

2021-2093

In the
United States Court of Appeals
For the Federal Circuit

FINJAN LLC,
Plaintiff-Appellant

v.

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

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

**DEFENDANTS-APPELLEES’
PETITION FOR REHEARING EN BANC**

NICOLA A. PISANO
JOSE L. PATIÑO
SCOTT A. PENNER
JUSTIN E. GRAY
REGIS C. WORLEY, JR.
EVERSHEDS SUTHERLAND (US) LLP
12255 El Camino Real, Suite 100
San Diego, CA 92130
Telephone: (858) 252-6502

November 21, 2022

Attorneys for Defendants-Appellees

CERTIFICATE OF INTEREST

Counsel for Defendants-Appellees ESET, LLC and ESET SPOL. S.R.O., certifies the following:

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

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

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

Not applicable.

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

Not applicable.

4. The names of all law firms and the partners or associates that appeared for the party now represented by me in the trial court or agency or are expected to appear in this court are:

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

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

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47.4(a)(5) and 47.5(b):

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

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

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

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

Finjan, Inc. v. Fortinet, Inc., No. 3:18-cv-06555 (N.D. Cal.)

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

Not applicable.

Date: November 21, 2022

By: /s/ Nicola A. Pisano

Nicola A. Pisano
Jose L. Patiño
Scott A. Penner
Justin E. Gray
Regis C. Worley, Jr.
EVERSHEDS SUTHERLAND (US) LLP
12255 El Camino Real, Suite 100
San Diego, CA 92130
(858) 252-6502

*Attorneys for Defendants-Appellees
ESET, LLC and ESET spol. s.r.o.*

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STATEMENT OF COUNSEL UNDER RULE 35(b)

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States or the precedents of this court: *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318 (2015); *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005); *Modine Mfg. Co. v. U.S. Int'l Trade Comm'n*, 75 F.3d 1545 (Fed. Cir. 1996); and *X2Y Attenuators, LLC v. U.S. Int'l Trade Comm'n*, 757 F.3d 1358 (Fed. Cir. 2014).

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

1. Whether a District Court's construction of a claim term in an asserted patent, determined to be consistent with a totality of the evidence based on analysis of conflicting definitions provided in multiple incorporated-by-reference patents, should be reviewed for clear error as required by *Teva*.
2. Where an inventor, acting as his own lexicographer, defined a claim term to have multiple conflicting meanings, may this Court, notwithstanding *Phillips*, *Modine*, and *X2Y Attenuators*, construe that term differently from the inventor's own definitions?

/s/ Nicola A. Pisano
Nicola A. Pisano
Counsel for Defendants-Appellees
ESET, LLC and ESET spol. s.r.o.

I. INTRODUCTION

This rehearing petition seeks a proper construction for the term “Downloadable” used in the asserted claims of five expired patents: the ’844, ’780, ’086, ’621, and ’755 patents. The patents incorporate a quilt-work of priority applications that define “Downloadable” inconsistently. The ’844 and ’780 patents explicitly define “Downloadable” as “an executable application program...” The ’086, ’621, and ’755 patents incorporate by reference priority applications that define Downloadable as either “a small executable or interpretable application program...” or “an executable application program...” While the ’621 and ’755 patents incorporate these disjoint definitions, the prosecution histories for those patents establish that written description support for the alleged inventions comes from the ’962 patent, wherein the inventor specifically defined “Downloadable” to include both “small” and “interpretable.”

No asserted or incorporated patent defines Downloadable as does the panel decision, as “a[n] ~~small~~ executable *or interpretable* application program...” That is, no patentee-coined definition includes the word “interpretable” without also including the word “small.” The panel decision is contrary to the clear precedent of this Court as set forth in *Phillips*, *Modine*, and *X2Y Attenuators*. Moreover, contrary to *Teva*, the panel decision disregards the District Court’s painstaking analysis of the

evidence. The panel decision does not reconcile its extraordinary result with any of the controlling precedent.

