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FINJAN, INC.

IN THE UNITED STATES DISTRICT COURT

FOR THE SOUTHERN DISTRICT OF CALIFORNIA

SAN DIEGO DIVISION

FINJAN, INC., a Delaware Corporation, Plaintiff, v. ESET, LLC, a California Limited Liability Corporation, and ESET SPOL. S.R.O., a Slovak Republic Corporation, Defendants.	Case No.: 3:17-cv-00183-CAB-BGS **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**
ESET, LLC, a California Limited Liability Corporation, and ESET SPOL. S.R.O., a Slovak Republic Corporation, Counterclaim-Plaintiffs, v. FINJAN, INC., a Delaware Corporation, Counterclaim-Defendant.	

Pursuant to the Court's request during the claim construction hearing held on September 25 and 26, 2017, Finjan submits herewith decisions from the Patent Trial and Appeal Board ("PTAB") adopting the same construction of the claim term "downloadable" for U.S. Patent Nos. 9,189,621 (the "'621 Patent") and 9,219,755 (the "'755 Patent") as Finjan proposes here. Exs. 1-2. Below is a brief discussion of these decisions:

On March 1, 2017, third party Blue Coat Systems, Inc. ("Blue Coat") filed petitions for *inter partes* review ("IPR") of the '621 Patent (IPR2017-00995) and '755 Patents (IPR2017-00997). Both the '621 and '755 Patents were expired when Blue Coat filed these petitions. In both of these petitions, Blue Coat proposed that the claim term "downloadable" should be construed as "an executable application program, which is downloaded from a source computer and run on a destination computer." Ex. 3 ('621 Petition) at 18-19; Ex. 4 ('755 Petition) at 21-22. Blue Coat supported this construction with the declaration of its expert, Dr. Bestavros, who stated: "I interpret the term 'downloadable,'" as used in the '621 and '755 Patents " to include 'an executable application program, which is downloaded from a source computer and run on a destination computer.'" Doc. No. 139-18 at ¶ 36; *see also* Doc. No. 139-19 at ¶ 36 (Exs. 15-16 of Finjan's Opening Claim Construction Brief). In its preliminary responses to Blue Coat's petitions, Finjan did not dispute this construction. *See generally*, Ex. 5 at 9-16 ('621 Response); Ex. 6 at 11 ('755 Response).

On September 5, 2017, the PTAB instituted the IPR for the '621 Patent and denied institution of IPR for the '755 Patent. In both of these decisions, the PTAB explained that, "[f]or claims of an expired patent, the Board's claim interpretation analysis is similar to that of a district court. *See In re Rambus Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012)." Ex. 1 at 5; Ex. 2 at 7. The PTAB further explained:

> Claim terms are given their ordinary and customary meaning, as they would be understood by one of ordinary skill in the art

> in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312−13 (Fed. Cir. 2005) (en banc). Although we construe the claims in light of the specification, limitations discussed in the specification may not be read into the claims. *Intervet Inc. v. Merial Ltd.*, 617 F.3d 1282, 1287 (Fed. Cir. 2010); *Abbott Labs. v. Sandoz, Inc.*, 566 F.3d 1282, 1288 (Fed. Cir. 2009).

Ex. 1 at 5-6; Ex. 2 at 7; *see also, In re CSB-System Int'l, Inc*., 832 F.3d 1335, 1341 (Fed. Cir. 2016) ("Even so, when an expired patent is subject to reexamination, the traditional *Phillips* construction standard attaches.")(citing *In re Rambus*, 694 F.3d at 46). In both decisions, the PTAB construed "downloadable" as "an executable application program, which is downloaded from a source computer and run on a destination computer." Ex. 1 at 8; Ex. 2 at 10.

As such, the PTAB adopted the ***same construction*** of the term "downloadable" in the '621 and '755 Patents as Finjan proposes here. In doing so, the PTAB was held to the ***same standards*** for claim construction as this district court. Moreover, the party *opposing* Finjan in the IPR proceedings, Blue Coat, along with Blue Coat's expert, advocated for the same construction that Finjan proposes here. These PTAB decisions, along with the submissions by Blue Coat during these proceedings, form part of the intrinsic record for the '621 and '755 Patents. *See*, *e.g.*, *Fairfield Indus., Inc. v. Wireless Seismic, Inc.*, No. 4:14–CV–2972, 2015 WL 1034275, at *5 (S.D. Tex. Mar. 10, 2015) ("[The PTAB's IPR] claim construction analysis serves as further intrinsic evidence that [the] proposed construction is appropriate.").

Thus, the Court should adopt Finjan's construction of "downloadable" consistent with the PTAB decisions.

Respectfully submitted,

DATED: September 29, 2017

By: *s/ James Hannah*

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EXHIBIT 1

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