No. 21-2093

IN THE

United States Court of Appeals for the Federal Circuit

FINJAN LLC,

Plaintiff-Appellant

v.

ESET, LLC, ESET SPOL. S.R.O.,

Defendants-Appellees.

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

REPLY BRIEF OF FINJAN LLC

Juanita R. Brooks
Jason W. Wolff
FISH & RICHARDSON P.C.
12860 El Camino Real, Ste. 400
San Diego, CA 92130
Telephone: 858-678-5070

Robert Courtney
FISH & RICHARDSON P.C.
60 S 6th St., Suite 3200
Minneapolis, MN 55402
Telephone: 612-335-5070

November 22, 2021

Attorneys for Plaintiff-Appellant

CERTIFICATE OF INTEREST

Counsel for Plaintiff-Appellant Finjan LLC ("Finjan") certifies the following:

1. Provide the full names of all entities represented by undersigned counsel in this case.

   Finjan LLC

2. Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.

   Finjan LLC

3. Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.

   Finjan Holdings LLC, CFIP Goldfish Holdings LLC

4. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

   Kramer Levin Naftalis & Frankel: Benu C. Wells, Matthew W. Olinzock, Aaron M. Frankel, Cristina L. Martinez, James R. Hannah, Linjun Xu, Michael H. Lee, Phuong D. Nguyen, Yuridia Caire

   Kramer Levin LLP: Paul J. Andre, Gregory C. Proctor, Hannah Y. Lee, Hien Khanh Lien, Kristopher B. Kastens, Lisa Kobialka

   Fish & Richardson P.C.: Lawrence R. Jarvis, K. Nicole Williams, Michael Amon, Roger A. Denning

5. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

***Finjan LLC v. Qualys Inc.*, No. 4:18-cv-07229 (N.D. Cal.)**

***Finjan, Inc. v. SonicWall, Inc.*, No. 5:17-cv-04467 (N.D. Cal.)**

***Finjan, Inc. v. Rapid7, Inc.*, No. 1:18-cv-01519 (D. Del.)**

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

***Finjan, Inc. v. Fortinet, Inc.*, No. 3:18-cv-06555 (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

Month November 22, 2021 */s/ Juanita R. Brooks*
Juanita R. Brooks

TABLE OF CONTENTS

INTRODUCTION 1

ARGUMENT 3

I. ESET DOES NOT MATERIALLY DEFEND THE DISTRICT COURT'S RESTRICTION OF THE '844 AND '780 CLAIMS TO "SMALL" PROGRAMS 3

A. That Downloadables may be "interpretable" does not support the District Court's importation of "small" into the '844 and '780 claims 3

1. Because "interpretable" programs are a species of "executable" ones, the '844 and '780 Patents' "Downloadable" definition is complete as written 4

2. Nothing about the '844 and '780 Patent claims' coverage of "interpretable" programs requires that Downloadables be "small" 10

B. Finjan has never urged that differences among the patents are immaterial for claim construction 11

C. As ESET concedes, the '844 and '780 Patents both expressly define "Downloadable" without reference to "small" 12

II. ESET ALSO DOES NOT MATERIALLY DEFEND THE IMPORTATION OF "SMALL" INTO THE '086 PATENT 15

A. ESET's "interpretable" arguments for the '086 Patent are as deficient as its arguments for the '844 and '780 Patents 15

B. Reciting "interpretable" in the construction of "Downloadable" does not mandate importing "small" 16

C. The '086 patent describes flexible technology for all "Downloadables," not just "small" ones 16

III. ESET'S ANALYSIS OF THE '621 AND '755 PATENTS IS WRONG 17

IV. EVEN IF THE COURT AFFIRMS AS TO THE "SMALL" RESTRICTION, THE RECORD FALLS FAR SHORT OF SUPPORTING ESET'S FACT-BASED ATTACK ON DEFINITENESS 20

A. The absence of any expert opinion rebutting Dr. Cole's pre-mistrial description "small" should have been dispositive 21

B. The clear ability of ESET's own expert to determine the claims' scope should have been dispositive 23

C. Testimony from other Finjan experts confirming definiteness should have been dispositive 26

D. Nothing in the record supported judgment as a matter of law, particularly not at the summary judgment phase 27

CONCLUSION 28

CERTIFICATE OF SERVICE AND FILING 30

TABLE OF AUTHORITIES

Page(s)

Cases

Atmel Corp. v. Information Storage Devices, Inc.,
198 F.3d 1374 (Fed. Cir. 1999) 22, 23, 28

Biomedino, LLC v. Waters Tech. Corp.,
490 F.3d 946 (Fed. Cir. 2007) 22

Chimie v. PPG Indus.,
402 F.3d 1371 (Fed. Cir. 2005) 6

Conroy v. Reebok Int'l, Ltd.,
14 F.3d 1570 (Fed. Cir. 1994) 26

Dow Chem., Co. v. Nova Chems. Corp. (Canada),
809 F.3d 1223 (Fed. Cir. 2015) 25

IBEW, AFL-CIO Local 47 v. S. Cal. Edison Co.,
880 F.2d 104 (9th Cir. 1989) 20

Lydall Thermal/Acoustical, Inc. v. Federal-Mogul Corp.,
344 F. App'x 607 (Fed. Cir. 2009) 12

Modine Mfg. Co. v. U.S. Int'l Trade Comm'n,
75 F.3d 1545 (Fed. Cir. 1996) 14

MPHJ Tech. Invs. LLC, v. Ricoh Ams. Corp.,
847 F.3d 1363 (Fed. Cir. 2017) 11

Nautilus, Inc. v. Biosig Instruments, Inc.,
572 U.S. 898 (2014) 25

Paice LLC v. Ford Motor Co.,
881 F.3d 894 (Fed. Cir. 2017) 14

Phillips v. AWH Corp. et al.,
415 F.3d 1303 (Fed. Cir. 2005) (en banc) 6, 19, 28

TABLE OF AUTHORITIES (CONT.)