II. FACTUAL BACKGROUND

A. None of the Asserted (or Incorporated Non-Asserted) Patents Define Downloadable as Does the Panel 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 led to the asserted patents. *See* Appx979 at n.1; Appx928. The asserted patents and incorporated-by-reference patents provide conflicting definitions for the patentee-coined term “Downloadable”: “an executable application program...” (Appx178 (’844 patent at 1:44-47); Appx199 (’780 patent at 1:51-53)) or “a *small* executable *or interpretable* application program” (Appx1016 (’520 patent at 1:32-34); Appx1047 (’962 patent at 1:38-40) (emphasis added)).¹ The ’086 patent cites to and incorporates both definitions. *See* Finjan Opening Brief at 35. No asserted patent or incorporated patent/application defines “Downloadable” the way the panel opinion does: “an executable or interpretable application program.”

¹ The ’844 and ’780 patents incorporate by reference the ’639 provisional application, which defines a Downloadable as an executable application program that is automatically downloaded and run. Appx1863.

B. The District Court Construed “Downloadable” Consistently with the Specifications and Prosecution Histories.

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. Appx2. Consistent with this Court’s precedent, the District Court understood that it could not rewrite the inventor’s definitions, but should 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 possibly predict how a court might later redefine a disputed claim term. After extensive analysis of the specifications and prosecution histories of the asserted and incorporated-by-reference patents, and multiple rounds of briefing supported by expert declarations, the District Court arrived at its construction.

In so doing, the District Court credited the patentee’s arguments to the Patent Office that the ’962 patent² provided sole support for the inventions claimed in the ’621 and ’755 patents, where the definition of Downloadable includes both “small” and “interpretable.” Appx3. The Court found that the express definition in the ’844 and ’780 patents, which incorporates the ’639 provisional application and refers to “executable application programs” as applets, does not cover interpretable application programs, e.g., scripts, mentioned as examples of Downloadables in the

² The ’962 patent is a continuation of the ’520 patent where the definition including “small” and “interpretable” appears.

'844 and '780 patents. Appx3. The Court received conflicting expert testimony whether “interpretable application programs” are a species of “executable application program” and rejected that contention. Appx928-931, Appx23582, Appx23585-23588.

Based on its detailed review, the District Court found that the only patentee-coined definition of “Downloadable” that encompassed the full scope of the files described in the asserted patents necessarily had to include the words “small” and “interpretable.” The District Court did not determine that including the word “small” in the construction of Downloadable rendered that term indefinite. Rather, the District Court indicated that whether “Downloadable” was sufficiently definite would turn on the evidence adduced from the parties’ experts. Appx19.

III. ARGUMENT

A. The Panel Decision Does Not Explain How the Court Arrived at a Construction Broader Than Any Formulated by the Inventor Acting as His Own Lexicographer.

Prior to this precedential panel decision, it was the settled law of this Court that, where the inventor acts as his own lexicographer, the patentee’s definition controls as a matter of law. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (where the specification reveals a special definition given to a claim term, the inventor’s lexicography governs); *Honeywell Int’l, Inc. v. Univ. Avionics Sys. Corp.*, 493 F.3d 1358, 1361 (Fed. Cir. 2007). It also was the settled

law of this Court that a district court may not rewrite an inventor's express definition of a claim term. *Id.* at 1316 (inventor's intention, as expressed in the specification, is regarded as dispositive); *Modine Mfg. Co. v. U.S. Int'l Trade Comm'n*, 75 F.3d 1545, 1552 (Fed. Cir. 1996) (range specifically narrowed in child patent not entitled to broader range specified in incorporated-by-reference parent patent). The panel decision cites to no authority, and Appellees are aware of none, that empowers a court to override an express definition provided by a patentee by *selectively* editing the inventor's express definition. Nor would the public notice function of patent claiming countenance such ambiguity. *See Digit. Biometrics, Inc. v Identix, Inc.*, 149 F.3d 1335, 1347 (Fed. Cir. 1998).

The '639 provisional application, which is incorporated by reference into all asserted patents except the '086 patent, defines a "Downloadable" as an "executable application program which is automatically downloaded from a source computer and run on the destination computer." Appx1863. The '844 and '780 patents incorporate by reference the '639 provisional application, as well as the application that matured as the '520 patent. The '520 patent (and '962 patent incorporated in the '086, '621, and '755 patents) each define a Downloadable as "a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer." Appx1016 ('520 patent at 1:32-34); Appx1047 ('962 patent at 1:38-40). In drafting the '520 and '962 patents, the inventor expressly deleted the

word “automatically” and broadened the definition of Downloadable to include interpretable application programs.

