

Not Reported in F.Supp.2d, 2013 WL 5302560 (D.Del.)  
(Cite as: 2013 WL 5302560 (D.Del.))

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United States District Court, D. Delaware  
Finjan, Inc., Plaintiff,

v.

Symantec Corp., Sophos, Inc., and Websense, Inc.,  
Defendants.

C.A. No. 10–cv–593 (GMS)  
September 19, 2013

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**MEMORANDUM OPINION**

**GREGORY M. SLEET**, CHIEF, UNITED STATES DISTRICT JUDGE

**I. INTRODUCTION**

\*1 In this patent infringement action, plaintiff Finjan, Inc. (“Finjan” or “the plaintiff”) alleges that the defendants, Symantec Corporation (“Symantec”), Sophos, Inc. (“Sophos”), and Websense, Inc. (“Web-

sense”) (collectively, “the defendants”) infringe the asserted claims of the patents-in-suit.<sup>FN1</sup> (D.I. 1.) The court held a thirteen-day jury trial in this matter on December 3, 2012 through December 19, 2012. (D.I. 826–839.) At trial, each of the defendants and Finjan moved for judgment as a matter of law (“JMOL”) on a number of grounds pursuant to [Rule 50\(a\) of the Federal Rules of Civil Procedure](#) and the court denied these motions.<sup>FN2</sup>

**FN1.** The patents-in-suit are [U.S. Patent Nos. 6,480,962](#) (“the ‘SYM>>962 Patent’”) and [6,092,194](#) (“the ‘194 Patent’”). The patents-in-suit are owned by Finjan. Finjan asserted claims 1, 5, 6, 12, 15, 33, 37, 38, 45, 52, and 55 of the ‘962 Patent and claims 1, 2, 32, 35, 36, 37, 58, 65, and 66 of the ‘194 Patent.

**FN2.** Specifically, Sophos moved for Judgment as a Matter of Law (“JMOL”) on various grounds on December 11, 2012 (D.I. 706), accompanied by an Opening Brief in Support (D.I. 707). On December 12, 2012, Symantec and Websense also filed motions for JMOL (D.I. 709; D.I. 711), accompanied by Opening Briefs in Support (D.I. 710). Finjan responded with Answering Briefs to each of these motions on December 17, 2012. (D.I. 713; D.I. 714; D.I. 15.) In addition, each of the defendants filed motions for JMOL at the close of evidence on December 18, 2012. (D.I. 724; D.I. 726; D.I. 736.) Likewise, Finjan filed JMOL motions against each of the defendants on December 19, 2012, supporting its position on various grounds. (D.I. 731; D.I. 732; D.I. 733.) Finjan also filed motions for JMOL against each of the defendants at the close of evidence on December 20, 2012. (D.I. 740; D.I. 741; D.I.

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742.) The parties subsequently filed briefs in support and opposition to these motions. (D.I. 727; D.I. 737; D.I. 738; D.I. 748; D.I. 749; D.I. 750; D.I. 751; D.I. 760; D.I. 761; D.I. 765.) The court denied these motions by oral orders as they were raised throughout the trial.

On December 20, 2012, the jury returned a unanimous verdict in favor of each of the defendants on the issues of infringement with respect to each asserted claim of the patents-in-suit. (D.I. 746.) The jury further found that the asserted claims of the patents-in-suit were invalid due to obviousness and anticipation. (*Id.*) The court entered judgment on the verdict on December 21, 2012. (D.I. 747.) Presently before the court are Finjan's post-trial motions and Websense's Motion for Attorney Fees. Having considered the entire record in this case, the substantial evidence in the record, the parties' post-trial submissions, and the applicable law, the court will deny each of Finjan's post-trial motions (D.I. 770; D.I. 771; D.I. 772; D.I. 773) and Websense's attorney fees motion (D.I. 762). The court's reasoning follows.