Page(s)

Cases

Smartphone Techs. LLC v. Research in Motion Corp.,
No. 6:10-cv-74, 2012 WL 489112 (E.D. Tex. Feb. 13, 2012) 11

Sonix Tech. Co. v. Publications Int'l, Ltd.,
844 F.3d 1370 (Fed. Cir. 2017) 24

Wi-LAN USA, Inc. v. Apple Inc.,
830 F.3d 1374 (Fed. Cir. 2016) 5

Young Dental Mfg. Co. v. Q3 Special Prods., Inc.,
112 F.3d 1137 (Fed. Cir. 1997) 10

INTRODUCTION

Since this case involves the district court's construction of the term "Downloadable," it is subject to *de novo* review. In its opening brief, Finjan clearly detailed why the district court's construction is incorrect. Simply put, this Court need look no further than the specification of the '844 Patent at Appx178 at 1:44–47 ("A Downloadable is an executable application program, which is downloaded from a source computer and run on the destination computer") and 1:49–53, to find both the definition of "Downloadable" and its embodiments. The district court, however, rejected this express definition and replaced it with a narrower definition from an earlier filed, unasserted patent, with a different specification, which was incorporated by reference.

By doing so, the district court imported a limitation into the claims that could not be found anywhere in the specifications of the asserted patents, i.e., the downloadable must be ". . . a ***small*** executable or interpretable application program which is downloaded from a source computer and run on a destination computer." Appx3 (emphasis added). Then, using the imported limitation, the district court invalidated the asserted claims because it found the intrinsic record did not support the scope of the term "small." The district court did so based on a finding 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." Appx23468 (emphasis added). This finding came after a mistrial was declared in the early stages of Finjan's case-in-chief due to the global pandemic.

It is no surprise that, based on this record, ESET's responsive brief falls far short of supporting the district court's construction or justifying the subsequent grant of summary judgment. ESET concedes that the "District Court adopted, verbatim, the definition from the '520 patent: 'small executable and interpretable application programs . . .'" Red Br. 30. In other words, despite the fact that the specifications of later-filed asserted patents contain an express definition of downloadable with no reference to "small," the district court chose to adopt a different definition from an earlier unasserted patent that was incorporated by reference. ESET attempts to support this construction by arguing that it ". . . is the only definition that made sense in light of the remainder of the specification and claims." *Id.* ESET then does an about-face when it tries to justify the district court's subsequent grant of summary judgment by arguing that the court's construction, which now incorporates the word "small," renders the claims indefinite because the term makes *no sense* in light of the specification and the claims. *See, e.g.,* Red Br. 54 ("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 the art, which each of Finjan's experts purported to be, could not understand the scope of the term 'small.'").

ARGUMENT

I. ESET DOES NOT MATERIALLY DEFEND THE DISTRICT COURT'S RESTRICTION OF THE '844 AND '780 CLAIMS TO "SMALL" PROGRAMS

In a concession that speaks volumes, ESET does not directly defend the district court's holding that the '844 and '780 Patents' claims are restricted to "small" programs. *See* Red Br. 34–39. As Finjan's Opening Brief explained and ESET does not dispute, the '844 and '780 Patent specifications define "Downloadable" without reference to any "small" restriction. Blue Br. 13–14.

A. That Downloadables may be "interpretable" does not support the District Court's importation of "small" into the '844 and '780 claims

To the extent ESET attempts to find a justification for the district court's claim interpretation for these patents, that justification is seriously flawed. ESET's argument begins with a fact all parties agree to: that the patentee intended "Downloadable" to cover "interpretables." Red Br. 37. From there the argument takes a circuitous journey. ESET's premise is that the absence of the word "interpretable" from the '844 and '780 Patents' stated definition of "Downloadable" makes that definition untenable. Red Br. 36 (proposing that

"the word 'interpretable'" must appear in any construction of Downloadable). Having set-up a strawman deficiency, ESET then reasons that the only remedy is to reach beyond the '844 and '780 Patents, and seize the definition of "Downloadable" from the earlier-filed '520 Unasserted Patent. *See* Red Br. 36 (noting that only the '520 Unasserted Patent's definition has the word "interpretable"). ESET proposes that because the word "interpretable" is in the earlier-filed '520 Unasserted Patent definition, that word must be brought into the '844 and '780 Patents' "Downloadable" term expressly. ESET then argues that since the word "small," is also in the earlier-filed '520 Unasserted Patent's definition it should come along for the ride. *Id.* ESET errs on all aspects of this fallacious analysis.

1. Because "interpretable" programs are a species of "executable" ones, the '844 and '780 Patents' "Downloadable" definition is complete as written

ESET's central thesis—that the word "interpretable" must literally appear in any construction of "Downloadable"—contravenes the record. The '844 and '780 Patents unequivocally establish that "interpretable" Downloadables are a ***species*** of "executable" Downloadables, so there is no requirement that they be separately articulated. Moreover, the parties agree that a Downloadable was intended to cover executables and interpretables—a fact that is a central premise of ESET's argument.

