

Exhibit B

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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,

Plaintiff,

v.

ESET, LLC et al.,

Defendants.

Case No.: 17-CV-183-CAB-BGS

**ORDER ON MOTIONS FOR
SUMMARY JUDGMENT AND
MOTIONS TO EXCLUDE OR
STRIKE**

[Doc. Nos. 466, 467, 469, 470, 474, 476,
478, 479, 481, 483, 484, 486, 488, 490,
492, 494, 497, 499, 501, 506, 509, 510,
513, 515, 524, 526, 530, 531]

AND RELATED COUNTERCLAIMS

I. Introduction

At the close of fact and expert discovery and in accordance with the scheduling order in this case, the parties filed motions for summary judgment, Daubert motions challenging each other’s experts, and motions to exclude certain evidence. The Court provided no limitations regarding the number of dispositive motions that could be filed or total page limitations. The parties took extreme advantage of this and filed in total twenty-eight complex motions, putting before the Court an extraordinary number of issues purportedly without material facts in dispute and therefore proper for adjudication as a matter of law. Having reviewed the voluminous briefing, declarations and exhibits submitted by both

1 parties, the Court concludes that for the majority of the substantive motions, facts were
2 most definitely in dispute and summary judgment was not appropriate. Similarly, for the
3 majority of the challenges to the admissibility of expert testimony, the Court concludes that
4 the challenges go to the weight to be afforded the opinions. They are best challenged by
5 cross-examination rather than deemed inadmissible and excluded as an exercise of the
6 Court's gatekeeper role.

7 A number of the motions to exclude certain evidence centered on accusations of
8 untimely disclosures and resulting prejudice to the moving party. These accusations flew
9 in both directions, and the pages of briefing allocated to these arguments of attorney
10 misconduct were exhausting. Generally, the Court concludes that there was no undue
11 prejudice and that all of the evidence in question can be presented to a jury.

12 Of the twenty-eight motions, the Court held a hearing on six motions on September
13 26, 2019. [Doc. No. 679, transcript of 9/26/19 hrg.] Those six motions are addressed
14 below. As to the remaining twenty-two motions, the Court issued tentative rulings [Doc.
15 No. 695] which remain unchanged.

16 **II. ESET's Motions**

17 **A. Summary Judgment of Non-Infringement, License or Unenforceability**

18 The Court finds numerous material facts in dispute as to the following motions and
19 they are therefore **DENIED**.

- 20 • Doc. No. 470 Motion for Non-Infringement of CMPS
 - 21 • Doc. No. 476 Motion for Non-Infringement of '621/'755 Patents
 - 22 • Doc. No. 481 Motion for Non-Infringement of '844 Patent
 - 23 • Doc. No. 484 Motion for Non-Infringement of '086 Patent
 - 24 • Doc. No. 488 Motion for Non-Infringement of '780 Patent
 - 25 • Doc. No. 486 Motion for License Defense
 - 26 • Doc. No. 531 Motion for Unenforceability of '086, '621 and '755 Patents
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1 **B. Motions to Exclude Experts and Strike Contentions**

2 The Court declines to exclude the experts contested in the motions listed below
3 because their opinions are best challenged by cross-examination rather than exclusion. The
4 motions are therefore **DENIED**. ESET’s request to strike Finjan’s Third Amended
5 Infringement Contentions is also **DENIED**.

- 6 • Doc. No. 474 Exclusion of Bims
- 7 • Doc. No. 479 Exclusion of Mitzenmacher, Medvidovic, Goodrich and Cole
- 8 • Doc. No. 469 Exclusion of Orso¹
- 9 • Doc. No. 492 Motion to Strike Third Amended Contentions

10 **III. FINJAN’s Motions**

11 **A. Summary Judgment of Infringement or of ESET’s Defenses**

12 The Court finds numerous material facts in dispute as to the following motions and
13 they are therefore **DENIED**.

- 14 • Doc. No. 497 Motion for Infringement of ‘086 Patent
- 15 • Doc. No. 499 Motion for Infringement of ‘621 Patent
- 16 • Doc. No. 501 Motion for Infringement of ‘780 Patent
- 17 • Doc. No. 506 Motion for No License Defense
- 18 • Doc. No. 509 Motion for No Inequitable Conduct
- 19 • Doc. No. 513 Motion for Validity over Certain Prior Art References

20 **B. Motions to Exclude Experts and Strike Evidence**

21 The Court declines to exclude the experts contested in the motions listed below
22 because their opinions are best challenged by cross-examination rather than exclusion. The
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27 ¹ ESET moved to exclude the testimony of Dr. Alessxandro Orso regarding his opinions as to secondary
28 considerations of non-obviousness. The Court **RESERVES** on this motion. ESET may voir dire this witness out of the presence of the jury to determine if his opinions are supported by the requisite nexus between the inventions and his conclusions regarding the secondary considerations of non-obviousness.

1 motions are therefore **DENIED**. Finjan's motions to exclude certain prior art and non-
2 infringing alternatives are also **DENIED**.

- 3 • Doc. No. 510 Exclusion of Thompson
- 4 • Doc. No. 515 Exclusion of Spafford
- 5 • Doc No. 524 Exclusion of Britven
- 6 • Doc. No. 530 Motion to Exclude Certain Prior Art
- 7 • Doc. No. 526 Motion to Exclude Non-Infringing Alternatives.

8 **IV. The Remaining Motions**

9 **A. Priority Dates [Doc. No. 483]**

10 As stated on the record at the hearing, this motion is **DENIED** as to ESET's
11 proposed priority dates for the '780, '086, '621 and '755 patents. There are material facts
12 in dispute regarding whether the earlier patents to which Finjan claims priority disclose the
13 inventions claimed in these patents.

14 The Court, however, was prepared to adopt the IPR decision that the inventors of the
15 '844 patent were not in possession of the subject matter of the challenged claims of that
16 patent any time prior to the December 22, 1997 filing date of the 08/995,648 application.
17 [Doc. No. 483-20, at 21-25; Doc. No. 697, at 51.] The parties represented that there had
18 been further developments in the Patent Office regarding that determination. The matter
19 therefore remains under submission pending updates from the parties.

20 **B. ESET Motion re: Indefiniteness of "Downloadable" [Doc. No. 478]**

21 The genesis of this motion goes back to the claim construction of the term
22 "Downloadable." The Court references the claim construction order [Doc. No. 195], the
23 portion of the claim construction hearing regarding this term [Doc. No. 610-3], and the
24 portion of the hearing on this motion [Doc. No. 697 at 3:13-22:19] for context. In
25 summary, the term "Downloadable" is defined by the inventor somewhat differently in the
26 lineage of the patents at issue. In U.S. Patent No. 6,167,520, filed January 29, 1997, it is
27 defined as, "a small executable or interpretable application program which is downloaded
28 from a source computer." In U.S. Patent No. 6,092,194, filed November 6, 1997 and

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