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United States District Court
Northern District of California

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,

                Plaintiff,

       v.

SYMANTEC CORP.,

                Defendant.

Case No.14-cv-02998-HSG

CLAIM CONSTRUCTION ORDER

Re: Dkt. Nos. 72, 151

Plaintiff Finjan, Inc. filed this patent infringement action against Defendant Symantec Corp. The parties seek construction of a total of twelve claim terms found in eight patents: Patent Nos. 6,154,844 ("'844 Patent"), 7,613,926 ("'926 Patent"), 8,677,494 ("'494 Patent"), 7,756,996 ("'996 Patent"), 7,930,299 ("'299 Patent"), 8,015,182 ("'182 Patent"), 7,757,289 ("'289 Patent"), and 8,141,154 ("'154 Patent"). This order follows claim construction briefing, a technology tutorial, a claim construction hearing, two rounds of supplemental claim construction briefing, and a supplemental claim construction hearing held on January 20, 2017.[1]

I. LEGAL STANDARD

Claim construction is a question of law to be determined by the Court. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384 (1996). "The purpose of claim construction is to determine the meaning and scope of the patent claims asserted to be infringed." *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008) (internal quotation marks omitted).

Generally, claim terms should be "given their ordinary and customary meaning"—*i.e.*, "the

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[1] Following the original claim construction briefing and hearing, the Court granted Defendant's motion to stay the case pending IPR proceedings. Dkt. No. 117. After the U.S. Patent Trial and Appeal Board denied institution of IPR on ten of the eleven petitions filed, the Court lifted the stay

1   meaning that the terms would have to a person of ordinary skill in the art at the time of the

2   invention." *Phillips v. AWH Corp.,* 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (en banc) (internal

3   quotation marks omitted). There are only two circumstances where a claim is not entitled to its

4   plain and ordinary meaning: "1) when a patentee sets out a definition and acts as his own

5   lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the

6   specification or during prosecution." *Thorner v. Sony Computer Entm't Am. LLC,* 669 F.3d 1362,

7   1365 (Fed. Cir. 2012).

8   When construing claim terms, the Federal Circuit emphasizes the importance of intrinsic

9   evidence such as the language of the claims themselves, the specification, and the prosecution

10 history. *Phillips*, 415 F.3d at 1312-17. The claim language can "provide substantial guidance as

11 to the meaning of particular claim terms," both through the context in which the claim terms are

12 used and by considering other claims in the same patent. *Id.* at 1314. The specification is likewise

13 a crucial source of information. *Id.* at 1315-17. Although it is improper to read limitations from

14 the specification into the claims, the specification is "the single best guide to the meaning of a

15 disputed term." *Id.* at 1315 ("[T]he specification is always highly relevant to the claim

16 construction analysis. Usually, it is dispositive." (internal quotation marks omitted)); *see*

17 *also Merck & Co. v. Teva Pharms. USA, Inc.,* 347 F.3d 1367, 1371 (Fed. Cir. 2003) ("[C]laims

18 must be construed so as to be consistent with the specification . . . .").

19   Despite the importance of intrinsic evidence, courts may also consider extrinsic evidence—

20 technical dictionaries, learned treatises, expert and inventor testimony, and the like—to help

21 construe the claims. *Phillips,* 415 F.3d at 1317-18. For example, dictionaries may reveal what the

22 ordinary and customary meaning of a term would have been to a person of ordinary skill in the art

23 at the time of the invention. *Frans Nooren Afdichtingssystemen B.V. v. Stopaq Amcorr Inc.,* 744

24 F.3d 715, 722 (Fed. Cir. 2014) ("Terms generally carry their ordinary and customary meaning in

25 the relevant field at the relevant time, as shown by reliable sources such as dictionaries, but they

26 always must be understood in the context of the whole document—in particular, the specification

27 (along with the prosecution history, if pertinent)."). Extrinsic evidence is, however, "less

1 language." *Phillips,* 415 F.3d at 1317 (internal quotation marks omitted).

2 **II.   DISPUTED TERMS**

3   For the first time the Court can recall in any of its patent cases, the parties have failed to

4 reach agreement as to the construction of *even one* initially disputed claim term.

5   **A.   "Downloadable" ('844, '926, '494)**

Finjan's Construction	Symantec's Construction
an executable application program, which is downloaded from a source computer and run on the destination computer	mobile code that is requested by an ongoing process and downloaded from a source computer to a destination computer for automatic execution

9   **The Court adopts Finjan's construction.**

10   The parties' dispute concerning this term reduces to whether an explicit definition in the

11 specification controls over a narrower definition referenced in the prosecution history. Finjan

12 argues that the '844 Patent expressly defines the term "Downloadable" in its specification:

13   A Downloadable is an executable application program, which is
             downloaded from a source computer and run on the destination
14   computer.

15 '844 Patent at 1:44-47. Finjan asserts that this express definition ends the inquiry. *See Edwards*

16 *Lifesciences LLC v. Cook Inc.*, 582 F.3d 1322, 1329 (Fed. Cir. 2009) (holding that the court will

17 adopt a definition where "the patentee acted as his own lexicographer and clearly set forth a

18 definition of the disputed claim term in either the specification or prosecution history" (internal

19 quotation marks omitted)).

