

No. 22-

IN THE
Supreme Court of the United States

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

Petitioners,

v.

FINJAN LLC,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Finjan asserted five interrelated U.S. patents relating to anti-malware systems and methods against ESET. The Finjan patents purport to analyze a “Downloadable,” a term that had no meaning to persons of skill in the computer art. In three of the asserted patents, conflicting definitions of the term “Downloadable” are supplied by incorporated-by-reference patents as an “executable application program” or as a “small executable or interpretable application program...” In the other two asserted patents, the patentee expressly defined the term “Downloadable” as an “executable application program...” but also incorporated by reference prior related patents that contained the conflicting definition of “Downloadable” as a “small executable or interpretable application program...” The District Court adopted for its construction of the term “Downloadable” in all five asserted patents the patentee-provided definition that included “small,” “executable,” and “interpretable,” applying Federal Circuit precedent that a patentee may act as his own lexicographer in defining his invention. Ignoring its own precedent and that of this Court, the Federal Circuit reversed, fashioning an entirely new definition that included “executable” and “interpretable” but excluded the word “small.” There is no patentee-coined definition of “Downloadable” that includes “interpretable” but excludes “small.” The Federal Circuit opined, counterfactually, that there was no conflict in the definitions provided in the incorporated-by-reference patents.

The questions presented are:

1. In a case of first impression for this Court, where a patentee expressly defines a claim term, may the Federal

Circuit disregard its decades-old precedent that the patentee's express definition governs?

2. Does a Federal Circuit *ex post facto* claim construction comply with pre-AIA 35 U.S.C. § 112 ¶¶ 1 and 2, and this Court's precedent in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014), when a person of skill in the art could not have predicted the Federal Circuit's claim construction with reasonable certainty?

3. Must the Federal Circuit, under *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318 (2015), credit a District Court's underlying factual determinations in resolving conflicts arising from a patentee incorporating-by-reference multiple conflicting definitions of a patentee-coined claim term?

CORPORATE DISCLOSURE STATEMENT

Petitioner ESET, LLC is a wholly owned subsidiary of ESET spol. s.r.o. No other publicly held corporation owns 10% or more of the stock of ESET spol. s.r.o.

RELATED PROCEEDINGS

The following proceedings are directly related to this case within the meaning of Rule 14.1(b)(iii):

- *Finjan LLC v. ESET, LLC, ESET spol. s.r.o.*, Case No. 17-cv-0183 CAB(BGS), U.S. District Court for the Southern District of California. Judgment entered on March 23, 2021 and amended on March 29, 2021.
- *Finjan LLC v. ESET, LLC, ESET spol. s.r.o.*, Case No. 2021-2093, U.S. Court of Appeals for the Federal Circuit. Judgment entered, reversing-in-part, vacating-in-part, and remanding district court judgment on November 1, 2022.

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OPINIONS BELOW

The Federal Circuit’s opinion (App. 1a-12a) is reported at 51 F.4th 1377. The Federal Circuit’s order denying rehearing *en banc* (App. 41a-42a) is unreported. The opinion of the District Court granting summary judgment (App. 13a-23a) is unreported. The District Court’s claim construction order (App. 24a-40a) is unreported.

JURISDICTION

The Federal Circuit entered judgment on November 1, 2022 and denied rehearing *en banc* on December 27, 2022. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

STATUTORY PROVISION

Section 112 ¶ 1 of Title 35 of the U.S. Code provided¹:

“The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.”

1. Because the applications that led to the asserted patents were all filed before September 16, 2012, the pre-AIA provisions of Title 35 apply.

Section 112 ¶ 2 of Title 35 of the U.S. Code provided:

“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”

INTRODUCTION

Federal Circuit precedent has long held, among the canons that a district court may employ during claim construction, that a patentee may act as his own lexicographer. In so doing, the patentee may coin a term to describe his invention, including a term that may not have been previously known in the field. The courts and the public have understood that when a patentee acts as his own lexicographer, the patent claims should be construed consistent with the patentee’s express definition. The Federal Circuit’s opinion, for which certiorari is sought, departs from that well-understood law and charts a new and perilous course.

In cases where the inventor incorporates by reference multiple priority or related applications into a patent specification that contains conflicting definitions for the same patentee-coined term, the claim construction process is even murkier. Where resolution of such conflicting definitions requires the district court to make ancillary fact findings, those determinations are subject to review for “clear error,” as set forth in *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318 (2015). Here, the Federal Circuit disregarded its “inventor-lexicographer” precedent, substituted its own interpretation of the underlying facts, and created a new *ex post facto* definition

that is inconsistent with the patentee's conflicting and differing definitions. The confusion caused by the patentee's carelessness in inconsistently defining his invention fails the definiteness requirement of Section 112 of the Patent Code, violates the public notice function of the claims, and should have rendered the claims invalid.

This Court can and should restore predictability to this aspect of claim construction. If a person of skill in the art, due to inconsistent patentee-provided definitions, cannot understand what is claimed until the Federal Circuit weighs in, is that not sufficient reason enough to hold the asserted claims indefinite? The trial courts in this regard become mere waystations, where parties await progression to the appellate level so that the four corners of the invention can be determined.

In this case, the patentee-coined term "Downloadable" was used in the asserted claims of five expired patents: U.S Patent Nos. 8,079,086 ("the '086 patent"), 9,189,621 ("the '621 patent"), 9,219,755 ("the '755 patent"), 6,154,844 ("the '844 patent"), and 6,804,780 ("the '780 patent"). The patents incorporate a quilt-work of priority applications that define "Downloadable" inconsistently. The '086, '621, and '755 patents do not contain any explicit definition within the four corners of the patent but instead incorporate by reference multiple priority applications that inconsistently define Downloadable as either "a small executable or interpretable application program..." or "an executable application program..." The '844 and '780 patents explicitly define "Downloadable" as only "an executable application program..." but also incorporate by reference the definition of Downloadable as "a small executable or interpretable application program..." While

the '621 and '755 patents incorporate the foregoing disjoint definitions, the prosecution histories for those patents establish that the sole written description support for the alleged inventions comes only from a priority patent wherein the patentee specifically defined "Downloadable" to include both "small" and "interpretable."

Following prior Federal Circuit precedent that a patentee may act as a lexicographer to define the words used to describe his invention, the District Court dutifully understood that the inventor's definitions should control. Accordingly, the District Court understood its claim construction should choose between the patentee's definitions in the context of the asserted patents. The District Court further understood that it was not free to create a new definition beyond those formulated by the patentee.

On appeal, the Federal Circuit minted a new definition of "Downloadable" that corresponds to *none* of the definitions the patentee coined. No asserted or incorporated patent defines "Downloadable" the way the Federal Circuit did: "a[n] ~~small~~ executable *or interpretable* application program." The Federal Circuit decision: (1) inserted "interpretable" into one definition by the patentee that had been specifically revised by the patentee to remove that term casually reinserted by the Federal Circuit; and (2) deleted the word "small" from the other patentee definition though the inventor specifically included that term. The Federal Circuit decision is contrary to its own clear precedent, as set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), *Modine Manufacturing Co. v. U.S. International Trade Commission*, 75 F.3d 1545 (Fed. Cir. 1996), and

X2Y Attenuators, LLC v. U.S. International Trade Commission, 757 F.3d 1358 (Fed. Cir. 2014). Moreover, contrary to this Court’s controlling precedent in *Teva*, the Federal Circuit failed to consider the District Court’s analysis of the intrinsic and extrinsic evidence that informed the District Court’s construction. Although designated as a precedential opinion, the Federal Circuit decision does not reconcile its extraordinary result with any controlling precedent or provide any guidance to the district courts.

STATEMENT OF THE CASE

I. None of the Asserted (or Incorporated Non-Asserted) Patents Define Downloadable as Does the Federal Circuit Decision.

It is undisputed that the term “Downloadable” had no common or ordinary meaning to a person of skill in the art at the time the patentee filed the applications that matured into the asserted patents. The ’086, ’621, and ’755 patents incorporated-by-reference patents that provide conflicting definitions for the patentee-coined term “Downloadable” as an “executable application program...” or “a *small* executable *or interpretable* application program.” The ’780 and ’844 patents provide an explicit definition of “Downloadable” as only an “executable application program...” but incorporated by reference the conflicting definition. No asserted patent or incorporated patent/application defines “Downloadable” the way the Federal Circuit did, as “an executable or interpretable application program.”

The District Court recognized that “Downloadable” had no ordinary and accustomed meaning, but rather, the patentee had coined the term by acting as his own lexicographer. Consistent with Federal Circuit precedent, the District Court understood that it could not rewrite the patentee’s definitions but should instead select from amongst the patentee-coined definitions. To do otherwise would undermine the public notice function of claims, as a person of skill in the art could not predict how a court might later redefine a disputed claim term. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 899 (2014). After extensive analysis of the evidence and multiple rounds of briefing supported by expert declarations, the District Court construed the term.

In so doing, the District Court credited the patentee’s arguments to the Patent Office that sole support for the inventions claimed in the ’621 and ’755 patents employed a definition of “Downloadable” that includes both “small” and “interpretable.” The Court found that the express definition in the ’780 and ’844 patents, which refers only to “executable application programs,” did not encompass interpretable application programs, which are mentioned in those patents as examples of Downloadables. The Court received conflicting expert testimony whether “interpretable application programs” are a species of “executable application program” and ultimately rejected that contention.

