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2 UNITED STATES DISTRICT COURT  
3 NORTHERN DISTRICT OF CALIFORNIA  
4

5 FINJAN, INC.,  
6 Plaintiff,

7 v.

8 PROOFPOINT, INC., et al.,  
9 Defendants.

Case No. 13-cv-05808-HSG

**ORDER GRANTING IN PART AND  
DENYING IN PART MOTIONS FOR  
SUMMARY JUDGMENT**

Re: Dkt. Nos. 310, 312

[Redacted Version of Order Filed Under Seal]

10 This action arises from eight patents granted to Plaintiff Finjan, Inc., all of which involve  
11 software technologies concerning behavior-based internet security. Plaintiff filed the instant  
12 lawsuit on December 16, 2013, alleging that numerous products sold by Defendants Proofpoint,  
13 Inc. and Armorize Technologies, Inc. infringe eight patents: Patent Nos. 6,154,844 (“the ’844  
14 Patent”), 7,058,822 (“the ’822 Patent”), 7,647,633 (“the ’633 Patent”), 7,975,305 (“the ’305 Patent”),  
15 8,141,154 (“the ’154 Patent”), 7,613,918 (“the ’918 Patent”), 8,079,086 (“the ’086 Patent”), and  
16 8,225,408 (“the ’408 Patent”). The Court issued a claim construction order on December 4, 2016,  
17 Dkt. No. 267.

18 Pending before the Court are Plaintiff and Defendants’ motions for summary judgment,  
19 Dkt. Nos. 310, 312. The motions are appropriate for decision without oral argument, as permitted  
20 by Civil Local Rule 7-1(b). Having read and considered the parties’ arguments and the evidence  
21 submitted, the Court GRANTS IN PART and DENIES IN PART each party’s summary judgment  
22 motion.

23 **I. LEGAL STANDARD**

24 A motion for summary judgment should be granted where there is no genuine issue of  
25 material fact and the movant is entitled to judgment as a matter of law. Fed. R. Civ. P. 56;  
26 *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986). The purpose of summary judgment  
27 “is to isolate and dispose of factually unsupported claims or defenses.” *Celotex v. Catrett*, 477  
28 U.S. 317, 323-24 (1986). The moving party has the initial burden of informing the Court of the

1 basis for the motion and identifying those portions of the pleadings, depositions, answers to  
2 interrogatories, admissions, or affidavits which demonstrate the absence of a triable issue of  
3 material fact. *Id.* at 323.

4 If the moving party meets its initial burden, the burden shifts to the non-moving party to  
5 present facts showing a genuine issue of material fact for trial. Fed. R. Civ. P. 56; *Celotex*, 477  
6 U.S. at 324. The Court must view the evidence in the light most favorable to the nonmovant,  
7 drawing all reasonable inferences in its favor. *T.W. Elec. Serv., Inc. v. Pac. Elec. Contractors*  
8 *Ass'n*, 809 F.2d 626, 630-31 (9th Cir. 1987). Summary judgment is not appropriate if the  
9 nonmoving party presents evidence from which a reasonable jury could resolve the disputed issue  
10 of material fact in the nonmovant's favor. *Anderson*, 477 U.S. at 248. Nonetheless, "[w]here the  
11 record taken as a whole could not lead a rational trier of fact to find for the non-moving party,  
12 there is no genuine issue for trial." *Matsushita Elec. Indus. Co. v. Zenith Radio*, 475 U.S. 574, 587  
13 (1986) (internal quotation marks omitted).

14 Infringement is a question of fact. *Frank's Casing Crew & Rental Tools, Inc. v.*  
15 *Weatherford Int'l, Inc.*, 389 F.3d 1370, 1376 (Fed. Cir. 2004). The patent holder has the burden to  
16 prove that each accused product "includes every limitation of [an asserted] claim." *Dolly, Inc. v.*  
17 *Spalding & Evenflo Cos.*, 16 F.3d 394, 397 (Fed. Cir. 1994). The Court can resolve the issue on  
18 summary judgment only if "no reasonable jury could find that every limitation recited in the  
19 properly construed claim either is or is not found in the accused device." *Id.* at 1376; *see*  
20 *TechSearch, L.L.C. v. Intel Corp.*, 286 F.3d 1360, 1371 (Fed. Cir. 2002) ("[A]ll of the elements of  
21 the claim, as correctly construed, must be present in the accused system."). "Any deviation from  
22 the claim precludes" a finding of literal infringement. *Telemac Cellular Corp. v. Topp Telecom,*  
23 *Inc.*, 247 F.3d 1316, 1330 (Fed. Cir. 2001). The absence from the accused product of one  
24 limitation in the claim means that, as a matter of law, there is no literal infringement of that claim.  
25 *Frank's Casing Crew*, 389 F.3d at 1376.