20   Symantec proposes a construction drawn from the prosecution history of another Finjan

21 patent (the '194 Patent), which predates the patents at issue in this case. According to Symantec,

22 the examiner rejected the initial '194 Patent application over U.S. Patent No. 5,623,600 (the "Ji

23 Patent"). The Ji Patent disclosed a virus scanner that "detect[s] . . . viruses attached to executable

24 files." Dkt. No. 74 ("Def. Resp. Br.") at 2. Symantec directs the Court to a passage of the

25 prosecution history in which it argues that the inventors of the '194 Patent distinguished their

26 invention from the Ji Patent on the ground that the Ji Patent "does not teach hostile Downloadable

27 detection," because "[a]s is well known in the art, a Downloadable is mobile code that is requested

28 by an ongoing process, downloaded from a source computer to a destination computer for

1   automatic execution." *Id*. (internal quotation marks omitted) (emphasis in original).

2   The Court adopts Finjan's construction, and agrees that the patentee acted as his own

3   lexicographer in defining this term. The Court is not persuaded by Symantec's argument based on

4   the prosecution history of the '194 patent, and finds that the cited history does not reflect a "clear

5   and unmistakable disavowal" in any event. *See Verizon Servs. Corp. v. Vonage Holdings Corp.*,

6   503 F.3d 1295, 1306 (Fed. Cir. 2007) ("To operate as a disclaimer, the statement in the

7   prosecution history must be clear and unambiguous, and constitute a clear disavowal of scope.").

8   **B.   "Database" ('926, '494)**

Finjan's Construction	Symantec's Construction
a collection of interrelated data organized according to a database schema to serve one or more applications	Organized collection of data

12   **The Court adopts Finjan's construction.**

13   When engaging in claim construction, district courts have granted "reasoned deference" to

14   claim construction orders outside their jurisdiction that address the same term in the same patent,

15   given the importance of uniformity in claim construction. *See Visto Corp. v. Sproqit Techs., Inc.*,

16   445 F. Supp. 2d 1104, 1108 (N.D. Cal. 2006); *Maurice Mitchell Innovations, L.P. v. Intel Corp.*,

17   No. 2:04-CV-450, 2006 WL 1751779, at *4 (E.D. Tex. June 21, 2006), *aff'd*, 249 F. App'x 184

18   (Fed. Cir. 2007); *see also Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1329 (Fed. Cir.

19   2008) ("In the interest of uniformity and correctness, this court consults the claim analysis of

20   different district courts on the identical terms in the context of the same patent.") Under this

21   standard, the court considers the prior claim construction order for its persuasive value, while still

22   ultimately reaching its own independent judgment. *Visto*, 445 F. Supp. 2d at 1108-09; *Maurice*

23   *Mitchell*, 2006 WL 1751779, at *4; *see also B-50.com, LLC v. InfoSync Servs., LLC*, No. 3:10-

24   CV-1994-D, 2012 WL 4866508, at *4 (N.D. Tex. Oct. 15, 2012) (deferring "where appropriate" to

25   construction of same patent claim by court outside jurisdiction in furtherance of the "patent law

26   goal of uniformity"). If anything, to the extent possible, the degree of deference should be greater

27   where the prior claim construction order was issued in the same jurisdiction. As observed by

28   Judge Chen, the Supreme Court has stressed the particular importance of intrajurisdictional

1 uniformity in claim construction, *see Visto*, 445 F. Supp. 2d at 1107-08 (discussing *Markman*, 517

2 U.S. at 390-91), such that claim construction orders from within the jurisdiction arguably should

3 receive greater deference than those from outside it, *see id.* at 1108.

4   In *Finjan, Inc. v. Sophos, Inc.*, No. 14-CV-01197-WHO, 2015 WL 890621, at *2-4 (N.D.

5 Cal. Mar. 2, 2015), Judge Orrick adopted Finjan's identical proposed construction of "database" in

6 the same patents at issue here, on the ground that this construction reflects the patents' "context"

7 and the "well-accepted definition of the term." While still independently weighing the arguments

8 made by the parties here, the Court is persuaded by Judge Orrick's thorough reasoning for

9 adopting Finjan's construction, and accepts that reasoning *in toto* to arrive at the same

10 construction of "database" here. The Court's holding is also consistent with the policy favoring

11 uniformity in claim construction to the extent possible, particularly within the same district.

12   **C.**   **"Means for Receiving a Downloadable" ('844)**

Finjan's Construction	Symantec's Construction
Function: receiving a Downloadable	**Function**: receiving a Downloadable
Structure: Downloadable file interceptor	**Structure**: indefinite

16   **The Court adopts Finjan's construction.**

17   As reflected above, the parties do not dispute that this is a means-plus-function claim under

18 section 112(f), or that the claimed function is "receiving a Downloadable." *Compare* Dkt. No. 72

19 ("Pl. Br.") at 11-12 *with* Def. Resp. Br. at 8-9. Instead, their dispute concerns the corresponding

20 structure that performs that function. *Compare* Pl. Br. at 12-13 *with* Def. Resp. Br. 9-10.

21 Symantec argues that "means for receiving a Downloadable" is indefinite because Finjan's

22 proposed structure—a Downloadable file interceptor—is a general purpose processor or computer

23 "programmed to perform the disclosed algorithm," Def. Resp. Br. at 9, but the '844 Patent does

24 not disclose an algorithm for performing that function. *See Noah Sys., Inc. v. Intuit Inc.*, 675 F.3d

25 1302, 1317 (Fed. Cir. 2012) ("[R]estat[ing] the function associated with the means-plus-function

26 limitation . . . is insufficient to provide the required corresponding structure."). Finjan asserts that

27 the specification designates the "Downloadable file interceptor" as the structure performing the

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