Based on its detailed review, the District Court factually and correctly determined that: (1) “interpretable” application programs were within the scope of the definition; (2) “interpretable” applications were different than “executable” applications; and (3) the only patentee-

coined definition of “Downloadable” that encompassed the full scope of the alleged invention must therefore include the “interpretable” applications. As such, the only patentee-coined definition that fully encompassed the scope of the alleged inventions necessarily included the words “small” and “interpretable.”²

Prior to its precedential decision here, it was settled Federal Circuit law that, where the patentee acts as his own lexicographer, his definition controls as a matter of law. *See, e.g., Autogiro Co. of Am. v. United States*, 181 Ct. Cl. 55, 62 (1967) (“[P]atent law allows the inventor to be his own lexicographer.”); *Gen. Elec. Co. v. United States*, 215 Ct. Cl. 636, 647 (1978) (“Since the patentee is his own lexicographer, no genuine issue of fact as to the meaning of a claimed term can be found to exist where the meaning is made incontrovertibly clear elsewhere in the patent or in the file wrapper.”); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1558 (Fed. Cir. 1983) (“It is well settled that a patent applicant may be his own lexicographer.”); *Hormone Rsch. Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1563 (Fed. Cir. 1990) (“It is a well-established axiom in patent law that a patentee is free to be his or her own lexicographer, and thus may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings.” (internal citations omitted)); *Beachcombers, Int’l, Inc. v. Wildewood Creative Prods., Inc.*, 31 F.3d 1154, 1159 (Fed. Cir. 1994) (“As we have repeatedly said, a patentee can be his own lexicographer

2. The District Court did not determine that including the word “small” in the construction of “Downloadable” rendered that term indefinite. Instead, the District Court indicated that whether “Downloadable” was sufficiently definite would turn on the evidence adduced from the parties’ experts.

provided the patentee's definition, to the extent it differs from the conventional definition, is clearly set forth in the specification."); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) ("As we have often stated, a patentee is free to be his own lexicographer."); *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) ("Although words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history."); *Digit. Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1344 (Fed. Cir. 1998) ("The written description is considered, in particular to determine if the patentee acted as his own lexicographer, as our law permits, and ascribed a certain meaning to those claim terms."); *Bell Atl. Network Servs., Inc. v. Covad Commc'ns Grp., Inc.*, 262 F.3d 1258, 1268-70 (Fed. Cir. 2001); *Jack Guttman, Inc. v. Kopykake Enters., Inc.*, 302 F.3d 1352, 1360 (Fed. Cir. 2002) ("It is black letter law that a patentee can 'choose to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term that could differ in scope from that which would be afforded by its ordinary meaning.'" (quoting *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001))); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) ("[O]ur cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs."); *Honeywell Int'l, Inc. v. Univ. Avionics Sys. Corp.*, 493 F.3d 1358, 1361 (Fed. Cir. 2007); *Martek Biosciences Corp. v. Nutrinova, Inc.*, 579 F.3d 1363, 1380 (Fed. Cir. 2009) ("When a patentee

explicitly defines a claim term in the patent specification, the patentee’s definition controls.”); *Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1365-66 (Fed. Cir. 2012); *Kyocera Senco Indus. Tools, Inc. v. Int’l Trade Comm’n*, 22 F.4th 1369, 1378 (Fed. Cir. 2022). Likewise, it was settled Federal Circuit law that a district court may not rewrite an inventor’s express definition of a claim term. *See, e.g., Renishaw PLC v. Marposs Societa’ Per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998) (“[T]he definition selected by the patent application controls.”); *Vitronics Corp.*, 90 F.3d at 1582 (“The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.”); *Phillips*, 415 F.3d at 1316 (inventor’s intention, as expressed in the specification, is regarded as dispositive); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) (“[T]he claim term will not receive its ordinary meaning if the patentee acted as his own lexicographer and clearly set forth a definition of the disputed claim term in either the specification or prosecution history.”); *Modine Mfg.*, 75 F.3d at 1552 (range specifically narrowed in child patent not entitled to broader range specified in incorporated-by-reference parent patent); *Cont’l Cirs. LLC v. Intel Corp.*, 915 F.3d 788, 797 (Fed. Cir. 2019) (“When the patentee acts as its own lexicographer, that definition governs.”); *Kyocera Senco Indus. Tools, Inc.*, 22 F.4th at 1379 (“Because the patentee clearly defined [a claim term] in the written description, that definition controls.”).

The Federal Circuit’s decision here changed all that. In the appeal below, the Federal Circuit overrode the express definitions provided by the patentee by selectively editing those definitions. In so doing, the Federal Circuit

ignored this Court’s holding in *Teva*, and the District Court’s factual determination, instead concluding that the conflicting definitions were in fact “not competing.” The Federal Circuit cited no intrinsic basis for its *ex post facto* rewrite of the patentee’s express definitions, nor did it explain how its determination complied with the written description requirement of 35 U.S.C. § 112 ¶ 1, the definiteness requirement of 35 U.S.C. § 112 ¶ 2 and this Court’s precedent in *Nautilus*, or fulfill the public notice function of patent claiming. *Cf., Digit. Biometrics*, 149 F.3d at 1347.

In derogation of *Teva*, the Federal Circuit held that “the district court erred because it viewed the differing definitions throughout the patent family as competing and determined that the asserted patents should be limited to the most restricted definition of the term.” *Finjan*, 51 F.4th at 1382-83. But the District Court did not choose the “most restricted definition.” On the contrary, the District Court chose the patentee-coined definition of “Downloadable” that is broader in scope and covers an entire class of files (*i.e.* interpretable application programs) not covered by the patentee-coined definition that is restricted only to “executables.”

II. Proceedings Below

In July 2016, Finjan, Inc.³ sued ESET spol. s.r.o. and ESET LLC (collectively, “ESET”) in the U.S. District Court for the Northern District of California. On November 10, 2016, ESET filed a motion to transfer

3. Finjan, Inc. changed corporate forms during the pendency of the action and is now Finjan LLC.

venue to the United States District Court for the Southern District of California. On January 26, 2017, the motion to transfer venue was granted, and the case was transferred to the United States District Court for the Southern District of California and assigned Case No. 3:17-cv-00183-CAB-BGS. Following a mistrial in March 2020 due to the COVID-19 pandemic, in July 2020, the Court granted ESET's request to file a renewed motion for summary judgment of invalidity for indefiniteness for all of Finjan's patents except U.S. Patent No. 7,975,305 ("the '305 patent"). In an amended Order issued on March 29, 2021, the Court granted ESET's motion, ruling that five of Finjan's asserted patents were invalid because the term "Downloadable" used in each of the asserted claims is indefinite.

A. The Federal Circuit's panel decision

Finjan filed a notice of appeal to the United States Court of Appeals for the Federal Circuit on June 17, 2021. Briefing on the appeal was completed on November 22, 2021, and the Federal Circuit heard oral argument on May 3, 2022. On November 3, 2022, the Federal Circuit issued a panel opinion reversing-in-part the District Court's judgment with respect to indefiniteness and vacating-in-part.

B. The Federal Circuit's decision denying rehearing *en banc*

Because the Federal Circuit panel decision was counterfactual and ignored controlling authority of this Court and of the Federal Circuit itself, ESET filed a petition for rehearing *en banc*. The Federal Circuit denied the petition for rehearing *en banc* on December 27, 2022.

REASONS FOR GRANTING THE PETITION

I. The Federal Circuit Decision Upends a Well-Understood and Routinely-Applied Claim Construction Canon.

The Federal Circuit’s decision below obfuscates what previously was a straightforward analysis: Where a patentee acts as a lexicographer in defining a term to describe the invention, the patentee-coined term governs construction of that term. Until now, district courts have faithfully and consistently applied the patentee—lexicographer canon. *See, e.g., Duplan Corp. v. Deering Milliken, Inc.*, 370 F. Supp. 769, 773 (D.S.C. 1973) (“Since the patent applicant is his own lexicographer and his own grammarian, no genuine issue of fact as to the meaning of a term used in the claims will be considered by the court to exist if the meaning is made incontrovertibly clear elsewhere in the patent or in the file wrapper.”); *CIVIX-DDI, LLC v. Microsoft Corp.*, 84 F. Supp. 2d 1132, 1157-58 (D. Colo. 2000); *AstraZeneca Pharms., LP v. Mayve Pharma (USA) Inc.*, 352 F. Supp. 2d 403, 412-13 (S.D.N.Y. 2004); *SPX Corp. v. Bartec USA, LLC*, 530 F. Supp. 2d 914, 937-38 (E.D. Mich. 2008); *Netscape Commc’ns Corp. v. Valueclick, Inc.*, 684 F. Supp. 2d 678, 685-88 (E.D. Va. 2009) (“[W]here, as here, the patentee has explicitly defined a claim term in the specification, ‘the inventor’s lexicography governs.’” (quoting *Phillips*, 415 F.3d at 1316)); *NUtech Ventures v. Syngenta Seeds, Inc.*, 984 F. Supp. 2d 957, 968-69 (D. Neb. 2013); *SurfCast, Inc. v. Microsoft Corp.*, 6 F. Supp. 3d 136, 146-47 (D. Me. 2014); *Intellectual Ventures I, LLC v. Lenovo Grp., Ltd.*, 365 F. Supp. 3d 200, 206-07 (D. Mass. 2019). Previously, it was not the role of the Federal Circuit to redefine a

term differently than the inventor. Moreover, where the Federal Circuit engages in *ex post facto* redefinition of an invention, the term is bereft of a written description, as required by 35 U.S.C. § 112 ¶ 1, is rendered indefinite under 35 U.S.C. § 112 ¶ 2, and violates the public notice function of patent claiming.