In the ’844 and ’780 patents, the patentee again redefined Downloadable, this time as “an executable application program which is downloaded from a source computer and run on a destination computer” – explicitly deleting “interpretable” from the definition. The ’086 patent, which incorporates, *inter alia*, the conflicting definitions of the ’780 and ’194 patents, has no other express definition for the term Downloadable. Similarly, the ’621 and ’755 patents each incorporate, *inter alia*, the conflicting definitions provided in the ’639 provisional application, the ’962/’520 patents, and the ’780/’844 patents.

The panel opinion asserts 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.” But it was not error to view the differing definitions as competing: one includes “interpretable” and “small” and the other covers only executable application programs. And the definition that includes “small” and “interpretable” is *broader* in scope because it covers an entire class of files (*i.e.* interpretable application programs) not covered by the patentee-coined definition restricted to only “executables.” Moreover, it is not true, as the panel decision contends at page 8, that there is any “definition of ‘Downloadable’ that does not include a size requirement

[and] refers to executable or interpretable application programs of all sizes...” Rather, the patentee-coined definition that does not include a size requirement, e.g., in the ’844 and ’780 patents, does not include interpretable application programs.³

The panel decision does not explain how the patentee’s explicit definition of Downloadable set forth in the ’844 and ’780 patents – expressly limited to *only* “executable” application programs – could be broadened to include “interpretable” application programs. In rewriting the inventor’s definition, the panel decision disregards its prior precedent and U.S. Supreme Court authority that where the patentee acts as lexicographer, it is the inventor’s definition that governs. *See Modine*, 75 F.3d at 1551; *Phillips*, 415 F.3d at 1316; *Honeywell*, 493 F.3d at 1361.

The panel decision relies on *Modine* to strike “small” from the definition of “Downloadable” provided in the ’520 patent to arrive at its construction for the ’844 and ’780 patents. Panel Decision at page 8. Yet *Modine* directly refutes broadening “Downloadable” to reinstate the word “interpretable” the inventor had deleted. *Modine*, 75 F.3d at 1553 (“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.”).

³ Based on the extrinsic evidence presented by the experts, the District Court found files “executable” and “interpretable” had different meanings that cover entirely different sets of files. Appx3.

Here, the patentee purposely deleted “interpretable” from the definition of Downloadable in the ’844 and ’780 patents. The panel decision offers no explanation why *Modine* (or any precedent) supports rewriting the definition of Downloadable to strike the word “small” from the definition provided in the ’520 patent but simultaneously reinsert the word “interpretable” from the ’520 patent. The panel decision offers no authority nor any analytical framework to guide a district court in deciding whether or when words may be added to, or stricken from, a patentee-coined definition. Petitioner is unaware of any precedent or rule of construction that supports such an entirely novel approach to claim construction.

The ’086, ’621, and ’755 patents also incorporate by reference the conflicting definitions of the incorporated family members, as noted above. The panel decision states at page 9 that “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.” There is no broader patentee definition that includes “interpretable.” And the panel’s assertion the ’520 patent’s definition is “restricted” lacks analysis. On the contrary, as discussed above, the ’520 patent’s definition is broader because it incorporates an entirely different type of files (i.e. interpretable application programs). The panel decision cannot be reconciled with the factual record or the controlling authority of this Court.

B. The Panel Decision Ignored the Prosecution Histories for the '621 and '755 Patents.

During claim construction, the District Court requested briefing on the impact of the prosecution histories on the construction of “Downloadable” as used in the '621 and '755 patents. Appx2896; Appx2897-2899. As noted in those prosecution histories, the Patent Examiner initially rejected the claims as lacking written description support. *See* Appx1061-1062; Appx1073-1076. To overcome those rejections, the patentee pointed solely to the '962 patent as providing the necessary support. *See* Appx1061-1062; Appx1073-1076. In the '962 patent, the patentee-coined definition for Downloadable is “a *small* executable or *interpretable* application program which is downloaded from a source computer and run on a destination computer.” Appx1047 ('962 patent at 1:38-40) (emphasis added).

More specifically, during prosecution of the '621 patent, the Examiner rejected claim 1 for lack of written description for the phrase “wherein the information pertaining to the downloadable includes information pertaining to an operation of the downloadable and distinct from information pertaining to the request.” Appx1061. The patentee responded that support was found in the incorporated '962 patent. Appx1061-1062. Likewise, the terms “probes” and “response engine” of claim 1, and “downloadable engine” of claim 15, of the '621 patent find written description support only in the incorporated '962 patent. *See, e.g.,* Appx894, Appx908, Appx910, Appx912.

