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28UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

FORTINET, INC.,

Plaintiff,

v.

SOPHOS, INC., et al.,

Defendants.

Case No. 13-cv-05831-EMC

**ORDER GRANTING IN PART AND
DENYING IN PART PLAINTIFF'S
MOTION FOR SUMMARY JUDGMENT**

Docket No. 218

Plaintiff Fortinet, Inc. has filed suit against Defendants Sophos, Inc. and two of its officers, Michael Valentine and Jason Clark, both of whom left employment with Fortinet to work for Sophos. In the operative first amended complaint (“FAC”), *see* Docket No. 9 (FAC), Fortinet has asserted a variety of claims against Sophos, including patent infringement. Sophos has counterclaimed for infringement of its own patents. Currently pending before the Court is Fortinet’s motion for summary judgment, in which it seeks summary judgment as to some of Sophos’s patent claims and summary judgment as to one of its own patent claims.

I. DISCUSSION**A. Legal Standard**

Under Federal Rule of Civil Procedure 56(a), a party may seek summary judgment on a claim or even part of a claim. “The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). As indicated by the language of the rule, “[t]he moving party has the burden of establishing the absence of a genuine dispute of material fact. The court must view the evidence in the light most favorable to the non-movant and draw all reasonable

1 inferences in the non-movant’s favor.” *City of Pomona v. SQM N. Am. Corp.*, 750 F.3d 1036,
2 1049-50 (9th Cir. 2014). ““Where the record taken as a whole could not lead a rational trier of fact
3 to find for the nonmoving party, there is no genuine issue for trial.”” *Id.*

4 Where the plaintiff ultimately bears the burden of proof, the defendant may prevail on a
5 motion for summary judgment by pointing to the plaintiff’s failure “to make a showing sufficient
6 to establish the existence of an element essential to [the plaintiff’s] case.” *Celotex Corp. v.*
7 *Catrett*, 477 U.S. 317, 322 (1986).

8 In contrast, where a plaintiff seeks summary judgment in favor of its own claim, it ““must
9 offer evidence sufficient to support a finding upon every element of [its] claim . . . , except those
10 elements admitted . . . ‘ by the adversary.” *Watts v. United States*, 703 F.2d 346, 347 (9th Cir.
11 1983).

12 As indicated above, in the instant case, Fortinet seeks summary judgment on some of
13 Sophos’s claims (*i.e.*, where Fortinet is the defendant) as well as summary judgment on one of its
14 own claims (*i.e.*, where Fortinet is the plaintiff). More specifically, Fortinet makes the following
15 arguments:

- 16 (1) Sophos is not entitled to pre-suit damages for its ‘587 and ‘347 patents because of its
17 failure to mark;
- 18 (2) Sophos infringes on Fortinet’s ‘430 patent because it has failed to rebut the testimony of
19 Fortinet’s expert;
- 20 (3) Three of Sophos’s patents – the ‘002, ‘050, and ‘687 patents – are invalid based on the
21 un rebutted testimony of Fortinet’s expert;
- 22 (4) Claim 9 of Sophos’s ‘587 patent is either not infringed or invalid.

23 Each of these arguments is addressed below.

24 B. Sophos’s ‘587 and ‘347 Patents – Pre-Suit Damages

25 Title 35 U.S.C. § 287 provides as follows:

26
27 Patentees, and persons making, offering for sale, or selling within
28 the United States any patented article for or under them, . . . may
give notice to the public that the same is patented, either by fixing
thereon the word “patent” or the abbreviation “pat.”, together with

1 the number of the patent, or by fixing thereon the word “patent” or
2 the abbreviation “pat.” together with an address of a posting on the
3 Internet, accessible to the public without charge for accessing the
4 address, that associates the patented article with the number of the
5 patent, or when, from the character of the article, this cannot be
6 done, by fixing to it, or to the package wherein one or more of them
7 is contained, a label containing a like notice. In the event of failure
8 so to mark, no damages shall be recovered by the patentee in any
9 action for infringement, except on proof that the infringer was
10 notified of the infringement and continued to infringe thereafter, in
11 which event damages may be recovered only for infringement
12 occurring after such notice. Filing of an action for infringement
13 shall constitute such notice.

14 35 U.S.C. § 287(a).

15 Here, Fortinet argues that Sophos is not entitled to pre-suit damages on two of its patents
16 (the ‘587 and ‘347 patents) because it failed to mark in compliance with the statute. As the Court
17 held in its order on Sophos’s summary judgment motion, the patentee generally has the burden of
18 pleading and proving compliance with § 287 (*i.e.*, actual or constructive notice), but, where the
19 predicate issue is whether the patentee’s product practices the claimed invention in the first place,
20 the accused infringer has the burden of production which, if met, then shifts the burden of
21 persuasion to the patentee.