When multiple conflicting definitions for the same term are presented in multiple incorporated-by-reference patents and applications, the claim construction process is even murkier. The District Court recognized that the asserted patents contained conflicting definitions and adopted the patentee-coined definition that provided the broadest coverage of the disclosed examples. Another viable solution, which the District Court did not choose, would have been to conclude that no definition of “Downloadable” was possible as the patentee-provided definitions are mutually exclusive (i.e., one includes “interpretables” and the other explicitly removed “interpretables” from its definition). That option also would have been faithful to the patentee’s lexicography: neither definition could be correct, thus rendering the term indefinite.

The Federal Circuit’s resolution, however, denied the existence of a conflict and simply redefined “Downloadable” differently than any of the patentee’s definitions, in accordance with no discernible or predictable rule. The district courts and public are entitled to claim construction jurisprudence for patentee-coined claim terms that has cognizable limits and is faithful to the patent specification. The Federal Circuit’s decision upsets that balance, leaving the district courts without guidance and depriving the public of the right to rely on patentee-defined terms to understand patent claims.

This Court should clarify whether and when the Federal Circuit’s precedent regarding the effect of the patentee acting as lexicographer may be disregarded. Does the patentee’s definition govern the claim construction as a meaningful canon of claim construction? Are the Federal Circuit’s prior pronouncements on this topic instead mere *ipse dixit*, having no relevance to the district court’s claim construction process? This Court further should determine that in cases where the patentee incorporates multiple conflicting definitions, the patentee should shoulder the burden of his imprecision by having the claims adjudged indefinite, rather than saddling the public with a judge-made construction previously unknown even to the inventor.

II. A Federal Circuit Claim Construction Broader Than Any Patentee-Coined Definition Cannot Meet the Requirements for Definiteness Under *Nautilus, Inc. v Biosig Instruments, Inc.*

In *Nautilus*, this Court emphasized the vitality of Section 112(b) of the Patent Code, which requires that a patent “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as the invention.” 35 U.S.C. § 112(b).⁴ This Court, in a unanimous decision, held that a patent fails to comply with this requirement when the patent’s claims, read in light of the specification and the prosecution history, “fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus*, 572 U.S. at 901.

4. Pre-AIA 35 U.S.C. § 112 ¶ 2 uses nearly identical language. The only change made to this clause post-AIA was to replace “his invention” with “the invention.”

Here, the District Court was confronted by two patents, the '780 and '844 patents, that contained an explicit definition for “Downloadable” that excluded from the express patentee-coined definition a large swath of the disclosed examples and an incorporated definition that covered those examples. The specifications of the other three patents, the '086, '621, and '755 patents, included definitions of “Downloadable” only by incorporation by reference of priority applications that employed mutually exclusive definitions—one definition expressly **included** “small executable application programs” and “small interpretable application programs,” while the other expressly **excluded** “interpretable application programs” of any size. After considering the intrinsic and extrinsic evidence and several rounds of briefing, the District Court found that the broader of the two patentee-coined definitions, the one that included “small,” “interpretable,” and “executable” should apply for all five asserted patents. In so doing, the District Court made an ancillary factual finding that “executable application programs” are different in kind than “interpretable application programs,” a position fully supported by the extrinsic evidence submitted by ESET’s expert.

On appeal, the Federal Circuit reviewed the District Court’s claim construction *de novo*, ignoring both *Teva* and the reasoning supporting the District Court’s choice between the competing definitions. Despite decades of precedent holding that a patentee-coined definition should control during claim construction, the Federal Circuit rejected both patentee-coined definitions and fashioned an entirely new definition of Downloadable not found in any of the asserted or incorporated patent

specifications.⁵ Moreover, because it is undisputed that the term “Downloadable” had no meaning prior to its conjured existence in the patent specifications, the Federal Circuit’s construction could *not* have been contemplated by the patentee nor by any person of skill in the art.

Despite this Court’s ruling in *Nautilus*, the Federal Circuit still clings *de facto*, if not *de jure*, to its concept that indefiniteness requires “insoluble ambiguity.” Rather than acknowledge, as the District Court did, that the patentee-coined definitions were mutually exclusive, the Federal Circuit counterfactually (and in opposition to the District Court’s factual finding) found no inconsistency and created a new definition, faithful to neither of the patentee-coined definitions.

The Federal Circuit’s definition fails the *Nautilus* test for definiteness. For the ’780 and ’844 patents, the Federal Circuit definition reinserts “interpretable application programs,” which the patentee had expressly excluded. For the other three patents, the Federal Circuit’s new definition inexplicably includes a huge swath of application programs that are larger than “small” and therefore outside the express limits of what the patentee allegedly invented. Because a person of skill in the art would be confounded by the Federal Circuit’s selective rewriting of the definition of “Downloadable,” that definition cannot meet the reasonable certainty standard promulgated

5. In prior litigations with other defendants, the parties by agreement had adopted a claim construction for “Downloadable” consistent with the Federal Circuit’s definition, but in none of those cases had any defendant raised the issue, nor the district courts considered, the conflicting incorporated patentee-coined definitions.

in *Nautilus*. Had the Federal Circuit followed its own precedent regarding patentee–lexicographers and this Court’s precedent in *Teva* and *Nautilus*, it should have either affirmed the District Court’s claim construction or determined that all five asserted patents should have been found indefinite.

This Court should correct the Federal Circuit’s departure from this Court’s and the Federal Circuit’s own precedent to restore order and certainty to the claim construction process by holding that:

- Where the patentee has defined a claim term to have a specific meaning, the courts of pertinent jurisdiction should construe that term as defined by the patentee, and abstain from redrafting the claim terms; and
- Where the patentee has incorporated mutually exclusive definitions for a claim term in a patent by incorporation, the courts of pertinent jurisdiction should find the claim construction unresolvable, lacking reasonable certainty, and thus hold the claim term indefinite.

Only by enforcing such previously-thought established bright-line rules can this Court ensure that patentees do not profit by imprecision in claim drafting at the expense of the public.

III. The Federal Circuit Ignored this Court's Requirement Under *Teva* That the District Court's Fact Findings Ancillary to Claim Construction Be Reviewed for Clear Error.

The District Court analyzed the patentee-coined definitions and chose the only version that made sense in view of the intrinsic and extrinsic evidence, including the specifications, prosecution histories, and expert testimony. Under *Teva*, the District Court's factual determination based on extrinsic evidence should have been reviewed for clear error. In derogation of *Teva*, the Federal Circuit conducted a completely *de novo* review and adopted the fiction that the various patentee-coined definitions are "not competing." *Finjan*, 51 F.4th at 1383. Moreover, the Federal Circuit failed to consider or discuss the prosecution histories for the '621 and '755 patents, which the District Court correctly found dispositive of the claim construction issues for those patents following its factual determination that "executable" and "interpretable" programs were not overlapping.

The District Court undertook a thorough review of the specifications and prosecution histories, not only of the asserted patents, but also an incorporated provisional application, and the three other incorporated patents. It received expert testimony from both parties' experts that the term "Downloadable" had no ordinary and accustomed meaning. ESET's expert, Dr. Spafford, testified that one of skill in the art would have understood that executable application programs differ from interpretable application programs and that the two programs have significantly different scope, and submitted multiple computer dictionary definitions and contemporaneous articles

showing that those of skill in the art understood that the scope of the terms “executable” and “interpretable” differed.

The District Court’s decision to choose the patentee-coined definition that used both the words “small” and “interpretable” falls squarely within the ambit of *Teva*. Accordingly, the Federal Circuit should have reviewed the District Court’s construction for clear error. *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.”). In *Teva*, this Court specifically identified situations requiring this higher standard of appellate review as those in which “the district court will need to look beyond the patent’s intrinsic evidence and to consult extrinsic evidence in order to understand, for example, the background science or the meaning of a term in the relevant art during the relevant time period.” *Teva Pharms. USA*, 574 U.S. at 331-32.

The Federal Circuit decision acknowledged the *Teva* standard of review but did not apply it. Instead, the Federal Circuit conducted a *de novo* review. Had the Federal Circuit afforded the District Court’s analysis proper weight, it should have affirmed the District Court’s judgment. This Court should grant this petition to provide direction to the Federal Circuit that following this Court’s decisions is not optional.

IV. This Court Can and Should Resolve the Uncertainty Whether Incorporation of Multiple Conflicting Inventor-Coined Definitions in a Patent Meets the Definiteness Requirement and Public Notice Function.

