

1 NICOLA A. PISANO, CA Bar No. 151282  
npisano@foley.com

2 JOSE L. PATIÑO, CA Bar No. 149568  
jpatino@foley.com

3 JUSTIN E. GRAY, CA Bar No. 282452  
jegrays@foley.com

4 SCOTT A. PENNER, CA Bar No. 253716  
spenner@foley.com

5 **FOLEY & LARDNER LLP**  
6 3579 VALLEY CENTRE DRIVE, SUITE 300  
7 SAN DIEGO, CALIFORNIA 92130  
8 TELEPHONE: 858.847.6700  
FACSIMILE: 858.792.6773

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-0183-CAB-BGS

**ESET, LLC AND ESET SPOL. S.R.O.’S  
RESPONSIVE SUPPLEMENTAL  
BRIEF REGARDING ’621 PATENT**

Judge: Hon. Cathy Ann Bencivengo

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19  
20 AND RELATED COUNTERCLAIMS.  
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1 ESET spol. s.r.o. and ESET, LLC (collectively “ESET”) respectfully submit this  
2 Responsive Supplemental Brief regarding the means-plus-function term “the plurality of  
3 operating system probes ... includes means for monitoring a request sent to a  
4 downloadable engine” in claim 15 of U.S. Patent No. 9,189,621 (“the ’621 patent”)  
5 pursuant to this Court’s Preliminary Claim Construction Order. (D.I. 178-1 at 6.)

## 6 **I. INTRODUCTION**

7 Finjan’s attempt to identify structure for the means-plus-function term in claim 15  
8 of the ’621 patent is entirely untethered from the claim language and the specification.  
9 (See D.I. 183 at 1.) Not only does Finjan’s purported structure have nothing to do with  
10 the requirements of the claim, but there is no clear nexus, indeed there is no nexus at all,  
11 between the purported structure and the recited means as required by *B. Braun Med., Inc.*  
12 *v. Abbott Labs.*, 124 F.3d 1419 (Fed. Cir. 1997). Moreover, Finjan’s attempt to read out  
13 “downloadable engine” from the purported structure of the means-plus-function element  
14 is contradicted by Finjan’s own brief explaining that it must be part of the “function” for  
15 which structure must be identified. In light of the above, and in view of the analysis set  
16 forth in ESET’s supplemental brief (D.I. 182), there is no support in the ’621 patent or  
17 the relevant incorporated-by-reference patent, specifically U.S. Patent No. 6,480,962  
18 (D.I. 138-9, “the ’962 patent”) for identifying the structure associated with the means  
19 clause of claim 15. Claim 15 is therefore indefinite.

## 20 **II. ARGUMENT**

21 Finjan alleges that the structure for the “means for monitoring” is “a request broker  
22 programmed to perform the algorithm disclosed at Col. 4, ll. 12-18 of the ’962 patent.”  
23 (D.I. 183 at 1.) This cannot be true. Claim 15 of the ’621 patent requires “*wherein the*  
24 *plurality of operating system probes operating substantially in parallel for monitoring*  
25 *the operating system* includes means for monitoring a request sent to a downloadable  
26 engine.” (emphasis added). The claim language specifically requires that *the plurality of*  
27 *operating system probes* must include means for monitoring a request sent to a  
28 downloadable engine. Noticeably absent from Finjan’s brief is any mention of the

1 operating system probes at all. Instead, Finjan relied on a completely different portion of  
2 the specification that has no relationship, and makes no mention of, the operating system  
3 probes. Finjan identifies the “request broker,” which is item 306 in Figures 3 and 4. But  
4 the request broker, as shown in the Figures, is not interconnected with, and does not  
5 communicate with, the operating system probes. Indeed, nothing in the specification  
6 links the request broker to the operating system probes. As the Federal Circuit has held,  
7 the specification (or file history) must not only identify the structure that performs the  
8 recited function, but it must also clearly link it to the function of the claims. *B. Braun*  
9 *Med.*, 124 F.3d at 1424 (“We hold that, pursuant to this provision, structure disclosed in  
10 the specification is ‘corresponding’ structure only if the specification or prosecution  
11 history clearly links or associates that structure to the function recited in the claim.”).  
12 There is simply no link between the request broker and the “operating system probes” as  
13 required by the claims and the controlling case law.

14 Moreover, the algorithm that Finjan purports to identify makes it clear that the  
15 “event broker” cannot be associated with the identified function. Finjan identifies the  
16 following algorithmic passage as purportedly performing the recited function:

17 When a new applet requests the service of a Java class 302, the  
18 corresponding Java class extension 304 interrupts the request  
19 and generates a message to notify the request broker 306 of the  
20 Downloadable’s request. The request broker 306 uses TCP/IP  
21 message passing protocol to forward the message to the event  
22 router 308.

