. Finjan faults ESET for not noting in seeking a construction
23 that Finjan had disclaimed that the web server could be a network gateway in August
24 2017. At that point in this litigation, however, Finjan’s infringement contentions were
25 an unintelligible jumble, and relied for alleged infringement on ESET’s Threatsense
26 (LiveGrid) system. It was not until Finjan served the expert report of Dr. Cole on
27 November 30, 2018, that ESET learned how Finjan intended to distort its claims to read
28 on ESET’s standalone network gateway software.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.