The Federal Circuit decision, although designated precedential, provides no meaningful guidance to district courts on how to construe patent claim terms where multiple incorporated-by-reference patents and applications provide conflicting definitions. The Federal Circuit decision here sidestepped that issue by finding the various definitions are “not competing.” As factually resolved by the District Court, however, in the ’086, ’621, and ’755 patents the incorporated definitions are competing. In the ’780 and ’844 patents, apart from the incorporated definition that included “small” and “interpretable,” the patentee-coined definition specifically excluded “interpretable application programs.” Yet the Federal Circuit decision selectively added back “interpretable” while omitting “small.”

The Federal Circuit’s flawed factual assumptions led it to overlook, and fail to address, the primary issue presented by Finjan’s patents: How does a district court decide which of multiple conflicting patentee-coined definitions should apply in construing claims supported by a morass of incorporated patents? In an analogous situation, the Federal Circuit determined that the correct approach was to find the disputed term indefinite. *See Infinity Comput. Prods., Inc. v. Oki Data Ams., Inc.*, 987 F.3d 1053, 1059-60 (Fed. Cir. 2020) (patentee’s inconsistent statements regarding disputed claim term “passive link” during prosecution and reexamination rendered term

indefinite). That same logic should apply here to all five asserted patents.

The Federal Circuit’s precedential decision provides no guidance to the district courts and calls into question the vitality of the Federal Circuit’s own precedent regarding the patentee–lexicographer where the patentee offers conflicting definitions. *See, e.g., Nanoco Techs., Ltd. v. Samsung Elecs. Co.*, No. 2:20-cv-00038-JRG, 2021 U.S. Dist. LEXIS 89223, at *14-27 (E.D. Tex. May 10, 2021) (finding the claim term “molecular cluster compound” should be construed by selecting from amongst multiple conflicting patentee-coined definitions, not rewritten by the Court to harmonize those definitions). To the extent that the Federal Circuit decision here suggests any guidance to district courts, it is contrary to the Federal Circuit’s long-standing precedent. *See, e.g., X2Y Attenuators, LLC v. U.S. Int’l Trade Comm’n*, 757 F.3d 1358 (Fed. Cir. 2014). Had the logic of *X2Y Attenuators* been applied here, the Federal Circuit should have affirmed the District Court’s judgment.

Regrettably, the Federal Circuit decision below suggests that a district court is free to subjectively fashion a definition during claim construction that does not correspond to any expressly provided by a patentee.

This Court should grant this petition to (i) reaffirm and maintain primacy of the Federal Circuit’s patentee–lexicographer precedent, (ii) confirm that mutually exclusive patentee definitions compel a conclusion of indefiniteness, and (iii) enforce this Court’s precedent in *Teva* that a district court’s ancillary fact findings during claim construction must be afforded due weight. There

should be no room for the Federal Circuit to craft a new definition of a disputed claim term that ignores the patentee's definition(s) and lacks support in the intrinsic evidence. This Court should sweep away the confusion that has and will result from the Federal Circuit's decision and provide meaningful guidance to district courts that ensures claim constructions are predictable and serve the public notice function of patent claiming.

CONCLUSION

For the foregoing reasons, Petitioners respectfully request that the Court grant this petition.

Date: March 22, 2023

Respectfully submitted,

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**APPENDIX A — OPINION OF THE UNITED
STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT, FILED NOVEMBER 1, 2022**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

FINJAN LLC,

Plaintiff-Appellant,

v.

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

Defendants-Appellees.

2021-2093

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

November 1, 2022, Decided

Before PROST, REYNA, and TARANTO, *Circuit Judges.*

REYNA, *Circuit Judge.*

Appellant Finjan, Inc. appeals the U.S. District Court for the Southern District of California's grant of summary judgment of invalidity. The district court construed the claim term "Downloadable" in the

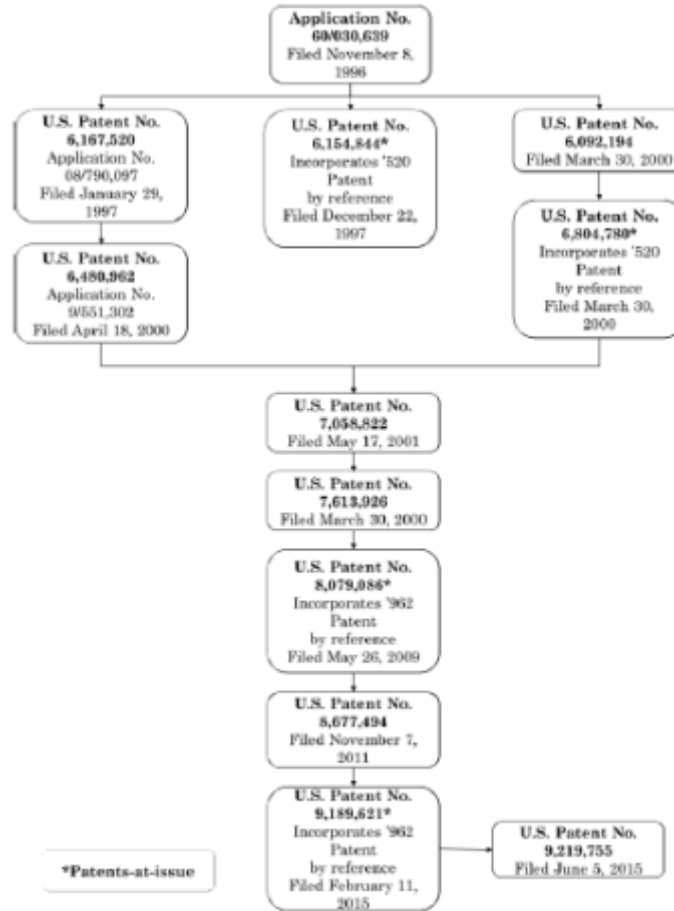
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asserted patents to be restricted to “small” executable or interpretable application programs based on the definition of “Downloadable” provided by a patent in the same family that was incorporated by reference into the asserted patents. The district court determined that the asserted claims were indefinite and thus invalid. We reverse the district court’s claim construction, vacate its grant of summary judgment, and remand for further proceedings.

BACKGROUND

In 2017, Finjan, Inc. (“Finjan”) filed suit against ESET, LLC (“ESET”) in the Southern District of California, asserting that ESET infringed U.S. Patent Nos. 6,154,844 (“the ’844 Patent”); 6,804,780 (“the ’780 Patent”); 8,079,086 (“the ’086 Patent”); and 9,189,621 (“the ’621 Patent”) (collectively, “the asserted patents” or “the patents-at-issue”). *Finjan, Inc. v. ESET, LLC*, 2017 U.S. Dist. LEXIS 197005, 2017 WL 5501338, at *1 (S.D. Cal. Nov. 14, 2017) (*Claim Construction Order*). The asserted patents, which are all expired, are part of a family of patents directed to systems and methods for detecting computer viruses in a “Downloadable” through a security profile. *See, e.g.*, ’844 Patent col. 1 ll. 23-27. Finjan claims priority for each of the asserted patents back to provisional application No. 60/030,639 (“the ’639 application”), filed November 8, 1996. The family’s chain of priority and incorporation by reference relationships are as follows:

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J.A. 13.

On September 25 and 26, 2017, the district court held a *Markman* hearing. *Claim Construction Order 2017* U.S. Dist. LEXIS 197005, 2017 WL 5501338, [WL] at *1. The court focused on the meaning of the term “Downloadable” and requested further briefing on that term.

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“Downloadable” appears in the claims of all asserted patents. The ’639 application first defines “Downloadable” as “an executable application program which is automatically downloaded from a source computer and run on the destination computer. Examples of Downloadables include applets designed for use in the Java™ distributing environment . . .” J.A. 1863.

Non-asserted U.S. Patent Nos. 6,167,520 (“the ’520 Patent”) and 6,480,962 (“the ’962 Patent”) define Downloadables as “applets” and as “a *small* executable or interpretable application program which is downloaded from a source computer and run on a destination computer.” ’520 Patent col. 1 ll. 31-34; ’962 Patent col. 1 ll. 38-41 (emphasis added). Two of the asserted patents, the ’844 and ’780 patents, define a Downloadable as “an executable application program, which is downloaded from a source computer and run on the destination computer.” ’844 Patent col. 1 ll. 44-47; ’780 Patent col. 1 ll. 50-53. The patents list as examples Java applets and JavaScripts scripts. *Id.* Both patents incorporate the ’520 Patent by reference. ’844 Patent col. 1. ll. 14-18; ’780 Patent col. 1. ll. 19-23. The three remaining asserted patents, the ’086, ’621, and ’755 patents, do not include a definition of “Downloadable” but incorporate the ’962 and ’780 patents by reference. ’086 Patent col. 1. ll. 24, 34-35; ’621 Patent col. 1 ll. 40-41, 58; ’755 Patent col. 1. ll. 44, 58-59.

The district court construed the term “Downloadable” to mean “a *small* executable or interpretable application program which is downloaded from a source computer and run on a destination computer.” *Claim Construction*

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Order, 2017 U.S. Dist. LEXIS 197005, 2017 WL 5501338, [WL] at *2 (emphasis added). The court based its construction on the incorporation by reference of the '520 Patent.¹ 2017 U.S. Dist. LEXIS 197005, [WL] *1-2. The district court reasoned that the patent family contained “somewhat differing definitions” that “can be reconciled.” 2017 U.S. Dist. LEXIS 197005, [WL] at *1. The court found that based on the definitions and examples included throughout the various patents in the family tree, the term Downloadable in the patents-at-issue should be construed to include the word “small” as defined in the '520 Patent. 2017 U.S. Dist. LEXIS 197005, [WL] at *2.

