**No. 21-2093**

**UNITED STATES COURT OF APPEALS**
**FOR THE FEDERAL CIRCUIT**

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FINJAN LLC,
*Plaintiff-Appellant*

v.

ESET, LLC, ESET SPOL. S.R.O.,
*Defendants-Appellees*

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Appeal from the United States District Court for the Southern District of California, Case No. 3:17-cv-00183-CAB-BGS

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# 1st CORRECTED BRIEF OF APPELLEES ESET, LLC AND ESET SPOL. S.R.O.

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October 18, 2021

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**U.S. Patent No. 6,154,844 (Appx169-185)**[1]

*Claim 1 (Unasserted)*

1. A method comprising:
receiving by an inspector a ***Downloadable***;
generating by the inspector a first Downloadable security profile that identifies suspicious code in the received ***Downloadable***; and
linking by the inspector the first Downloadable security profile to the ***Downloadable*** before a web server makes the ***Downloadable*** available to web clients.

*Claim 7*

7. The method of claim 1, wherein the ***Downloadable*** includes a JavaScript™ script.

*Claim 15*

15. An inspector system comprising:
memory storing a first rule set; and
a first content inspection engine for using the first rule set to generate a first Downloadable security profile that identifies suspicious code in a ***Downloadable***, and for linking the first Downloadable security profile to the ***Downloadable*** before a web server makes the ***Downloadable*** available to web clients.

**U.S. Patent No. 6,804,780 (Appx187-204)**

*Claim 9*

9. A system for generating a Downloadable ID to identify a ***Downloadable***, comprising:
a communications engine for obtaining a ***Downloadable*** that includes one or more references to software components required to be executed by the ***Downloadable***; and
an ID generator coupled to the communications engine that fetches at least one software component identified by the one or more references, and for performing a hashing function on the ***Downloadable*** and the fetched software components to generate a Downloadable ID.

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[1] Finjan's Opening Brief did not identify the claims asserted against ESET in the district court. In compliance with Fed. Cir. R. 28(a)(12), ESET identifies the complete list of claims Finjan asserted. *See* Appx23140. Nevertheless, ESET agrees that the claims identified in Finjan's Opening Brief are representative with respect to the term "Downloadable."

*Claim 13*

13. The system of claim 9, wherein the ***Downloadable*** includes HTML code.

**U.S. Patent No. 8,079,086 (Appx240-264)**

*Claim 24*

24. A system for managing ***Downloadables***, comprising:

a receiver for receiving an incoming ***Downloadable***;

a Downloadable scanner coupled with said receiver, for deriving security profile data for the ***Downloadable***, including a list of suspicious computer operations that may be attempted by the ***Downloadable***; and

a transmitter coupled with said receiver and with said Downloadable scanner, for transmitting the ***Downloadable*** and a representation of the Downloadable security profile data to a destination computer, via a transport protocol transmission.

*Claim 42*

42. A system for managing ***Downloadables***, comprising:

a receiver for receiving an incoming ***Downloadable***;

a database manager for retrieving security profile data for the incoming ***Downloadable*** from a database of Downloadable security profiles indexed according to Downloadable IDs, based on an ID of the incoming ***Downloadable***, the security profile data including a list of suspicious computer operations that may be attempted by the ***Downloadable***; and

a transmitter coupled with said receiver, for transmitting the incoming ***Downloadable*** and a representation of the retrieved Downloadable security profile data to a destination computer, via a transport protocol transmission.

**U.S. Patent No. 9,189,621 (Appx266-300)**

*Claim 1*

1. A system for determining whether a ***downloadable*** is suspicious, comprising:
at least one processor for accessing elements stored in at least one memory associated with the at least one processor and for executing instructions associated with the elements, the elements including:
a plurality of operating system probes operating substantially in parallel for monitoring a plurality of subsystems of the operating system during runtime for an event caused from a request made by a ***downloadable***;
an interrupter for interrupting processing of the request;
a first comparator coupled to the plurality of operating system probes for comparing information pertaining to the ***downloadable*** against a predetermined security policy, wherein the information pertaining to the ***downloadable*** includes information pertaining to an operation of the ***downloadable*** and distinct from information pertaining to the request; and
a response engine for performing a predetermined responsive action based on the comparison.

*Claim 6*

6. The system of claim 1, wherein the predetermined responsive action includes storing results of the comparison in an event log.

*Claim 7*

7. The system of claim 1, wherein the predetermined responsive action includes informing the user when the security policy has been violated.

*Claim 10*

10. A system for reviewing an operating system call issued by a ***downloadable***, comprising:

at least one processor for accessing elements stored in at least one memory associated with the at least one processor and for executing instructions associated with the elements, the elements including:

a plurality of operating system probes for monitoring substantially in parallel a plurality of subsystems of an operating system during runtime for an event caused from a request made by a ***Downloadable***, wherein the plurality of subsystems includes a network system;

an interrupter for interrupting processing of the request;

a comparator coupled to the plurality of operating system probes for comparing information pertaining to the ***Downloadable*** against a predetermined security policy; and

a response engine for performing a predetermined responsive action based on the comparison.

**U.S. Patent No. 9,219,755 (Appx302-338)**

*Claim 3*

3. A system for reviewing an operating system call issued by a ***downloadable***, comprising:

at least one processor for accessing elements stored in at least one memory associated with the at least one processor and for executing instructions associated with the elements, the elements including:

a downloadable engine for intercepting a request message being issued by a ***downloadable*** to an operating system, wherein the request message includes an extension call;

a request broker for receiving a notification message from the downloadable engine regarding the extension call;

a file system probe and a network system probe each being associated with an operating system function for receiving the request message from the downloadable engine, intercepting an operating system call being issued by the ***downloadable*** to an operating system and associated with the operating system function and providing an event message regarding the operating system call;

a runtime environment monitor for receiving the notification message and the event message and comparing the extension call and the operating system call against a predetermined security policy before allowing the operating system to process the extension call and the operating system call; and

a response engine for receiving a violation message from the runtime environment monitor when one of the extension call and the operating system call violate one or more rules of the predetermined security policy and blocking extension calls and operating system calls that are forbidden according to the predetermined security policy, and for allowing extension calls and operating system calls that are permitted according to the predetermined security policy.

*Claim 5*

5. The system of claim 3, wherein the response engine stores results of the comparison in an event log.

*Claim 6*

6. The system of claim 3, wherein the response engine informs the user when the security policy has been violated.

## CERTIFICATE OF INTEREST

Counsel for Appellees ESET, LLC and ESET, spol. s.r.o. certifies the following:

1. The full name of every party represented by undersigned is:

   **ESET, LLC and ESET, spol. s.r.o.**

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by the undersigned is:

   **Not applicable**

3. All parent corporations and any publicly held companies that own more than 10 percent of the stock of the party represented by the undersigned are:

   **Not applicable**

4. The names of all law firms and the partners or associates that appeared for the party now represented by the undersigned in the trial court or agency or are expected to appear in this Court (and who have not or will not enter an appearance in this case) are:

   **Christopher C. Bolten**
   **Eversheds Sutherland (US) LLP**

   **Kadmiel E. Perez**
   **Foley & Lardner LLP**

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by

this court's decision in the pending appeal. *See* Fed. Cir. R. 47.4(a)(5) and 47.5(b):

***Finjan LLC v. SonicWall, Inc.,* No. 5:15-cv-04467 (N.D. Cal)**

***Finjan LLC v Palo Alto Networks, Inc.,* No. 4:14-cv-4908 (N.D. Cal.)**

6. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6):

**Not applicable.**

Date: October 18, 2021

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## STATEMENT OF RELATED CASES

Per Federal Circuit Rule 47.5(a), Appellees state that no other appeals from this civil action have previously been before this or any other appellate court.

Per Federal Circuit Rule 47.5(b), the undersigned counsel is aware of the following pending cases that will directly affect or be directly affected by this Court's decision in the pending appeal:

- *Finjan, Inc. v. SonicWall, Inc.*, No. 5:17-cv-04467 (N.D. Cal.)
- *Finjan LLC v. Palo Alto Networks, Inc.*, No. 4:14-cv-04908 (N.D. Cal.)

## STATEMENT OF THE CASE

### I. ESET and Its Anti-Malware Software Products

ESET, spol. s.r.o. was founded in 1992 in present-day Slovakia to develop and commercialize anti-virus software, called NOD. Before Finjan was even founded, ESET's NOD anti-virus program used heuristic algorithms to conduct behavioral analysis of files in search of potentially malicious software. Since 1999, ESET, spol. s.r.o. has distributed its award-winning server-side and end-user software in the United States via San Diego-based ESET, LLC (collectively, hereafter, "ESET").

### II. Finjan's Asserted Patents

The five patents Finjan asserts against ESET—U.S. Patent Nos. 6,154,844, 6,804,780, 8,078,086, 9,189,621, and 9,219,755—all are part of the same family and are all expired. Each claims priority to, and incorporates by reference, U.S. provisional application serial no. 60/030,639 as well as one or more of U.S. Patent Nos. 6,092,194, 6,167,520, and 6,480,962. As illustrated on page 16 of its Opening Brief ("Brief"), and conceded by Finjan on page 24, "the patents in this family used extensive incorporation by reference, so every asserted patent incorporates (one way or another) ***conflicting definitions*** of Downloadable" (emphasis added).[2] As a

[2] All emphasis in brief added unless otherwise stated.

review of the various patents reveals, and as Finjan concedes, the subject matter of the various specifications is widely divergent. *See* Brief at 9.

The term "Downloadable," as Finjan further concedes, had no inherent or intrinsic meaning in the art at the time Finjan filed for the patents. *See* Appx1203-1204. Instead, the patentee defined the term "Downloadable." *Id.* The tangled web of incorporation in Finjan's patents makes context-dependent analysis of the disclosures of the asserted patents difficult and time-consuming. Thus, the District Court conducted a painstaking analysis to determine how a person of skill in the art, reading the asserted patents, would have understood the term "Downloadable." The District Court concluded, following multiple rounds of briefing and a lengthy oral argument, that a Downloadable is "a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer," exactly as the inventors defined it. Appx2-3. The District Court rejected Finjan's definition of "an executable application program" because that definition ***excludes*** interpretable programs, such as scripts, that each asserted patent identifies as exemplary Downloadables. Moreover, Finjan's construction, which leaves out the word "interpretable," renders certain dependent claims—for example those directed to "scripts" and "HTML"—incomprehensible.

"[A]t the time of the alleged inventions, JavaScript was one of the canonical ***interpreted*** languages." Appx930-931 (citing article stating, "JavaScript is an

interpreted language"). On the other hand, executables are programs in machine language. Appx930 (¶¶24-25); Appx1024-1028 (defining "executable" as "a program in machine language that is ready to run in a particular computer"); Appx1031-1035 (defining "executable" as "a program that is ready to run on a given computer. For a program to be executable, it first must be translated, usually by a compiler, into the machine language of a particular computer"). Moreover, the executable program set and interpretable program set are disjoint, thus, scripts such as JavaScript scripts, are "***interpretable***" programs not "executable" programs. *See* Appx931.