22 Here, Fortinet has met its burden of production by pointing to evidence that Sophos
23 practices the inventions claimed in the ‘587 and ‘347 patents. That evidence consists of Sophos’s
24 own infringement contentions and interrogatory responses. As Fortinet has met its burden of
25 production, then the burden of persuasion shifts to Sophos to show that its products do not practice
26 the claimed inventions or that it did mark the products. Sophos has failed to do either, and
27 therefore Fortinet is entitled to summary judgment – *i.e.*, there should be no pre-suit damages for
28 Sophos, should it prevail, on the ‘587 and ‘347 patents.

29 In its opposition brief, Sophos contends that summary judgment is appropriate only if
30 Fortinet concedes that the Sophos products practice the claimed inventions or this Court rules as a
31 matter of law that Sophos practices the claimed inventions. *See* Opp’n at 2. According to Sophos,
32 without such a concession or ruling, there is an issue of fact for the jury to decide. This argument
33 lacks merit for the reasons stated above. *See U.S. Ethernet Innovations, LLC*, No. C 10-3724 CW,
34 2013 U.S. Dist. LEXIS 116640 (N.D. Cal. Aug. 16, 2013) at *51-53 (noting that “Movants offered

1 evidence that the marking requirement was not met and thus the burden shifted to USEI to raise an
2 issue of fact to preclude summary judgment[;] [i]t cannot meet its burden to do so simply through
3 argument unsupported by evidence”). In any event, the Court also notes that, in its reply brief,
4 Fortinet essentially stated that, although it need not make a concession, it is willing to do so. *See*
5 Reply at 2-3 (“[W]hile no concession is necessary from Fortinet, Fortinet agrees that it will not
6 dispute before the jury Sophos’s position that Sophos sold unmarked ‘patented articles’ under the
7 ‘587 and ‘347 patents before asserting those those patents against Fortinet in this case.”).

8 Accordingly, on this issue of pre-suit damages, the Court grants Fortinet summary
9 judgment.

10 C. Fortinet’s ‘430 Patent – Infringement

11 One of Fortinet’s patent infringement claims is based on the ‘430 patent. Fortinet
12 contends that it is entitled to summary judgment that Sophos infringes on the ‘430 patent because
13 Fortinet provided an expert report (from Angelos Stavrou) detailing how Sophos infringes, *see*
14 *generally* Stavrou Decl., but Sophos failed to provide an expert report to the contrary. Fortinet
15 notes that, although there is an expert report from Sophos (from Frederick Cohen), *see*
16 Cunningham Decl., Ex. P (Cohen report), which is titled “Expert Report . . . Regarding Non-
17 Infringement”), the substance of that report is about invalidity only, not infringement.

18 In its opposition, Sophos’s argument boils down to the contention that it cannot be said to
19 infringe the ‘430 patent because it is invalid, and therefore summary judgment is not proper. *See*
20 Opp’n at 4 (“It is axiomatic that one cannot infringe an invalid patent.”) (quoting *Richdel, Inc. v.*
21 *Sunspool Corp.*, 714 F.2d 1573, 1580 (Fed. Cir. 1983)).

22 Sophos’s position lacks merit. Fortinet is not asking this Court to make a liability
23 determination on the ‘430 patent. Rather, Fortinet is just asking for partial summary judgment to
24 dispose of the issue of infringement. That does not bar Sophos from still arguing that the ‘430
25 patent is invalid (which would preclude liability); it simply prevents Sophos from taking the
26 position that it does not practice the invention claimed in the ‘430 patent. As Fortinet notes in its
27 reply, it is not uncommon for courts to render partial summary judgment on infringement. *See,*
28 *e.g., Apple, Inc. v. Samsung Elecs. Co.*, No. 12-CV-00630-LHK, 2014 U.S. Dist. LEXIS 8157, at

1 *156 (N.D. Cal. Jan. 21, 2014) (granting Apple’s motion for summary judgment of infringement
2 of the ‘172 patent).

3 Accordingly, the Court grants Fortinet summary judgment on infringement of the ‘430
4 patent, although this ruling does not bar Sophos from contesting the validity of the patent.

5 D. Sophos’s ‘002, ‘050, and ‘687 Patents – Invalidity

6 For three of the patents asserted by Sophos – i.e., the ‘002, ‘050, and ‘687 patents –
7 Fortinet argues that it is entitled to summary judgment because Sophos never served an expert
8 report on infringement and then failed to respond to Fortinet’s expert’s report on invalidity. See
9 Mot. at 14; see also note 2, supra.

10 Fortinet presented the above argument in its opening brief filed on September 7, 2015.
11 Sophos’s opposition brief was due on September 18, 2015. On September 17, 2015 (at 12:55
12 p.m., to be precise) – i.e., the day before its opposition brief was to be filed – Sophos offered
13 Fortinet a covenant not to sue on the three patents. See Jaffe Reply Decl., Exs. 6-7 (e-mail and
14 letter). Sophos argues that, in light of the covenant, this Court no longer has jurisdiction over the
15 patent infringement claims. See *Super Sack Mfg. v. Chase Pkg. Corp.*, 57 F.3d 1054, 1058-59
16 (Fed. Cir. 1995) (evaluating whether a covenant not to sue on patents extinguished an actual
17 controversy between the parties).