An interpretable is simply one form of an executable. Column 1 of the '844 Patent provides an example. Immediately after stating that Downloadables are "executable application programs," the Patent gives as an example "JavaScript scripts":

> ***A Downloadable is an executable application program***, which is downloaded from a source computer and run on the destination computer. A Downloadable is typically requested by an ongoing process such as by an Internet browser or web client. ***Examples of Downloadables include*** Java™ applets designed for use in the Java™ distributing environment developed by Sun Microsystems, Inc., [and] ***JavaScript™ scripts*** also developed by Sun Microsystems, Inc. . . .

Appx178 (1:44–54 (emphasis added)); *see also* Appx199 (1:50–61 (same, for '780 Patent)). At the very least, JavaScript scripts are "interpretable" programs. Both sides presented expert witnesses who agreed on this point:

- Finjan presented testimony from Nenad Medvidovic, Ph.D.: "[A]n executable application program includes ***interpretable*** application programs such as those written in JavaScript . . ." (Appx2115 (¶ 16, emphasis added))
- ESET presented testimony from Eugene Spafford, Ph.D.: "At the time of the alleged inventions, JavaScript was one of the canonical ***interpreted*** languages." (Appx930 (¶ 26, emphasis added))

This Court has regularly held that where a patent uses a term, then gives examples, those examples inform the term's meaning during claim construction. *Wi-LAN USA, Inc. v. Apple Inc.*, 830 F.3d 1374, 1382 (Fed. Cir.

2016) ("Consistent use of a term in a particular way in the specification can inform the proper construction of that term."); *Chimie v. PPG Indus*., 402 F.3d 1371, 1378–79 (Fed. Cir. 2005) (affirming the district court's interpretation of the scope of the claims with reference to examples in the specification.) Here, the '844 and '780 Patents' text confirms that "interpretable" programs are not, as ESET incorrectly urges, a distinct class from "executable" programs. They are, for purposes of claim interpretation, a ***subset or species*** of "executable" programs. Any other interpretation would directly contravene the patents' clear statement that JavaScript scripts are an "example" of an "executable" program. *See* Appx178 (1:44–54). And, as the Court knows, interpretations that contravene clear statements and embodiments in a patent description are highly disfavored. *Phillips v. AWH Corp. et al.*, 415 F.3d 1303, 1320–21 (Fed. Cir. 2005) (en banc) (discussing primacy of specification); *Chimie*, 402 F.3d at 1377.

Unable to address these issues, ESET's brief ignores them. It turns to extrinsic evidence over the clear weight of the intrinsic record to re-write the express definition. Though conceding that its own expert, Dr. Spafford, described JavaScript scripts as "interpretable" programs, ESET still asserts that such scripts "differ in scope from the express definition in these patents[.]" Red Br. 36. Not so. As just discussed, the patents' own

specifications expressly indicate that interpretable programs are ***within*** the scope of "executable" programs, and thus are already encompassed by the "Downloadable" definition written into the '844 and '780 Patents. *See* Appx178 ('844 Patent 1:44–54); *see also* Appx199 ('780 Patent 1:50–61). To ascertain the status of "interpretables," it is unnecessary to reach outside the '844 and '780 Patents to an unasserted patent. ESET's entire justification for reaching back to the '520 Unasserted Patent is baseless.

ESET's next contention, that "there is no dispute that scripts . . . are not executable programs," Red Br. 37, is flatly wrong. Not only do the patents say the opposite, Finjan expressly directed the district court to evidence showing how such statements by ESET ignore the record:

> THE COURT: All right. Could you respond to this? So in essence, [ESET is] saying that a definition that is set forth at column 1 for Downloadable, subsumed within that has to be a definition of what an executable application program is, and that does not include an interpretable program.
>
> [FINJAN'S COUNSEL]: Sure, your Honor. So I think the easiest thing to do is just look at the patent itself. So if you go to the '844 Patent.
>
> THE COURT: I have the patent in front of me. Go ahead.
>
> [FINJAN'S COUNSEL]: The '844 Patent, and your Honor pointed out the ***specific definition in column 1, line 45***. If we just go to ***line 50*** and see what are the examples that are given of Downloadable in the patent

> itself. Let's not look at the extrinsic record of the testimony of anybody else.
>
> Let's look at the examples. The examples are Java, JavaScript, and ActiveX. ***JavaScript [, as] anyone of skill in the art understands[, is] not a [program in] machine language.*** Spafford said it, Medvidovic said it, everyone said that. So right there, the patent is in ***fundamental disagreement*** with ESET's proposed construction.
>
> ***The patent specifically says that a Downloadable is JavaScript.*** So that means that it [the term "Downloadable"] is not [only] an executable application program . . . [in] machine language. Let's just look at the patent itself. You don't have to look at anything else.

Appx23582–23583 (34:13–35:14, emphasis added); *see also* Appx178 (1:45–50). Moreover, the three Appendix citations tendered by ESET on this point do nothing to support ESET's claim that this issue is uncontested. Red Br. 37. The first (Appx929–931) is to ESET's own expert; the other two (Appx1024–1028; Appx1031–1035) are to dictionaries. Not one is an admission, concession, or even an agreement by Finjan.

