

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 **EVERSHEDS SUTHERLAND (US) LLP**

6 12255 EL CAMINO REAL, SUITE 100

7 SAN DIEGO, CALIFORNIA 92130

8 TELEPHONE: 858.252.6502

8 FACSIMILE: 858.252.6503

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

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

13 FINJAN, INC.,

14 Plaintiff,

15 v.

16 ESET, LLC, et al.,

17 Defendants.

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

**ESET, LLC AND ESET, SPOL. S.R.O.’S
REPLY BRIEF IN SUPPORT OF
RENEWED MOTION FOR PARTIAL
SUMMARY JUDGMENT REGARDING
THE EFFECTIVE FILING DATE OF
U.S. PATENT NO. 6,154,844**

Judge: Hon. Cathy Ann Bencivengo

19 AND RELATED COUNTERCLAIMS.
20

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

1 **I. OVERVIEW**

2 The '844 patent does not include an operative priority claim to the provisional
3 '639 application, and is entitled to an earliest effective filing date no earlier than
4 December 22, 1997. The layers of obfuscation presented in Finjan's Opposition cannot,
5 in the end, obscure that Finjan's claim of priority to the '639 provisional was defective.
6 That defect served as an independent basis – in addition to the lack of written description
7 – upon which the PTAB denied the '844 patent any earlier effective filing date. The
8 PTAB's reasoning was sound, addressed all of Finjan's tired arguments, and should
9 guide a similar determination in this action.

10 **II. FINJAN'S "FACTS" ARE INCORRECT AND INCOMPLETE.**

11 Finjan asserts as a "fact" that "the '844 [sic] Patent claims the benefit of the 1996
12 Application" and that the "PRIORITY REFERENCE TO RELATED APPLICATIONS"
13 includes the words "[t]his application claims benefit of" the 1996 provisional '639
14 application. See D.I. 814 ("Opp.") at 1:23-2:6. That assertion omits critical facts, and
15 was considered and rejected by the PTAB. Instead, the PTAB expressly found that "the
16 'PRIORITY REFERENCE TO RELATED APPLICATIONS' section of the '844 patent
17 fails to satisfy [37 C.F.R. § 1.78(a)(2)'s] requirement, because it does not 'indicat[e] the
18 relationship' of the '639 provisional, '388 application, and '097 application to the '844
19 patent" and therefore "the challenged claims are not entitled to any earlier priority date."
20 D.I. 809-3 at 35-36. That determination was independent of, and in addition to, the
21 PTAB's determination that the '388 application also lacked written description support
22 in the '639 provisional.

23 Finjan contends that it filed a Certificate of Correction for the '844 patent to
24 address its defective priority claim. Opp. at 2. Finjan's contention fails to recognize that
25 the PTAB found that "the Office denied that Request [for a Certificate of Correction] in
26 relevant part, stating that the Request was improper" and that Finjan's request "was an
27 improper attempt to perfect a claim of priority that was not found in the original
28 application." D.I. 809-3 at 36.

1 Finjan's Opposition is replete with attorney argument about prior litigations, in
2 which Finjan claims Abadi was asserted against the '844 patent, either alone or in
3 combination with other prior art. ESET was not a party to any of those of litigations,
4 which also involved different claim constructions. Opp. at 3. Collateral estoppel does
5 not apply to preclude re-litigation of an issue where the party against whom the estoppel
6 is sought did not have a full and fair opportunity to litigate the issue. *Kendall v. Visa*
7 *U.S.A., Inc.*, 516 F.3d 1042, 1050 (9th Cir. 2008) (one requirement for collateral
8 estoppel is "the person against whom collateral estoppel is asserted in the present action
9 was a party or in privity with a party in the previous action"). Unlike Finjan, which had
10 a full and fair opportunity to litigate the priority date of the '844 patent before the
11 PTAB, ESET has not yet had its day in Court. *See, e.g., Monolithic Power Sys. Inc. v.*
12 *O2 Micro Int'l Ltd.*, 476 F. Supp. 2d 1143, 1150-51 (N.D. Cal. 2007) (defendant not
13 collaterally estopped from litigating patent validity when defendant's customer litigated
14 the issue in prior litigation).

15 **III. IT IS UNDISPUTED THAT THE PTAB DETERMINED THAT THE '844**
16 **PATENT'S PRIORITY DATE IS ITS ACTUAL FILING DATE.**

17 Finjan does not dispute that the PTAB found that the '844 patent is not entitled to
18 a priority date any earlier than its actual filing date of December 22, 1997. Rather, it
19 wants this Court to ignore the PTAB's well-reasoned analysis so Finjan can have yet
20 another bite at the apple.