26 With respect to invalidity, "a moving party seeking to invalidate a patent at summary  
27 judgment must submit such clear and convincing evidence of invalidity so that no reasonable jury  
28 could find otherwise." *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 962 (Fed. Cir. 2001).

1 “Alternatively, a moving party seeking to have a patent held not invalid at summary judgment  
2 must show that the nonmoving party, who bears the burden of proof at trial, failed to produce clear  
3 and convincing evidence on an essential element of a defense upon which a reasonable jury could  
4 invalidate the patent.” *Id.* “In determining whether a genuine issue of material fact exists, the  
5 court views the evidence in the light most favorable to the nonmoving party and resolves all  
6 doubts in its favor.” *Id.*

7 **II. PLAINTIFF’S MOTION FOR SUMMARY JUDGMENT**

8 Plaintiff’s motion focuses on five of the eight patents-in-suit. Plaintiff seeks a summary  
9 judgment of infringement as to two patents (the ’844 and ’086 Patents), contending there are no  
10 material issues of fact. As to the other three patents (the ’918, ’154 and ’305 Patents), Plaintiff  
11 argues Defendants do not have evidence to support invalidity.

12 **A. Literal Infringement**

13 **1. Claims 1 and 15 of the ’844 Patent**

14 Plaintiff argues it is entitled to summary judgment of infringement as to claims 1 and 15 of  
15 the ’844 Patent. Claims 1 and 15 of the ’844 Patent include limitations requiring the inspector to  
16 link “the first Downloadable security profile to the Downloadable before a web server makes the  
17 Downloadable available to web clients.” ’844 Patent at 11:18-21, 11:66-12:2. There are issues of  
18 disputed fact as to this limitation that preclude summary judgment.

19 Defendants argue that Proofpoint does not infringe this claim limitation because the  
20 “linking” alleged is not done “before a web server makes the Downloadable available to web  
21 clients,” Dkt. No. 323 at 8-12. On the other hand, Plaintiff contends that [REDACTED]  
22 [REDACTED] Dkt. No.  
23 310, Ex. 39. The parties further dispute the limitation’s reference to “web clients”— [REDACTED]  
24 [REDACTED]  
25 [REDACTED] Dkt. No. 323 at 11; *see* Dkt. No. 329 at 4 [REDACTED]  
26 [REDACTED] Additionally, the parties dispute when the downloadable becomes “available.” *Compare*  
27 Dkt. No. 323 at 11-12 [REDACTED]  
28 [REDACTED], *with* Dkt. No. 310 at 17 [REDACTED]

1 [REDACTED]  
2 [REDACTED] These are factual questions of infringement that a finder of fact must resolve. *See*  
3 *PPG Indus. v. Guardian Indus. Corp.*, 156 F.3d 1351, 1355 (Fed. Cir. 1998). Therefore, summary  
4 judgment is DENIED.

5 **2. Claim 24 of the '086 Patent**

6 Claim 24 of the '086 patent describes “transmitting the Downloadable and a representation  
7 of the Downloadable security profile data to a destination computer, via a transport protocol  
8 transmission.” '086 Patent at 22:17-20. Plaintiff contends that the HackAlert product satisfies  
9 this claim as it transmits “the Downloadable in the form of snippets, as well as a security profile  
10 for the Downloadable, to a destination computer via an API return call.” Dkt. No. 310 at 19  
11 (citing Dkt. No. 310, Ex. 39 ¶ 1007). However, there are disputes of material fact as to this claim  
12 limitation. The parties dispute [REDACTED]

13 [REDACTED] *Compare* Dkt. No. 322-6, Ex. J ¶ 441 [REDACTED]  
14 [REDACTED]  
15 [REDACTED] *with* Dkt. No. 329, Ex. 3, ¶ 908 [REDACTED]

16 [REDACTED] The parties also dispute  
17 whether [REDACTED]  
18 [REDACTED]. *See* Dkt. No. 323 at 16; Dkt. No. 322-6, Ex. J ¶ 442-43; Dkt. No. 329 at 8. In  
19 light of these disputed issues of material fact, the Court cannot grant summary judgment of  
20 infringement as to claim 24 of the '086 Patent, and Plaintiff's motion as to that patent is DENIED.

