

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

FINJAN LLC, a Delaware Limited Liability  
Company,

Plaintiff,

v.

RAPID7, INC., a Delaware Corporation  
and RAPID7 LLC, a Delaware Limited  
Liability Company,

Defendants.

C.A. No. 1:18-cv-01519-MN

Jury Trial Demanded

**REDACTED VERSION  
(Filed on October 16, 2020)**

**ANSWERING LETTER BRIEF REGARDING PERMISSION TO FILE  
MOTION FOR PARTIAL SUMMARY JUDGMENT**

Sealed Version  
Dated: October 9, 2020

**\*OF COUNSEL:**

L. Norwood Jameson  
Matthew C. Gaudet  
David C. Dotson  
John R. Gibson  
Robin McGrath  
Jennifer H. Forte  
**DUANE MORRIS LLP**  
1075 Peachtree Street NE, Suite 2000  
Atlanta, GA 30309  
Tel.: (404) 253-6900  
wjameson@duanemorris.com  
mcgaudet@duanemorris.com  
dcdotson@duanemorris.com

Jarrad M. Gunther  
Joseph A. Powers  
**DUANE MORRIS LLP**  
30 South 17th St.  
Philadelphia, PA 19103-4196  
Tel.: (215) 979-1837  
jmgunther@duanemorris.com  
japowers@duanemorris.com

Richard L. Renck (No. 3893)  
**DUANE MORRIS LLP**  
222 Delaware Avenue, Suite 1600  
Wilmington, DE 19801-1659  
Tel.: (302) 657-4900  
Fax: (302) 657-4901  
RLRenck@duanemorris.com

*Counsel for Defendants  
Rapid7, Inc. and Rapid7 LLC*

Jordana Garellek  
**DUANE MORRIS LLP**  
1540 Broadway  
New York, NY 10036-4086  
Tel.: (212) 471-1829  
jgarellek@duanemorris.com

*\*admitted pro hac vice*

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RICHARD L. RENCK  
E-MAIL: RLRenck@duanemorris.com

October 9, 2020

## VIA ECF

The Honorable Judge Maryellen Noreika  
844 N. King Street, Unit 19, Room 4324  
Wilmington, DE 19801-3555

**Re: *Finjan LLC v. Rapid7, Inc. and Rapid7 LLC*, Case No. 18-1519-MN (D. Del.)**

Dear Judge Noreika:

Defendants Rapid7, Inc. and Rapid7 LLC (collectively, “Rapid7”) respectfully oppose Plaintiff Finjan, LLC’s (“Finjan”) letter (D.I. 192) seeking permission to file a motion for summary judgment of no invalidity for lack of written description under 35 U.S.C. § 112, regarding Patent Nos. 7,613,918 (“the ’918 Patent”), 7,757,289 (“the ’289 Patent”), 7,975,305 (“the ’305 Patent”), 8,079,086 (“the ’086 Patent”), 8,141,154 (“the ’154 Patent”), 8,225,408 (“the ’408 Patent”), and 8,677,494 (“the ’494 Patent”) (collectively, the “Patents-in-Suit”).

Finjan’s Letter mischaracterizes Rapid7’s experts’ methodology for determining whether the Patents-in-Suit comply with the written description requirement. Rapid7’s experts do not “compare the patent specification to the accused products,” as Finjan alleges. D.I. 192 at 2. Instead, Rapid7’s experts explicitly identify various claim elements in the asserted claims that lack written description support. They then explain that these claim elements lack written description support because – under the scope of the claim that would be necessary under Finjan’s allegation regarding how the claim element is satisfied – the scope of the specific claim elements exceeds what is supported by written description.<sup>1</sup> The written description requirement, of course, hinges on the scope of the claims, a legal principle that Finjan sidesteps in its letter. Finjan’s infringement allegations likewise require a particular scope of the claims, and thus are relevant to the written description analysis. Rapid7’s experts do not agree with Finjan’s interpretation of the scope of the claim elements, but if Finjan’s interpretation is correct for purposes of infringement, it must also be correct for purposes of invalidity. Finjan’s proposed summary judgment motion is an attempt to insulate its ability to apply an overbroad claim scope for purposes of infringement, without regard to the impact such an interpretation has on the validity of the asserted claims. *Pandrol USA, LP v. Airboss Ry. Prods., Inc.*, 424 F.3d 1161, 1165 (Fed. Cir. 2005) (the written description requirement prevents “an applicant from later asserting that he invented that which he did not.”).