Each asserted patent provides example Downloadables of both program types: executable (i.e. Java applets) and interpretable (i.e. Javascript script, Visual Basic script, and HTML). *See, e.g.*, Appx169-185 ('844 patent) at Appx178 (1:51-55, 1:62-65 ("The present invention provides systems for protecting a network from suspicious Downloadables, e.g., Java applets, ActiveX controls, ***JavaScript scripts***, or ***Visual Basic scripts***)), Appx183 (claim 7 ("wherein the Downloadable includes a JavaScript ***script***"), claim 8 ("wherein the Downloadable includes a Visual Basic ***script***")); Appx187-204 ('086 patent) at Appx199 (2:38-43 ("For example…downloadable application programs…such as Java™ applets, ActiveX™ controls, JavaScript™ Visual Basic ***scripts***, addins, etc…")), Appx203 (claim 4 ("wherein the Downloadable includes program ***script***")); Appx240-264 ('780

patent) at Appx253 (1:55-61, 2:4-6 ("The Downloadable may include a Java applet, an ActiveX control, a JavaScript ***script***, or a Visual Basic ***script***")), Appx263 (claim 4 ("wherein the Downloadable includes a program ***script***"), claim 5 ("wherein the Downloadable includes HTML code")).

In light of the examples in the specification and the dependent claims, the correct construction of Downloadable must encompass both executable ***and*** interpretable programs. The ***only*** patentee-coined definition of Downloadable that covers ***both*** types of files comes from the incorporated '520 and '962 patents.

## III. The District Court's Claim Construction Order

The parties submitted initial claim-construction briefs on August 7, 2017. Appx1195-1125; Appx883-915. Supported by its technical expert, Dr. Spafford, ESET argued that the term Downloadable "has no special meaning to one of skill in the art." Appx890; Appx928 (¶20). ESET explained that for the '844 and '780 patents, the patentee defined Downloadable differently in the incorporated applications, and that the explicit definition provided in those two patents could not be reconciled with the disclosed examples, thus rendering the claims indefinite.[3]

[3] Contrary to Finjan's contention that ESET's motion for summary judgment of indefiniteness "was a new theory not previously ventured by ESET," that eventual motion was plainly contemplated during claim construction. *See* Brief at 19. Moreover, the potential indefiniteness of the word "small" was specifically noted at the *Markman* hearing. *See* Appx23577-23589 (29:15-41:15), Appx23613-23616 (65:21-68:1). Moreover, the District Court concluded that ESET preserved the issue.

ESET cited Dr. Spafford's declaration for his undisputed testimony that JavaScript scripts are interpreted programs, not "executable application programs." Appx930-931.

Finjan wrongly asserts on appeal that "no party proposed [a] family-wide approach to claim construction [for Downloadable]." Brief at 18. In fact, Finjan argued in its opening claim construction brief that "[c]onsistent with the controlling case law, Finjan's proposed construction for 'Downloadable' is the same across all of the Finjan Patents…" Appx1206. Finjan also argued in its responsive claim construction brief that "'Downloadable' should be construed the same across all relevant Finjan Patents, as it is used identically in these patents." Appx2543.

At the September 2017 *Markman* hearing, the District Court stated it had "found that Downloadable includes both executable and interpretable," and the only remaining issue was whether the inventors' definition required the word "small." Appx23614-23615. The Court accordingly ordered supplemental briefing on the term "Downloadable" as used in the '621 and '755 patents. Appx2886.

In its supplemental brief, ESET explained that no prior patent challenger had addressed the impact of the incorporated patents or argued for a construction of "Downloadable" based on the incorporated '962 patent. Appx2897. ESET cited

*See* Appx22637-22638, n.2 ("This issue was identified at claim construction and Finjan was on notice that ESET would likely pursue it.").

this Court's case law holding that, where multiple specifications are incorporated by reference into a patent, the District Court must consider the effect of those incorporated specifications. Appx2897-2899. ESET further argued that because Finjan's definition of "Downloadable" did not cover the disclosed examples in the '844, '780, and '086 patents, it could not be correct for those patents either. *Id.*

The District Court's November 2017 Claim Construction Order adopted the definition of "Downloadable" provided in the '962 patent, explaining that it was the only definition faithful to the examples and claims of the asserted patents, each of which included interpretable application programs. Appx2-3. Specifically, the District Court explained "[t]he entirety of the specification's description would inform that **Downloadable** includes executable ***and interpretable*** application programs, in accordance with the examples and incorporated references." Appx3 (bold in original).

## IV. ESET's Motion for Summary Judgment Based on Indefiniteness

ESET's initial motion for summary judgment of indefiniteness explained that a person of skill in the art could not ascertain the upper bound of "Downloadable," i.e., could not tell which files qualified as "small." Appx5506-5520. ESET explained that "'small' is a vague term of degree having no defined boundaries in either the intrinsic record of the patents or the extrinsic record developed in this case." Appx5510. "The law requires that a term of degree be specific enough that

a person of ordinary skill in the art could recognize and understand the bounds of the term – yet 'small' has no accepted, recognized meaning with respect to a 'Downloadable' to those of skill in the art." *Id.*

As detailed in ESET's brief, none of Finjan's experts could determine the scope of the word "small" in the context of a Downloadable. Appx5513-5515. Finjan retained six technical experts to address issues of alleged infringement and validity of the asserted patents:

| Finjan Expert | Subject Matter |
|---|---|
| Dr. Cole | Infringement, '844 patent (Appx5513) |
| Dr. Mitzenmacher | Infringement, '780 and '086 patents (Appx5514) |
| Dr. Medvidovic | Infringement, '621 and '755 patents (Appx5515) |
| Dr. Jaeger | Validity, '844, '780, and '086 patents (Appx23494) |
| Dr. Goodrich | Validity, '621 and '755 patents (Appx5515) |
| Dr. Orso | Secondary factors, all asserted patents (Appx4791) |

During their depositions, ESET asked Finjan's experts to explain how a person of ordinary skill would understand the term "small" in the construction of Downloadable. Their responses to that straightforward question produced widely divergent answers, as summarized below (Appx5513-5515):

| Finjan Expert | Explanation of "small" in Context of Downloadable File |
|---|---|
| Dr. Cole | "Something of a relative small size. Something that is not really large…Like a three gig word executable, I wouldn't consider to be small…something that was of ***reasonable size***, that wasn't extremely large, it wasn't ***multiple gigs***." Appx5539 (170:17-20; 171:19-21). Reasonable size could be a "few megs [up to] 40 megs." Appx5540 (173:8-10). The definition of small "could potentially change" "depending on the speed of computers." Appx5539 (169:23-24). |
| Dr. Mitzenmacher | "there are many examples of things…under, you know, the -- the 10 megabyte range…So many of the files would be even much smaller than -- than 10k…10 kilobytes." Appx5544 (71:16-25; 72:1-8). The definition of "small" would not have changed between 1996 and 2018. *Id.* (72:15-25); Appx5545 (73:1-10). |
| Dr. Medvidovic | "***I don't know that it's possible to ascribe a specific size limit***. Could be ***kilobytes*** to megabytes." Appx5549 (116:17-22). "It is an application program that would be |

| | |
|---|---|
| | smaller than something like Microsoft Word, which is ***hundreds of megabytes*** in size." Appx5550 (117:3-9). |
| Dr. Goodrich | "[s]mall is a relative term" where something that is small is contrasted with "something that would not necessarily be a small executable or interpretable application program in that same context." Appx5555 (101:21-25; 102:1-10). "[O]n the order of, you know, ***5, 10 kilobytes***, then something ***on the order of gigabytes*** would be an example of something ***that's not small*** in that context." *Id.* (102:14-22). Whether something is small "depends upon what you are comparing it to." Appx5556 (106:23-24). |
| Neither Drs. Jaeger nor Orso testified about the term "small." | |

As noted above, Finjan's experts' answers varied in the extreme, ranging from "a few megs…something that's not multiple gigs or really large" (Cole) to "less than 10 kilobytes" (Mitzenmacher), to "an application program that would be smaller than something like Microsoft Word, which is hundreds of megabytes in size" (Medvidovic), to "on the order of…5, 10 kilobytes, then something on the order of gigabytes would be an example of something that's not small in that context" (Goodrich). As to when these ranges were applicable, at least some of Finjan's experts opined that "small" included a temporal component. Appx5519;

Appx21334. To those Finjan experts, whether something was "small" and therefore potentially infringing, would be based on the year the alleged infringement took place. *See, e.g.,* Appx5519. In short, Finjan's own experts could not agree on the appropriate scale or associated metrics to determine the scope of "small."

Finjan's Opposition argued that because ESET's expert had opined that certain prior art invalidates the asserted patents, he must have understood the term "small" to be definite. Appx20073-20074. But Dr. Spafford only testified that if the files Finjan accused of infringing met the claim requirement of being "small," then the files processed by the prior art systems, which were either the same size or smaller, also must qualify as "small." Appx21329; Appx21331-21332. Dr. Spafford did not rely on the size of a Downloadable as the basis for any non-infringement opinion. *Id*.

During oral argument on ESET's motion, the District Court stated: "I still have serious concerns what the scope of small is, but I'm going to hold off and leave this for an issue for trial. We'll send it to the jury, but I might have an advisory." Appx22558. In its October 2019 Order, the Court denied ESET's motion "without prejudice to ESET demonstrating this invalidity defense at trial." Appx22639.

## V. Trial Testimony Regarding "Small" in the Context of a Downloadable

Trial began March 10, 2020. By March 12, Dr. Cole, Finjan's '844 patent infringement expert, completed his testimony. Appx23215. During cross-

examination, Dr. Cole confirmed that at his deposition he was unable to give an exact size of a file that would constitute small. *See* Appx23146. Instead Dr. Cole testified, "the definition of small is an executable that doesn't require installation when it runs on your system, and I believe I did give that during my deposition."[4] *Id.; see also* Appx23146-23149 ("a small on [sic] Downloadable, someone skilled in the art is going to deem that as a Downloadable that doesn't require installation…[its] really based on whether you install it or not is the criteria for small."); Appx23152 ("What I'm saying is, ***small executable is something that doesn't require installation compared to large executables that do require installation***."). Dr. Cole continued, adding that "[w]ith small executable, we're using whether it requires installation or not, so ***the size*** or number, that ***doesn't matter in determining small.***" Appx23155. Consistent with his contention that "small" in the context of Downloadable has nothing to do with size, Dr. Cole conceded that a two-terabyte non-installed executable would be "small" within the Court's construction. Appx23214 ("that would be extremely unusual, but if it didn't require installation, then, yes, that would fit the requirement of being small").

