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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 RESPONSE TO PLAINTIFF FINJAN, INC.'S SUPPLEMENTAL INFORMATION IN SUPPORT OF CLAIM CONSTRUCTION OF THE TERM "DOWNLOADABLE" FOR U.S. PATENT NOS. 9,189,621 AND 9,219,755

Judge: Hon. Cathy Ann Bencivengo

ESET spol. s.r.o. and ESET, LLC (collectively "ESET") respectfully submit this responsive brief regarding the term "Downloadable" for U.S. Patent Nos. 9,189,621 ("the '621 patent") and 9,219,755 ('the '755 patent") pursuant to this Court's Preliminary Claim Construction Order (D.I. 178-1 at 2).

First, Finjan's IPR submissions do not address the salient question at issue, which is whether the term Downloadable should be construed in line with the definition provided in U.S. Patent No. 6,480,962 ("the '962 patent"), one of the incorporated patents from which the inventions of the '621 and '755 patents derive their support. In both IPRs submitted by Finjan to this Court on September 29, 2017, the issue of the incorporated specifications was never raised by either party and therefore not considered by the PTAB when deciding whether to institute IPRs on the '621 and '755 patents. Moreover, neither party proposed, as ESET does here, that the construction should be consistent with the patentee's definition from the '962 patent: "a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer." D.I. 138-9 at 1:39-41. Thus, the PTAB was never presented with the argument, and did not consider, whether the incorporated specification and alternative definition should be used, and whether the alternative and contradictory construction renders the claims invalid (an issue the PTAB cannot consider during an IPR in any event).

Second, the case law is clear that when multiple specifications are incorporated by reference it is improper to incorporate only portions of those specifications. Instead, the entirety of all specifications incorporated by reference must be considered. *See Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1329 (Fed. Cir. 2001) ("When a document is 'incorporated by reference' into a host a document, such as a patent, the referenced document becomes effectively part of the host document as if it were explicitly contained therein."); *Harari v. Lee*, 656 F.3d 1331, 1335-36 (Fed. Cir. 2011) (discussing incorporating multiple patent applications into a patent specification by reference). Here, and with the term "Downloadable" for U.S. Patent Nos. 6,154,844

("the '844 patent"), 8,079,086 ("the '086 patent"), and 6,804,780 ("the '780 patent"), the Court must consult *all* of the identified incorporated-by-reference specifications and cannot pick and choose only one of the incorporated specifications. This is particularly true for the '086 patent which does not include a definition of Downloadable at all. For that patent, this Court looked only to the incorporated '780 patent specification because the '780 patent was the most recent patent from which the '086 patent claimed priority. In doing so, this Court did not also consider the incorporated '962 patent specification, which must be given equal weight. *See Joao Control & Monitoring Sys., LLC v. Protect Am., Inc.*, No. 1-14-cv-134-KY, 2015 WL 4937464, at *7-8 (W.D. Tex. Aug. 18, 2015) (finding the disputed terms indefinite – patentee not allowed to rely on definitions from one of the two incorporated references when those definitions are directly contradicted by additional statements contained in both of the references). Because the '621 and '755 patents (like the '086 patent) contain no express definition of "Downloadable" and because each of the patents incorporates the '962 patent's definition: "small … interpretable" as well as the '780 patent's contradictory definition, which leaves out the "small" and "interpretable" language, the term is indefinite.[1] The Court is required to construe the claims as the specification requires, and if the resulting construction renders the claim invalid, then that is the appropriate outcome. *See Rhine v. Casio, Inc.*, 183 F.3d 1342, 1345 (Fed. Cir. 1999) ("We have also admonished against judicial rewriting of claims to preserve validity.").

Nonetheless, to the extent the Court does not find the term indefinite due to the multiple incorporated and contradictory definitions, at the very least, there is no dispute that the asserted claims of the '621 and '755 patents are supported solely by the specification of the '962 patent. The prosecution history (D.I. 138-10 at 6-7; 138-11 at 6-9) and oral argument at the claim construction hearing, confirmed that the '962 patent specification provides the sole support for the claims. Thus, to the extent the Court

[1] The same argument applies with respect the '844 and '780 patents which also

decides to look only to the specification that provides the purported support for the alleged inventions (as opposed to all incorporated specification as the case law requires), then at the very least the term Downloadable for the '621 and '755 patents should be limited to the definition set forth in the incorporated by reference '962 patent specification: "a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer." '962 patent (D.I. 138-9) at 1:38-40.

In summary, the parties in the IPRs did not dispute the definition of "Downloadable" for the '621 and '755 patents and thus the PTAB did not consider the implications of the multiple incorporated specifications. The case law, however, is clear, that the entirety of all incorporated specifications must be considered and that it is improper to pick and choose only a subset of the incorporated disclosure. Because all of the claims that use the term Downloadable in this case are from patents that incorporate contradictory definitions, these claims should all be held invalid for indefiniteness. Nonetheless, if this Court looks to the specification providing the support for the alleged inventions, then there is no dispute that construction of Downloadable for the '621 and '755 patents should be limited to the express definition the patentee provided in the '962 patent because only the '962 patent specification provides support for the alleged inventions of the '621 and '755 patents. Therefore, Downloadable, to the extent not indefinite for the '621 and '755 patents, should be construed exactly as the patentee defined the term: "a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer." '962 patent (D.I. 138-9) at 1:38-40.

Dated: October 6, 2017

Respectfully submitted,

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