## II. BACKGROUND OF THE TECHNOLOGY

\*2 This action involves [U.S. Patent Nos. 6,092,194](#) (“the ‘194 Patent’”) and 6,480,962 (“the ‘962 Patent’”). Generally speaking, the patents-in-suit relate to systems and methods for protecting a computer and a network from hostile Downloadables. *See generally* [‘194 Patent](#); [‘962 Patent](#). The [‘194 Patent](#), entitled “System and Method for Protecting a Computer and Network From Hostile Downloadables,” discloses a system comprised of a security policy, an interface for receiving a Downloadable, and a comparator, coupled to the interface, for applying the security policy to the Downloadable to determine if the security policy has been violated. *See* [‘194 Patent](#) at Abstract. The [‘962 Patent](#), entitled, “System and Method for Protecting a Client During Runtime From Hostile Downloadables,” discloses a system that protects clients from hostile Downloadables and describes the system

as including security rules defining suspicious actions and security policies defining the appropriate responsive actions to rule violators. The [‘962 Patent](#) system includes an interface for receiving incoming Downloadables and requests made by the Downloadable, as well as a comparator coupled to the interface for examining the Downloadable, requests made by the Downloadable, and runtime events to determine whether a security police has been violated. *See* [‘962 Patent](#) at Abstract. The system also includes a response engine coupled to the comparator for performing a violation-based responsive action. *Id.*

## II. STANDARD OF REVIEW

Finjan asserts that it is entitled to judgment as a matter of law pursuant to [Rule 50 of the Federal Rules of Civil Procedure](#) and that a new trial is warranted under [Rule 59 of the Federal Rules of Civil Procedure](#).

### A. Renewed JMOL Motions

To prevail on a renewed motion for judgment as a matter of law following a jury trial and verdict, the moving party “must show that the jury's findings, presumed or express, are not supported by substantial evidence or, if they were, that the legal conclusion(s) implied [by] the jury's verdict cannot in law be supported by these findings.” [Pannu v. Iolab Corp.](#), 155 F.3d 1344, 1348 (Fed. Cir. 1998) (quoting [Perkin-Elmer Corp. v. Computervision Corp.](#), 732 F.2d 888, 893 (Fed. Cir. 1984)). “Substantial evidence” is defined as “such relevant evidence from the record taken as a whole as might be accepted by a reasonable mind as adequate to support the finding under review.” [Perkin-Elmer Corp.](#), 732 F.2d at 893.

The court should only grant the motion “if, viewing the evidence in the light most favorable to the nonmovant and giving it the advantage of every fair and reasonable inference, there is insufficient evidence from which a jury could reasonably find liability.” [Lightnin Lube, Inc. v. Witco Corp.](#), 4 F.3d 1153, 1166 (3d Cir. 1993) (citing [Witekamp v. Gulf Western Inc.](#), 991 F.2d 1137, 1141 (3d Cir. 1993)). “In deter-

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mining whether the evidence is sufficient to sustain liability, the court may not weigh the evidence, determine the credibility of witnesses, or substitute its version of the facts for the jury's version." *Lightning Lube*, 4 F.3d at 1166 (citing *Fineman v. Armstrong World Indus., Inc.*, 980 F.2d 171, 190 (3d Cir. 1992)). Rather, the court must resolve all conflicts of evidence in favor of the non-movant. *Williamson v. Consol. Rail Corp.*, 926 F.2d 1344, 1348 (3d Cir. 1991); *Perkin-Elmer Corp.*, 732 F.2d at 893.

"The question is not whether there is literally no evidence supporting the party against whom the motion is directed but whether there is evidence upon which the jury could properly find a verdict for that party." *Lightning Lube*, 4 F.3d at 1166 (quoting *Patzig v. O'Neil*, 577 F.2d 841, 846 (3d Cir. 1978)). Thus, a court should only grant JMOL if "the record is critically deficient of the minimum quantum of evidence." *Gomez v. Allegheny Health Servs., Inc.*, 71 F.3d 1079, 1083 (3d Cir. 1995). Importantly, in conducting the JMOL analysis, "the court may not determine the credibility of the witnesses nor 'substitute its choice for that of the jury between conflicting elements of the evidence.'" *Syngenta Seeds, Inc. v. Monsanto Co.*, 409 F.Supp.2d 536, 539 (D. Del. 2005) (quoting *Perkin-Elmer Corp.*, 732 F.2d at 893).

### B. New Trial

Pursuant to [Federal Rule of Civil Procedure 59](#), a court may grant a new trial "for any of the reasons for which a new trial has heretofore been granted in an action at law in federal court." [Fed. R. Civ. P. 59\(a\)\(1\)\(A\)](#). The decision to grant or deny a new trial is within the sound discretion of the trial court. See *Allied Chem. Corp. v. Daiflon, Inc.*, 449 U.S. 33, 36 (1980). In making this determination, the trial judge should consider the overall setting of the trial, the character of the evidence, and the complexity or simplicity of the legal principles which the jury had to apply to the facts. *Lind v. Schenley Indus., Inc.*, 278 F.2d 79, 89 (3d Cir. 1960). Unlike the standard for determining judgment as a matter of law, the court

need not view the evidence in the light most favorable to the verdict winner. *Allied Chem. Corp.*, 449 U.S. at 36. A court should grant a new trial in a jury case, however, only if "the verdict was against the weight of the evidence ... [and] a miscarriage of justice would result if the verdict were to stand." *Williamson v. Conrail*, 926 F.2d 1344, 1352 (3d Cir. 1991).