The identical situation arose during prosecution of the '755 patent, where the patentee again pointed to only the '962 patent as providing the sole Section 112 support. Appx1073-1076. In view of the patentee's overt reliance on the '962 patent to secure allowance of the claims of the '621 and '755 patents, the District Court concluded that construing the term Downloadable in accordance with the '962 patent was proper. *Digit. Biometrics*, 149 F.3d at 1342 (absent qualifying language in the remarks, arguments made to obtain the allowance of one claim are relevant to interpreting other claims in the same patent); *Hockerson-Halberstadt, Inc. v. Avia Grp. Int'l, Inc.*, 222 F.3d 951, 957 (Fed. Cir. 2000) (public entitled to rely on patentee's representations, made during prosecution, concerning the scope and meaning of the claims).

Notably, the panel decision does not refer to the prosecution history for either of the '621 or '755 patents, nor does it explain why either patent would be entitled to a different definition of Downloadable than the patentee-coined definition in the '962 patent – the sole written description support for the asserted claims. There is no support in the intrinsic or extrinsic evidence for any other construction of the term Downloadable in the '621 and '755 patents. *C.f. Elkay Mfg. Co. v EbcO Mfg. Co.*, 192 F.3d 973, 980 (Fed. Cir. 1999) (“When multiple patents derive from the same initial application, the prosecution history regarding a claim limitation in any patent that has issued applies with equal force to subsequently issued patents that contain

the same claim limitation.”); *Iridescent Networks, Inc. v. AT&T Mobility, LLC*, 933 F.3d 1345, 1350 (Fed. Cir. 2019) (“Statements made during prosecution of a parent application are relevant to construing terms in a patent resulting from a continuation application if such statements relate to the subject matter of the claims being construed.”).

C. The Panel Decision Should Have Reviewed the District Court’s Analysis of the Conflicting Intrinsic and Extrinsic Evidence for Clear Error.

The District Court analyzed the patentee-coined definitions and chose the only version that harmonized the intrinsic and extrinsic evidence, including the specifications, prosecution histories, and expert testimony. In doing so, the Court made subsidiary findings that, under *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318 (2015), should have been reviewed for clear error. Instead, the panel decision conducted a *de novo* review, based on the misconception that the various definitions are “not competing.” The panel decision also failed to consider or discuss the prosecution histories, e.g., for the ’621 and ’755 patents, which are dispositive of the claim construction issue for those patents.

The District Court undertook a thorough review of the specifications and prosecution histories, not only of the five asserted patents, but also the incorporated ’639 provisional application, and the ’194, ’520, and ’962 patents. In fact, the District Court prepared the detailed genealogy of the asserted patents, a version of

which is included at page 3 of the panel decision. Appx13. In so doing, the District Court held multiple days of hearings, and considered multiple rounds of briefing, including expert testimony. Appx52 (initial briefing); Appx52 (reply briefing); Appx56-57 (multiple days of claim construction hearings); Appx57 (supplemental claim construction briefing); Appx59 (further supplemental briefing); Appx188 (Finjan's first request for reconsideration of claim construction); Appx61-62 (Finjan's second request for reconsideration of claim construction); Appx928-931 (expert declaration from Dr. Spafford).

The District Court received expert testimony from both parties' experts that the term Downloadable had no ordinary and accustomed meaning. Appx928-931 (Dr. Spafford); Appx2114-2116 (Dr. Medvidovic). ESET's expert, Dr. Spafford, testified that “[o]ne of skill in the art would have understood that executable application programs differ from interpretable applications programs and that the two programs have significantly different scope.” Appx929 at ¶ 23. Dr. Spafford also cited multiple computer dictionary definitions and contemporaneous articles showing that those of skill in the art understood the scope of the terms executable and interpretable differed. Appx930-931 at ¶¶ 25-26.

After considering all of the foregoing evidence in the context of each patent, the District Court chose the patentee-coined definition that used both of the words “small” and “interpretable.” That decision falls squarely within the ambit of *Teva*,

and accordingly the panel decision 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*, the Supreme 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.*, 574 U.S. at 331-32.

