

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,

Plaintiff,

v.

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

Defendants.

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

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

Before the Court is the renewed motion of Defendants ESET, LLC and ESET spol. s.r.o (collectively “ESET”) for summary judgment to invalidate Plaintiff Finjan’s United States Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 (“the patents at-issue”) as indefinite pursuant to 35 U.S.C. § 112 based on this Court’s construction of the claim term “Downloadable.” The motion is fully briefed, and the Court deems it suitable for submission without oral argument.

I. Background

This motion has an unusual history. ESET filed a motion for summary judgment asserting that the patents at-issue are indefinite at the close of fact discovery in this case, and the Court held argument on September 26, 2019. Finding that there were factual disputes regarding what a skilled artisan in 1997 would have understood constituted a



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

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

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

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

23 **II. The Construction of “Downloadable”**

24 In 2017, Finjan filed this litigation against defendants ESET asserting infringement
25 of the patents at-issue, and United States Patent No. 7,975,305.¹ Finjan claims priority for
26

27 _____
28 ¹ The ‘305 patent is not subject to this motion as it does not include the claim term “Downloadable.”

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

- 10 • “applets” (little applications) described in the 1990s as small interpreted or
11 executable programs. See Provisional Application 60/030639 (filed
12 November 8, 1996) [*Id.* at 5-6.]
- 13 • “Downloadables (i.e., applets)” as “a small executable or interpretable
14 application program which is downloaded from a source computer and run
15 on a destination computer,” in conformity with the original provisional
16 application. See U.S. Patent No. 6,167,520, at Col. 1:31-34 (application filed
17 January 29, 1997); U.S. Patent No. 6,480,962, at Col. 1:38-41 (filed April 18,
18 2000).
- 19 • “an executable application program which is downloaded from a source
20 computer and run on a destination computer” (without “i.e., applet,” “small”
21 or “interpretable” included in the definition but using applets and
22 interpretable programs as examples of a “Downloadable” and incorporating
23 the earlier definition by reference). See U.S. Patent No. 6,092,194, at Col.
24 1:44-55 (filed November 6, 1997); U.S. Patent No. 6,804,780 at Col. 1:50-60
25 (filed March 30, 2000).

26 Other district courts have determined that “Downloadable” lacked ordinary meaning
27 when the patents were filed and construed it as “an executable application program which
28 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).
28

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.