The parties do, however, agree on some points. ESET states, "[T]he claims of both patents ['844 and '780] reveal that interpretable programs are types of Downloadables." Red Br. 37. Finjan agrees. As ESET correctly notes, the dependent claims do specifically indicate that Downloadables cover interpretable programs like scripts. *See* Appx183 ('844 claims 7, 8). Finjan also agrees with ESET's statement, "it necessarily follows that the definition of

Downloadable must be broad enough to cover 'interpretable' programs." Red Br. 37. But far from supporting ESET, these statements confirm that the definition of Downloadable as stated in the '844 and '780 Patents, covers interpretable programs. They do not support the district court ignoring the '844 and '780 Patents' express statements, reaching out to an unasserted patent, with a different specification, and creating a narrower definition.

ESET's contention that the district court's claim construction was based on resolution of a "factual dispute," and so subject to deferential review, is equally baseless. *See* Red Br. 38. First, nowhere in the district court's order does the court find as a matter of fact that "interpretable" is a separate and non-overlapping category of program from "executable." *See generally* Appx2–3. While the order does use the word "executable" and the word "interpretable," it does not discuss, in any way, the relationship between them. *Id.* In fact, the district court stated during the *Markman* hearing that it understood the stated definition of "Downloadable" in the '844 and '780 Patents to "cover interpretable programs, and it doesn't need to be singled out or otherwise rewritten to cover that." Appx23606 (58:7–9). This statement alone puts the lie to ESET's argument that the court felt compelled to reach back to the definition of Downloadable in the '520 Unasserted Patent because

it had to find a construction which explicitly contained the term "interpretable."

2. Nothing about the '844 and '780 Patent claims' coverage of "interpretable" programs requires that Downloadables be "small"

Even were the Court to conclude that, contrary to the discussion above, the word "interpretable" must be in any construction of "Downloadable," nothing about that supports restricting the '844 and '780 Patent claims to only "small" programs. It is undisputed that neither the '844 nor the '780 Patent use the term "small" in their specifications, nor do any of the embodiments provide a basis for limiting the term downloadable to "small."

ESET's theory is that modifying the Patents' express definition is necessary to give effect to the accompanying description that JavaScript scripts are a preferred embodiment of the claimed Downloadables. *See supra*; *see also* Red Br. 36–37. As the previous discussion demonstrates, that is not a valid theory, but even if it were, none of those considerations apply to the limitation, "small." ESET acknowledges that neither the '844 Patent specification nor the '780 Patent specification has even a modest suggestion that their claims cover only "small" programs and it is those specifications which are relevant to the inquiry. *See Young Dental Mfg. Co. v. Q3 Special Prods., Inc.*, 112 F.3d 1137, 1143 (Fed. Cir. 1997) ("The specification that is

relevant to claim construction is the specification of the patent in which the claims reside."). As ESET acknowledges, these patents include an express definition of "Downloadable" with no reference to being "small." Red Br. 36. Importing "small" into the '844 and '780 claims would thus overwhelm the express definition and written text of both patents, and the clear intent of the inventors, who filed each asserted patent ***after*** the '520 Unasserted Patent and chose not to include the narrower definition or even the word "small" in their original specifications. *See MPHJ Tech. Invs. LLC, v. Ricoh Ams. Corp.*, 847 F.3d 1363, 1369 (Fed. Cir. 2017) ("[I]t is the deletion from the '798 Provisional application that contributes to the understanding of the intended scope of the final application."); *Smartphone Techs. LLC v. Research in Motion Corp.*, No. 6:10-cv-74, 2012 WL 489112, *4 (E.D. Tex. Feb. 13, 2012) (incorporated patent did not restrict the meaning of a disputed term.)

B. Finjan has never urged that differences among the patents are immaterial for claim construction

To be clear, Finjan does believe "Downloadable" should receive the same construction for each of the ***asserted*** patents, which is the construction stated in the '844 and '780 Patents, as Finjan argued to the district court. *See, e.g.*, Appx1206. That construction is supported by the record, for the reasons discussed in Finjan's opening brief.

That does not mean, however, that a claim term must automatically receive an identical interpretation across separate patents, with different filing dates, separate priority claims, separate figures, separate descriptions, and even separate inventive entities. As the Court held in *Lydall Thermal/Acoustical, Inc. v. Federal-Mogul Corp.*, 344 F. App'x 607 (Fed. Cir. 2009) "when the prosecution history appears in conflict with the specification"—the circumstance here—"any ambiguity must be resolved in favor of the specification." *Id.* at 614. The '844 and '780 Patents are clear in their adoption of a definition for "Downloadable" that lacks the "small" restriction. Those specifications should be given primacy over whatever happened in the earlier history of the '520 Unasserted Patent.