On March 16, due to the Covid-19 pandemic, the District Court declared a mistrial.

[4] Dr. Cole's installation-based definition of "small" appears nowhere in his deposition testimony. *See* Appx23147-23148.

## VI. ESET's Renewed Summary Judgment Motion of Indefiniteness

On July 23, 2020, ESET requested leave to file a renewed summary judgment motion of invalidity based on indefiniteness that encompassed Finjan's ***new theory*** of "small" in light of Dr. Cole's testimony. The District Court granted ESET's request that day. Appx23360.

On August 21, 2020, ESET filed its renewed summary judgment motion of invalidity based on indefiniteness of the term Downloadable. Appx23363-23383. ESET explained that, whereas Finjan's experts offered widely divergent views as to the size of "small" during expert discovery, Dr. Cole's trial testimony completely eschewed any consideration of size. Appx23370-23374. As noted above, Dr. Cole testified that whether or not a file is "small" turns on whether the file is installed. *Id.* So size didn't matter to Dr. Cole; in his opinion even a two-terabyte non-installed file qualifies as small. *Id.* ESET pointed out that Dr. Cole's newly-invented trial-definition of "small" took indefiniteness to another level. Dr. Cole's definition completely ignored the "plain and ordinary" meaning of "small" as size-related. Appx23367. Instead, Dr. Cole's new theory usurped the role of the Court and attempted to construe the term "small" as "non-installed." Appx23373. Finjan's theory, presented via Dr. Cole's testimony, is entirely unsupported by the intrinsic and extrinsic evidence of record. Appx23373.

ESET also reprised the various and widely divergent deposition testimony provided by Finjan's experts for the term "small." Appx23370-23376. For example, ESET cited Dr. Goodrich's testimony that "small is a ***relative*** term" whereby the meaning could only be determined by examining the file in context: "Small is a relative term, so you have to compare it to something. So just in the isolation, one product could be small or could be large, depending on what you're comparing it to." Appx23375; Appx5555 (103:7-20). ESET explained that Dr. Goodrich's definition, which Finjan advances in this appeal, provides no meaningful guidance to determine which files the asserted patents cover. Appx23375.

ESET's brief also highlighted that Dr. Cole's trial-definition of "small," as whether a Downloadable was installed, was utterly devoid of intrinsic or extrinsic support, and had nothing at all to do with size. Appx23371-23372. At no point in any of Finjan's previous briefs, expert reports, expert testimony, or oral argument did Finjan advance the theory that "small" was based on whether or not the file was "installed." ESET's brief also reviewed the relevant case law, and how Finjan's expert testimony, in the aggregate, established there were no metrics or meaningful bounds for the term Downloadable, such that the claims of the asserted patents failed the public notice function. Appx23377-23380.

Finjan's Opposition to ESET's renewed motion trotted out many of the same arguments that Finjan advances before this Court. Appx23391-23411. There, as

here, Finjan advanced the non-sequitur that because Dr. Spafford identified invalidating prior art, he must have understood the scope of the term "small." Appx23397-23398. But as previously explained, Dr. Spafford simply adopted Finjan's apparent understanding of "small" based on Finjan's infringement contentions. *See* Appx23453-23454.

Finjan also argued, inconsistently, that Dr. Spafford had not opined on the meaning of small in his expert report, and thus could not have testified on that topic at trial. Appx23399-23499; Appx23407-23410. Finjan did not explain what evidence it contended raised a genuine (or ***any***) issue of material fact. Appx23401. Instead, Finjan pointed to other litigations and administrative proceedings where the definition for the term "Downloadable" as used in the asserted patents was adopted by agreement of the parties.[5] Appx23396.

Finjan also argued that "Dr. Cole's testimony from the mistrial ***will be replaced by his testimony at the future trial***, and Finjan's other experts will provide complete testimony." Appx23401. Yet Finjan offered the Court no clue as to what Dr. Cole's "replacement testimony" would be, why his current testimony was somehow insufficient, or why in a future trial he should be permitted to opine on his

[5] During discovery, despite repeated requests from ESET, Finjan ***refused*** to provide discovery on other litigations and administrative proceedings involving the family of patents as "unduly burdensome." *See*, Appx23955-23956. Finjan now seeks to burden this Court by asking it to consider materials not present in the record below. *See* Brief at 4, n.2.

"installability" theory when he never provided such testimony in his expert report or deposition. *Id.* Finjan further argued, "Dr. Cole's explanation of 'small' [at trial] accounts for size," Appx23402, notwithstanding his express testimony that "***the size…doesn't matter in determining small.***" Appx23154-23155.

Finjan also argued: "[t]o the extent Dr. Cole and Finjan's other experts discussed potential size ranges at their depositions, they ***are consistent*** with Dr. Cole's explanation of the plain meaning of 'small.'" Appx23405. Finjan did not explain how it planned to reconcile the differences in Dr. Cole's testimony, or how its other experts' testimonies of "context dependent" size were consistent with Dr. Cole's assertion that size didn't matter. The District Court, reviewing Finjan's arguments, rightly realized that gaslighting was afoot.

ESET noted in its Reply brief, Appx23448-23459, that Dr. Cole's testimony replaced the word "small" in the inventors' ***own*** definition of Downloadable with "non-installed." Appx23449. Thus, irrespective of the Court's construction, Finjan planned to advance a definition of Downloadable at trial of "a ~~small~~ **non-installed** executable or interpretable application program which is downloaded from a source computer and run on a destination computer." *Id.* ESET's Reply also pointed out that "Finjan's Opposition…is at war with itself" in arguing that the Court should not decide ESET's motion without hearing from Dr. Spafford while at the same time arguing that Dr. Spafford should not be heard on the topic as beyond his expert

report. *Id.* Nevertheless, on summary judgment the District Court did consider Dr. Spafford's report and deposition testimony in deciding that neither created a genuine issue of material fact.

ESET explained that Dr. Spafford had provided undisputed testimony that Javascript scripts and Visual Basic scripts were interpretable application programs. This testimony demonstrated that the inventors' definition of Downloadable from the incorporated specifications was the ***only*** definition that covered the examples and claims of the asserted patents. Appx23453. ESET demonstrated that nothing in Finjan's Opposition detracted from the clear and convincing evidence of indefiniteness of the term "Downloadable" established in the record, nor created a triable issue of fact. As ESET observed, Finjan could not create a triable issue by having its own experts offer radically different opinions, all of which conflict with the intrinsic evidence. Appx23450-23452.

Finally, ESET explained that the record, including Dr. Cole's trial testimony, was sufficiently developed for the Court to decide the indefiniteness issue on summary judgment; just as countless issues are decided at the summary judgment phase. Finjan's Opposition presented no evidence of a genuine fact issue, and unless Finjan planned to come to trial with an entirely new spin on "Downloadable," the Court need not await that new, and improper, testimony. Appx23456.

## VII. The District Court's Determination on Renewed Summary Judgment

On March 23, 2021, the District Court entered its Order adjudging all of asserted claims of the asserted patents invalid as indefinite because a person of skill in the art could not reasonably determine the scope of the term "Downloadable" as used in those claims. The Court issued an amended Order on March 29, 2021 that corrected a grammatical mistake. Appx14-21. The Order noted none of Finjan's prior litigations or administrative proceedings had touched upon "how earlier references incorporated into the patents at-issue inform the construction of the term 'Downloadable.'" Appx15.

The District Court reiterated its claim construction analysis and affirmed its construction that "[Downloadable] is limited to '***small*** executable or interpretable application programs,' and not ***all*** executable application programs." Appx15.

Citing the Supreme Court's decision in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014) ("*Nautilus I*"), the District Court stated, "[t]erms of degree must provide sufficient certainty to one of skill in the art to afford clear notice of what is claimed and what is still open to the public." Appx18. The District Court further explained:

> Finjan opposed ESET's initial motion for summary judgment for indefiniteness as to the scope of 'small' on the grounds that a numerical limitation or cut-off is not necessary because a skilled artisan could determine if an application is 'small' from the examples in the '962 patent and based on the context. Finjan, however, did not provide an

> explanation as to how that skilled artisan would therefore interpret 'small' or the context that would apply.

Appx19 (footnote omitted). The District Court then noted:

> Finjan's contention that the understanding of what is 'small' depends on the context is not supported by the intrinsic evidence or even extrinsic evidence of the state of the art at the relevant time. It amounted to 'unpredictable vagaries of any one person's opinion' and therefore failed to provide sufficient notice as to the scope of the term.

Appx20 (citations omitted). The District Court also noted Dr. Cole's trial testimony on behalf of Finjan that "'small' depends not on size but on the function," concluding "Dr. Cole did not however provide support from the specification, the prosecution history, or from any extrinsic sources in the relevant time period [for his new definition]." Appx20-21.

Accordingly, the District Court held that "Finjan never offered evidence of a reasonable range for the size of a small executable or interpretable application program as understood by a skilled artisan in 1997 based on examples provided in the patent specification" but instead "elected at trial to offer a new understanding without reference to the size of the application as the objective boundary of a 'small' application" that "is not supported by the specification or prosecution history." Appx21. The District Court went on to note that because Finjan's new definition could not be reconciled with its pre-trial positions, the new definition did not "provide clear notice of what constitutes a 'small executable or interpretable

application program' so as to create a genuine fact issue precluding summary judgment on invalidity of the claims of the asserted patents." *Id.*

**VIII. Finjan's Motion for Reconsideration**

On April 12, 2021, Finjan filed its motion for reconsideration together with an "Offer of Proof" setting forth the opinions of Finjan's other technical experts, including Drs. Goodrich, Medvidovic, and Jaeger. Appx23489-23499. Finjan's Offer of Proof also described Finjan's intended cross-examination of Dr. Spafford on the issue of indefiniteness based on the word "small."[6] Appx23494-23497. Finjan argued, as here on appeal, that the District Court had shifted the burden to Finjan to prove that the patents were not invalid. Appx23480.

Finjan also argued that the Court considered only Dr. Cole's testimony but had not considered that of Dr. Goodrich, Finjan's invalidity expert. Appx23482. Finjan did not even try to explain how Dr. Goodrich's definition of Downloadable, in which small was "context dependent," could be reconciled with Dr. Cole's trial testimony of "installable," where size doesn't matter. Appx23473-23488. Nor did Finjan explain why it was entitled to one definition for Downloadable for infringement, and a different definition of Downloadable for invalidity. Nor did Finjan explain how Dr. Goodrich's or Dr. Medvidovic's purported trial testimony—

[6] Any such cross-examination is objectionable as outside the scope of any proffered direct examination because Dr. Spafford's expert report did not opine on the "size" of a Downloadable.

which simply repackaged their expert deposition testimony and had been thoroughly considered during ESET's motions for summary judgment—could somehow lead to a different outcome. Finjan again repeated its thoroughly debunked contention that ESET had not put indefiniteness in issue. *Id.*

On May 19, 2021, the District Court denied Finjan's motion for reconsideration explaining:

> ESET filed a motion of summary judgment arguing that Finjan's evidence, specifically the Rule 26 reports and deposition testimony of Finjan's experts demonstrated by clear and convincing evidence that one of skill in the art would not know with reasonable certainty what constitutes a 'small executable or interpretable application program.' Each of Finjan's experts had offered widely varying characterizations of the scope of 'small.'