### C. Attorneys' Fees

\*3 In deciding whether to award attorneys' fees, the court must undertake a two-step inquiry. See *Interspiro USA, Inc. v. Figgie Intern. Inc.*, 18 F.3d 927, 933 (Fed. Cir. 1994). First, the court "must determine whether there is clear and convincing evidence that the case is 'exceptional.'" *Id.* (quotation omitted). Second, the court must determine whether "an award of attorney fees to the prevailing party is warranted." *Id.* Exceptional cases include: "inequitable conduct before the PTO; litigation misconduct; vexatious, unjustified, or otherwise bad faith litigation, frivolous suit or willful infringement." *Epcor Gas Sys., Inc. v. Bauer Compressors, Inc.*, 279 F.3d 1022, 1034 (Fed. Cir. 2002) (citation omitted).

## III. DISCUSSION

### A. Validity

Finjan first moves for judgment as a matter of law or, alternatively, a new trial, on validity. The court will address Finjan's motions for JMOL against each of the defendants in this section.<sup>FN3</sup> With regard to the defendants' obviousness arguments, under [35 U.S.C. § 103](#), a patent may not be obtained on subject matter that "would have been obvious at the time the invention was made to a person having ordinary skill in the art." [35 U.S.C. § 103](#). "Obviousness is a question of law based on underlying findings of fact." *In re Kubin*, 561 F.3d 1351, 1355 (Fed. Cir. 2009). Specifically, the trier of fact must consider: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level

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of ordinary skill in the art; and (4) secondary considerations of non-obviousness such as commercial success, long felt but unsolved need, failure of others, and acquiescence of others in the industry that the patent is valid, and unexpected results. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

FN3. The court discusses Finjan's Motion for a New Trial *infra*. *See* Section III.D.

To determine whether an invention is patentable over the prior art, “a court must ask whether the improvement is more than the predictable use of prior elements according to their established functions.” *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417, 419 (2007). In this assessment, “the invention must be considered as a whole without the benefit of hindsight, and the claims must be considered in their entirety.” *Rockwell Int'l Corp. v. United States*, 147 F.3d 1358, 1364 (Fed. Cir. 1998) (citing *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983); *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567 (Fed. Cir. 1983)). Invalidity by “anticipation requires that the four corners of a single[ ] prior art document describe every element of the claimed invention, either expressly or impliedly, such that a person of ordinary skill in the art could practice the invention without undue experimentation.” *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1271, 1282 (Fed. Cir. 2000).

When challenging the validity of a patent for obviousness based on a combination of prior art references, the challenger bears the burden of proving, by clear and convincing evidence, that one of ordinary skill in the art would have had reason to attempt to make the combination and would have had a reasonable expectation of success in doing so. *PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007). A defendant must prove invalidity by clear and convincing evidence and the ultimate burden of persuasion never shifts to the plaintiff. *See Pfizer, Inc. v. Teva Pharm. U.S.A., Inc.*, 882

F.Supp.2d 643, 700 (D. Del. 2012).

### 1. Obviousness

\*4 As noted, Finjan has filed motions for JMOL against each defendant and has submitted separate briefs in support. Because there is overlap in the obviousness arguments advanced at trial and discussed in these briefs by each defendant and Finjan, the court combines its discussion here. Where a prior art reference was argued by only one defendant, the court makes note of this distinction.

At trial, the defendants presented prior art references and, in light of these references, the jury concluded that the '194 and '962 Patents are invalid. In its motions for JMOL as to obviousness, Finjan asserts that the jury verdict should be set aside because: (1) the ThunderByte reference is not prior art to the '194 Patent and, even if it were, the asserted claims of the '194 Patent are valid over ThunderByte and all other references Symantec presented; and (2) Norton Anti-virus 95 (“NAV 95”) is not prior art to the '962 Patent and, even if it were, the asserted claims of the '962 Patent are valid over NAV 95 and all other references Symantec presented. (D.I. 791 at 1 (citing D.I. 732 at 2–5, 6–10; D.I. 742 at 2–4, 4–7).) The court addresses each argument separately below.