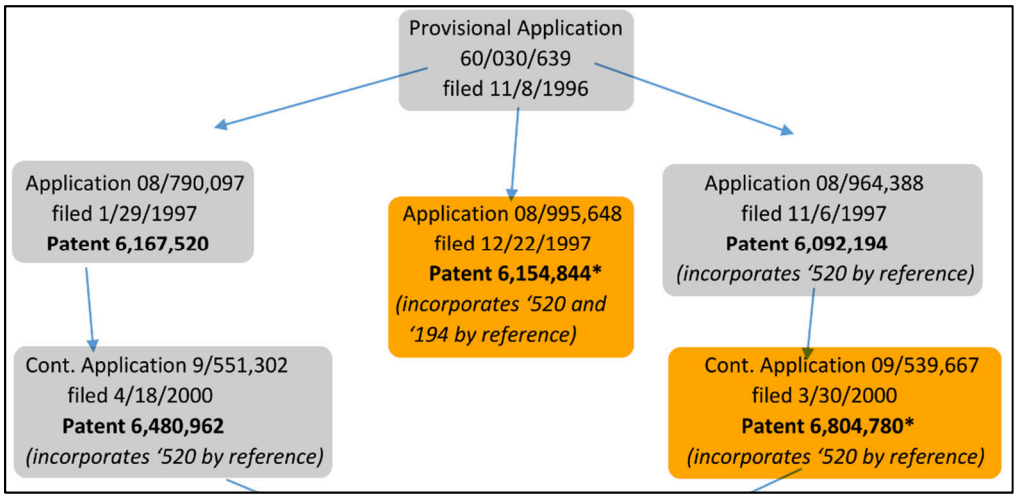
C. As ESET concedes, the '844 and '780 Patents both expressly define "Downloadable" without reference to "small"

The reason ESET focuses on collateral issues like "interpretable" rather than directly supporting the district court's importation of "small" into the '844 and '780 claims is that the importation is indefensible. ESET concedes, as it must, that "for the '844 and '780 [P]atents, the patentee defined 'Downloadable' differently [than] in the incorporated applications[.]" Red Br. 5. As Finjan's Opening Brief describes, the '844 and '780 Patents defined "Downloadable" to have a meaning that never mentions being "small":

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

Appx178 (1:44–47); *see also* Appx199 (1:50–53); Blue Br. 13–14.

ESET is unable to muster any authority as to why the '844 and '780 Patents' express definition of "Downloadable" should not control the interpretation of that term. The file history overwhelmingly teaches otherwise. For example, the '780 Patent arose from a continuation application. Its direct parent, the '194 Unasserted Patent, has a materially identical disclosure, including an expansive definition of "Downloadable." *See* Appx187 at [63]; *see also* Appx996 (1:44–47). And as described in Finjan's Opening Brief, the '639 Provisional also defined "Downloadable" without reference to "small." Blue Br. 11. The figure below summarizes the relationships:



Appx13 (highlighting added, asserted patents in orange highlighting). Put another way, three original specifications use the definition Finjan urged at the district court, and two of those are the specifications for the '844 and '780 asserted patents. Only one intervening original specification, the '520 Unasserted Patent, used a different definition, a patent with a different specification than the '639 Provisional, and the '194 and '844 Patents.

It appears that the district court's rationale for limiting the scope of the '844 and '780 Patent claims to "small" Downloadables was those patents' incorporation-by-reference of the '520 Unasserted Patent. Appx2–3. Such a rationale, however, is not supported by the law. "[I]ncorporation by reference does not convert the invention of the incorporated patents into the invention of the host patent." *Modine Mfg. Co. v. U.S. Int'l Trade Comm'n*, 75 F.3d 1545, 1555 (Fed. Cir. 1996). Moreover, ESET fails to cite any case from this Court indicating that a definition from an incorporated, non-priority document may overwhelm an expressly contrary definition within the patent's four corners. Such an outcome would contravene the holding in *Paice LLC v. Ford Motor Co.*, 881 F.3d 894 (Fed. Cir. 2017) that "in every case, the host patent purports to improve upon that which it incorporates." 881 F.3d at 908.

There is no basis in the record to restrict the '844 and '780 Patent claims to "small" Downloadables. The Court should set that restriction aside.

II. ESET ALSO DOES NOT MATERIALLY DEFEND THE IMPORTATION OF "SMALL" INTO THE '086 PATENT

ESET's purported defense of the district court's restriction of the '086 claims to "small" Downloadables tracks most of the same issues as for the '844 and '780 Patents, and is deficient for the same reasons.

A. ESET's "interpretable" arguments for the '086 Patent are as deficient as its arguments for the '844 and '780 Patents

As Finjan's opening brief described, the '086 Patent's description varies in some places from that of the '844 or '780 Patents, but nothing in those variances supports ESET. They do not make "interpretable" any more relevant to the meaning of "Downloadable," and they do not support ESET's theory of importing "small" from the '520 Unasserted Patent.

Nothing in the '086 Patent suggests that the construction of "Downloadable" must include the word "interpretable," for similar reasons already discussed. The '086 Patent's SUMMARY OF THE INVENTION makes clear that its invention is practicable with "JavaScript [ ] scripts," as well as other "downloadable application programs." Appx253 (2:38–43). The '086 Patent also describes its invention as addressing "executable" programs, and makes clear that said term encompasses "interpretable" programs. Appx257 (9:24–32, stating that information having "executable" code "will be referred to as a 'Downloadable' . . . (regardless of whether the executable code includes

. . . distributable 'components' such as Java, ActiveX, add-ins, etc.)"). Moreover, when the '086 Patent does describe "binary executables," it takes pains to indicate that such is but one embodiment, and not the entire scope of "Downloadable," or executables. Appx258 (11:16–17, "For example, where the Downloadable is a binary executable . . .").

B. Reciting "interpretable" in the construction of "Downloadable" does not mandate importing "small"

As is the case for the '844 and '780 Patents, ESET's attempt to couple "small" to "interpretable" is meritless for the '086 Patent. ESET does not dispute that there is no suggestion in the '086 Patent of a limitation to "small" programs, nor is there any linkage between a program being "interpretable" and it being "small." ESET's proposal is plainly ends-driven, and lacks support in the record.