Appx23. In addition, the District Court concluded there was "no consensus among [the experts] as to the scope of the claim term to establish that the public would have notice with any reasonable certainty." Appx24.

The District Court further explained that:

> [a]t trial Finjan offered the testimony of one of its experts on infringement. To establish that the accused systems were covered by the limitation at issue, the expert provided yet another, previously undisclosed, interpretation of the construction of a small application program that was not in accordance with his prior interpretation or the opinions of any of Finjan's other experts.

*Id.* The District Court agreed, "this testimony further demonstrated that there was no reasonable certainty among those of skill in the art as to what constitutes 'small' in the context of the asserted patents." *Id.* The District Court also rejected Finjan's

contention that the burden of proof had been shifted to Finjan, observing that "***ESET demonstrated*** by clear and convincing evidence that Finjan's inconsistent interpretations of a claim term employed in its infringement analyses established that the term was indefinite" and that "the lack of consensus among [Finjan's] own experts in construing the term only serves to underscore the lack of certainty among those of skill in the art." *Id.*

## SUMMARY OF THE ARGUMENT

The District Court's claim construction was well-reasoned, the product of extensive briefing by the parties, and based on a thorough review by the District Court of the intrinsic record and the parties' expert submissions. The District Court's construction of "Downloadable" as "a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer" is the ***only*** definition discernible from the asserted patents that encompasses the disclosed examples and renders the claims coherent. Where the inventor acts as his own lexicographer, courts are bound by the inventor's definition, even if that definition renders the claims indefinite. And Finjan should not be heard to complain that the District Court construed Downloadable the same across all of the asserted patents, as Finjan itself argued for that very outcome.

Finjan received a full and fair hearing on ESET's renewed motion for summary judgment and Finjan's motion for reconsideration. In addition, the District Court considered Finjan's proffer of purported additional evidence submitted with its motion for reconsideration. That additional evidence further demonstrated the correctness of the District Court's determination. The District Court did not, as Finjan contends, shift the burden of proving validity to Finjan. Instead, Finjan simply failed to identify a genuine issue of material fact to rebut the clear and convincing evidence of indefiniteness marshaled in ESET's renewed motion.

Finjan could not have solicited any expert testimony at trial that would have resulted in a different outcome. Finjan's experts' widely divergent testimony already was in the record and considered by the District Court in deciding ESET's renewed summary judgment motion. Finjan could not create a genuine fact issue by highlighting the disagreements between its ***own experts*** as to the meaning and scope of "small." Nor could trial testimony from ESET's expert, Dr. Spafford, save Finjan's patents, as he never opined about the scope of the term "small" in the definition of Downloadable.

Finjan deliberately chose to execute a "shifting sands" approach to infringement. During expert discovery, Finjan's experts testified that "small" could vary in size by ***six orders*** of magnitude. Finjan's experts also testified during discovery that the size of "small" might depend on temporal considerations, might depend on the speed of an end-user's network, and might be relative to what other files the system processed. Then, at trial, Dr. Cole testified that "small" suddenly does not relate to size at all, in complete disregard for the District Court's claim construction as well as the intrinsic and extrinsic evidence. The District Court did not need any further testimony from Finjan's experts (or anyone else for that matter) to conclude that Finjan's ever-changing, inconsistent, and boundless definitions provided no guidance as to the appropriate scope of the term "small." Put simply,

Finjan's arguments were irreconcilable. Finjan is not entitled to a "do-over"; its appeal is frivolous.

## ARGUMENT

### I. The District Court Construed "Downloadable" Properly Based on the Disclosed Examples and Claims of the Asserted Patents.

The District Court conducted an exhaustive review of the specifications of the asserted patents, including the incorporated '520 and '962 patents, the intrinsic evidence, and the parties' expert submissions. Based on that review, the District Court properly concluded that (1) the term "Downloadable" had no ordinary and accustomed meaning in 1997 when the patents were written; and (2) among the conflicting definitions provided in the specifications, the ***only*** definition that was faithful to the disclosed examples of Downloadables and supported the dependent claims in the asserted patents was "a small executable or interpretable application program…" Contrary to Finjan's mischaracterization throughout its Brief, the District Court did not conclude that Downloadable "for the purposes of the claim, must always be 'small'." Brief at 27. Instead, the District Court concluded that "small" was an integral part of the definition the inventors created for the term "Downloadable."[7]

[7] Finjan argues, "Downloadables are Downloadables, regardless of whether or not they are 'small'." Brief at 31. ESET agrees. Small is ***part of the inventors' definition*** of Downloadable, not a separate modifier of the term Downloadable.

### A. Applying the Proper Claim Construction Rules Demonstrates that the District Court Properly Construed the Term "Downloadable."

When the ordinary meaning of claim language as understood by those of ordinary skill in the art is readily apparent even to lay judges, then the claims terms should be given their plain and ordinary meaning. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc). One exception to the ordinary meaning rule is when the patentee acts as her own lexicographer. *Thorner v. Sony Computer Entm't Am. LLC*, 669 F.3d 1362, 1365-66 (Fed. Cir. 2012). Where a term has no meaning other than that provided by the patentee, the patentee's definition controls as a matter of law. *Edwards Lifesciences LLC v. Cook Inc.*, 582 F.3d 1322, 1329 (Fed. Cir. 2009). Furthermore, where the inventor acts as his own lexicographer in defining a claim term, a court may not rewrite the inventor's definition to remove language that renders the claims indefinite. *See, e.g.*, *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1374 (Fed. Cir. 2014). Thus, if a patentee acts as his own lexicographer and defines a term in such a way that the term is indefinite, it would be error for a court to "fix" the patentee-created definition to preserve validity. *See, e.g., Elekta Instrument S.A. v. O.U.R. Sci. Int'l, Inc.*, 214 F.3d 1302, 1309 (Fed. Cir. 2000) (finding that if the construction of the claim is clear and renders the claim invalid, then the claim is invalid).

Where one patent incorporates a second patent by reference, the entirety of the incorporated material must be considered. *Paice LLC v. Ford Motor Co.*, 881

F.3d 894 (Fed. Cir. 2017) (incorporated "material is effectively part of the host document as if it were explicitly contained therein"). Moreover, even if the patent-at-issue has an explicit teaching, that explicit teaching can be overwritten by an incorporated priority patent where the teaching of the incorporated patent better comports with described embodiments of the patent-at-issue. *X2Y Attenuators, LLC v. ITC*, 757 F.3d 1358 (Fed. Cir. 2014) (affirming construction of a term relying on statements in ***incorporated priority patents*** based on disclosed examples notwithstanding that the patent-at-issue explicitly taught the opposite). "Whether and to what extent material has been incorporated by reference into a host document is a question of law." *Advanced Display Sys. v. Kent State Univ.*, 212 F.3d 1272, 1283 (Fed. Cir. 2000). The contents of a host document along with all information incorporated by reference are treated as a unified disclosure. *Id*. ("if incorporation by reference comes into play in an anticipation determination, the court's role is to determine what material in addition to the host document constitutes the single reference"). When a host document includes narrow and broad incorporations by reference of a single document, the broader incorporation controls. *Harari v. Lee*, 656 F.3d 1331, 1335 (Fed. Cir. 2011)

As described below, the District Court properly applied the rules of claim construction to conclude (1) the term "Downloadable" had no meaning to one of skill in the art; (2) the patentees acted as their own lexicographers in defining the

term; and (3) the inconsistencies in the patentees' definitions of "Downloadable" could only be resolved by adopting the definition that incorporated "small" and "interpretable."

### 1. The Patentees Acted As Their Own Lexicographers in Inconsistently Defining the Term "Downloadable."

The parties agree that the term "Downloadable" had no meaning to one of skill in the art at the time Finjan filed the patents. *See* Appx979 at n.1; Appx928.

Instead, the inventors first coined the term in their November 8, 1996 provisional application. There, the inventors defined "Downloadable" as "an executable application program which is automatically downloaded from a source computer and run on the destination computer." Appx1863. But the definition evolved as the inventors began filing non-provisional applications. On January 29, 1997, the inventors changed the definition of "Downloadable" when they filed the application that matured into the '520 patent. In that application, the inventors defined "Downloadable" as "a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer." Appx1016 (1:32-34). This definition broadened the scope of the term by doing away with the word "automatically" and adding coverage for interpretable programs. In addition, the inventors modified the language to clarify that Downloadables, be they executable or interpretable, had to be "small." By November 8, 1997, the inventors modified the definition again when filing the application that matured into the '194

patent. There, the inventors provided a third definition: "an executable application program, which is downloaded from a source computer and run on the destination computer." Appx996 (1:45-47). This third definition removed the word "automatically" from the provisional definition but excluded interpretable programs.

Each of the asserted patents incorporates all three of the patentee-coined definitions. Brief at 16 (chart showing incorporations). Because the parties agree that "Downloadable" has no plain and ordinary meaning, the patentees' definition controls as a matter of law. *Edwards*, 582 F.3d at 1329. Moreover, because it would be inappropriate for a court to rewrite a definition where a patentee acted as its own lexicographer, the question becomes which of the definitions should apply? *See Interval Licensing*, 766 F.3d at 1374.

#### 2. The Conflicting Definitions Incorporated into the Asserted Patents Could Only Be Resolved by Using the Patentees' Definition Including "Interpretable" and "Small."

Resolving the inherent contradiction in the various definitions, the District Court recognized that it could not rewrite any of the express patentee-coined definitions and therefore should choose among them. *Id*. The District Court adopted, verbatim, the definition from the '520 patent: "small executable and interpretable application programs…" This definition is the only definition that made sense in light of the remainder of the specification and claims.

**a. The Prosecution History of the '621 and '755 Patents Shows that the Context of the Alleged Inventions Hail from the '520 Specification and Compel the Definition of Downloadable That Includes "Small" and "Interpretable."**

During claim construction, Finjan conceded that neither the '621 nor '755 patents contain an express definition of the term "Downloadable." Appx1206 (relying on other patents to provide the definition). Therefore, any definition for the term "Downloadable" in those two patents must come from the incorporated material. Both patents incorporate the entirety of the '962 and '780 patents, each of which contains a different patentee-coined definition of "Downloadable." Thus, the '621 and '755 patents incorporate two ***different*** patentee-coined definitions. *See* Appx13.