21 **B. Anticipation**

22 Invalidity by anticipation requires that the four corners of a single prior art reference  
23 disclose each and every limitation of the claimed invention, such that a person of ordinary skill in  
24 the art could practice the invention without undue experimentation. *Schering Corp. v. Geneva*  
25 *Pharmas.*, 339 F.3d 1373, 1379 (Fed. Cir. 2003); *Advanced Display Sys., Inc. v. Kent State Univ.*,  
26 212 F.3d 1272, 1282 (Fed. Cir. 2000). A prior art reference may, however, anticipate “without  
27 disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or  
28 inherent, in the single anticipating reference.” *SmithKline Beecham Corp. v. Apotex Corp.*, 403

1 F.3d 1331, 1343 (Fed. Cir. 2005); *see In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)  
2 (holding that inherent anticipation requires more than mere probability or possibility that the  
3 missing descriptive materials are present in the prior art); *see also Cont'l Can Co. v. Monsanto*  
4 *Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991).

5 Finjan seeks summary judgment of no anticipation, alleging that Defendants failed to  
6 address each element of an alleged prior art reference or to establish anticipation through  
7 inherency.

8 **1. Claims 32 and 42 of the '844 Patent**

9 A triable issue of fact exists as to whether U.S. Patent No. 6,253,370 ("Abadi") anticipates  
10 claims 32 and 42 of the '844 Patent. Plaintiff contends that Defendants cannot meet their burden  
11 under the clear and convincing standard because Defendants' reliance on Abadi as the only  
12 anticipation reference is insufficient to disclose every element of the claims as required. *See* Dkt.  
13 No. 310 at 21 (citing Dkt. No. 310, Ex. 21). Defendants respond that what Plaintiff refers to as  
14 conclusory statements are in fact the result of a typographical error. *See* Dkt. No. 323 at 19 ("For  
15 limitation 32D, Dr. Franz erroneously referred back to limitation 32D itself, an inadvertent circular  
16 reference.").

17 The Court finds that this issue cannot be resolved on summary judgment. Viewing the  
18 evidence in the light most favorable to Defendants and resolving all doubts in their favor,  
19 Defendants have proffered clear and convincing evidence of anticipation as to the essential  
20 element related to "determining whether to trust" a Downloadable security profile in claims 32 and  
21 42. A reasonable jury could invalidate those claims if it credits Defendants' evidence. Because  
22 there is a factual dispute as to the existence of a typographical error, and the underlying issue of  
23 whether the claims are anticipated, the Court DENIES Plaintiff's motion as to claims 32 and 42 of  
24 the '844 Patent.

25 **2. The '154 Patent**

26 Plaintiff moves for summary judgment as to claims 1 and 4 of the '154 Patent, arguing that  
27 U.S. Publication No. 2007/0113282 ("Ross") does not disclose elements related to the "call to a  
28 first function" for these claims. Dkt. No. 310 at 21. Plaintiff primarily relies on the Patent Trial

1 and Appeal Board’s rejection of a similar anticipation argument in a request for *inter partes*  
2 *review*. The Court finds that Defendants have identified a factual dispute as to the anticipation  
3 contention: namely, whether Ross discloses that the client’s script processing engine receives  
4 “content including a call to a first function” over a network or whether Ross is limited to situations  
5 where the content (including the call to first function) is not received over a network. Viewing the  
6 evidence in the light most favorable to Defendants, as it must at this stage, the Court finds  
7 Defendants have produced clear and convincing evidence upon which a reasonable jury could  
8 make an invalidity finding if it credits Defendants’ evidence. The Court DENIES summary  
9 judgment as to claims 1 and 4 of the ‘154 Patent.

10 **3. Anticipation by Inherency**

11 Plaintiff argues that no asserted prior art reference inherently discloses any element of the  
12 ‘844, ‘918, and ‘305 Patents. Plaintiff contends that Defendants failed to show that each element  
13 is “necessarily present” in each reference. The Court addresses each element below.