C. The '086 patent describes flexible technology for all "Downloadables," not just "small" ones

As is the case for the '844 and '780 Patents, ESET's discussion of the '086 Patent identifies no reference to "small" Downloadables in the '086 Patent, because no such reference exists. Red Br. 34–36. Finjan's Opening Brief describes, and ESET does not dispute, that limitation of the '086 Patent to "small" files would run against the '086 Patent's statements that its

technology was not as "inflexible" as prior art, as well as the wide array of programs that the patented technology could protect against:

> While enabling the capabilities of prior systems, the present invention is not nearly so limited, resource intensive or inflexible, and yet enables more reliable protection. For example, remotely operable code that is protectable against can include ***downloadable application programs, Trojan horses and program code groupings, as well as software "components" such as Java™ applets, ActiveX™ controls, JavaScript™/Visual Basic scripts, add-ins, etc., among others.***

Appx253 (2:30–43, emphasis added). Restricting that list to only "small" files would have no basis whatsoever in the '086 Patent's text.

III. ESET'S ANALYSIS OF THE '621 AND '755 PATENTS IS WRONG

ESET's contentions concerning the '621 and '755 Patents offer a variant of the same proposal: to hitch the "small" restriction to some other item of claim construction. ESET's argument fails for the same reasons already discussed, namely, ESET's inability to demonstrate that the "small" restriction is actually warranted by anything in the '621 and '755 Patents original specifications or their prosecution histories.

The Red Brief does not dispute that the '621 and '755 Patents include all the text discussed above from the '086 Patent—all of which suggests that the invention had broad scope, and none of which so much as hints at a restriction

to "small" Downloadables. Rather than address this aspect of the '621 and '755 Patents, ESET ignores it, directing the Court instead to an unrelated interaction during examination regarding written description. *See* Red Br. 31–32.

Finjan does not dispute that some written description support for the '621 and '755 Patent claims can be found in the '962 Unasserted Patent. But none of it has anything to do with restricting Downloadables to "small" programs. The facts are as follows. During prosecution, Finjan directed the Examiner to the '962 Unasserted Patent to confirm written description support of two claim elements:

- For the application that became the '621 Patent, to support the claims' requirement that certain information both (1) "pertain[] to an operation of the downloadable," and (2) be "distinct from information pertaining to the request." Appx1061–1062. The requirement had nothing to do with the Downloadable's size, and only a tangential relationship to the Downloadable at all. The word "small" was never discussed.
- For the application that became the '755 Patent, to support the claims' requirement of an "extension call." Appx1073–1076. Again, the requirement had nothing to do with the Downloadable's size, or with the Downloadable at all. Again, the word "small" was never discussed.

ESET ignores all this context, and its argument is as flawed as it is reductive. ESET reasons that because Finjan directed the Examiner to the '962 Unasserted Patent on totally different issues, the inquiry is over, and all claims must be restricted to "small" Downloadables. Red Br. 31–32. But such a blinkered approach to claim interpretation has never been adopted by the Court, and should not be adopted now. The issue before the Court is not whether Finjan relied in part on the '962 Unasserted Patent for written description support, but rather whether anything about that reliance indicated a restriction to "small" Downloadables. It does not, for the reasons given. A person of ordinary skill seeking to understand the scope of "Downloadables" for these patents—as, indeed, for all the patents on appeal—would not begin by looking at an unasserted patent snatched from the middle of several patent filings that were incorporated by reference. Such a person would begin with the specification of the patents themselves. *See generally Phillips*, 415 F.3d at 1315 ("The specification is, thus, the primary basis for construing the claims.").

As with the other asserted patents, the specifications of the '621 and '755 patents never use the word "small" nor is there any support to be found in those specifications for limiting the term "Downloadable" to cover only "small" executables. And while the '962 Patent is incorporated by reference,

ESET acknowledges that so are the '639 Provisional and '194 Patent. The former defines a Downloadable as "an executable application program, which is automatically downloaded from a source computer and run on the destination computer" and the latter defines it in exactly the same way, only omitting the term "automatically." Red Br. 29-30. ESET's red brief not only fails to support the district court's construction, it actually makes the case for Finjan.

IV. EVEN IF THE COURT AFFIRMS AS TO THE "SMALL" RESTRICTION, THE RECORD FALLS FAR SHORT OF SUPPORTING ESET'S FACT-BASED ATTACK ON DEFINITENESS

The district court's Indefiniteness Order is procedurally and factually wrong as a matter of law. And ESET's brief, like the Indefiniteness Order, ignores the heavy burden the law places on one who seeks summary judgment of invalidity, especially one based on alleged conflicts in the opinions of designated experts. Not only was ESET under a burden to establish that such conflicts were "clear and convincing" evidence of indefiniteness, its proffer had to be so overwhelming as to support ESET even when viewed in the light most favoring Finjan, and with all reasonable inferences drawn in Finjan's favor. *IBEW, AFL-CIO Local 47 v. S. Cal. Edison Co.*, 880 F.2d 104, 105 (9th Cir. 1989). ESET's brief cannot conceal that the record here falls far short of this high standard.