During prosecution of both the '621 and '755 patents, the Examiner questioned whether there was specification support for the proposed claims. Appx1061-1062 ('621 patent); Appx1073-1076 ('755 patent). The Examiner noted that nothing in the specifications of the '621 and '755 patents (excluding incorporated material) related to the asserted claims. *See* Appx894. In response, Finjan pointed to language from the '962 incorporated-by-reference specification as providing the necessary support.[8] Appx1061-1062 (citing exclusively to the '962

[8] Finjan's Brief argues that the asserted patents had nothing to do with the '520 and '962 patents because those patents focused on applets. *See, e.g.,* Brief at 28-31. Finjan ignores where the support for the claims of the '621 and '755 patents came

patent specification for support for the '621 patent claims); Appx1073-1076 (same for the '755 patent).

Finjan admitted during prosecution of the '621 and '755 patents that the claimed subject matter was disclosed in the '962 patent specification. If the alleged inventions in the '621 and '755 patents are supported by the specification of the '962 patent, then at the very least, the ***definition*** of Downloadable from the '962 patent also ought to apply. The '962 patent is a continuation of the '520 patent. Appx13. And the '520 and '962 patents do ***not*** incorporate by reference the definition from the '780 patent (i.e. the definition that Finjan proposes). *See id.* Thus, the ***sole*** patentee-coined definition applicable to the claims of the '621 and '755 patents is the one that includes the words "small" and "interpretable."

Finjan repeatedly argued "Downloadable" should be construed the same for all five patents. Appx1206; Appx2543. Because the only construction of "Downloadable" that makes sense with respect to the '621 and '755 patents includes the words "small" and "interpretable," the District Court properly used that construction for all asserted patents.

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from by stating that the specifications are a continuation of the '086 patent. *Id.* at 37-38. But it is undisputed that the ***alleged inventions*** of the '621 and '755 patents find no support in the '086 specification. Instead, as Finjan explained to the Examiner, the support comes ***solely*** from the'962 patent specification, which is identical to the'520 patent specification. Finjan's effort to write off the '520 patent as inconsequential to the asserted patents is belied by its prosecution arguments to the Examiner. *See,* Appx1061-1062; Appx1073-1076.

Finjan further urges this Court to ignore that the specification support for the alleged inventions of the '621 and '755 patents comes from the '962 patent. Brief at 38. Finjan's sole argument is that *X2Y* requires this Court to consider "context." *Id.* Yet Finjan fails to provide any evidence that the ***specification*** of the '621 or '755 patents has ***any bearing*** on the ***claims*** of the '621 and '755 patents.[9] Nor could it. The record is clear that the entire support for the alleged inventions of the '621 and '755 patents comes from the specification of the '962 patent. *See* Appx1061-1062; Appx1073-1076. Finjan offers no rationale for why the definition of "Downloadable" from the '780 patent should apply while at the same time arguing the support for the claims comes from the '962 patent. Indeed, if context matters, as the *X2Y* Court held, then the term Downloadable in the '621 and '755 patents should be tied to the specification from which the alleged inventions derived (i.e. the context of the alleged inventions). Finjan, instead of focusing on context as *X2Y* requires, suggests that the appropriate interpretive cannon is to ignore the basis of support for the alleged inventions. Finjan's position does the very opposite of focusing on context and should be rejected.

[9] Finjan focuses on the word "probes" from ESET's brief before the District Court. Brief at 38. While ESET specifically identified the word "probes" as a ready example to demonstrate that the support for the '621 and '755 patents came from the '962 patent, ESET also provided evidence from the file histories showing that many of the other terms in the claims lacked antecedent support in the specifications of the '621 and '755 patents. *See* Appx1061-1062 ('621 patent); Appx1073-1076 ('755 patent).

**b. The Specification and Claims of the '086 Patent Confirm the Definition of Downloadable Must Include the Word "Interpretable."**

The specification and claims of the '086 patent also compel a finding that the patentee-coined definition that includes the word "interpretable" is correct. As Finjan concedes, the '086 patent also lacks an express definition of Downloadable. Brief at 35. Instead, the '086 patent incorporates conflicting patentee-coined definitions of Downloadable. *Id.*

The specification answers the question as to which definition controls by providing examples of Downloadables that are "interpretable." The Summary of the Invention section of the '086 patent notes that downloadable application programs include "…Javascript™ / ***Visual Basic scripts***." Appx253 (2:30-43). In addition, the Background of the Invention section explains "that Downloadable information comprising program code can include distributable components (e.g. Java™ applets and ***JavaScript scripts***, ActiveX™ controls, Visual Basic, add-ins and/or others)." Appx252 (2:3-7). Dr. Spafford explained that Javascript and Visual Basic scripts are interpretable, not executable, applications. Appx929-931 (¶¶23-27). Thus, the specification shows that Downloadables are not limited to "executable" programs; instead, "interpretable" programs also are "Downloadables."

The claims of the '086 patent bolster that conclusion. Dependent claims 4 and 12 both require that "Downloadable includes ***program script***," which is

"interpretable." Appx263; Appx929-931. Because the dependent claims recite "interpretable" programs as a type of Downloadable, it necessarily follows that the definition of Downloadable must be broad enough to cover "interpretable" application programs. *See Enzo Biochem, Inc. v. Applera Corp.*, 780 F.3d 1149, 1156 (Fed. Cir. 2015) ("dependent claims cannot broaden an independent claim from which they depend"). The District Court, therefore, properly acknowledged the context of the specification and claims in choosing the only patentee-coined definition that included "interpretable" programs—the one from the '520 patent.[10]

Finjan argues that the context of the patent shows that "incorporating the restrictive 'small' interpretation of Downloadable…would make little sense." Brief at 37. In doing so, Finjan urges this Court to ignore the express examples provided by the patentees and simultaneously invalidate dependent claims 4 and 12 by choosing the definition that excludes the word "interpretable." Alternatively, Finjan appears to argue that the patentees wrongly included the word "small" in their definition and this Court should simply strike that word. But this Court has repeatedly held that where a patentee acts as its own lexicographer, the definition provided by the patentee controls, even if that definition renders the claims invalid.

[10] Finjan argued for a consistent construction of "Downloadable." Appx1206; Appx2543.

*See Edwards*, 582 F.3d at 1329; *Interval Licensing*, 766 F.3d at 1374; *Elekta Instrument*, 214 F.3d at 1309.

**c. The Specifications and Claims of the ’844 and ’780 Patents Confirm the Definition of Downloadable Must Include the Word “Interpretable.”**

Aside from Finjan’s belief that Downloadable should be construed consistently for the asserted patents, the specification and claims of the ’844 and ’780 patents also compel choosing the patentee-coined definition with the word “interpretable.”

The ’844 and ’780 patents contain an express definition of Downloadable that does not include “interpretable.” *See* Appx178 (1:44-47); Appx199 (1:51-53). But both patents also incorporate the application that led to the ’520 patent, which contains the alternative definition with the words “small” and “interpretable.” *See* Appx178 (1:14-18); Appx199 (1:19-23).

The specifications and claims of the ’844 and ’780 patents demonstrate that the patentees intended to include interpretable programs within the scope of the claims. For example, the specifications teach that interpretable applications are types of Downloadables. Appx178(1:48-55); Appx199 (1:55-61); *see also* Appx178 (1:62-65); Appx199 (2:4-6). The examples include Javascript scripts, which differ in scope from the express definition in these patents and are incongruous with that express definition. *See* Appx929-931 (¶¶24-27). Nevertheless, those examples ***are***

covered by the definition from the '520 patent, which includes interpretable programs. *See id.*

Similarly, the claims of both patents reveal that interpretable programs are types of Downloadables. Claims 7 and 8 of the '844 patent expressly claim scripts. Appx183. Similarly, claims 5 and 13 of the '780 patent expressly claim HTML. Appx203. Again, there is no dispute that scripts (like Javascript) and HTML (which is in plain text) are not executable programs. Appx929-931 (¶¶24-27); *see also* Appx1024-1028; Appx1031-1035. Therefore, because the dependent claims recite "interpretable" programs as a type of Downloadable, it necessarily follows that the definition of Downloadable must be broad enough to cover "interpretable" programs. *See Enzo Biochem*, 780 F.3d at 1156. If the definition of Downloadable was limited to "executables," as Finjan argues, the above-noted dependent claims of the '844 and '780 patents would be invalid.

Finally, nothing in Finjan's Brief disputes that the specifications of the asserted patents characterize interpretable application programs – such as scripts – as Downloadables.[11] Nor does Finjan identify a definition provided by the inventors that does not include the word "small" but still covers "interpretable" applications. In short, interpretable applications are Downloadables and the only patentee-coined

[11] Finjan never analyzes the disclosures of the asserted patents or explains how its definition covers interpretable programs that also are described as Downloadables as set forth in the specifications and dependent claims. *See, e.g.,* Brief at 30-38.

definition of Downloadable that includes interpretable applications also uses the word "small."

To the extent Finjan's Brief raises a dispute regarding the scope of interpretable and executable programs, or whether scripts and HTML are interpretable, such factual disputes were conclusively resolved by the District Court. Relying on extrinsic evidence, the District Court made the factual determination that executable and interpretable programs were distinct. As such, the District Court chose the patentee-coined definition that used both words. The standard of review for such factual findings is the clearly erroneous standard. *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1339 (Fed. Cir. 2015) ("The reviewing court…should review subsidiary factual findings under the clearly erroneous standard."). To determine which of the definition applies, the District Court first had to make a factual finding regarding whether interpretable and executable programs overlapped.[12] Dr. Spafford explained, "[o]ne of skill in the art would have understood that executable application programs differ from interpretable

[12] If interpretable programs were merely a subset of executable programs then there would be no need to include both words in the definition because doing so would be redundant. *See Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005) ("A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so."); *Cephalon, Inc. v. Abraxis Bioscience, LLC*, 618 F. App'x 663, 666 (Fed. Cir. 2015) ("construing the two terms to have no difference in meaning would render one of the terms superfluous, which is disfavored in claim construction").

applications programs and that the two programs have significantly different scope." Appx929 (¶23). Dr. Spafford explained the technical difference, consulted multiple dictionaries contemporaneous with the filing of the applications, and referenced articles from that time explaining that executable and interpretable applications were not coextensive. Appx929-931 (¶¶24-27). The District Court must have credited that extrinsic evidence in determining that executable and interpretable programs are different in scope. Appx2.

### B. Finjan's Arguments Relating to the '520 Patent's "Focus on" Applets Are Misplaced.

Finjan's arguments that the '520 and '962 patents "focus on" and "centered on" "small applets" are misplaced. Brief at 28, 35. Finjan provides no citations to inventor testimony, expert opinion, or any pleadings to support its novel argument. *Id.* at 28-31, 35-38. Moreover, Finjan's argument is belied by the specifications of the '520 and '962 patents. In the Background of the Invention section of these patents, the inventor explained that prior art "systems are typically not configured to recognize computer viruses which have been attached to or masked as harmless Downloadables (i.e., applets). A Downloadable is a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer." Appx1916 (1:29-34); Appx1047 (1:36-40). Finjan focuses on the word "applets" in the first sentence and the word "small" in the second sentence to contend that these patents related to "small applets." *See* Brief at 12-13,

28-31. But, as can be seen, the first sentence demonstrates that a Downloadable may be an applet." The second sentence, however, provides a far broader definition of what the inventor means by the word Downloadable. Appx1916 (1:32-34); Appx1947 (1:38-40).