14 First, Plaintiff argues that Defendants have not produced clear and convincing evidence  
15 that “Abadi inherently disclosed ‘memory for first rule set’ from claims 15 and 16” of the ‘844  
16 Patent. The Court finds, however, that Defendants have produced facts that, if credited, establish  
17 clear and convincing evidence to the contrary. Dr. Franz indicated that [REDACTED]  
18 [REDACTED] Dkt. No. 310, Ex. 21, Ex. A-1 at 9. Although his  
19 report and deposition testimony do not expressly include the words “necessarily present,” Dr.  
20 Franz indicated that the “memory was inherently disclosed by Abadi.” Dkt. No. 310, Ex. 45 at  
21 172. Construing the evidence in Defendants’ favor, the Court concludes that a reasonable jury  
22 could invalidate the patent based on the expert’s testimony and report by recognizing the “memory  
23 storing the first rule set” limitation in the prior art. The Court DENIES summary judgment as to  
24 this contention.

25 Second, Plaintiff argues that Defendants have not produced clear and convincing evidence  
26 that Abadi inherently discloses JavaScript for claim 7 of the ‘844 Patent. But, Dr. Franz testified  
27 that in Abadi the phrase “source code can be written in any programming language” “necessarily  
28 includes a Javascript.” Dkt. No. 310, Ex. 45 at 59 (confirming that he is “relying on an inherent

1 anticipation for disclosing Javascript”). Dr. Franz’s testimony raises a factual dispute as to  
2 whether a person of ordinary skill in the art would understand that the JavaScript is implicitly  
3 disclosed and necessary. *See Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1347 (Fed. Cir. 2000).  
4 Viewing the evidence in the light most favorable to Defendants and making all inferences in their  
5 favor, the Court finds that clear and convincing evidence upon which a rational trier of fact could  
6 find invalidity has been produced. Therefore, the Court DENIES summary judgment as to this  
7 anticipation theory.

8 Third, contrary to Plaintiff’s contention, Defendants do not argue that Kramer inherently  
9 discloses “security context generator” from claim 12 of the ’918 Patent. *See* Dkt. No. 323 at 23  
10 (“Dr. Franz did not testify that it was inherent, only that it did not have a name.”). Given that  
11 Defendants do not argue anticipation by inherency, and rather limit their argument to anticipation  
12 directly, *see* Dkt. No. 310, Ex. 45 at 137 (testifying that he “believes” the “security-context  
13 generator is necessarily included”), the Court GRANTS summary judgment in Plaintiff’s favor  
14 specifically as to an anticipation by inherency theory for claim 12 of the ’918 Patent.

15 Fourth, Plaintiff contends that Defendants failed to produce clear and convincing evidence  
16 that U.S. Patent No. 7,636,945 (“Chandanani”) inherently discloses “patterns of types of tokens”  
17 from claims 1, 2, 5 and 13 of the ’305 Patent. Dr. Franz’s report states that “patterns of types of  
18 tokens” is necessarily inherent to the following: [REDACTED]

19 [REDACTED] Dkt. No. 310, Ex. 21, Ex.  
20 E-1 at 8; Dr. Franz’s deposition further confirms this interpretation. Viewing the evidence in the  
21 light most favorable to Defendants and making all inferences in their favor, the Court finds that  
22 the expert’s report and testimony, if credited, set forth sufficient facts to satisfy the clear and  
23 convincing evidence standard. Accordingly, this anticipation theory survives summary judgment,  
24 and Plaintiff’s motion is DENIED.

25 **C. Obviousness**

26 Section 103(a) forbids issuance of a patent when “the differences between the subject  
27 matter sought to be patented and the prior art are such that the subject matter as a whole would  
28 have been obvious at the time the invention was made to a person having ordinary skill in the art

1 to which said subject matter pertains.” 35 U.S.C. § 103(a). Although obviousness is a question of  
2 law, the question is premised on the following underlying factual questions: “(1) the scope and  
3 content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the  
4 level of ordinary skill in the art; and (4) secondary evidence of non-obviousness.” *Seiko Epson*  
5 *Corp. v. Coretronic Corp.*, No. C 06-6946 MHP, 2010 WL 4916424, at \*4 (N.D. Cal. Nov. 23,  
6 2010) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *KSR Int’l Co. v. Teleflex Inc.*,  
7 550 U.S. 398, 406 (2007)). The relevant question is “whether the combination was obvious to a  
8 person with ordinary skill in the art.” *KSR*, 550 U.S. at 420.