21 **A. Finjan Does Not Deny That the '844 Patent Fails to Comply with the**
22 **Requirements of 37 CFR § 1.78.**

23 As set forth in ESET's opening brief, the '844 patent fails to comply with 37
24 C.F.R. § 1.78(a)(2). This is a standalone reason for concluding that the challenged
25 claims are not entitled to a priority date any earlier than its filing date, and is entirely
26 independent of lack of written description support, as the PTAB also found. *See D.I.*
27 *808-1 at 11-12; see also Droplets, Inc. v. E*TRADE Bank*, 887 F.3d 1309, 1315 (Fed.
28 Cir. 2018) (a patent application must comply with 37 C.F.R. § 1.78 when referencing an

1 application to which a claim of priority is sought); MPEP § 1481.03 (to claim benefit to
2 a prior provisional application “all requirements set forth in 37 CFR 1.78(a)(1) and
3 (a)(2) must have been met in the application which became the patent to be corrected”).
4 The PTAB relied on this exact reasoning as “an independent basis for concluding that
5 the challenged claims are not entitled to any earlier priority date.” D.I. 809-3 at 35-36.

6 When a party fails to rebut a fact, the Court properly may consider that fact
7 undisputed and may grant a motion for summary judgment. Fed. R. Civ. P. 56(e); *see*
8 *also Franklin v. Smalls*, No. 09CV1067-MMA (RBB), 2013 U.S. Dist. LEXIS 33450, at
9 *15-16 (S.D. Cal. Mar. 8, 2013). Here, Finjan’s Opposition does not address that the
10 ’844 patent fails to comply with 37 C.F.R. § 1.78(a)(2). Instead, Finjan concedes that
11 fact as if it doesn’t matter. *See* Opp. at 2-3 (“Notably, the PTAB did not dispute that the
12 ’844 Patent claimed priority to the 1996 Application, ’194 Patent, or the ’520 Patent
13 under 35 U.S.C. § 120, just that ***Finjan had not complied with 37 C.F.R. § 1.78(a)(2)***
14 (1997) by not indicating the relationship of the ’194 and ’520 Patents to the ’844
15 Patent.”) (emphasis added); *see also* D.I. 809-3 at 35-36 (noncompliance with 37 C.F.R.
16 § 1.78(a)(2)’s requirements is an independent basis for concluding that the challenged
17 claims of the ’844 patent are not entitled to any earlier priority date).

18 It does matter. Because an application ***must*** comply with 37 C.F.R. § 1.78 in
19 order to claim priority to an earlier application’s filing date, and it is undisputed that the
20 ’844 patent does not comply with 37 C.F.R. § 1.78, the ’844 patent is not entitled to a
21 priority date earlier than its actual filing date of December 22, 1997. The Court need not
22 even consider the extensive arguments in Finjan’s Opposition regarding its contention
23 that the ’639 provisional contains written description support for the claims of the ’844
24 patent. It does not, as discussed in ESET’s opening brief and further below, but whether
25 or not it does is simply irrelevant. The priority claim is valid for failure to comply with
26 37 C.F.R. § 1.78(a)(2).

1 **B. The PTAB’s Well-Reasoned Analysis Found No Written Support**
2 **Earlier Than the December 22, 1997 Filing Date.**

3 The PTAB determined that the challenged claims of the ’844 patent lack written
4 description support in the ’639 provisional. D.I. 809-3 at 32-33.

5 Finjan zealously argued to the PTAB – much of which it retreads in its Opposition
6 at 9-12 – that Dr. Jaeger opines that the claims of the ’844 patent have written support in
7 the ’639 provisional. *See, e.g.*, D.I. 809-3 at 33-34. The PTAB disagreed with Finjan’s
8 arguments pointing to Dr. Jaeger’s analysis that a “web server” is disclosed in the ’639
9 provisional, concluding that Finjan “does not identify a *web server* that makes the
10 Downloadable available to web clients *after* such linking, as required by the challenged
11 claims.” *Id.* at 34. Failure to support that critical limitation of the ’844 patent claims
12 puts an end to the dispute.

13 That Dr. Jaeger opined he could find other claim limitations in the ’639
14 provisional is irrelevant because the PTAB was “not persuaded that the ’639 provisional
15 demonstrates possession by the inventors of linking a DSP to the Downloadable *‘before*
16 *a web server* makes the Downloadable available to web clients.” D.I. 809-3 at 35.
17 Finjan strives to obscure that requirement by regurgitating Dr. Jaeger’s opinion that the
18 “code scanner performs linking and that the linking can be performed before the
19 Downloadable is provided to the client.” *Opp.* at 9. But the PTAB rejected that
20 argument as well, finding “*by the time that the DSP has been linked to the*
21 *Downloadable* (e.g., *by code scanner* 325, in Patent Owner’s mapping), we understand
22 that *the Downloadable has already been received—and hence ‘made available’—by*
23 *the web server.*” D.I. 809-3 at 35 (emphasis added). These observations led to the
24 PTAB’s unescapable decision:

25 In conclusion, therefore, we are not persuaded that the inventors were in
26 possession of the subject matter of the challenged claims at any time prior to
27 the December 22, 1997, filing date of the ’648 application.

28 *Id.*

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.