The inventor did not limit Downloadables in these patents to only "small applets." Far from it. Instead, the inventor explained that Downloadables include interpretable and executable programs. And to avoid any doubt, the specification clarifies that "[a]lthough Downloadables are being described with reference to the Java™ distributed environment, Downloadables herein correspond to all ***downloadable executable or interpretable programs*** for use in any distributed environment…" Appx1017 (3:49-54), Appx1048 (3:59-62). Thus, the patentee explicitly stated that the scope of the '520 and '962 patents was broader than mere "applets" and covered downloaded interpretable programs as well.

Finjan's arguments that the asserted patents do not have "an extensive focus" and teach "applets" or "small Downloadables" are simply untrue. Brief at 30. First, it is entirely irrelevant whether the asserted patents have an "extensive focus" on applets. Finjan cites no cannon of claim construction that relies on how much of a "focus" a specification gives to one concept over another. Nor did the inventors tie the word "small" to applets only.

Second, the specification of the '844 patent expressly mentions that Downloadables include "applets." Appx169; *see also* Appx179 (4:45-46); Appx175; Appx181 (8:45-46 (describing how the engine "includes all components, e.g. all Java™ classes for a Java™ applet…"). Dependent claim 5 of the '844 patent expressly contemplates the inventions being applicable to applets: Appx183 ("Downloadable includes a Java™ applet."). A similar analysis applies to the '780, '086, '621 and '755 patents because all of the asserted patents specifically describe and claim applets as Downloadables. Appx178 (1:49-55); Appx183 (claim 5); Appx199 (1:55-62); Appx203 (claim 2); Appx253 (2:38-43); Appx263 (claim 2); Appx291 (3:2-7); Appx328 (3:2-7). Thus, Finjan's claim that the later patents also do not have an "extensive focus" on applets is demonstrably untrue.

Finjan's further efforts to distance the '520 and '962 patents from the asserted patents by arguing that "the record makes clear that [the '962] patent was an outlier" and that "the 'small' restriction would make no sense in the '621 and '755 Patents" also fall flat. *See* Brief at 24, 37. As discussed above, during examination of the application that led to the '621 and '755 patents, Finjan relied solely on the '962 patent specification to provide support for the claims. *See supra* 31-33. And the USPTO would disagree that the '962 patent was an "outlier." During prosecution of the application that led to both the '621 and '755 patents, the Examiner rejected the then-pending claims for obviousness-type double patenting over the '962 patent

stating: "[a]lthough the conflicting claims are not identical, ***they are not patentably distinct from each*** other because independent claim 22 of the present application is ***broader in every aspect than independent claim 52 of US 6,480,962 C1 and are therefore an obvious variant thereof***." Appx14300-14302.

The '520 and '962 patents were not "outliers;" instead, they are indispensably connected to at least the '621 and '755 patents. The definition of "Downloadable" from the '520 and '962 patents is therefore critical to understanding the term in the '621 and '755 patents. In keeping with Finjan's position that the claims be interpreted the same in the asserted patents, the definition from the '520 patent is the only correct choice. Appx1206; Appx2543.

### C. Finjan's Cited Case Law Related to the Law of Incorporation Is Either Inapplicable or Supports ESET's Position.

Finjan identifies several cases relating to incorporation by reference; none are applicable. *See* Brief at 31-33. First, no cases Finjan cites involve a patentee acting as his own lexicographer by creating two contradictory definitions. Rather, Finjan's cited case law mostly stands for the unremarkable proposition that whether a disclosure of an incorporated patent informs a claim construction is context-dependent.

For example, in *Modine Manufacturing Co. v. ITC*, this Court held that where a patentee amended the specification expressly to redefine an upper bound of a range, he could not then override that express redefinition by importing a broader

range recited in an incorporated patent. 75 F.3d 1545, 1551 (Fed. Cir. 1996); *see also* Brief at 31. Unlike the instant case, in *Modine*, there was no ambiguity requiring consideration of the incorporated disclosures to make sense of the asserted claims. With respect to the '844 and '780 patents, the incorporation by reference of a conflicting definition is adopted not to override the express redefinition, but to resolve the inherent conflict between the examples in the specification and the claims. Moreover, three of the five asserted patents (the '086, '621, and '755 patents) do not have any express definition of the term "Downloadable." Those three patents incorporate conflicting definitions. *Modine* says nothing as to how to choose between two conflicting definitions, each of which are incorporated by reference. Thus, *Modine* is inapposite.

In *Paice LLC v. Ford Motor Co.*, this Court reversed a PTAB decision that only part of a patent was incorporated by reference and could be relied upon for written description support. 881 F.3d 894, 907 (Fed. Cir. 2018), *see also* Brief at 31. Recognizing that incorporated "'material is effectively part of the host document as if it were explicitly contained therein,'" the Court remanded for further analysis of the written description question. *Paice,* 881 F.3d at 906 (*quoting Advanced Display Sys.*, 212 F.3d at 1282). The *Paice* Court noted, "[t]he applicability of a document's disclosed features and the incorporation of the document itself are distinct concepts, and one does not imply the other." *Id.* at 908. Here, however,

applicability of the incorporated patents is essential for understanding the meaning of the word "Downloadable," which the parties agree has no meaning other than that provided by the patentees. The '086, '621, and '755 patents each use the word "Downloadable" without any express definition. Thus, incorporation of the previous specifications, which contain the patentee-coined definitions, is required to provide meaning to the term. Moreover, with respect to the '844 and '780 patents, incorporation of the term is required to resolve the ambiguity highlighted by the disclosed examples and dependent claims.

*X2Y Attenuators, LLC v. ITC*, cited by Finjan, favors the District Court's rationale for construing Downloadable here. *See* 757 F.3d 1358 (Fed. Cir. 2014); *see also* Brief at 32, 33, 35. In *X2Y*, this Court affirmed an ITC construction of the claim term "electrode" to require oppositely charged conductors on either side of a central electrode based on statements in ***incorporated priority patents*** that the "oppositely charged" feature was an essential part of the invention and present in all disclosed embodiments. *X2Y*, 757 F.3d at 1362-63. This Court acknowledged explicit teaching in the asserted patent that conductors of the electrode ***need not*** be oppositely charged, but found that language insufficient to override the express teaching of the incorporated patents and disclosed examples. *Id.* at 1363. Similarly, here the asserted patents disclose and claim Downloadables other than executables,

and thus only the inventor's definition in the '520 and '962 patents is faithful to that disclosure.[13]

Finally, in *MPHJ Technologies Investments, LLC v. Ricoh Americas Corp.*, this Court rejected the patentee's effort to characterize a feature as essential, based on an incorporated provisional application, where the patent expressly described the feature as optional. 847 F.3d 1363, 1369 (Fed. Cir. 2017); *see also* Brief at 32. By contrast, Finjan's proposed construction for Downloadable excludes "interpretable application programs" and is inconsistent with the disclosed examples of Downloadables and claims of the asserted patents.[14]

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[13] In *Young Dental Manufacturing Co. v. Q3 Special Products, Inc.*, this Court found that the district court's claim construction was "wholly consistent" with the specification of the patent in which the claim resided; incorporation of disclosure of an earlier application was not at issue. 112 F.3d 1137, 1143 (Fed. Cir. 1997); *see also* Brief at 32. The '086, '621, and '755 patents have no definition for "Downloadable" and therefore have nothing to be "wholly consistent" with. Moreover, the '844 and '780 patents create undeniable ambiguity between the express definition in those patents on the one hand (executables only) and the examples of Downloadables and dependent claims on the other (executables and interpretable applications).

[14] *Smartphone Technologies* and *Asics,* both district court cases not binding on this Court, cited by Finjan, shed no light on proper analysis of incorporated patents. *See* Brief at 32-33. In *Smartphone*, the district court construed the terms "synchronize" and "synchronizing" differently in related patents because each patent contained a different explicit definition. *Smartphone Techs. LLC v. Research in Motion Corp.,* No. 6:10-cv-74, 2012 WL 489112 (E.D. Tex. Feb. 13, 2012). In *Asics,* the district court decided a motion to dismiss not involving claim construction. *Asics Am. Corp. v. Akeva LLC,* No. 1:09-cv-135, 2015 WL 1013645 (M.D.N.C. Mar. 9, 2015).

### 1. Finjan's "Broader" Definition of Downloadable Is Actually Narrower and Impermissibly Excludes Exemplary Downloadables Disclosed in, and Alleged Inventions Claimed in, the Asserted Patents.

Finjan argues that its definition of Downloadables as "executable application programs" is "broader" than the District Court's construction because Finjan's definition omits the term "small." But Finjan ignores that its definition omits an entire class of Downloadables described in the asserted patents: interpretable programs. *See* Appx3.

As noted *supra* at 3-5, each of the asserted patents specifically describes Javascript scripts and Visual Basic scripts as example Downloadables. There is no dispute that these types of scripts are not "executable." Appx929-931 (¶¶23-27). Similarly, there is no dispute that these types of scripts are "interpretable application programs." *Id.* There also can be no doubt that the patentee expressly desired to include interpretable application programs within the scope of the term Downloadable. All of the specifications of the asserted patents provide examples of Downloadables that are interpretable. Appx178 (1:49-55), Appx199 (1:55-61), Appx253 (2:34-43), Appx291 (3:1-7), Appx328 (3:1-7). Moreover, as discussed

above, Finjan's definition would render multiple dependent claims invalid.[15] *See supra* at 34-37.

The problem with Finjan's proposed construction is similar to that of the patentee in *Trustees of Columbia University v. Symantec Corp.*, 811 F.3d 1359 (Fed. Cir. 2016). There, this Court observed: "The patentee cannot rely on its own use of inconsistent and confusing language in the specification to support a broad claim construction which is otherwise foreclosed." *Id.* at 1366. This Court affirmed a district court construction of the term "byte code sequence" as consisting only of "machine code instructions," and specifically excluded "resource information," which the patentee argued should have been included. *Id.* at 1367. Rejecting the patentee's argument that the asserted patent defined the disputed term to include resource information, this Court held: "This single sentence in the specification cannot overcome the overwhelming evidence in other parts of the specification and the provisional application (described above) demonstrating that the intended definition of this term does not include information other than machine code instructions." *Id.* at 1366. Here, the overwhelming evidence in the specification, file history, and claims, demonstrates that the patentee intended for Downloadable to cover interpretable applications too. Consequently, the appropriate patentee-

[15]As this Court explained: "[i]t is not our function to rewrite the claims to preserve their validity. *Allen Eng'g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1349 (Fed. Cir. 2002).

coined definition to choose is the one broad enough to cover interpretable application programs.