On April 23, 2019, ESET moved for summary judgment of invalidity based on indefiniteness. *Finjan, Inc. v. ESET, LLC*, 2021 U.S. Dist. LEXIS 68078, 2021 WL 1241143, at *1 (S.D. Cal. Mar. 29, 2021). The court held oral argument and determined that there were genuine disputes of material fact over what a skilled artisan would have understood “Downloadable” to mean as of the effective filing date in 1997. *Id.* The court denied the motion without prejudice.

On March 10, 2020, the case went to trial. Three days later, the court vacated the remainder of the trial due to California’s COVID-19 stay-home order. *Id.*

1. The asserted patents also incorporate the '962 Patent by reference. The '962 Patent is substantially similar to the '520 Patent. Reference to the '520 Patent definition throughout the opinion also applies to the '962 Patent.

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On August 21, 2020, ESET renewed its motion for summary judgment in light of the testimony from Finjan's expert during the trial. *Id.* On March 29, 2021, the district court granted the motion, finding the asserted patents indefinite based on the word "small" as used in the court's construction of "Downloadable." *Finjan, Inc. v. ESET, LLC*, 2021 U.S. Dist. LEXIS 68078, 2021 WL 1241143, at *1 (S.D. Cal. Mar. 29, 2021). Finjan timely appealed. This court has jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

STANDARD OF REVIEW

The Federal Circuit reviews a district court's grant of summary judgment under the standard applied in the respective regional circuit, in this case the Ninth Circuit. *See Neville v. Found. Constructors, Inc.*, 972 F.3d 1350, 1355 (Fed. Cir. 2020). The Ninth Circuit reviews a grant of summary judgment de novo. *Id.* (citation omitted). "Summary judgment is proper when, drawing all justifiable inferences in the non-movant's favor, 'there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.'" *Akzo Nobel Coatings, Inc. v. Dow Chem. Co.*, 811 F.3d 1334, 1338-39 (Fed. Cir. 2016) (quoting Fed. R. Civ. P. 56(a); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 106 S. Ct. 2505, 91 L. Ed. 2d 202, (1986)).

The Court reviews a district court's claim construction de novo and its underlying factual determinations for clear error. *See Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 325-26, 135 S. Ct. 831, 190 L. Ed. 2d 719, (2015). "Whether and to what extent material has

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been incorporated by reference into a host document is a question of law.” *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1283 (Fed. Cir. 2000) (citing *Quaker City Gear Works, Inc. v. Skil Corp.*, 747 F.2d 1446, 1453-54 (Fed. Cir. 1984)).

“We review [a] district court’s indefiniteness determination de novo.” *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1317 (Fed. Cir. 2015) (citation omitted). A claim is invalid for indefiniteness under 35 U.S.C. § 112 if its language, when read in light of the specification and prosecution history, fails to inform skilled artisans about the scope of the invention with reasonable certainty. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 909-911, 134 S. Ct. 2120, 189 L. Ed. 2d 37 (2014).

DISCUSSION

Finjan makes two arguments on appeal: (1) the district court erred by construing the term “Downloadable” to be limited to “small” executable application programs and (2) the district court erred by finding that the word “small” rendered the claims indefinite and thus, invalid. We address each issue in turn below.

Finjan argues that the district court erred in its construction and that the word “small” should not be read into the definition of “Downloadable.” Appellant’s Br. 27-28. We agree.

Claims must be read in light of the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir.

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2005) (en banc). That includes any patents incorporated by reference. Patents that are incorporated by reference are “effectively part of the host [patents] as if [they] were explicitly contained therein.” *X2Y Attenuators, LLC v. U.S. Int’l Trade Comm’n*, 757 F.3d 1358, 1362-63 (Fed. Cir. 2014) (alterations in original) (citations omitted). Incorporation by reference of a patent “renders ‘the entire contents’ of that patent’s disclosure a part of the host patent.” *Id.* at 1363 (citing *Ultradent Prods., Inc. v. Life-Like Cosmetics, Inc.*, 127 F.3d 1065, 1069 (Fed. Cir. 1997); Manual of Patent Examining Procedure § 608.01(p) (6th ed. 1996)). Accordingly, definitions in any incorporated patents or references are a part of the host patent.

Yet, “incorporation by reference does not convert the invention of the incorporated patent into the invention of the host patent.” *Modine Mfg. Co. v. U.S. Int’l Trade Comm’n*, 75 F.3d 1545, 1553 (Fed. Cir. 1996), *abrogated on other grounds by Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000) (en banc). Rather, the disclosure of the host patent provides context to determine what impact, if any, a patent incorporated by reference will have on construction of the host patent claims. *See, e.g., X2Y Attenuators*, 757 F.3d at 1363. “The disclosures of related patents may inform the construction of claim terms common across patents, but it is erroneous to assume that the scope of the invention is the same such that disclaimers of scope necessarily apply across patents. . . .” *Id.* at 1366 (J. Reyna, concurring).

The district court erred because it viewed the differing definitions throughout the patent family as competing and

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determined that the asserted patents should be limited to the most restricted definition of the term. We disagree. Here, it is not necessary to limit the asserted patents because the two definitions are not competing. The use of a restrictive term in an earlier application does not reinstate that term in a later patent that purposely deletes the term, even if the earlier patent is incorporated by reference. *Modine Mfg.*, 75 F.3d at 1553 (finding that a grandparent patent defining “relatively small” to be “0.07 inches or less” did not incorporate this definition into the parent and child applications that deleted the definition).

The '520 Patent, which defines a Downloadable as “small,” represents a subset of the patent family claiming an invention capable of downloading only small executable or interpretable application programs. That is because the disclosure in the '520 Patent focuses on applets as small executable or interpretable application programs. *See, e.g.*, '520 Patent col. 1 ll. 31-32. The '520 Patent summarizes the invention as “a system for protecting a client from hostile Downloadables. The system includes security rules . . . and security policies defining the appropriate responsive actions to rule violations such as terminating the *applet*, limiting the memory or processor time available to the *applet*, etc.” '520 Patent col. 1 l. 66 to col. 2 l. 6 (emphases added).

The definition of “Downloadable” that does not include a size requirement refers to executable or interpretable application programs of all sizes, including, but not limited to, “small” executable or interpretable application programs. Because these two definitions can exist in

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harmony within the patent family, we do not necessarily have to apply the '520 Patent's definition to the asserted patents.

The '844 and '780 patents describe a Downloadable as “an executable application program, which is downloaded from a source computer and run on the destination computer.” '844 Patent col. 1 ll. 45-47; '780 Patent col. 1 ll. 51-53. This definition is not limited to “small” executable application programs. The '844 and '780 patents list examples of Downloadables, including “Java™ applets,” “ActiveX™ controls,” “JavaScript™ scripts,” and “Visual Basic scripts.” '844 Patent col. 1 ll. 63-65; '780 Patent col. 2 ll. 3-4. These examples expand upon the sole example listed in the '520 Patent—applets. The '844 and '780 patents define Downloadable to contemplate a broader functionality of the claimed invention not limited to downloading only “small” executable application programs, and the examples in the '844 and '780 patents provide further support. Hence, in the '844 and '780 patents, “Downloadable” should not be construed to include the term “small.”

As noted, the '086, '621, and '755 patents do not expressly define Downloadable but incorporate patents by reference that include both the '520 Patent's restricted definition of Downloadable with the word “small” and the broader definition without it. Similar to the '844 and '780 patents, the '086, '621, and '755 patents include examples expanding upon the '520 Patent's focus on “small” executable or interpretable application programs like applets as well. For example, the '086 Patent recites:

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“Java applets and JavaScript™ scripts, ActiveX™ controls, Visual Basic, add-ins, and/or others . . . Trojan horses, multiple compressed programs such as zip or meta files.” ’086 Patent col. 2 ll. 3-9; ’621 Patent col. 2 ll. 36-40; ’755 Patent col. 2 ll. 36-40. Based on the context provided by the ’086, ’621, and ’755 patents, the term “Downloadable” should not be restricted to “small” executable application programs.

In sum, the term “Downloadable” as used in the ’844, ’780, ’086, ’621, and ’755 patents means “an executable or interpretable application program, which is downloaded from a source computer and run on the destination computer.” We therefore reverse the district court’s claim construction.

Because we reverse the district court’s claim construction, we need not to review the entirety of the district court’s determination of invalidity due to indefiniteness.

CONCLUSION

We reverse the district court’s claim construction and determine that Downloadable should be construed as “an executable or interpretable application program, which is downloaded from a source computer and run on a destination computer.” We vacate the district court’s grant of summary judgment based on invalidity due to indefiniteness and remand for further proceedings consistent with our claim construction.

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**REVERSED-IN-PART, VACATED-IN-PART, AND
REMANDED**

COSTS

No costs.

**APPENDIX B — ORDER OF THE UNITED
STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF CALIFORNIA,
FILED MARCH 29, 2021**

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,

Plaintiff,

v.