Whether the claim elements in question – if they have the scope necessarily advanced by Finjan – are supported by written description is a question of fact for the jury. As Finjan acknowledges in its letter, compliance with the written description requirement is a question of fact. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). “[T]he purpose of the written description requirement is to ‘ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor’s contribution to the field of art

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<sup>1</sup> Attached hereto as Exhibits 1, 2, and 3 are exemplary portions of the written description analyses performed by Dr.’s McDaniel, Jha, and Almeroth, respectively, in their opening reports.

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as described in the patent specification.” *Id.* at 1353-54 (internal citations omitted). In order to determine whether the written description requirement is met, courts analyze “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* at 1351. While this analysis does “require an inquiry into the specification,” it also “require[s] an inquiry into the scope of the invention.” *Verinata Health, Inc. v. Ariosa Diagnostics, Inc.*, No. C 12-05501 SI, 2014 U.S. Dist. LEXIS 57519, at \*7 (N.D. Cal. Apr. 23, 2014); *see also LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1346 (Fed. Cir. 2005) (“Although the specification would meet the requirements of section 112 with respect to a claim directed to that particular engine, it would not necessarily support a broad claim to every possible type of fuel-efficient engine, no matter how different in structure or operation from the inventor’s engine.”). This latter part of the inquiry – i.e., determining the scope of the claims – is what Finjan sidesteps. Infringement contentions describe “the scope of what [a plaintiff] asserts is claimed by the patents” and therefore impact a defendant’s written description defenses.” *Verinata Health*, 2014 U.S. Dist. LEXIS 57519, at \*7. (allowing a defendant to amend its written description defenses in its invalidity contentions because plaintiff amended its infringement contentions to expand the asserted scope of its claims).

Finjan alleges that Rapid7’s experts improperly “compare the patent specification to the accused products,” but that is not true. Rapid7’s experts do not assert that the patent specifications must disclose the accused products or that every possible embodiment of the claims must be disclosed in the specification. *See, e.g.*, Ex. 4, Reply Expert Report of Kevin Almeroth at ¶144 (“[T]he written description requirement does not require that the patent specification disclose every possible application or implementation of the claimed invention.”); Ex. 5, Reply Expert Report of Somesh Jha at ¶124 (“[T]he specification has to disclose the scope of the claims, as they are written, but not [] every potential application[] of the claimed inventions.”). Instead, Rapid7’s experts used Finjan’s infringement allegations in their written description analysis only “insofar as those allegations demonstrate the asserted scope of the claims.” Ex. 4, Reply Expert Report of Kevin Almeroth dated August 31, 2020 at ¶128. Even the sections Finjan quotes from Rapid7’s expert reports in support of its letter demonstrate that analysis. *See, e.g.*, D.I. 192 at 2 quoting the Reply Expert Report of Patrick McDaniel at ¶49 (attached hereto as Ex. 6) (“[T]he Asserted Patents do not provide written description for the scope of the claims that Finjan uses for its infringement analysis and therefore fail to satisfy the written description requirement.” (emphasis added)).

The Federal Circuit has acknowledged this methodology of applying the asserted scope of the claims based on a plaintiff’s infringement allegations purporting to cover the accused products, to determine whether claims are invalid for lack of written description. In *Rivera v. ITC*, the Federal Circuit noted that “[b]oth parties analyze[d] the written description issue under the assumption that the asserted claims read on Solofill’s K2 and K3 cup-shaped containers.” 857 F.3d 1315, 1319 (Fed. Cir. 2017). The Court found that “written description support for broad claims covering a receptacle with integrated filter such as Solofill’s accused products and Rivera’s Eco-Fill products is lacking.” *Id.* at 1321. *See also Auto. Techs. Int’l, Inc. v. BMW of N. Am., Inc.*, 501 F.3d 1274, 1285 (Fed. Cir. 2007) (“ATI sought to have the scope of the claims of the ‘253 patent include both mechanical and electronic side impact sensors. It succeeded, but then was unable to demonstrate that the claim was fully enabled.”).