23 ’962 patent at 4:12-18. Finjan claims that this shows the “request broker ‘monitors a  
24 request sent to a downloadable engine’ by receiving a request from a downloadable via a  
25 downloadable engine and forwarding a message regarding the Downloadable’s request to  
26 an event router.” (D.I. 183 at 2.) But Finjan’s statement of what this algorithm  
27 purportedly shows is completely at odds with the actual text. First, there is nothing in the  
28 passage that talks about “monitoring.” Finjan substituted the verb “monitoring” of the

1 claim with the verb “receiving” – which does not even appear in the specification. Apart  
2 from this linguistic sleight-of-hand, monitoring is very different than receiving.  
3 Monitoring is an active process whereas receiving is a passive one, a distinction that is  
4 clearly spelled out in the specification. For the operating system probes, the specification  
5 teaches: “[m]ethod 700 begins with operating system probes 310, 312, 314, and 316 in  
6 step 705 **monitoring** the operating system 260 for Operating System (OS) requests from  
7 Downloadables 140.” ’962 patent at 6:24-27 (emphasis added). Thus, the operating  
8 system probes are actively watching (i.e. monitoring) the operating system to see if a  
9 request comes in. By contrast, the “request broker” is described passively: “Java class  
10 extension...generates a message **to notify the request broker.**” ’962 patent at 4:13-15.  
11 The terminological distinction drawn by the specification between makes clear that the  
12 request broker is not “monitoring” anything.

13 In addition, the request broker does not even receive the “request,” as is required  
14 by the claim (“for monitoring a **request**...”). Instead, the specification teaches that the  
15 request broker gets a “message” meant to “notify” the request broker that some request  
16 has been made, but the specification does not teach that request broker ever actually  
17 receives the request (as opposed to the notification message). The lack of nexus between  
18 what the event router actually receives and the claimed functionality of the means-plus-  
19 function term is fatal to Finjan’s argument. *See B. Braun Med.*, 124 F.3d at 1424.

20 Finally, Finjan erroneously argues that the “request sent to the downloadable  
21 engine” should be interpreted as the request made by the Downloadable to the  
22 downloadable engine. (D.I. 183 at 2.) But that interpretation does not comport with the  
23 claims. One of the elements of independent claim 10, from which claim 15 depends,  
24 includes the term “a request made by a Downloadable.” Claim 15 does not use the  
25 definite article “the” in front of “a request sent to a downloadable engine” and therefore it  
26 must be a different request than the request of claim 10. If the request of claim 10 is the  
27 request from the Downloadable to the downloadable engine, then the request of claim 15  
28 must be a different request being sent to the downloadable engine. As explained in

1 ESET’s opening brief on this issue, the specification lacks any written description of  
2 monitoring of a request being sent “to the downloadable engine” as required by the  
3 claims. (D.I. 182 at 3-4.) Indeed, as just discussed above, even if the request in claim 10  
4 and the request in claim 15 *were* the same request made from the Downloadable to the  
5 downloadable engine, then neither the operating system probes nor the request broker  
6 would be monitoring *that* “request.” Instead, claim 10 states the “operating system  
7 probes monitor an *event* caused from [the] request” and the event router passively gets “a  
8 *message*.” ’962 patent at 4:13-14; ’621 patent at claim 10. Once again, the lack of nexus  
9 between what the event router actually receives and the claimed functionality of the  
10 means-plus-function term is fatal to Finjan’s argument. *See B. Braun Med.*, 124 F.3d at  
11 1424.

12 Finally, to the extent the Court finds there is specification support for an algorithm  
13 according to which the operating system probes “monitor a request sent to a  
14 downloadable engine,” the recited structure must include the structure disclosed for the  
15 downloadable engine as well. As Finjan acknowledges, the function is “monitoring a  
16 request sent to a downloadable engine.” (D.I. 183 at 4.) Thus, the construction must  
17 include the structure for the *entirety* of the function. Finjan offers no case law to support  
18 its proposition that only part of the function needs to have associated structure. The  
19 result can be determined by a simple thought experiment. If the identified function were  
20 merely “monitoring a request”, Finjan’s identified structure would be the same. But here  
21 the function is “monitoring a request sent to a downloadable engine” and, therefore, the  
22 recited structure must identify what the downloadable engine is as part of the algorithmic  
23 step.

24 As set forth in ESET’s opening brief on this issue, the “downloadable engine” is  
25 described in the specification in purely functional terms. It is introduced in the  
26 specification as follows: “[t]he web browser 245 includes a Downloadable engine 250  
27 *for managing and executing received Downloadables* 140.” ’962 patent at 3:39-40.  
28 Moreover, it is described as being part of a web browser. That is, the Downloadable

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