ESET, LLC, A CALIFORNIA LIMITED
LIABILITY AND ESET SPOL. S.R.O.,
A SLOVAK REPUBLIC CORPORATION,

Defendants.

Case No.: 3:17-cv-0183-CAB-BGS

March 29, 2021, Decided; March 29, 2021, Filed

**AMENDED ORDER ON DEFENDANTS'
RENEWED MOTION FOR SUMMARY
JUDGMENT OF INDEFINITENESS [Doc. No. 806]**

Before the Court is the renewed motion of Defendants ESET, LLC and ESET spol. s.r.o (collectively “ESET”) for summary judgment to invalidate Plaintiff Finjan’s United States Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 (“the patents at-issue”) as indefinite pursuant to 35 U.S.C. § 112 based on this Court’s

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construction of the claim term “Downloadable.” The motion is fully briefed, and the Court deems it suitable for submission without oral argument.

I. Background

This motion has an unusual history. ESET filed a motion for summary judgment asserting that the patents at-issue are indefinite at the close of fact discovery in this case, and the Court held argument on September 26, 2019. Finding that there were factual disputes regarding what a skilled artisan in 1997 would have understood constituted a “Downloadable” based on the Court’s construction of that term, the Court denied the motion without prejudice. [Doc. No. 699.] It was anticipated that trial testimony would establish what was generally understood in the art in 1997 as a “Downloadable” and such testimony would inform the scope of infringement. [Doc. No. 697, at 22:3-15.]

A jury trial commenced in this case on March 10, 2020. After three trial days the Court was forced to vacate the remainder of the trial, excuse the jury and declare a mistrial due to the COVID-19 pandemic and the issuance of the State of California’s stay-home order. [Doc. No. 783.] This District’s continuing moratorium on civil jury trials and backlog of criminal jury trials currently precludes scheduling a new trial in this matter.

Having heard testimony from Finjan’s expert during the vacated trial on this issue, however, the Court permitted ESET to renew this motion in consideration of

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the testimony that was taken. Although Finjan’s patents have been the subject of much litigation, and the term “Downloadable” has been construed by other courts, the issue raised in ESET’s current motion does not appear to have been addressed by any prior constructions.

Finjan is the owner of a large family tree of patents for security systems and methods of detecting malware in computer programs. Finjan has litigated many of their patents, including some of the patents at-issue in this motion, in other district courts. Many have also been subject to *inter partes* review by the Patent and Trademark Office (PTO). The Federal Circuit has issued at least nine opinions, precedential and non-precedential, on appeals from district courts and the PTO regarding Finjan patents. Yet none of these orders or opinions discuss how earlier references incorporated into the patents at-issue inform the construction of the term “Downloadable.”

II. The Construction of “Downloadable”

In 2017, Finjan filed this litigation against defendants ESET asserting infringement of the patents at-issue, and United States Patent No. 7,975,305.¹ Finjan claims priority for the patents at-issue back to an application filed on November 8, 1996, Provisional Application 60/030639. [Doc. No. 139-24.] The application is directed at “a system and method for protecting computers from hostile Downloadables,” described as executable

1. The ’305 patent is not subject to this motion as it does not include the claim term “Downloadable.”

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application programs automatically downloaded from a source computer and run on the destination computer that might carry computer “viruses.” [Id., at 5-6.] The claim term “Downloadable” is presented as a capitalized term in the provisional application and all the patents at-issue, signaling it is a specifically defined term. The definition of “Downloadables,” however, is not consistent throughout Finjan’s subsequently issued patents. The explicit definitions include:

- “applets” (little applications) described in the 1990s as small interpreted or executable programs. *See* Provisional Application 60/030639 (filed November 8, 1996) [*Id.* at 5-6.]
- “Downloadables (i.e., applets)” as “a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer,” in conformity with the original provisional application. *See* U.S. Patent No. 6,167,520, at Col. 1:31-34 (application filed January 29, 1997); U.S. Patent No. 6,480,962, at Col. 1:38-41 (filed April 18, 2000).
- “an executable application program which is downloaded from a source computer and run on a destination computer” (without “i.e., applet,” “small” or “interpretable” included in the definition but using applets and interpretable programs as examples of a “Downloadable” and incorporating the earlier definition by reference). *See* U.S. Patent No. 6,092,194, at Col. 1:44-

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55 (filed November 6, 1997); U.S. Patent No. 6,804,780 at Col. 1:50-60 (filed March 30, 2000).

Other district courts have determined that “Downloadable” lacked ordinary meaning when the patents were filed and construed it as “an executable application program which is downloaded from a source computer and run on a destination computer,” applying the explicit definition from the ’194 patent. [Doc. No. 139-10, at 3; Doc. No. 138-4, at 2-5 (the term was not amenable to plain and ordinary meaning and the patent applicant intended to act as the lexicographer of this term, therefore the specification definition controls).] None of these orders, however, discussed the significance of the ’520 patent’s definition incorporated into the ’194 patent and its continuations. One district court, without explanation, applied the broader definition from the ’194 patent specification to the construction of the term “Downloadable” in the ’962 patent as “the same” definition [id., at 3, fn. 4], disregarding the fact the ’962 patent explicitly defines “Downloadable” as “a *small* executable or interpretable application program which is downloaded from a source computer and run on a destination computer.” See U.S. Patent No. 6,480,962, at Col. 1:39-41 (*emphasis* added).

Incorporation by reference provides a method for integrating material from various documents into a host document by citing such material in a manner that makes clear that the material is effectively part of the host document as if it were explicitly contained therein. See *Trustees of Columbia Univ. v. Symantec*, 811 F.3d 1359, 1365-66 (Fed. Cir. 2016) (*citing Advanced Display*

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Sys. v. Kent State Univ., 212 F.3d 1272, 1282 (Fed. Cir. 2000) (provisional applications incorporated by reference are effectively part of the specification as though it was explicitly contained therein.)). By incorporating the earlier definition of “Downloadable” from the ’520 patent into the ’194 patent and subsequent continuations (including the patents at-issue), the scope of the term is limited to “*small* executable or interpretable application programs,” and not *all* executable application programs (*emphasis* added). See *Symantec*, 811 F.3d at 1365 (rejecting a broad interpretation of a claim term in part because a provisional application incorporated by reference the same term more narrowly defined.) Inconsistent language used later cannot support a broad claim construction when the explicit definition is incorporated from earlier patents in the family tree.

In this case, the Court concluded that based on its incorporation by reference in all the patents at-issue, the explicit definition of “Downloadables” from the ’520 patent and the ’962 patent, which is supported by the examples provided in the specification, is the proper construction of “Downloadables” - “a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer.” [Doc. No. 195.]

III. The Indefiniteness Determination

The Court’s claim construction, not unexpectedly, resulted in the present dispute as to the scope of the modifier “small.” ESET argues that “small” is a term of degree with not technical meaning or defined boundaries

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and there is insufficient information in the intrinsic record for a skilled artisan to have clear notice of what constitutes a “small executable or interpretable application program.” They further argue that this is demonstrated by the inability of Finjan’s experts to come to a consistent opinion as to what objective boundaries constitute a small application program. [806-1, at 5, 17.]

The definiteness requirement of paragraph 2 of 35 U.S.C. §112 requires that the “specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” The definiteness requirement focuses on whether “a patent’s claims, viewed in light of the specification and prosecution history 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, 134 S. Ct. 2120, 189 L. Ed. 2d 37 (2014). The inquiry “trains on the understanding of a skilled artisan at the time of the patent application.” *Id.* at 911.

Terms 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. *See Biosig Instruments, Inc. v. Nautilus, Inc.*, 783 F.3d 1374, 1378 (Fed. Cir. 2015) (“When a ‘word of degree’ is used, the court must determine whether the patent provides ‘some standard for measuring that degree.’”); *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370 (Fed. Cir. 2014) (the definiteness standard must allow for a modicum of uncertainty but must also require clear notice of what is claimed thereby apprising the public of what is still open to them).

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Finjan's contention that the claim term "Downloadable" cannot be indefinite simply because the Court was able to construe it by adopting the explicit definition provided by the inventor in the '520 patent fails to address the issue raised by ESET. A defined term 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). The issue therefore is whether a skilled artisan in 1997 would have understood with reasonable certainty based on the specification and prosecution history what the inventor meant by a "small" application program and therefore understood what comes within the scope of the claims.

The '520 patent, incorporated into all the later patents, describes a Downloadable as an "applet," a small interpretable or executable application program, and provides that "a Downloadable is used in a distributed environment such as the Java™ distributed environment produced by Sun Microsystems or in the Active X™ distributed environment produced by Microsoft Corporation." *See* '520 patent, at Col. 1:31-32, 34-38. Because such examples existed in the 1990s, there should be an objective standard for the size of a "small" program. While "absolute or mathematical precision" was not required, some objective boundary should be identifiable from the disclosed embodiments. *See Biosig Instruments*, 783 F.3d at 1381.

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

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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. [Doc. No. 610, at 8 and 15.]²

ESET argued then, as it does now, that Finjan’s experts did not provide any objective boundaries for a “small” application program based on what a skilled artisan would have understood was upper end of “small” in the context of application programs being downloaded from a source computer to run on a destination computer at the time the application was filed. [Doc. No. 816, at 5.] 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. *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.”)