Similarly, the district court in *Ware v. Abercrombie & Fitch Stores Inc.* adopted the report and recommendations of the Special Master granting the defendants’ motion for summary

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judgment under 35 U.S.C. 112, ¶ 1 for lack of written description. No. 4:07-CV-00122-RLV, 2012 U.S. Dist. LEXIS 206575, at \*8-9, 2012 WL 13134065 (N.D. Ga. Mar. 1, 2012). The Special Master explained, “[t]he issue here is whether or not the '592 specification supports claim 1 as now asserted by plaintiffs in order to sustain their charge of infringement. It is these assertions by plaintiffs that give rise to Section 112(1) issues.” *Ware v. Abercrombie & Fitch Stores Inc.*, 4:07-CV-00122 RLV, 2011 WL 13322747, at \*20 (N.D. Ga. Oct. 17, 2011), report and recommendation adopted, 4:07-CV-00122-RLV, 2012 U.S. Dist. LEXIS 206575, 2012 WL 13134065 (N.D. Ga. Mar. 1, 2012). The Special Master stated “[i]f claim 1 is read broadly to capture defendants' systems, the '592 patent is invalid under Section 112(1). If claim 1 is construed to cover that which is disclosed in the '592 specification, defendants have not infringed.” *Id.* at \*28.

The district court's decisions in *Visteon Glob. Techs., Inc. v. Garmin Int'l, LLC* is particularly instructive, and worthy of a full discussion here. The district court denied Visteon's motion for summary judgment regarding Garmin's § 112 defenses and stated that it was “premature to conclude at this point that Visteon has carried its burden to establish that no genuine issue of material fact exists as to the validity of Garmin's § 112 defenses.” No. 10-cv-10578, 2015 U.S. Dist. LEXIS 33306, at \*35 (E.D. Mich. Mar. 18, 2015) (“*Visteon 1*”). Like Finjan, Visteon argued “Garmin's expert[] improperly focused his opinions exclusively on the accused products.” *Id.* at \*27. However, like Rapid7's experts, Garmin's expert was not “worried about any particular commercial manifestation of a product” and instead was “looking at the claim interpretation that Visteon appears to be putting forth, and that claim interpretation appears to be completely and utterly antithetical to the teachings of the specification.” *Id.* (internal quotations omitted). Like Rapid7's experts, the court stated that Garmin's expert “ties his opinions both to the full scope of the claims, as interpreted by him based upon Visteon's infringement contentions, and to the time of filing.” *Id.* at \*31.

Visteon later brought a motion *in limine* to exclude Garmin's § 112 defenses that were allegedly directed to the accused products and the court denied the motion “for the reasons stated by the Special Master in his Report and Recommendation.” *Visteon Glob. Techs., Inc. v. Garmin Int'l, Inc.*, No. 10-cv-10578, 2016 U.S. Dist. LEXIS 145316, at \*12 (E.D. Mich. Oct. 20, 2016) (“*Visteon 2*”). The Special Master explained “only at trial will the theoretical construction suggested by Dr. Michalson (based on Visteon's infringement contentions) become real or vanish. At trial Visteon will have to take a stand, but it has not done so in the motion *in limine*, and thus its effort to block Garmin's §112 defense is still premature.” *Visteon Glob. Techs., Inc. v. Garmin Int'l, Inc.*, Civil Action No. 2:10-cv-10578--PDB-DRG, 2016 U.S. Dist. LEXIS 145816, at \*27 (E.D. Mich. Aug. 10, 2016) (“*Visteon 2 Special Master Report*”). The Special Master in noted:

To be sure, were Visteon to present an understanding of the '060 Patent claims that actually align with the patent disclosure, Garmin would have no need for its § 112 defenses. But if Visteon proceeds at trial with its overbroad interpretation that far exceeds any reasonable “plain and ordinary” meaning of the claim language, Garmin must be able to present its § 112 defenses—the critical fetters that keep patent owner's honest to the invention they actually disclosed.

*Id.* at \*24-25.

Like Finjan does here, Visteon “incorrectly focuses on Dr. Michalson's references to the accused products to try to bring the case in line with” cases where the expert “failed to make any

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