9 The Court finds that summary judgment as to the four remaining obviousness  
10 combinations is not appropriate as there are material disputes as to the underlying facts with  
11 respect to each claim. *See, e.g.*, Dkt. No. 322-15, Ex. Z at ¶ 327 (“[T]o someone of ordinary skill  
12 in the art it would have been obvious by combining Abadi and Islam to reproduce the same system  
13 disclosed in the ‘844 patent, using not merely an equivalent mechanism for establishing a ‘link’ . . .  
14 but reproducing the exact same linking mechanism disclosed in the specification of the ‘844  
15 patent.”); Dkt. No. 323-14, Ex. S (providing a limitation-by-limitation analysis for Abadi and the  
16 ‘844 Patent); Dkt. No. 323-15, Ex. T (providing obviousness disclosures for the ‘844 and ‘086  
17 Patents). The expert’s opinions disclose underlying factual discrepancies between the prior art and  
18 the claims at issue, and under these circumstances, the ultimate determination of obviousness will  
19 depend on resolution of these factual disputes at trial. Because the combinations, when viewed in  
20 the light most favorable to the nonmovant, could support findings of obviousness under the clear  
21 and convincing evidence standard, the Court DENIES Plaintiff’s motion.<sup>1</sup>

22 **III. DEFENDANTS’ MOTION FOR SUMMARY JUDGMENT**

23 Defendants move for summary judgment as to all asserted claims. Dkt. No. 314.

24 **A. Proofpoint Enterprise Protection (“PEP”)**

25 Defendants contend that the Court should grant summary judgment, holding that the  
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27 <sup>1</sup> The Court reminds the parties that expert opinions at trial will be limited to those that were  
28 properly and fully disclosed under Rule 26 and the Patent Local Rules. All previously undisclosed  
opinions will be excluded or stricken.



1 Enterprise Protection product does not infringe the '822, '844, '633, '305, and '408 Patents.  
2 Defendants argue that Plaintiff has improperly conflated PEP with TAP, and that Plaintiff  
3 mistakenly accuses features of the TAP product, not PEP, when arguing infringement of these  
4 patents. Dkt. No. 314 at 2-3. The Court finds there are disputes of material fact as to the  
5 relationships between PEP and TAP and between PEP and Proofpoint Protection Server ("PPS").  
6 *Compare* Dkt. No. 312, Ex. 11 ¶ 97-99 [REDACTED]  
7 [REDACTED] with Dkt. No. 311, Ex. A at 98 [REDACTED]  
8 [REDACTED] The resolution of these factual disputes is not  
9 appropriate at summary judgment. Therefore, Defendants' motion as to the PEP product is  
10 DENIED.

11 **B. The '822 and '633 Patents**

12 Defendants seek summary judgment of noninfringement as to the '822 and '633 Patents.  
13 Defendants' motion relies on the premise that the Court struck all of Plaintiff's theories as to the  
14 "mobile protection code" in claim 9 for the '822 Patent and claims 8, 12, and 14 for the '633  
15 Patent. Dkt. No. 314 at 4.

16 The Court rejects Defendants' argument. First, contrary to Defendants' characterization,  
17 the Court only struck two specific theories for these patents: (1) [REDACTED]  
18 [REDACTED] and (2) [REDACTED]  
19 [REDACTED]  
20 [REDACTED] Dkt. No. 305 at 11. Second, in reference to the latter theory, the Court further rejects  
21 Defendants' assertion (in a footnote in their reply) that the Court's previous order, Dkt. No. 305,  
22 "struck this theory generally." Defendants' contention is especially inaccurate in light of the fact  
23 that Defendants expressly limited their motion to strike to claim 9 and claim 8 of the '822 and  
24 '633 Patents, respectively. *See* Dkt. No. 208-4 at 22. Because Defendants have offered no  
25 evidence to support their argument that summary judgment is appropriate as to the '822 and '633  
26 Patents, Defendants' motion is DENIED.

27 **C. The '305 Patent**

28 The parties dispute whether the accused products use rules that describe exploits in terms

1 of “patterns of types of tokens.” *See* Dkt. No. 314 at 6-8. Although Defendants contend that Dr.  
2 Mitzenmacher failed to identify any rules describing computer exploits as “patterns of types of  
3 tokens,” the Court disagrees. *See, e.g.,* Dkt. No. 321, Ex. 12 at ¶¶ 269-70 [REDACTED]

4 [REDACTED]  
5 [REDACTED]  
6 [REDACTED] The expert report specifically identifies rules and patterns of types of tokens. Although  
7 Defendants contend the expert’s characterization does not constitute “patterns of type of tokens,”  
8 the Court finds that this is a factual dispute that is not appropriately resolved at this stage. The  
9 Court DENIES summary judgment of noninfringement as to the ’305 Patent.