2. Finjan has also argued that the Court should reconsider its incorporation of “small” into the construction of Downloadable and disregard that modifier as other district courts have done to avoid this definiteness issue. [Doc. No. 812, at 6.] This solution may resolve Finjan’s problem with defining “small,” but the fact that the Court’s construction results in indefiniteness is not a basis for reconsideration.

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ESET contends that the trial testimony of Finjan expert Dr. Eric Cole did not remedy this defect.³ Dr. Cole presented an explanation how a skilled artisan would interpret “small” that was neither disclosed in his previous declaration to the Court (small meant “a few megs ... something that is not multiple gigs or really large” [Doc. No. 806-1, at 17]) or anchored to the specification or prosecution history. Rather than providing a range of application size that would have been construed as “small” by an artisan in 1997, Dr. Cole testified on Finjan’s behalf that an application would be understood to be small if it “did not require installation” and opined that “small” depends not on size but on the function. Dr. Cole testified that a small executable is an application that does not require installation is “self-contained” and is “just running automatically” which is “typical if you go to any website nowadays,” whereas an executable that is not small “requires installation” and has “a lot of shared libraries and dlls and other programs” in order to run. [Doc. No. 812, at 12.] Dr. Cole testified that regardless of time period, Internet speed and other factors related to capacity, what fits the criteria of “small” may change but this distinction (installed or not installed) is constant. Dr. Cole did not however provide support from the specification, the prosecution history, or from any extrinsic sources in the relevant time period, for this new explanation that a skilled artisan in 1997 would understand “small” to be “uninstalled” or “not requiring installation.”

3. Although the trial was terminated early due to the pandemic, Dr. Cole’s testimony was completed. Finjan suggests that Dr. Cole’s testimony at a future trial will replace his completed testimony, but 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. [Doc. No. 816, at 11.]

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In sum, 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. Instead, Finjan elected at trial to offer a new understanding without reference to the size of the application as the objective boundary of a “small” application. Finjan’s new definition is not supported by the specification or prosecution history. It may be convenient to support Finjan’s infringement contentions against ESET’s accused devices, but Finjan’s new explanation does not provide clear notice of what constitutes a “small executable or interpretable application program.”

IV. Conclusion

For the foregoing reasons, the Court finds that the term “Downloadable” as used in the patents at-issue is indefinite. Accordingly, it is hereby **ORDERED** that ESET’s motion for summary judgment of invalidity of Finjan’s United States Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 for indefiniteness is **GRANTED**.

It is **SO ORDERED**.

Dated: March 29, 2021

/s/ Cathy Ann Bencivengo
Hon. Cathy Ann Bencivengo
United States District Judge

**APPENDIX C — CLAIM CONSTRUCTION ORDER
OF THE UNITED STATES DISTRICT COURT FOR
THE SOUTHERN DISTRICT OF CALIFORNIA,
FILED NOVEMBER 14, 2017**

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

Case No.: 3:17-cv-0183-CAB-(BGS)

FINJAN, INC.,

Plaintiff,

v.

ESET, LLC, a California Limited Liability and
ESET SPOL. S.R.O., a Slovak Republic Corporation,

Defendants.

CLAIM CONSTRUCTION ORDER

On September 25 and 26, 2017, the Court held a hearing to construe certain terms and phrases of the following patents: U.S. Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; 9,219,755; and 7,975,305. The parties submitted briefing in accordance with this District's local patent rules and the case management order. A tutorial was presented by both sides to assist the Court with the history and background of the patents.

The Court requested further briefing regarding certain terms. Having now considered all the submissions of the parties, the arguments of counsel and for the reasons set forth at the hearing and herein, the Court hereby enters the claim constructions set forth below.

*Appendix C***A. “Downloadable” in U.S. Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621 and 9,219,755**

The parties seek construction of the term **Downloadable** as it is used in five of the patents at issue. This claim term can be traced through two branches of the family tree of this patent (*see* Attachment A) with somewhat differing definitions. The Court however concludes that the variations between the definitions can be reconciled and the specifications in their entirety give notice of what is encompassed by the claim term **Downloadable** to one of skill in the art.

Downloadable initially appears as a defined term in the specification of the 6,167,520 patent, and its continuation the 6,480,962 patent, as *a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer.*

The specification of the 6,092,194 patent, and its continuation the '780 patent (which is at issue in this litigation), define **Downloadable** as *an executable application program which is downloadable from a source computer and run on the destination computer.* The specification however provides as examples of a **Downloadable**, application programs such as Java™ applets, known as little application programs in machine language, and JavaScripts™ scripts, an interpretable application program. These examples are in accord with the definition, incorporated by reference, set forth in the '520 patent. The '194 patent and its progeny therefore

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conform to the '520 patent's definition of **Downloadable** as *small executable or interpretable application programs* through the use of the examples in the specifications. The Court finds that one of skill in the art would be able to ascertain what is claimed as a **Downloadable** in the context of these patents, and that in light of the examples provided in the '194 patent specification, concludes that the meaning of **Downloadable** is consistent with the definition provided in the '520 patent.

The '844 patent (which is at issue in this litigation) defines **Downloadable** as *an executable application program which is downloadable from a source computer and run on the destination computer* and also includes references to small executable and interpretable application programs as examples of a **Downloadable**. The '844 patent incorporates by reference the '520 patent and '194 patent. The Court finds that the definition of **Downloadable** based on the '844 patent specification, the examples provided therein and the incorporation of the '520 patent and the '194 patent, informs one of skill in the art with reasonable certainty the scope of the invention. The entirety of the specification's description would inform that **Downloadable** includes executable and interpretable application programs, in accordance with the examples and incorporated references.

The '822 patent is a Continuation in Part of both the '962 patent and '780 patent and incorporates those patents by reference. Its continuation patents, including the '086 patent, '621 patent and '755 patent, which are at issue in this litigation, do not include a definition of **Downloadable**

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in the specification but incorporate by reference the '962 patent and the '780 patent, and their definitions and examples of a **Downloadable**.

The Court finds that the two branches of the family tree of the patents at issue inform that a **Downloadable** in the context of these patents means a *small executable or interpretable application program which is downloaded from a source computer and run on a destination computer*. This construction comports with the plain definition set forth in the '520 patent and the '962 patent, and is supported by the written description including the definition and the examples set forth in the '194 patent and its progeny, and in the entirety of specification of the '844 patent.

The Court therefore construes the term **Downloadable** in all five patents as *a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer*.

B. U.S. Patent No. 6,154,844

The parties sought construction of the following phrase appearing in various claims of the '844 patent: **before the web server makes the Downloadable available to web clients**. The Court's construction for this term is: *Before the Downloadable is available on a web server to be called up or forwarded to a web client*. ('844 @ Col. 3:32-52; Col. 4:65 - Col. 5:13; Figure 1.)

*Appendix C***C. U.S. Patent No. 6,804,780**

The parties sought construction of the following terms and phrases appearing in various claims of the '780 patent. The Court's constructions for these terms are:

Claim Term	COURT'S CONSTRUCTION
software components required to be executed by the Downloadable	<i>components of code that the Downloadable is required to execute</i> (agreed construction)
ID generator	Defendant's request for application of 112 ¶6 denied. "ID generator" is not a nonce term as advocated by Defendant. It is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier.
performing a hashing function on the Downloadable and the fetched software components to generate a Downloadable ID	<i>performing a hashing function on the Downloadable together with its fetched software components</i> (Adopting PTO Construction from the IPR of the '780 patent April, 2016.)

*Appendix C***D. U.S. Patent No. 7,975,305**

The parties sought construction of the following phrase appearing in various claims of the '305 patent, **network interface, housed within a computer**. Defendant's proposed construction that "housed within a computer" necessarily limits the structure of the network interface to a hardware component is declined. The specification includes software interface examples. The Court therefore finds in the context of the patent, the use of "housed" in contrast to "stored" does not dictate that the claim be limited to hardware components. To the extent clarification is required the Court construes this phrase as ***network interface, contained within the computer***.

The parties agreed construction for **database, a collection of interrelated data organized according to a database schema to serve one or more applications**, is adopted.

E. U.S. Patent No. 8,079,086

The parties sought construction of the following terms appearing in various claims of the '086 patent. The Court's constructions for these terms are:

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Claim Term	COURT'S CONSTRUCTION
appended Downloadable	<p><i>a Downloadable with a representation of the DSP data attached to the end of the Downloadable</i></p> <p>Declaration of Dr. Spafford, ¶¶36-39, and references cited therein, that one skilled in the art at the time would understand “append” to mean attach or add to the end of the existing file. The claim recites appending a representations of the DSP data to the Downloadable indicating an order.</p>
destination computer	<i>Separate computer receiving the appended Downloadable</i>
file appender	Defendant’s request for application of 112 ¶ 6 is denied. “File appender” is not a nonce term as advocated by Defendant. It is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier.
Transmitter	Defendant’s request for application of 112 ¶ 6 is denied. “Transmitter” is not a nonce term as advocated by Defendant. It a common name for a known program construct that would be familiar to one of skill in the art.