The panel decision, while acknowledging the primacy of the *Teva* standard, did not apply it. Instead, the panel decision conducted a *de novo* review, without even mentioning the evidence considered by the lower court. Had the panel decision properly accorded the District Court's analysis due weight, this Court would have affirmed the District Court's judgment.

D. The Panel Decision Provides No Guidance to District Courts on How to Decide Amongst Conflicting Incorporated Definitions of Disputed Claim Terms.

The panel decision, although designated precedential, provides no guidance to a district court in construing patent claim terms where multiple incorporated-by-reference patents and applications provide conflicting definitions. Instead, the panel decision sidesteps that issue by concluding that the various definitions are "not

competing.” But as discussed above, it is a misconception that the definition of Downloadable in the ’844 and ’780 patents includes interpretable application programs. As factually resolved by the District Court, it does not. Instead, the patentee-coined definitions contained in the ’844 and ’780 patents were specifically revised to exclude interpretable application programs.

Because the panel decision’s factual assumptions are flawed, it fails to address the primary issue presented by Finjan’s appeal: 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? One solution, as this Court determined in an analogous situation, would be to find the disputed term indefinite. *See Infinity Comput. Prods., Inc. v. Oki Data Ams., Inc.*, 987 F.3d 1053, 1059 (Fed. Cir. 2020) (patentee’s inconsistent statements regarding disputed term “passive link” during prosecution and reexamination rendered term indefinite). Here, the District Court assessed the intrinsic and extrinsic evidence to determine which of the conflicting inventor’s definitions make sense in the context of the asserted patents.

The panel decision provides no guidance for the district courts, and fails even to appreciate the conflicting nature of the inventor’s express definitions. *See, e.g., Nanoco Techs., Ltd. v. Samsung Elecs. Co.*, No. 2:20-cv-00038-JRG, 2021 U.S. Dist. LEXIS 89223 (E.D. Tex. May 10, 2021) (finding term “molecular cluster compound” should be construed by selecting from amongst multiple conflicting

patentee-coined definitions provided in multiple asserted patents and applied uniformly across all asserted patents). Moreover, to the extent that the panel decision offers any guidance to district courts, it appears to be contrary to this Court's precedent, and in particular, *X2Y Attenuators, LLC v. U.S. Int'l Trade Comm'n*, 757 F.3d 1358 (Fed. Cir. 2014). That case and others are cited at page 7 of the panel decision for the proposition that “[p]atents that are incorporated by reference are ‘effectively part of the host [patents] as if [they] were explicitly contained therein.’” In *X2Y Attenuators*, this Court affirmed a construction that required the conductors on opposite sides of a central electrode to be oppositely charged, pursuant to an incorporated patent, notwithstanding language in the asserted patent stating the conductors need not be oppositely charged. Thus, this Court overrode a statement in the child patent in favor of electrode structure described as an essential element in the incorporated patents. *X2Y Attenuators*, 757 F.3d at 1362-63. Had the logic of *X2Y Attenuators* been applied here, it would have supported the affirmance of the District Court's judgment.

The panel opinion also appears to suggest that in construing disputed claim terms, non-asserted patents are entitled to lesser weight than the asserted patents – in direct contravention of the teachings of *X2Y Attenuators*. For example, the panel decision at page 4 refers to the “non-asserted” ’520 and ’962 patents and at page 8 states that those patents are only a subset of the patent family. But as discussed

above, the '962 patent provides the sole written description support for the '621 and '755 patents, so no other definition can apply. This Court's precedent provides no basis for distinguishing the weight to be accorded incorporated-by-reference patents based on whether or not those incorporated patents are also asserted. Indeed, as acknowledged in the panel decision at page 7, "definitions in any incorporated patents or references are a part of the host patent."

Nor does the panel decision provide guidance to district courts on how to construe claims subject to conflicting general rules of claim construction. For example, where the patentee expressly narrows a definition and thereby renders dependent claims invalid, which controls: the patentee definition or rewriting the definition to preserve validity? In *Littelfuse, Inc. v. Mersen USA EP Corp.*, 29 F.4th 1376 (Fed Cir. 2022), this Court reversed a district court's construction of the term "fastening stem" because it excluded embodiments described in the specification and recited in the dependent claims, holding that a construction that renders dependent claims a nullity is generally disfavored. But what should a district court do when the patentee *revises* his coined definition to exclude such embodiments?

