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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 SUPPLEMENTAL BRIEF REGARDING '621 PATENT

Judge: Hon. Cathy Ann Bencivengo

ESET spol. s.r.o. and ESET, LLC (collectively "ESET") respectfully submit this Supplemental Brief regarding the means-plus-function term "the plurality of operating system probes … includes means for monitoring a request sent to a downloadable engine" in claim 15 of U.S. Patent No. 9,189,621 ("the '621 patent") pursuant to this Court's Preliminary Claim Construction Order. (D.I. 178-1 at 6.)

I. INTRODUCTION

This Court ordered additional briefing specifically on the topic of "identifying the structure disclosed in the patent (the '962) that is the means for monitoring a request sent to a downloadable engine and whether the examples of the downloadable engines identified in that patent limit the means for monitoring." (D.I. 178-1 at 6.)

There is no dispute that the term at issue in claim 15 of the '621 patent is subject to 35 U.S.C. § 112, ¶ 6. It is written in "means for" language and is drafted in functional terms. Similarly, there is no dispute that the claimed function is "monitoring a request sent to a downloadable engine," precisely as stated in the claim. The only question then, as this Court recognized, is what *structure* is disclosed for performing the function. Because the specification fails to describe any structure for monitoring requests sent "***to***" a downloadable engine, ESET respectfully submits that the claim is indefinite. However, to the extent the Court finds monitoring requests to the downloadable engine is disclosed, the structure must necessarily include the downloadable engine because the *function* is monitoring a request sent *to a downloadable engine* (as opposed to requests sent to other modules or software components).

II. ANALYSIS

As discussed at length during the *Markman* hearing, there is no support for any of the alleged claimed inventions of the '621 patent within the four corners of the '621 patent specification. Instead, the only alleged support identified by Finjan is that of U.S. Patent No. 6,480,962 (D.I. 138-9, "the '962 patent"). For example, the terms "probe," "response engine," "interrupt," and "downloadable engine," which are all included as elements of dependent claim 15 of the '621 patent, appear in the '621 patent specification

only by way of incorporation of the '962 patent. Each of these terms appears prominently in the '962 patent. Figures 3 and 4 show the probes in boxes 310, 312, 314, and 316, the response engine in box 318, and the downloadable engine in box 250. *See* '962 patent at 3:55-56 ("a Java™ virtual machine 250 (i.e., the Downloadable engine 250)"); 5:26-27 ("the ActiveX™ platform (i.e., the Downloadable engine 250)"). In addition, the concept of "interrupting" is disclosed in Figure 7 at box 715 ("interrupt OS Request"). The '962 patent specification provides the only support for the alleged inventions of the '621 patent and, therefore, analysis of the structure corresponding to the functionality recited in the means-plus-function claim must come from the '962 specification.

After determining a term should be construed according to 35 U.S.C. § 112 ¶ 6, this Court must engage in a two-step process: "'First, the court must determine the claimed function. Second, the court must identify the corresponding structure in the written description of the patent that performs ***the function***.'" *Noah Sys., Inc. v. Intuit Inc.*, 675 F.3d 1302, 1311 (Fed. Cir. 2012) (quoting *Applied Med. Res. Corp. v. U.S. Surgical Corp.*, 448 F.3d 1324, 1332 (Fed. Cir. 2006)).

Here, the first step in the process is straightforward. The function is expressly set forth in the claim language, which states the means are "for monitoring a request sent to a downloadable engine." '621 patent at claim 15. Next, the corresponding structure in the written description that performs the entirety of the claimed function must be identified. Indeed, the specification itself must identify the structure that performs the recited function. *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed. Cir. 1997) ("We hold that, pursuant to this provision, structure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.").

The plurality of operating system probes are defined as items 310-316. The specification states "the security system 135*a* further includes ***operating system probes 310, 312, 314 and 316***." '962 patent at 4:19-20; *see also id.* at 6:24-25. There is no other

description in the '962 patent specification relating to the operating system probes. Similarly, the downloadable engine is identified as item 250. With respect to Figure 3, the specification teaches that "***a Java™ virtual machine 250*** (i.e., the Downloadable engine 250)" and with respect to Figure 4, the specification teaches "the ActiveX™ platform (i.e., the Downloadable engine 250)." '962 patent at 3:55-56 (emphasis added), 5:27. In other words, the downloadable engine is described as either the Java virtual machine or the ActiveX platform. In fact, at another point the specification expressly equates the downloadable engine to the Java virtual machine. *Id.* at 4:48-49 ("the Java™ virtual machine 250"). Thus, item 250, defined in the specification as the downloadable engine, is equated solely with the Java virtual machine and the ActiveX platform.

With the understanding that the operating system probes are items 310-316 and the downloadable engine is item 250, the structure must be identified that is disclosed for "monitoring request sent ***to*** a downloadable engine." '621 patent at claim 15. There is none.

There is no description that the operating system probes monitor "a request sent ***to*** a downloadable engine." Instead the specification teaches that the operating system probes 310-316 monitor requests ***from*** the downloadable engine sent ***to*** the operating system. The specification teaches that "a file management system probe 310 recognizes applet instructions ***sent to the file system*** 265 ***of operating system*** 260, a network system probe 312 recognizes applet instructions ***set [sic] to the network management system*** 270 ***of operating system*** 260, a process system probe 314 recognizes applet instructions ***sent to the process system*** 275 ***of operating system*** 260, and a memory management system probe 316 recognizes applet instructions ***sent to the memory system*** 280 ***of operating system*** 260." '962 patent at 4:20-28 (emphasis added). In other words, the operating system probes all monitor requests that are sent to ***the operating system***, not the downloadable engine. In addition, the specification teaches that the method of Figure 7 begins when the "operating system probes 310, 312, 314 and 316 in step 705 monitoring the operating system 260 ***for Operating System (OS) requests from Downloadables***

140." *Id.* at 6:25-27. Again, the purpose of the operating system probes, as taught by the specification, is to monitor requests ***from*** the downloadable engine, not ***to*** the downloadable engine as required by the claims. There are no other disclosures in the '962 patent specification regarding the operating system probes.

While Figures 3 and 4 do show a double sided arrow for communications between the operating system and the downloadable engine, that drawing depiction cannot constitute sufficient disclosure of the recited function. First, the figures do not show the probes are monitoring that communication. Second, there is no description in the specification about the probes performing any monitoring at that communication level. Third, the specification expressly states that the probes are only monitoring requests ***sent to the operating system***, not the downloadable engine as required by the claim. Because the specification lacks written description support identifying the structure corresponding to the claimed function, claim 15 is indefinite. *B. Braun*, 124 F.3d 1419 at 1424.

Nonetheless, should the Court conclude that even without express written description support, that the probes are also somehow monitoring requests sent to the downloadable engine, then the recited structure must at least include the disclosed structure for the downloadable engine. The claims recite that the function performed by the "means" is "monitoring a request sent to a downloadable engine." It would not make sense to parse the phrase and stop merely at the word "monitoring" or at the phrase "monitoring a request." Instead, the entirety of the function must find corresponding structural support in the specification. Because a "downloadable engine" has no generally understood structure and is not something that can be done by a general purpose computer without specialized programming (indeed here it is described as being part of a web browser, '962 patent at 3:37-40, and therefore clearly something that requires additional coding) it must have an express algorithm disclosed. *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1249, 1254 (Fed. Cir. 2005); *Ex parte Smith*, 108 U.S.P.Q.2d (BNA) 1198 (P.T.A.B. Mar. 14, 2013) ("opinion timeline engine" does not denote structure and must have a disclosed algorithm in the specification) (D.I. 179-2);

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