*Appendix C***F. U.S. Patent No. 9,189,621**

The parties sought construction of the following terms appearing in various claims of the '621 patent. The Court's constructions for these terms are:

Claim Term	COURT'S CONSTRUCTION
wherein the information pertaining to the downloadable includes information pertaining to operation of the downloadable and distinct from information pertaining to the request	Defendant asserts that this phrase is indefinite as it is not possible to ascertain the meaning of "information pertaining to the operation of the downloadable that is distinct from information pertaining to the request." The Court finds that in the context of the claim in its entirety and for the reasons set forth on the record, one of skill in the art would understand the meaning and scope of this claim language, and no further construction is needed.

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a response engine for performing a predetermined responsive action based on the comparison	<p>Defendant asserts that use of “response engine” is the equivalent of “means for” claiming and is limited to the structures disclosed in the ’520 Patent at Figs. 5 and 6, Steps 525, 530, 540 and 610-30. Plaintiff asserts that “engine” is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier, in this case “response.” The Court agrees that “engine” is not a nonce term as advocated by Defendant, and that the claim provides sufficient structure for one skilled in the art. Defendant’s request for application of 112 ¶ 6 is denied.</p>
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a response engine for performing a predetermined responsive action based on the comparison with the information pertaining to the predetermined suspicious downloadable	Defendant asserts that “response engine” is the equivalent of “means for” claiming and no structure to perform this function is disclosed. Plaintiff asserts that “engine” is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier, in this case “response.” “Engine” is not a nonce term. Defendant’s request for application of 112 ¶ 6 is denied.
Database	<i>a collection of interrelated data organized according to a database schema to serve one or more applications</i> (joint construction)

The final construction at issue with regard to the ’621 patent is a “means for” limitation. An element of a claim may be expressed as a means for performing a specified function without the recital of the structure and is construed to cover the corresponding structure described in the specification or equivalents thereof. 35 U.S.C. § 112, ¶ 6. The limitation at issue appears in claim 15, which is dependent on claim 10.

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

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...

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;

....

Claim 15. The system of claim 10, wherein the plurality of operating system probes operating substantially in parallel for monitoring the operating system includes **means for monitoring a request sent to a downloadable engine.**

The parties agree that the “means for” element of claim 15 is governed by 35 U.S.C. § 112, ¶ 6. The patent specification must disclose with sufficient particularity the corresponding structure for performing the claimed function and clearly link that structure to the function. *Triton Tech of Tx., LLC. V. Nintendo of Am., Inc.*, 753 F.3d 1375, 1378 (Fed. Cir. 2014). The claimed function is “monitoring a request sent to a downloadable engine.” After the claim construction hearing, the Court requested supplemental briefing from the parties identifying with sufficient particularity the corresponding structure in the specification for performing the claimed function. [Doc. 178-1.]

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The plaintiff refers to the specification of the '962 patent [Doc. No. 138-9], incorporated by reference in the '621 patent, for the corresponding structure that supports this “means for” claim. Plaintiff directs the Court to the component identified in the specification as the request broker 306 described at Col. 4:12-18, Figs. 3 and 4 [*id.* at 6-7, 12] as the corresponding structure providing the function in the system of monitoring a request sent to a downloadable engine. [*See* Doc. No. 183 at 3.]

The specification describes the system for monitoring requests made by a Downloadable 140 to a downloadable engine 250 at Col. 3:51 – Col. 5:48. [Doc. No. 138-9, at 6-7, 12-13.] In the examples provided (*see* Figs. 3 and 4), extensions 304, 404, 405, 406 examine a Downloadable's request for access to classes 302 of a Java™ Virtual Machine (the downloadable engine 250) or to message calls 401, DDE calls 402 and DLL calls 403 of a ActiveX™ platform (the downloadable engine 250). The Downloadable's request to the downloadable engine may be interrupted by the extension which then notifies the request broker 306 of the Downloadable's request. The request broker 306 in turn forwards the request to the event router 308. [*Id.*]

The extensions 304, 404, 405, 406 monitor requests made to the downloadable engine 250. Col. 5:40-49 (the extensions recognize a request made by a Downloadable to the downloadable engine, interrupt the processing of the request and generate and forward a message identifying the incoming Downloadable to request broker which forwards the message to the event router.); Col. 4:10-15

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(each extension 304 manages a respective one of the Java™ classes, interrupts the request and generates a message to the request broker 306); Col. 5:23-38 (each extension 404, 405, 406 recognizes a call to an ActiveX™ platform 401, 402, 403, and generates a message to the request broker 306). The request broker 306 forwards the request on for further analysis and response. The structures identified in the specification corresponding to a **means for monitoring a request sent to a downloadable engine**, are the Java Class extensions 304, the Message Extension 404, the Dynamic-Data-Exchange Extension 405 and Dynamically-Linked-Library Extension 406, and their equivalents.

F. U.S. Patent No. 9,219,755

The parties sought construction of the following terms appearing in various claims of the '755 patent. The Court's constructions for these terms are:

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Claim Term	COURT'S CONSTRUCTION
<p>a downloadable engine for intercepting a request message being issued by a downloadable to an operating system</p>	<p>Defendant asserts that “downloadable engine” is the equivalent of “means for” claiming and the disclosed structures disclosed to perform this function are a Java Virtual Machine 250 or Active X Platform 250 ('960 patent, Col. 3:54-56; Fig. 3; Col. 5:25-27; Fig. 4). Plaintiff asserts that “engine” is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier, in this case “response.” The Court agrees that “engine” is not a nonce term as advocated by Defendant, and that the claim provides sufficient structure for one skilled in the art. Defendant’s request for application of 112 ¶ 6 is denied.</p>
<p>intercepting an operating system call being issued by the downloadable to an operating system</p>	<p><i>stopping a request message before the request message is received by the operating system</i></p>

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<p>a response engine for receiving a violation message from the runtime environment ... and blocking ... and allowing</p>	<p>Defendant asserts that use of “response engine” is the equivalent of “means for” claiming and is limited to the structures disclosed in the ’520 Patent, at Figs. 5 and 6, Steps 525, 530, 540 and 610-30. Plaintiff asserts that “engine” is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier, in this case “response.” The Court agrees that “engine” is not a nonce term as advocated by Defendant, and that the claim provides sufficient structure for one skilled in the art. Defendant’s request for application of 112 ¶6 is denied.</p>
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It is **SO ORDERED**.

Dated: November 14, 2017

/s/ Cathy Ann Bencivengo
 Hon. Cathy Ann Bencivengo
 United States District Judge

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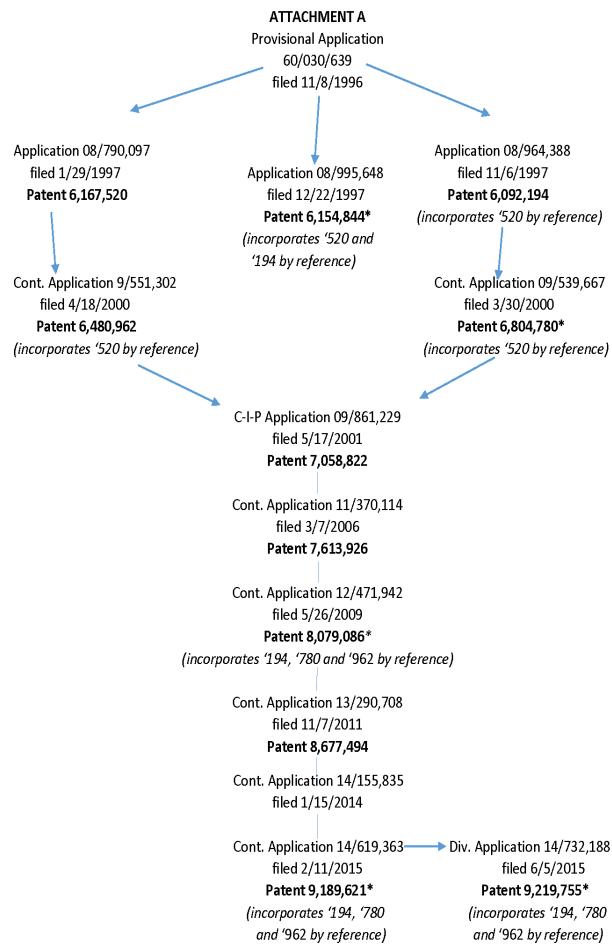
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Attachment A

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*Patents at issue in the litigation.

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**APPENDIX D — ORDER OF THE UNITED
STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT, FILED DECEMBER 27, 2022**

FINJAN LLC,

Plaintiff-Appellant,

v.

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

Defendants-Appellees.

2021-2093

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

ON PETITION FOR REHEARING EN BANC

Before MOORE, *Chief Judge*, NEWMAN, LOURIE, DYK, PROST, REYNA, TARANTO, CHEN, HUGHES, STOLL, CUNNINGHAM, and STARK, *Circuit Judges*.

PER CURIAM.

ORDER

ESET, LLC and Eset Spol. S.R.O. filed a petition for rehearing en banc. The petition was first referred as a petition for rehearing to the panel that heard the appeal, and

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thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue January 3, 2023.

FOR THE COURT

December 27, 2022
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

**APPENDIX E — RELEVANT STATUTORY
PROVISIONS**

35 U.S.C. § 112

§ 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim

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previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.