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UNITED STATES DISTRICT COURT

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SOUTHERN DISTRICT OF CALIFORNIA

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FINJAN, INC.,

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Plaintiff,

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v.

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ESET, LLC, a California Limited Liability
and ESET SPOL. S.R.O., a Slovak

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Republic Corporation,

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Defendants.

Case No.: 3:17-cv-0183-CAB-BGS

**ORDER ON DEFENDANTS'
RENEWED MOTION FOR
SUMMARY JUDGMENT OF
INDEFINITENESS**
[Doc. No. 806]

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Before the Court is the renewed motion of Defendants ESET, LLC and ESET spol.

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s.r.o (collectively "ESET") for summary judgment to invalidate Plaintiff Finjan's United

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States Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 ("the

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patents at-issue") as indefinite pursuant to 35 U.S.C. § 112 based on this Court's

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construction of the claim term "Downloadable." The motion is fully briefed, and the Court

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deems it suitable for submission without oral argument.

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I.   Background

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This motion has an unusual history. ESET filed a motion for summary judgment

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asserting that the patents at-issue are indefinite at the close of fact discovery in this case,

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and the Court held argument on September 26, 2019. Finding that there were factual

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disputes regarding what a skilled artisan in 1997 would have understood constituted a

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"Downloadable" based on the Court's construction of that term, the Court denied the motion without prejudice. [Doc. No. 699.] It was anticipated that trial testimony would establish what was generally understood in the art in 1997 as a "Downloadable" and such testimony would inform the scope of infringement. [Doc. No. 697, at 22:3-15.]

A jury trial commenced in this case on March 10, 2020. After three trial days the Court was forced to vacate the remainder of the trial, excuse the jury and declare a mistrial due to the COVID-19 pandemic and the issuance of the State of California's stay-home order. [Doc. No. 783.] This District's continuing moratorium on civil jury trials and backlog of criminal jury trials currently precludes scheduling a new trial in this matter.

Having heard testimony from Finjan's expert during the vacated trial on this issue, however, the Court permitted ESET to renew this motion in consideration of the testimony that was taken. Although Finjan's patents have been the subject of much litigation, and the term "Downloadable" has been construed by other courts, the issue raised in ESET's current motion does not appear to have been addressed by any prior constructions.

Finjan is the owner of a large family tree of patents for security systems and methods of detecting malware in computer programs. Finjan has litigated many of their patents, including some of the patents at-issue in this motion, in other district courts. Many have also been subject to *inter partes* review by the Patent and Trademark Office (PTO). The Federal Circuit has issued at least nine opinions, precedential and non-precedential, on appeals from district courts and the PTO regarding Finjan patents. Yet none of these orders or opinions discuss how earlier references incorporated into the patents at-issue inform the construction of the term "Downloadable."

II.   The Construction of "Downloadable"

In 2017, Finjan filed this litigation against defendants ESET asserting infringement of the patents at-issue, and United States Patent No. 7,975,305.[1] Finjan claims priority for

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[1] The '305 patent is not subject to this motion as it does not include the claim term "Downloadable."

the patents at-issue back to an application filed on November 8, 1996, Provisional Application 60/030639. [Doc. No. 139-24.] The application is directed at "a system and method for protecting computers from hostile Downloadables," described as executable application programs automatically downloaded from a source computer and run on the destination computer that might carry computer "viruses." [Id., at 5-6.] The claim term "Downloadable" is presented as a capitalized term in the provisional application and all the patents at-issue, signaling it is a specifically defined term. The definition of "Downloadables," however, is not consistent throughout Finjan's subsequently issued patents. The explicit definitions include:

- "applets" (little applications) described in the 1990s as small interpreted or executable programs. *See* Provisional Application 60/030639 (filed November 8, 1996) [*Id.* at 5-6.]

- "Downloadables (i.e., applets)" as "a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer," in conformity with the original provisional application. *See* U.S. Patent No. 6,167,520, at Col. 1:31-34 (application filed January 29, 1997); U.S. Patent No. 6,480,962, at Col. 1:38-41 (filed April 18, 2000).

- "an executable application program which is downloaded from a source computer and run on a destination computer" (without "i.e., applet," "small" or "interpretable" included in the definition but using applets and interpretable programs as examples of a "Downloadable" and incorporating the earlier definition by reference). *See* U.S. Patent No. 6,092,194, at Col. 1:44-55 (filed November 6, 1997); U.S. Patent No. 6,804,780 at Col. 1:50-60 (filed March 30, 2000).