10 **D. The ’408 Patent**

11 Defendants are not entitled to summary judgment of noninfringement for the ’408 Patent.  
12 Defendants argue that “Proofpoint’s products do not dynamically detect exploits by scanning a  
13 parse tree, let alone doing so while dynamically building the parse tree.” Dkt. No. 314 at 8  
14 (emphasis omitted). The Court finds that there is conflicting expert testimony as to Defendants’  
15 noninfringement contention. Dr. Mitzenmacher discusses both elements—dynamically detecting  
16 exploits and dynamically building a parse tree—in his report. *See, e.g.,* Dkt. No. 321, Ex. 12

17 ¶ 1782 [REDACTED]  
18 [REDACTED]  
19 [REDACTED] *id.* at ¶ 2445 [REDACTED]  
20 [REDACTED]  
21 [REDACTED]

22 Although Defendants disagree with the expert’s characterization, contending that the  
23 identified allegations do not literally satisfy the claim language, such factual disputes are  
24 inappropriate for resolution at summary judgment. Because Plaintiff’s expert has raised issues of  
25 material fact that could allow a reasonable jury to find infringement of the ’408 Patent, the Court  
26 DENIES Defendants’ motion.

27 **E. The ’844 Patent**

28 Defendants are not entitled to summary judgment of noninfringement of the ’844 Patent.

1 Defendants contest Plaintiff’s interpretation of the patent’s claim limitation, contending that the  
2 interpretation is contrary to its plain meaning and the intrinsic evidence. The limitation requires  
3 that a Downloadable security profile link to a Downloadable “before [a/the] web server makes the  
4 Downloadable available to web clients.” Dkt. No. 314 at 10. Defendants contend that once the  
5 Downloadable is “available for download, it is available to web clients, and anything that happens  
6 after” that does not fall within the claim limitation. *Id.*

7 As detailed *supra* in the Court’s analysis of Plaintiff’s summary judgment motion, there is  
8 a factual dispute regarding [REDACTED]  
9 [REDACTED]. Although Plaintiff contends there is only one  
10 “logical interpretation” and Defendants argue there is no genuine dispute on [REDACTED]  
11 [REDACTED], the Court disagrees, and finds  
12 these to be disputed issues of material fact. Accordingly, Defendants’ motion is DENIED.

13 **F. The ’086 Patent**

14 Defendants are not entitled to summary judgment of noninfringement of claims 17 and 24  
15 of the ’086 Patent. The claims describe a system comprising “a transmitter . . . for transmitting  
16 the Downloadable and a representation of the Downloadable security profile data to a destination  
17 computer, via a transport protocol transmission,” ’086 Patent at 21:57-59, 22:16-20. Construing  
18 the Plaintiff’s expert testimony in the light most favorable to Plaintiff, the Court finds disputed  
19 issues of material fact as to the claims’ limitations, [REDACTED]  
20 [REDACTED]. These issues  
21 preclude summary judgment. Defendants’ motion is DENIED.

22 **G. The ’918 Patent**

23 Defendants contend summary judgment is appropriate as to the ’918 Patent because  
24 Plaintiff has not identified “an executable wrapper code (CODE-B),” as required by claims 12 and  
25 21. The Court agrees.

26 Plaintiff argues that [REDACTED]  
27 [REDACTED]. See Dkt. No. 321 at 17; Dkt. No. 311-9, Ex. F ¶ 2176. In support  
28 of its argument that CODE-B need not be executable, Plaintiff cites the specification: CODE-B “is

1 used to wrap CODE-A therewithin.” *See* Dkt. No. 321 at 17. Plaintiff’s citation, however, omits  
2 the rest of the sentence, which expressly identifies CODE-B as *executable*. *See* ’918 Patent at  
3 7:58-60 (“At step 240 the gateway computer *prepares a predetermined wrapper executable file,*  
4 *designated CODE-B,* which is used to wrap CODE-A therewithin.” (emphasis added)). The Court  
5 also rejects Plaintiff’s contention that “CODE-B as an executable is only one preferred  
6 embodiment, not a requirement.” Dkt. No. 321 at 17 (emphasis omitted). The relevant claims at a  
7 minimum require CODE-B to be executable. *See, e.g.,* ’918 Patent, 12:51-56 (“[A] code packager  
8 . . . for packaging (i) information about the computer account . . . and (ii) CODE-A, with (iii)  
9 *executable wrapper code* (‘CODE-B’), into a combined code (‘CODE-C’)” (emphasis added)).  
10 Plaintiff’s alternative argument also fails, as nothing Plaintiff identifies in the expert reports  
11 sustains its contention [REDACTED] executable. *See* Dkt. No. 320-10, Ex. 11 ¶ 2176  
12 [REDACTED]  
13 [REDACTED] *see also* Dkt. No. 320-8 Ex. 10, 100:8-  
14 102:11, 128:6-18.