A. The absence of any expert opinion rebutting Dr. Cole's pre-mistrial description "small" should have been dispositive

ESET does not dispute that when it pressed Dr. Cole on the stand for a description of what "small" would mean to a skilled artisan, Dr. Cole gave one. Dr. Cole explained that to a skilled artisan at the time of the invention and in the context of the '844 Patent, "small" was a concept tied to the ease with which the Downloadable could be executed, that is, whether it required installation:

> Q: . . . [W]ould you have considered a 5-megabyte file . . . a small Downloadable in the context of the '844 Patent in 1996?
>
> A: Once again, in the context of the '844, I would have to look at what the executable did. ***If that executable didn't require installation, then I would consider it small. And if it required installation, than it wouldn't be considered small.*** But ***it's not based on a number.***

Appx23163–23164 (414:21–415:3, emphasis added).

ESET never contradicted that statement. As Finjan's Opening Brief explained, none of ESET's summary judgment papers presented rebuttal opinions from any of ESET's own experts (who, as discussed *infra*, had been able to interpret and apply the claim, and had never proposed indefiniteness of the term). *See* Blue Br. 42, 49.

The unrebutted nature of Dr. Cole's testimony is dispositive for summary judgment purposes. *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374 (Fed. Cir. 1999), is on point. *Atmel*, like the present case, involved a district court's summary judgment of indefiniteness. The issue was whether certain text in the specification was sufficient to teach a skilled artisan the structure corresponding to a means-plus-function limitation. The patentee presented expert testimony that one skilled in the art would have understood the scope of the claim; the expert's testimony was "essentially unrebutted." 198 F.3d at 1382. The absence of rebuttal settled the issue: "[W]e conclude that summary judgment was improvidently granted invalidating the [challenged] patent for indefiniteness[]." *Id.*; *see also Biomedino, LLC v. Waters Tech. Corp.*, 490 F.3d 946, 952–53 (Fed. Cir. 2007) (discussing *Atmel*, approvingly).

Unable to offer any rebuttal to Dr. Cole's trial testimony, ESET falls back on arguing that the interpretation of "small" by the Finjan-retained experts, including Dr. Cole, was "highly variable." Red Br. 49. What ESET is forgetting is that expert credibility is an issue for the jury, not the judge. ESET's contention that Dr. Cole's testimony "denied the very essence of the word 'small,'" *id.*, is simply not true. The questioning from ESET's counsel was specifically ***about*** the interpretation of the word "small." Appx23163

(413:21–23, "[W]ould you have considered a 5-megabyte file . . . a ***small*** downloadable . . . ?"). ESET not liking Dr. Cole's interpretation of "small" is not the same as Dr. Cole denying the word's existence.

Finally, the district court's criticism that Dr. Cole "did not . . . provide support from the specification, the prosecution history, or from any extrinsic sources" for his testimony (Appx21), is entirely out of place at the summary judgment stage. Such criticisms may go to the weight that a witness's testimony receives, but they cannot undo the total absence of contrary testimony from the record.

As in *Atmel*, Finjan's expert described, under oath, how a person of ordinary skill would understand the meaning and application of "small." No person testified otherwise, nor did any of ESET's experts tender a disputing declaration. This alone should be enough to secure Finjan's right to a determination of Dr. Cole's credibility by a ***jury***, and not by the district court at summary judgment.

B. The clear ability of ESET's own expert to determine the claims' scope should have been dispositive

ESET's denial that Finjan's patents could have been "saved" by the opinions of ESET's expert, Eugene Spafford, confirms the backwardness of ESET's analysis. Red Br. 50. ESET contends that Dr. Spafford's ability to

"identify [purportedly] invalidating prior art" did not necessarily mean that Dr. Spafford actually knew the scope of the claim. *Id.* at 51. ESET's argument is incoherent. Observing that Dr. Spafford had opined that "small" Downloadables were known in the prior art, a court could—and, reviewing summary judgment *de novo*, this Court must—reasonably infer that Dr. Spafford understood what "small" meant. *See* Blue Br. 49 (describing Dr. Spafford's statements about the presence of "small" Downloadables in various references).

ESET's statement that Dr. Spafford "offered no opinion" on definiteness specifically (Red Br. 51) only underlines the point. The fact that ESET's expert failed to offer an opinion as to whether a term rendered a claim indefinite was one of the factors this Court considered in *Sonix Tech. Co. v. Publications Int'l, Ltd.*, 844 F.3d 1370 (Fed. Cir. 2017), in reversing the district court's invalidity finding due to indefiniteness. *Id.* at 1390 ("Appellees' own expert, did not opine that the claims were indefinite or that a skilled artisan would not have understood the term . . ."). Unsurprisingly, ESET's brief fails to address *Sonix* even though it is cited and discussed in Finjan's Opening Brief. *See* Blue Br. 46, 48.

Before a jury, Finjan would have had the opportunity to ask Dr. Spafford about his opinions. That the pandemic prevented such questioning from

occurring is no basis for summary judgment. If anything, the pandemic's truncation of the trial underlines the impropriety of ESET's reasoning and, by extension, the district court's.

The definiteness of patent claims—a legal issue—turns on a determination of fact: do the claims, read in their full context, "inform those skilled in the art about the scope of the invention with reasonable certainty[?]" *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014); *see also Dow Chem., Co. v. Nova Chems. Corp. (Canada)*, 809 F.3d 1223, 1224–25 (Fed. Cir. 2015) (Moore, J., concurring in denial of reh'g pet.) ("Indefiniteness, like enablement, obviousness, and claim construction, sometimes requires resolution of underlying questions of fact." (collecting authority)). Here, Dr. Spafford's stated opinions that a skilled artisan would have viewed the claims as obvious over prior art amply support an inference that, in Dr. Spafford's view, such an artisan would have been understood the claims' scope. That should have doomed ESET's summary judgment motion from the outset. The district court erred in determining otherwise.