#### a. The '194 Patent: Prior Art References ThunderByte 7.0 & MIMESweeper

At trial, Symantec argued that the '194 Patent is invalid as obvious in light of prior art references ThunderByte 7.0 and MIMESweeper. Specifically, Symantec asserted that MIMESweeper is a gateway product that was designed for use with ThunderByte and, when combined as described in the MIMESweeper literature, the prior art technology would scan email attachments at the gateway. (D.I. 808 at 5 (citing Tr. at 2141:22–2143:8, 2147:2–2148:23).) During the scanning process, according to the defendants, ThunderByte would extract a list of suspicious computer operations from a Downloadable and compare that list to a security policy. (*Id.* (citing Tr. at

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2149:6–2152:15.) If the security policy was violated, ThunderByte could then delete the Downloadable, preventing execution at the client. (*Id.* at 5–6 (citing Tr. at 2152:16–2153:6).) Symantec asserts that the jury verdict of invalidity based on ThunderByte and MIMESweeper should not be overturned because: (1) there was substantial evidence that ThunderByte 7.0 qualifies as prior art; (2) the defendants were not required to demonstrate that ThunderByte and MIMESweeper were enabled; (3) a person of ordinary skill in the art could have combined ThunderByte and MIMESweeper; and (4) the ThunderByte/MIMESweeper combination disclosed the disputed elements of the asserted claims of the '194 Patent.

Conversely, Finjan asserts that the ThunderByte reference is not prior art to the '194 Patent and, even if it were, the asserted claims of the '194 Patent are valid over ThunderByte and all other references presented by Symantec and Websense. (D.I. 791 at 1 (citing D.I. 732 at 2–5; *see also* D.I. 742 at 2–4).) Specifically, Finjan asserts that Symantec and Websense's obviousness argument are fundamentally flawed, necessitating JMOL, because the defendants failed to prove that: (1) ThunderByte 7.0 was available in the United States before the '194 Patent's November 8, 1996 priority date; (2) the source code and manuals they relied upon were specifically for ThunderByte 7.0; (3) the ThunderByte and MIMESweeper manuals relied upon were enabled; (4) a person of ordinary skill in the art could have combined ThunderByte and MIMESweeper, let alone would have been motivated to do so; and (5) ThunderByte 7.0 and MIMESweeper disclosed the limitations of the asserted claims. (*Id.* at 3.)

#### ***i. ThunderBYTE 7.0's Availability in the United States***

\*5 Finjan argues that Symantec has failed to satisfy its burden of proving by clear and convincing evidence that ThunderBYTE 7.0 was available in the United States before November 8, 1996. (D.I. 791 at 3) Specifically, Finjan asserts that the testimony of Dr.

Spafford, Symantec's validity expert, was insufficient to demonstrate the prior art's availability and that, because Symantec's only witness who could establish availability was precluded from testifying as a sanction for improper assertions of privilege during his depositions, Symantec could not make this showing.<sup>FN4</sup> (*Id.* at 3–4 (citing Tr. at 2054:5–8).) With regard to Dr. Spafford, Finjan notes that he testified that a British Virus Bulletin contained a review of ThunderByte. Finjan maintains that this testimony is insufficient because the British article failed to: disclose when, if ever, ThunderByte, the product of a Netherlands company, was commercially available in the United States; demonstrate that the review was of a commercial version of ThunderByte; prove that ThunderByte, if available at all, was available outside of the Netherlands or Britain; and demonstrate that the version reviewed can prove availability, particularly where the article noted that the review was limited to a “demonstration version” and that there was “no serial number visible.” (*Id.* at 4 (citing DX 4708–21; DX 4708–23).)

FN4. Finjan states that Symantec's counsel acknowledged to the court on the record that it could not prove the availability of ThunderByte 7.0 as prior art without Dr. Slade's testimony. Specifically, Finjan notes that Symantec's counsel stated, in response to the court's question as to whether Symantec has “another way to prove what you are attempting to prove,” “No, Your Honor.” (D.I. 791 at 4 (citing Tr. at 2051:10–14).)

Finjan further notes that it objected to Dr. Spafford's testimony on ThunderByte as lacking foundation, but that the court permitted him to testify so long as Symantec's counsel would not ask him to opine on the availability of ThunderByte in the United States. (*Id.* (citing Tr. at 2137:13–2140:10).) While Symantec's counsel did not question Dr. Spafford on this issue, he did testify during his direct examination and without provocation, that “[t]he ThunderByte program



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