15 The unambiguous claim language coupled with Plaintiff’s failure to set forth any evidence  
16 showing that the [REDACTED] supports summary judgment in Defendants’ favor.  
17 Accordingly, the Court GRANTS Defendants’ motion as to the ’918 Patent.

18 **H. The ’154 Patent**

19 Defendants are entitled to summary judgment of noninfringement of the ’154 Patent. The  
20 Court previously struck Plaintiff’s infringement theories for the ’154 Patent for failure to properly  
21 disclose the theories under the local rules. *See* Dkt. No. 305 at 4-5 (striking from the expert report  
22 the theories [REDACTED]). The Court  
23 also struck [REDACTED] for the ’154 Patent  
24 for failure to specifically identify these products under the local rules. *Id.* at 2-4. The Court now  
25 finds that Plaintiff has failed to identify specific facts to support an infringement theory against the  
26 remaining accused product, HackAlert.

27 Plaintiff cites paragraphs 1077-79, 1081-86, and 1242-58 from Dr. Mitzemacher’s report  
28 to satisfy the limitations of claims 1 and 4 of the ’154 Patent. *See* Dkt. No. 321 at 18-19; *see* Dkt.

1 No. 321-3, Ex. 12. Although these paragraphs identify several examples of content, first function,  
2 and second function, the paragraphs do not address the other elements of claims 1 and 4. For  
3 instance, there is no discussion of a transmitter “transmitting the input to the security computer for  
4 inspection, when the first function is invoked.” *See* ’154 Patent at 17:39-41. Similarly, the cited  
5 paragraphs do not identify “a receiver for receiving an indicator from the security computer  
6 whether it is safe to invoke the second function with the input.” *See id.* at 17:42-44.

7 Plaintiff’s failure to identify specific facts supporting every element of claims 1 and 4 is  
8 fatal to its infringement claim. *See Jeneric/Pentron, Inc. v. Dillon Co., Inc.*, 205 F.3d 1377, 1382  
9 (Fed. Cir. 2000) (“[A]n accused product literally infringes if *every limitation* recited in the claim  
10 appears in the accused product.” (emphasis added)). Therefore, the Court GRANTS summary  
11 judgment as to noninfringement of the ’154 Patent.

12 **I. The Claimed Invention Dates of the ’844, ’633, and ’822 Patents**

13 Defendants contend that Plaintiff is not entitled to an invention date before its alleged  
14 reduction to practice for the ’844, ’633, and ’822 Patents.

15 **1. The ’844 Patent**

16 Plaintiff contends that the ’844 Patent was conceived on November 8, 1996 and reduced to  
17 practice on December 22, 1997. Dkt. No. 313-24 at 5. Defendants contend that Plaintiff is  
18 collaterally estopped from arguing that the ’844 Patent is entitled to an invention date before  
19 December 22, 1997. Defendants rely on the November 20, 2015 order in *Finjan v. Blue Coat*  
20 *Systems, Inc.*, which held that the “presumptive invention date of the ’844 patent is its filing date,”  
21 December 22, 1997, as Plaintiff had not met its burden to show that the ’844 Patent has a priority  
22 date of November 8, 1996. *See* Dkt. No. 313-25, Ex. FF.

23 Collateral estoppel requires that “(1) there was a full and fair opportunity to litigate the  
24 issue in the previous action; (2) the issue was actually litigated in that action; (3) the issue was lost  
25 as a result of a final judgment in that action; and (4) the person against whom collateral estoppel is  
26 asserted in the present action was a party or in privity with a party in the previous action.”