ESET's argument that Dr. Spafford could have been doing no more than analyzing prior art "based on Finjan's infringement accusations," and that such opinions "do not necessarily imply that a claim term has a definite meaning," misses the point. The issue is not whether Dr. Spafford's stated

opinions "necessarily" mean he thinks the claims are definite. The issue is whether his opinions could support a reasonable ***inference*** that he thinks the claims are definite. They do, and on that basis the Court should reverse.

C. Testimony from other Finjan experts confirming definiteness should have been dispositive

ESET's attempt to defend the district court ignoring Finjan's offer of proof from other testifying experts (Red Br. 52–55) is similarly flawed. ESET's contention that a rule restricting summary judgment to cases with a fully developed record "would preclude any court from ever granting summary judgment," Red. Br. 53, contravenes clear law. It is in all cases the movant's burden at summary judgment to establish the absence of any material fact questions. *Conroy v. Reebok Int'l, Ltd.*, 14 F.3d 1570, 1575 (Fed. Cir. 1994). If any of the material presented by the non-movant—when viewed in its most favorable light and all reasonable inferences favoring the non-movant—suggests a material fact question, the inquiry is over and summary judgment should be denied.

Here, ESET attempted to shoulder its summary judgment burden by pointing to a trial that ended prematurely after a single expert witness. In such a case, the testimony that other witnesses would have offered, but were prevented from doing so by mistrial, has plain relevance. Finjan presented

that testimony to the district court via an "offer of proof," as the Opening Brief describes. Blue Br. 50–51. The offer of proof described how the experts precluded from testifying would have explained how "small" had a context-dependent meaning to those of skill in the art, just as Dr. Cole described at trial. Even if said testimony exhibited something short of "consensus," to use the district court's phrase (Appx24), it was more than enough to establish a triable fact question.

D. Nothing in the record supported judgment as a matter of law, particularly not at the summary judgment phase

ESET's attempted defense of the district court's determination that Dr. Cole's opinions are "not supported by the intrinsic evidence or . . . extrinsic evidence" fails because ESET is unable to muster an iota of record support for it. *See* Red Br. 58–62.

As to the intrinsic record, as both this brief and the Opening Brief described, the concept of a Downloadable being "small" is not one that was developed in ***any*** of the asserted patents. It was erroneously imported by the district court, and it is therefore unsurprising that the intrinsic record offers little to aid in its interpretation. But a silent record is no support for ESET here. Again: at summary judgment it is ESET's burden to establish skilled artisans' inability to understand the claims' scope with reasonable certainty.

That ESET does not like Dr. Cole's explanation is not, without more, sufficient. ESET fails to point to a single contradictory line in any part of the intrinsic record, and it fails to present any supportive expert opinion of its own. At the summary judgment phase, an absence of clearly definitive evidence dooms ESET's motion. The Court should reject ESET's invitation to, as the district court did, improperly invert the burden of proof.

As to the extrinsic record, ESET repeats the district court's error of forgetting that Dr. Cole's opinion and the opinions of the Finjan's other experts, is itself extrinsic evidence. *E.g.*, *Phillips*, 415 F.3d at 1318 (discussing "extrinsic evidence consisting of expert reports and testimony"). Such evidence, particularly where it is unrebutted, can be more than enough to make summary judgment improper, as already discussed with reference to *Atmel*.

The Court should reject ESET's invitation to treat this indefiniteness dispute as though it had the benefit of a full trial record. It should reverse the judgment of indefiniteness and remand.

CONCLUSION

For the above-stated reasons, Finjan respectfully asks that the Court correct the district court's claim construction, reverse the Indefiniteness Order, vacate the judgment for ESET, and remand for further proceedings.

Dated: November 22, 2021

Respectfully submitted,

/s/ Juanita R. Brooks

Juanita R. Brooks
Jason W. Wolff
FISH & RICHARDSON P.C.
12860 El Camino Real, Suite 400
San Diego, CA 92130
Telephone: (858) 678-5070

Robert P. Courtney
FISH & RICHARDSON P.C.
60 South 6th Street, Suite 3200
Minneapolis, MN 55402
Telephone: (612) 335-5070

Attorneys for Appellant Finjan LLC

CERTIFICATE OF SERVICE AND FILING

I certify that on November 22, 2021, I electronically filed the foregoing **REPLY BRIEF OF FINJAN LLC** of Plaintiff-Appellant using the Court's CM/ECF filing system. Counsel for appellee were electronically served by and through the Court's CM/ECF filing system per Fed. R. App. P. 25 and Fed. Cir. R. 25(e).

/s/ Juanita R. Brooks
Juanita R. Brooks

CERTIFICATE OF COMPLIANCE

The **REPLY BRIEF OF FINJAN LLC** of Plaintiff-Appellant is submitted in accordance with the type-volume limitation of Fed. Cir. R. 32(b). The **REPLY BRIEF OF FINJAN LLC** contains 6162 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b)(2). This **REPLY BRIEF OF FINJAN LLC** has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in Cambria, 14 Point.

Dated: November 22, 2021

/s/ Juanita R. Brooks
Juanita R. Brooks