Other district courts have determined that "Downloadable" lacked ordinary meaning when the patents were filed and construed it as "an executable application program which is downloaded from a source computer and run on a destination computer," applying the

1   explicit definition from the '194 patent. [Doc. No. 139-10, at 3; Doc. No. 138-4, at 2-5 (the

2   term was not amenable to plain and ordinary meaning and the patent applicant intended to

3   act as the lexicographer of this term, therefore the specification definition controls).] None

4   of these orders, however, discussed the significance of the '520 patent's definition

5   incorporated into the '194 patent and its continuations.   One district court, without

6   explanation, applied the broader definition from the '194 patent specification to the

7   construction of the term "Downloadable" in the '962 patent as "the same" definition [id.,

8   at 3, fn. 4], disregarding the fact the '962 patent explicitly defines "Downloadable" as "a

9   *small* executable or interpretable application program which is downloaded from a source

10 computer and run on a destination computer." *See* U.S. Patent No. 6,480,962, at Col. 1:39-

11 41 (*emphasis* added).

12   Incorporation by reference provides a method for integrating material from various

13 documents into a host document by citing such material in a manner that makes clear that

14 the material is effectively part of the host document as if it were explicitly contained

15 therein.   *See Trustees of Columbia Univ. v. Symantec,* 811 F.3d 1359, 1365-66 (Fed. Cir.

16 2016) (*citing Advanced Display Sys. v. Kent State Univ.,* 212 F.3d 1272, 1282 (Fed. Cir.

17 2000) (provisional applications incorporated by reference are effectively part of the

18 specification as though it was explicitly contained therein.)). By incorporating the earlier

19 definition of "Downloadable" from the '520 Patent into the '194 Patent and subsequent

20 continuations (including the patents at-issue), the scope of the term is limited to "*small*

21 executable or interpretable application programs," and not *all* executable application

22 programs (*emphasis* added).   *See Symantec,* 811 F.3d at 1365 (rejecting a broad

23 interpretation of a claim term in part because a provisional application incorporated by

24 reference the same term more narrowly defined.) Inconsistent language used later cannot

25 support a broad claim construction when the explicit definition is incorporated from earlier

26 patents in the family tree.

27   In this case, the Court concluded that based on its incorporation by reference in all

28 the patents at-issue, the explicit definition of "Downloadables" from the '520 patent and

1 the '962 patent, which is supported by the examples provided in the specification, is the

2 proper construction of "Downloadables" – "a small executable or interpretable application

3 program which is downloaded from a source computer and run on a destination computer."

4 [Doc. No. 195.]

5   **III.   The Indefiniteness Determination**

6   The Court's claim construction, not unexpectedly, resulted in the present dispute as

7 to the scope of the modifier "small." ESET argues that "small" is a term of degree with

8 not technical meaning or defined boundaries and there is insufficient information in the

9 intrinsic record for a skilled artisan to have clear notice of what constitutes a "small

10 executable or interpretable application program." They further argue that this is

11 demonstrated by the inability of Finjan's experts to come to a consistent opinion as to what

12 objective boundaries constitute a small application program. [806-1, at 5, 17.]

13   The definiteness requirement of paragraph 2 of 35 U.S.C. §112 requires that the

14 "specification shall conclude with one or more claims particularly pointing out and

15 distinctly claiming the subject matter which the applicant regards as his invention." The

16 definiteness requirement focuses on whether "a patent's claims, viewed in light of the

17 specification and prosecution history inform those skilled in the art about the scope of the

18 invention with reasonable certainty." *Nautilus, Inc. v. Biosig Instruments, Inc.,* 572 U.S.

19 898, 910 (2014). The inquiry "trains on the understanding of a skilled artisan at the time

20 of the patent application." *Id.* at 911.

21   Terms of degree must provide sufficient certainty to one of skill in the art to afford

22 clear notice of what is claimed and what is still open to the public. *See Biosig Instruments,*

23 *Inc. v. Nautilus, Inc.*, 738 F.3d 1374, 1378 (Fed. Cir. 2015) ("When a 'word of degree' is

24 used, the court must determine whether the patent provides 'some standard for measuring

25 that degree.'"); *Interval Licensing LLC v. AOL, Inc.,* 766 F.3d 1364, 1370 (Fed. Cir. 2014)

26 (the definiteness standard must allow for a modicum of uncertainty but must also require

27 clear notice of what is claimed thereby apprising the public of what is still open to them).

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