For the '844 and '780 patents, the panel decision concluded that Downloadable should be construed to include interpretable application programs because such files are mentioned in the examples (and some dependent claims). The panel decision does not recognize or address that the patentee expressly revised his

definition of Downloadable for the '844 and '780 patents to delete the word “interpretable.” As in *Modine*, the inventor narrowed his definitional range and left a broader range in the examples. Regrettably, the panel decision offers no guidance whether or when a district court is free to rewrite an express definition provided by the inventor to cure invalidity defects. Here, the District Court resolved the conflicts and preserved validity of the dependent claims by choosing the patentee-coined definition of Downloadable in the '520 and '962 patents, which includes both “small” and “interpretable.”

The patentee-coined definition incorporated into the '844 and '780 patents by way of the '520 patent complies with this Court’s claim construction rules by (i) maintaining primacy of the inventor’s lexicography, (ii) preserving consistency with the examples and dependent claims, and (iii) acknowledging the extrinsic evidence that “interpretable” and “executable” cover entirely disjoint types of files. There was no need for the panel decision to fashion a new definition of Downloadable (excluding “small” but including “interpretable”) that ignores the inventor’s definitions and lacks support in the intrinsic or extrinsic evidence. Neither does the panel decision provide any guidance to district courts as to which rule of construction controls, which may be ignored, nor how or when to make such a choice.

IV. CONCLUSION

For the foregoing reasons, Appellees respectfully request that the Court grant this petition for rehearing *en banc*.

Date: November 21, 2022

Respectfully Submitted,

/s/ Nicola A. Pisano

Nicola A. Pisano

Jose L. Patiño

Scott A. Penner

Justin E. Gray

Regis C. Worley, Jr.

EVERSHEDS SUTHERLAND (US) LLP

12255 El Camino Real, Suite 100

San Diego, CA 92130

(858) 252-6502

Attorneys for Defendants-Appellees

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

Addendum

**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.

Decided: November 1, 2022

JUANITA ROSE BROOKS, Fish & Richardson P.C., San Diego, CA, argued for plaintiff-appellant. Also represented by JASON W. WOLFF; ROBERT COURTNEY, Minneapolis, MN.

NICOLA ANTHONY PISANO, Eversheds Sutherland (US) LLP, San Diego, CA, argued for defendants-appellees. Also represented by JUSTIN EDWIN GRAY, JOSE L. PATINO, SCOTT PENNER, REGIS CALVIN WORLEY, JR.

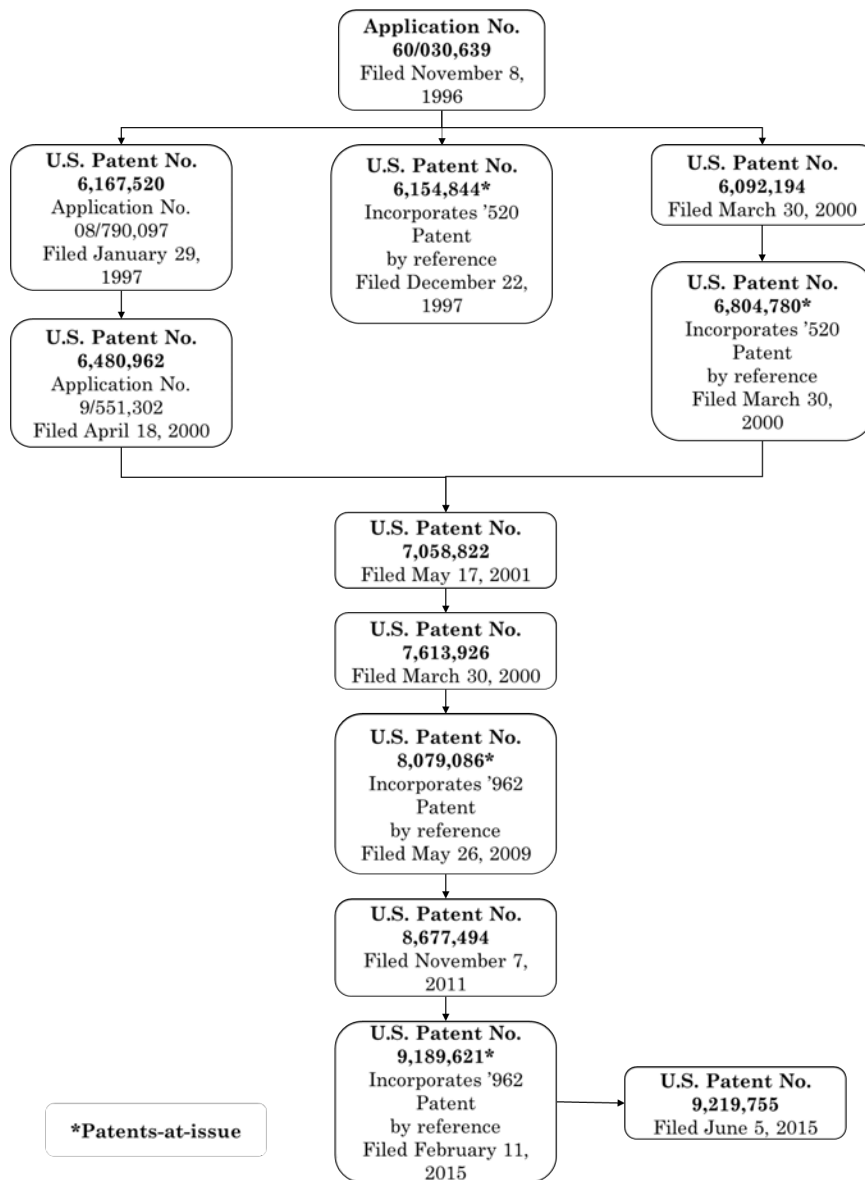
Before PROST, REYNA, and TARANTO, *Circuit Judges*.