Finjan's proposed construction of Downloadable is too narrow as it improperly excludes multiple disclosed examples of Downloadables from the specifications and renders dependent claims in each of the '844, '780, and '086 patents incomprehensible.[16] It therefore must be rejected.

This Court should affirm the District Court's determination that the correct construction of the term "Downloadable" was the express patentee-coined definition that included "small" and "interpretable." No other definition can be reconciled with the intrinsic evidence.

## II. The District Court Properly Allocated the Parties' Burdens In Granting Summary Judgment of Invalidity for Indefiniteness.

Finjan's contention that the District Court improperly allocated the burdens in deciding ESET's renewed summary judgment motion is frivolous. Finjan's appeal implies that the Court went directly from the mistrial to a finding of invalidity, but that narrative ignores the parties' extensive briefing on ESET's renewed summary judgment motion and Finjan's subsequent motion for reconsideration with associated proffer of additional evidence.

[16] Moreover, Finjan's contention that the exemplary Downloadables are not "small applets" only highlights the indefiniteness problem. As discussed in more detail throughout, Dr. Cole testified on Finjan's behalf at trial that "small" does even relate to the size of the Downloadable. *See* 11-12, and 57-59.

ESET's renewed summary judgment motion highlighted the flaws in, and further contradictions arising from, Dr. Cole's trial-definition of "Downloadable." As noted by the District Court in its order denying Finjan's reconsideration motion, indefiniteness was not a new issue in the case. Appx18-19. ESET's renewed motion demonstrated that Finjan's experts had established that the term "small" in Downloadable was highly variable, both in terms of size and its temporal application, in a way that failed the public notice function. Moreover, ESET's renewed motion demonstrated that ***additional*** evidence at trial, specifically Dr. Cole's trial testimony that "small" had nothing to do with the size of the application program, but instead was a synonym for "non-installed," met ESET's burden to show the claims were indefinite by clear and convincing evidence. Appx23363-23383. The chasm in unintelligibility of the word "small" established in ESET's initial summary judgment motion suddenly became the Grand Canyon.

The District Court, a seasoned jurist who has handled nearly 200 patent cases, consistently applied the burdens (of both production and persuasion) requiring ESET to show invalidity by clear and convincing evidence. ESET met those burdens. Finjan, on the other hand, failed to meet its burden of going forward by identifying a genuine issue of material fact precluding summary judgment. Appx21329-21330. Dr. Cole's trial testimony cannot be reconciled with the District Court's claim construction because he denied the very essence of the word "small." In such

circumstances, the District Court properly could – and did – conclude that ESET had met its burden by clear and convincing evidence, as the Court noted in its Order denying Finjan's motion for reconsideration.

Finjan has no reason to complain. Having its other experts testify to ***other*** definitions of "small" in the context of Downloadable, such as that it is "context dependent" cannot reconcile or "undo" Dr. Cole's testimony. *See* Brief at 5. Finjan is not entitled to a "do-over." Appx20, n.3. As the District Court noted in denying Finjan's reconsideration motion: "Finjan's proffer that it could offer still further testimony to explain the lack of consensus among its own experts in construing the term only serves to underscore the lack of certainty among those of skill in the art, making the term indefinite and the Court's entry of summary judgment correct." Appx24.

### A. Dr. Spafford's Testimony Cannot Save Finjan's Patents.

Finjan argues that if only it could have cross-examined ESET's technical expert, Dr. Spafford, his testimony could have saved Finjan's patents. Brief at 42. Not true.[17] Finjan submitted Dr. Spafford's deposition testimony with its

[17] Rule 56(e) requires the nonmoving party to identify specific facts demonstrating a genuine issue for trial, which it may show through the evidentiary materials of Rule 56(c). *Celotex Corp. v. Catrett*, 477 U.S. 317, 324 (1986). Summary judgment is the time "to put up or shut up." Fleming James, Jr. & Geoffrey C. Hazard, Jr., Civil Procedure 150 (2d ed. 1977); *see also Mondol v. City of Somervile*, 746 F. App'x 35, 39 (1st Cir. 2018); *Weinstock v. Columbia Univ.*, 224 F.3d 33, 59 (2d Cir. 2000); *Berckeley Inv. Grp., Ltd. v. Colkitt*, 455 F.3d 195, 201 (3d Cir. 2006);

oppositions to ESET's motions for summary judgment and its motion for reconsideration. Appx20073-20074; Appx23397-23398; Appx23494-23497. Specifically, Finjan argued that because Dr. Spafford was able to identify invalidating prior art for the asserted patents, he must have understood what "small" means in the context of Downloadable. *Id.* But Dr. Spafford did not opine on indefiniteness based on the word "small" in the construction of the term Downloadable. Appx21331-21332. To be clear, Dr. Spafford offered no opinion one way or the other on the term as part of his expert analysis. *Id.*

Instead, Dr. Spafford applied the prior art based on Finjan's infringement accusations as permitted by this Court's precedents. *See Cordance Corp. v. Amazon.com, Inc.*, 658 F.3d 1330, 1335 (Fed. Cir. 2011) (finding it proper during an invalidity analysis to map features present in the prior art "in a manner that mirrored [plaintiff's] infringement theory."). Further, it is acceptable to argue "that if a claim term must be broadly interpreted to read on an accused device, then this same broad construction will read on the prior art." *01 Communique Lab., Inc. v. Citrix Sys., Inc.*, 889 F.3d 735, 742 (Fed. Cir. 2018) *citing Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1380 (Fed. Cir. 2007) (explaining patentee must "beware of what [it] asks for" since a broad claim construction for infringement may

*Tillotson v. Manitowoc Co.*, 727 F. App'x 164, 169 (6th Cir. 2018); *Schacht v. Wis. Dep't of Corr.*, 175 F.3d 497, 503-04 (7th Cir. 1999).

ultimately result in invalidity). Such expert opinions do not necessarily imply that a claim term has a definite meaning and Finjan cites no authority for that novel proposition.

As ESET explained each time Finjan raised this argument, Dr. Spafford did not formulate an opinion about the scope of "small" nor need he have done so. Instead, Dr. Spafford reasoned that if, as Finjan contended, files processed by ESET's accused products qualified as "Downloadables" in the infringement context then those same files (or even much smaller files ) handled by the prior art must necessarily have been Downloadables in the invalidity context.

All of the evidence that ever could be adduced regarding Dr. Spafford's opinions was already in the record, which Finjan presented to the District Court. The District Court considered those submissions in denying Finjan's motion for reconsideration, explaining: "Although each expert opined on infringement or invalidity based on his own characterization of this claim limitation (including ***ESET's own experts***), there was no consensus among them as to the scope of the claim term to establish that the public would have notice with any reasonable certainty." Appx24. None of that evidence raises a genuine issue of material fact.

**B. No Additional Evidence Can Save Finjan's Patents.**

Finjan complains that the record on which the District Court based summary judgment was incomplete, citing additional testimony Finjan believes ***could have***

***been adduced*** from its other experts. Brief at 43-45. But on a motion for summary judgment, Finjan bore the responsibility of coming forward with whatever evidence it could marshal. *See supra* 50 n.17. Finjan cannot now complain additional evidence ***could*** be forthcoming. Moreover, the allegedly incomplete testimony Finjan complains of (i.e., the experts' opinions stated in their expert reports and expert deposition testimony) ***was already in the record***, as discussed *supra* at 20-22. The District Court considered all of it in deciding ESET's renewed summary judgment motion and Finjan's motion for reconsideration.[18]

Finjan's contention that the District Court should not have relied on the testimony of Finjan's infringement expert, Dr. Cole, but instead needed to hear from Finjan's invalidity experts at trial, is irrational. Finjan's theory would preclude any court from ever granting summary judgment. Moreover, Finjan's argument highlights its "nose-of-wax" approach to the claim terms, where the term means one thing for infringement and another for invalidity – a long rejected stratagem. *White v. Dunbar*, 119 U.S. 47, 51 (1886). Plainly, "small" in the definition of Downloadable should have ***the same meaning in both the infringement and invalidity contexts***.

[18] The District Court rejected Finjan's suggestion that Dr. Cole's testimony at a future trial could "replace" his completed testimony: "a subsequent trial is not an opportunity for Dr. Cole to change his opinions or supplement them with support he did not provide on the record at the first trial." Appx20, n.3.

Finjan's suggestion that the District Court should not have credited Dr. Cole's definition of "small" as "non-installed" because he "had not prepared or presented opinions on validity" also lacks merit. Brief at 44. Finjan cites no case law for such a novel proposition. Dr. Cole must have had a personal-understanding of the scope of the term "small" to arrive at his infringement opinions (despite his failure to disclose his novel "non-installed" criteria in his expert report or deposition). And Finjan agreed with Dr. Cole's position, eliciting further testimony during redirect about that very issue. *See* Appx23207. As noted in the Order granting summary judgment, Dr. Cole's trial-definition of "small" was untethered from and irreconcilable with the intrinsic evidence. Appx21. It was all the additional testimony the District Court needed to hear to conclude that ESET carried its burdens of production and persuasion by clear and convincing evidence, that one of skill in art, which each of Finjan's experts purported to be, could not understand the scope of the term "small."

As described above, the alleged additional testimony of Finjan's other experts was part of the summary judgment record and the motion for reconsideration.[19] *See*

[19] If either Dr. Goodrich or Dr. Medvidovic planned to testify to a definition of "small" outside (or inconsistent with) their prior opinions, such testimony could not raise a genuine issue of material fact. *See Doe v. Cutter Biological, Inc.*, 971 F.2d 375, 386 (9th Cir. 1992) ("a party cannot create its own issue of fact by having a witness contradict himself between affidavit and deposition testimony").

*supra* at 20-22; *see also* Appx23489-23499. The District Court considered that proffer in denying Finjan's motion for reconsideration. Appx24.

Contrary to Finjan's contention, it had a full and fair opportunity to present its evidence. Unfortunately for Finjan, its proffer only further demonstrated the lack of clarity regarding the scope of "small." The District Court accorded the evidence in Finjan's proffer all due weight, and properly concluded that ESET demonstrated the absence of a genuine issue of material fact. Contrary to Finjan's contention, the widely divergent views expressed by Finjan's other experts – which were inconsistent among themselves and irreconcilable with Dr. Cole's trial testimony – provided ample basis for the District Court to rule on ESET's motion. Appx21; Appx24.

### C. The District Court Properly Concluded that ESET Proved Finjan's Claims Are Indefinite by Clear and Convincing Evidence.