27 *Kendall v. Visa U.S.A., Inc.*, 518 F.3d 1042, 1050 (9th Cir. 2008) (internal quotation marks  
28 omitted); *see also In re Katz Interactive Call Processing Patent Litig.*, No. 07-ML-01816-C RGK,

1 2010 WL 8759131, at \*4 (C.D. Cal. Jan. 29, 2010) (“The application of collateral estoppel is not  
2 an issue unique to patent law. Thus, the law of the regional circuit applies.”).

3 All four requirements are met here. There is no question that Plaintiff was a party in the  
4 previous action, that the issue was actually litigated, and that Plaintiff had a “full and fair  
5 opportunity to litigate.” See Dkt. No., 313-25, Ex. FF at 2. Plaintiff’s argument that collateral  
6 estoppel does not apply because the priority date determination in *Blue Coat Systems* was not  
7 essential to the final judgment lacks merit. It is of no consequence that the determination did not  
8 affect the jury’s validity finding, given that the determination was made following a bench trial at  
9 which the priority date for the ’844 Patent was one of five issues decided. The parties filed briefs,  
10 and elicited testimony from witnesses at trial. The Court issued seventeen findings of fact related  
11 to the priority date, and concluded that Plaintiff “failed to show that it was diligent in reducing to  
12 practice the invention of the ’844 Patent.” *Id.* at 4-6. Moreover, the Court’s final judgment  
13 explicitly relied on the bench trial determination. See Dkt. No. 332, Ex. UU.

14 Based on this evidence, the Court GRANTS Defendants’ summary judgment motion,  
15 finding that Plaintiff is precluded from arguing an earlier date applies.

16 **2. The ’633 and ’822 Patents**

17 Defendants move for summary judgment as to the invention dates for the ’633 and ’822  
18 Patents. Plaintiff alleges diligence between the alleged conception, January 29, 1997, and when it  
19 was reduced to practice, May 17, 2000. Dkt. No. 313-24 at 5-6. Plaintiffs have identified  
20 disputed material facts regarding conception and diligence for these patents, identifying expert  
21 testimony as well as testimony from other inventors as evidence of diligence. See Dkt. No. 321-31  
22 at 33-34. Accordingly, Defendants’ motion as to the invention date of these patents is DENIED.

23 **J. The ’633 Patent: Anticipation**

24 Defendants contend that once the Court assigns the proper invention date to the ’633  
25 Patent, “there is no dispute of material fact that Ji . . . anticipates claim 14.” Because the Court  
26 denies Defendants’ motion as to the ’633 Patent’s invention date, it DENIES Defendants’ motion  
27 as to anticipation as well.  
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**K. The '086 Patent: Priority Date**

The '086 Patent states that it is a continuation of U.S. Patent No. 7,613,926, (“the '926 Patent”), which is a continuation of U.S. Patent No. 7,058,822, which is continuation-in-part of U.S. Patent No. 6,804,780, which is a continuation of application No. 08/964,388 (now U.S. Patent No. No. 6,092,194, or the '194 Patent) filed on November 6, 1997. *See* '086 Patent. Defendants contend that the '086 Patent is not entitled to claim priority to the November 1997 date for the '388 application, because the '388 application does not include any reference to the “transport protocol transmission” elements of claims 17 and 24 of the '086 Patent.

Plaintiff relies on a recent United States Patent & Trademark Office decision which, according to Plaintiff, rejects Defendants’ argument. That decision held that the '926 Patent claims priority to the '388 application, and includes a similar limitation requiring transmission to a destination computer via “a transport protocol transmission.” *See* Dkt. No. 321, Ex. 39 at 3-11. The Court finds that the relationship between the patents is a question of fact inappropriate for summary judgment. Defendants’ motion as to the '086 Patent’s priority date is DENIED.

**L. Plaintiff’s Cross Motion for Summary Judgment**


The Court DENIES Plaintiff’s cross motion for summary judgment for failure to comply with the Court’s standing order: “Parties are limited to filing one motion for summary judgment. Any party wishing to exceed this limit must request leave of Court and must show good cause.”

**IV. CONCLUSION**

For the foregoing reasons, the Court **GRANTS IN PART** and **DENIES IN PART** each party’s motion for summary judgment. In light of this order, the Court also DENIES as moot the parties’ first set of dispositive motions, Dkt. Nos. 223, 228, as well as all related administrative motions to file under seal, Dkt. Nos. 221, 226, 242, 250, 257, 262.

**IT IS SO ORDERED.**

Dated: 4/12/2016

  
HAYWOOD S. GILLIAM, JR.  
United States District Judge