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 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 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:



J.A. 13.

On September 25 and 26, 2017, the district court held a *Markman* hearing. *Claim Construction Order* at *1. The court focused on the meaning of the term “Downloadable” and requested further briefing on that term.

“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 Order* at *2 (emphasis added). The court based its construction on the incorporation by reference of the ’520 Patent.¹ *Id.*

¹ The asserted patents also incorporate the ’962 Patent by reference. The ’962 Patent is substantially similar

at *1–2. The district court reasoned that the patent family contained “somewhat differing definitions” that “can be reconciled.” *Id.* 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. *Id.* at *2.

On April 23, 2019, ESET moved for summary judgment of invalidity based on indefiniteness. *Finjan, Inc. v. ESET, LLC*, 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.*

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.” *Id.* at *5. 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

to the ’520 Patent. Reference to the ’520 Patent definition throughout the opinion also applies to the ’962 Patent.

(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.’” *Azko 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, (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, (2015). “Whether and to what extent material has 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 (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. *Philips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 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

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 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: “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.

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

COSTS

No costs.

CERTIFICATE OF SERVICE AND FILING

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

I hereby certify that on November 21, 2022, the foregoing **DEFENDANTS-APPELLEES' PETITION FOR REHEARING EN BANC** was filed electronically with the U.S Court of Appeals for the Federal Circuit by means of the Court's CM/ECF system. I further certify that the foregoing was served on the following counsel of record, by means of electronic mail:

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

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

Attorneys for Plaintiff-Appellant Finjan Inc.

Dated: November 21, 2022

/s/ Nicola A. Pisano
Nicola A. Pisano
EVERSHEDS SUTHERLAND (US) LLP
12255 El Camino Real, Suite 100
San Diego, CA 92130
(858) 252-6502

*Attorneys for Defendants-Appellees
ESET, LLC and ESET spol. s.r.o.*

CERTIFICATE OF COMPLIANCE

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

1. The filing has been prepared using a proportionally spaced typeface and includes 3,869 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b)(2).

2. The brief has been prepared using Microsoft Word 2016 in 14-point Times New Roman font. As permitted by Fed. R. App. P. 32(g), the undersigned has relied upon the word count feature of this word processing system in preparing this certificate.

Date: November 21, 2022

Respectfully Submitted,

/s/ Nicola A. Pisano

Nicola A. Pisano

Jose L. Patiño

Scott A. Penner

Justin E. Gray

Regis C. Worley, Jr.

EVERSHEDS SUTHERLAND (US) LLP

12255 El Camino Real, Suite 100

San Diego, CA 92130

(858) 252-6502

Attorneys for Defendants-Appellees

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