The District Court properly allocated the burdens of proof on summary judgment. ESET met its burdens of production and persuasion by establishing, with clear and convincing evidence, that a person of skill in the art could not determine with reasonable certainty the scope of the asserted claims. Finjan, whose other experts' opinions were already in the record and considered by the District Court, did not come forward with sufficient evidence to create a genuine fact issue. As the District Court acknowledged, Finjan's claims failed to provide the public with fair

notice regarding what was within, and without, the scope of the asserted claims. Appx18-19.

When read in light of the specification and the prosecution history, claims "must provide objective boundaries for those of skill in the art." *Dow Chem. Co. v. Nova Chems. Corp. (Can.)*, 803 F.3d 620, 630 (Fed. Cir. 2015) (internal citation omitted); *Interval Licensing*, 766 F.3d at 1371 (Fed. Cir. 2014) (same). There is an indefiniteness problem if the claim language "might mean several different things and no informed and confident choice is available among the contending definitions." *Nautilus I*, 572 U.S. at 911 n.8 (internal citations omitted). "The fact that [the patent holder] can articulate a definition supported by the specification…does not end the inquiry. Even if a claim term's definition can be reduced to words, the claim is still indefinite if a person of ordinary skill in the art cannot translate the definition into meaningfully precise claim scope." *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1251 (Fed. Cir. 2008); *see also Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350 (Fed. Cir. 2005) *abrogated on other grounds by Nautilus I*, 572 U.S. 898 ("The scope of claim language cannot depend solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention.").

There is no dispute that the term "small" is a term of degree, and to be definite there must be "some standard for measuring that degree." *Nautilus I*, 572 U.S. at

910. And even though this Court provided guidance in *Nautilus II* that "a determination whether [a] limitation is sufficiently definite is 'highly dependent on context'…" this inquiry does not grant a patentee license to offer inconsistent and entirely subjective opinions on the disputed meaning, as occurred here. *See Biosig Instruments, Inc. v. Nautilus Inc.*, 783 F.3d 1374, 1378 (Fed. Cir. 2015) ("*Nautilus II*"). Indeed, the intrinsic record must provide information such that a skilled artisan would have "clear notice of what is claimed." *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1260 (Fed. Cir. 2014). Nothing in the conflicting definitions provided in the intrinsic evidence informs a person of ordinary skill what the scope of "small" in the definition of Downloadable means.

The District Court did not impose on Finjan a burden of showing a "consensus." Rather, the Court concluded that ESET had demonstrated Finjan's own experts had widely divergent opinions that taken together "amounted to 'unpredictable vagaries of any one person's opinion' and therefore failed to provide sufficient notice as to the scope of the term. *Interval Licensing*, 766 F.3d at 1371 ('[A] term of degree fails to provide sufficient notice of its scope if it depends on the unpredictable vagaries of any one persons' opinion.')." Appx20.

By contrast, in *Presidio,* this Court affirmed a District Court's determination of definiteness because even though the test method was not described in the asserted patent, the method was generally known in the art. *Presidio Components, Inc. v.*

*Am. Tech. Ceramics Corp.,* 875 F.3d 1369, 1376 (Fed. Cir. 2017). But here, none of Finjan's proposed trial testimony identifies any information from the prior art that could shed light on the scope of the term "small." Moreover, unlike *Presidio*, none of Finjan's proposed "evidence" could undo the conflicting pre-trial deposition testimony of its experts or the further chaos created by Dr. Cole's trial testimony. The problem with Finjan's experts' opinions regarding "small" is not that they weren't in the same ballpark, but rather, they were not even in the same zip code.

**1. Dr. Cole's Trial-Definition of "Small" Cannot Be Reconciled with the Patents or His Pre-Trial Opinions.**

Finjan's efforts to reconcile Dr. Cole's trial-definition of "non-installed" using attorney argument are made of whole cloth. Brief at 47. In particular, Finjan states "Java applets and ActiveX controls…are programs that are designed to be interpreted line-by-line; they do not require separate installation on a user's computer." *Id.* However, the cited portion of the '520 patent at 3:42-54 does not mention installation, does not mention that applets are "interpreted," or that such interpretation occurs "line-by-line." *See* Appx1017. Indeed, Finjan offers ***no evidence*** to support this novel technical argument.[20] None of the cited material

[20] If Finjan is right that "Java applets" and "ActiveX" controls are "interpreted" then its argument further supports the District Court's construction of Downloadable that included interpretable application programs.

provides any teaching about the size of that a Downloadable that interacts with a Java virtual machine.

Moreover, if ActiveX and Java applets are ***interpretable*** applications (as Finjan argues in its Brief, albeit without evidence) then they do not fall within Dr. Cole's testimony that "the definition of small is an ***executable*** that doesn't require installation when it runs on your system." Brief at 47. Thus, it is unclear how, based on Finjan's analysis, such files could provide any support for Dr. Cole's definition.

Still further, none of the purported testimony by Finjan's experts in its proffer supports Dr. Cole's position. Not a single portion of any of the proffered evidence even contains the word "install" or any variation thereof. Appx23489-23499. As the District Court recognized, Dr. Cole's trial-definition of "small" in the context of Downloadable has no support in the intrinsic record. Appx21. Nor does it comport with the plain and ordinary meaning of small. Merriam Webster defines "small" as "having comparatively little ***size*** or slight dimensions." Appx23372. Dictionary.com defines the term as "of limited ***size***; of comparatively restricted dimensions; not big; little." *Id.* Simply put, the definition of "small" relates to "size." Yet, Dr. Cole testified that size doesn't matter. Appx23155. Dr. Cole did not apply the plain and ordinary meaning of small. Instead, he usurped the court's role and construed "small" as based on function, not size. Dr. Cole literally inverted

the standard definition of small (size matters) by claiming the exact opposite (size doesn't matter). *Compare* Appx23372 *with* Appx23155.

None of Finjan's experts could reconcile Dr. Cole's trial-definition – small has nothing to do with ***size***– with any of their vastly divergent opinions. Appx23449-23459. Nor was Dr. Cole (or Finjan) able to identify any portion of the specification that supported his novel theory that "non-installed" was an appropriate substitute for "small." *Id.* The District Court, having thoroughly reviewed the record in connection with the claim construction and the parties' dispositive motion practice, understood that Dr. Cole's testimony: (1) had no basis in his pre-trial opinions; (2) created additional confusion about how one of skill in the art would have understood "Downloadable;" and (3) subverted the plain and ordinary meaning of a common word with no basis for doing so. ESET's evidence demonstrated clearly and convincingly the term had no meaning. Finjan failed to identify a genuine fact issue.

#### 2. Finjan's Proffered Future Trial Testimony Could Not Undo Dr. Cole's Actual Trial Testimony or Create a Genuine Factual Issue.

Finjan laments that, if only given the chance at trial, its cross-examination of ESET's technical witness or Finjan's other experts could have imposed intelligibility on the incoherent mess for "small" revealed during expert discovery and in Dr. Cole's trial testimony. Brief at 48.

Finjan again argues that it could have cross-examined Dr. Spafford regarding opinions that he did not formulate about the scope of the term "small." *Id.* at 49. As discussed above, Finjan's argument lacks merit. *See supra* at 50-52.

Finjan next argues that its other experts were "barred" from presenting their opinions that could have saved Finjan's patents. Finjan reveals (for the first time in its 52-page brief) that the "meaning of 'small' was ***context-dependent*** and generally described a Downloadable that was small in comparison to other programs." Brief at 50 (original emphasis). But that testimony already was before the District Court in connection with ESET's summary judgment motions. *See supra* at 8-11, 14-16, and 20-21, Appx5527-5562. Finjan also submitted that testimony in its proffer, but the Court found that it too failed to identify a triable issue. Appx24. And with good reason: even if the term is "context-dependent," Finjan fails to provide any evidence from the specification or prior art that would help understand how to apply the nebulous context or what metrics should be used. In other words, Finjan's "context-dependent" analysis is simply another way of saying that its interpretation is entirely subjective; in essence, Finjan says the term means whatever Finjan's expert says it means. Such "vagaries" demonstrate the indefiniteness of the term. *Interval Licensing*, 766 F.3d at 1371.

As an example, Dr. Goodrich purportedly would testify that "small" is relative and context-dependent. For Dr. Goodrich, that context included whether the

question related to infringement or invalidity: "Q. Is Internet Explorer a downloadable as considered by the court? A. Do you have a context for that, like in a prior reference that you're talking about? Because, again, it's always relative, so is it -- when you say 'Internet Explorer,' compared to what?" Appx5555 (103:7-20). Dr. Medvidovic, on the other hand conclusively testified that context didn't matter for "programs like…Internet Explorer" because they "would be too large to fall within 'small.'" Appx5549 (116:2-7). And Dr. Goodrich's testimony also conflicted with Dr. Cole's trial testimony that a 2-terabyte file non-installed file was "small." Appx23214.

The pretrial testimony of Dr. Jaeger is equally unhelpful because his testimony about a type of file not being a "Downloadable" was not based on the size of the file. Instead, his opinion considered whether the files were executable, interpretable, or even "incoming files." Appx23494; Appx23539. Accordingly, Dr. Jaeger's proffered testimony has no relevance to the question of the appropriate scope of the term "small."

Finjan's wrongly contends that the District Court did not consider the foregoing components of its proffer. As explained above, the purported trial testimony of Finjan's other experts provides no reasonable certainty regarding what file sizes qualify as Downloadables and which do not.

The District Court understood all of this, and properly concluded that ESET had established to a clear and convincing standard that the term Downloadable is indefinite.

### D. This Court Should Affirm the District Court's Judgment.

Finjan's plea that this case be sent back to the District Court so that Finjan can continue its bad faith pursuit of ESET should be rejected. Brief at 51; *see also supra* at 53 n.18 and 54 n.19. Finjan chose and executed a trial strategy that included multiple experts opining on wildly inconsistent understandings of the scope of the term Downloadable. Finjan did so even after being apprised, virtually from the outset of the case, that indefiniteness was an issue with the asserted patents.

The District Court properly construed the claims, and concluded based on the record that ESET established by clear and convincing evidence that the claim term Downloadable was indefinite. Finjan, despite multiple opportunities to present evidence of a genuine fact issue, failed to do so. This Court should affirm the District Court's judgment.

## CONCLUSION

For the reasons stated herein, this Court should affirm the District Court's judgment of invalidity of the asserted patents for indefiniteness.

Date: October 18, 2021

Respectfully Submitted,

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## CERTIFICATE OF SERVICE

On October 15, 2021, I caused to be filed electronically the foregoing **1st CORRECTED BRIEF OF APPELLEES ESET, LLC AND ESET SPOL. S.R.O.** with the Clerk of Court using the CM/ECF System, which will serve via e-mail notice of such filing to all counsel registered as CM/ECF users.

Dated: October 18, 2021

*/s/ Nicola A. Pisano*
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## CERTIFICATE OF COMPLIANCE

The foregoing filing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because:

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Date: October 18, 2021

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