18 In its reply brief, Fortinet argued that the covenant not to sue is insufficient to divest this
19 Court of jurisdiction. At the hearing, the Court echoed some of Fortinet’s concerns, which led to
20 Sophos essentially offering a covenant not to sue with additional terms. As Sophos has now
21 offered this covenant not to sue – which is irrevocable and covers both direct and indirect
22 infringement, currently existing and past products and even certain future products, and extends
23 even to customers, see Docket No. 286 (notice of covenant not to sue) – this Court no longer has
24 jurisdiction over Sophos’s claims and Fortinet’s counterclaims on the three patents. All claims
25 related to the three patents at issue are therefore dismissed. The dismissal is with prejudice. At
26 the hearing, Sophos did not dispute that a dismissal with prejudice would be appropriate given a
27 sufficient covenant not to sue.

28 ///

1 E. Sophos’s ‘587 Patent – Noninfringement or Invalidity

2 The final issue for the Court is whether Fortinet is entitled to summary judgment of
3 noninfringement and/or invalidity on claim 9 of Sophos’s ‘587 patent. Claim 9 reads as follows:

- 4
- 5 9. A data processing system comprising a plurality a plurality
6 of data processors interconnected as a network, and
7 comprising:
8 means in a first data processor of the network for providing a
9 second data processor of the network with a copy of an item
10 of data which is stored for access by the first data processor;
11 storage means for access by the second data processor for
12 storing a set of information defining data of a plurality of
13 characteristic forms that are indicative of invalidity[;]
14 means in the second data processor for testing for the
15 presence of any of the characteristic forms, in the item of
16 data, and generating a validity signal indicative of whether
17 data of any of the characteristic forms has been detected in
18 the item of data; and
19 means for transmitting the validity signal to the first data
20 processor to indicate whether it may allow access to the item
21 of data.

22 ‘587 patent, claim 9. As indicated by the language above, claim 9 is a means-plus-function
23 claim.¹

24 1. Noninfringement

25 In its noninfringement argument, Fortinet seems to assume that the specification for the
26 ‘587 patent describes the structures which perform the specified functions in claim 9. Fortinet
27 argues, however, that Sophos has failed to point to any structure in the accused Fortinet products
28 that perform the specified functions.

The Court has reviewed the report of Sophos’s expert, Robert Stillerman, which is the
main evidence tendered by Sophos to support its claim of infringement. Based on that report, *see*
Cunningham Reply Decl., Ex. A (Stillerman Report ¶¶ 102, 103-16, 174-85), the Court concludes

¹ While Sophos makes a passing suggestion that the claim is not a means-plus-function claim, *see*
Opp’n at 8 (stating that “the Court has neither evaluated nor determined whether these limitations
should be interpreted as ‘means-plus-function’”), its opposition brief effectively treats the claim as
a means-plus-function claim.

1 that Sophos has sufficiently raised a genuine dispute of material fact regarding infringement. The
2 Court rejects Fortinet’s contention that “Mr. Stillerman does not (anywhere in his report) explain
3 how Fortinet’s accused products have an identical or equivalent structure to these four means-
4 plus-function terms.” Mot. at 23; *see also* Reply at 10 (arguing that Mr. Stillerman’s expert report
5 does not “map[] any corresponding structure or claimed function from claim 9 of the ‘587 patent
6 to anything in Fortinet’s products”). For example, for the means-plus-function limitation “storage
7 means for access by the second data processor for storing a set of information defining data of a
8 plurality of characteristic forms that are indicative of invalidity,” Mr. Stillerman identifies the
9 following structure in Fortinet’s products: [REDACTED]

10 [REDACTED]
11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED]

17 Accordingly, the Court denies Fortinet’s motion for summary judgment on
18 noninfringement.

19 2. Invalidity

20 The Court now turns to invalidity.² According to Fortinet, the first means-plus-function
21 limitation above – *i.e.*, “means in a first data processor . . . for providing a second data processor . .
22 . with a copy” – is invalid because it is indefinite. The party claiming indefiniteness has the
23 burden of establishing such by clear and convincing evidence. *See TecSec v. Int’l Bus Machines*
24 *Corp.*, 731 F.3d 1336, 1349 (Fed. Cir. 2013).

25
26 _____
27 ² As to invalidity, the Court ordered the parties to provide supplemental briefing. After the parties
28 filed their cross-briefs, Fortinet asked for leave to file a brief in response to Sophos’s supplemental
brief. *See* Docket No. 298 (motion). Sophos opposed the motion. While the Court is not
unsympathetic to Sophos’s opposition, the Court shall grant Fortinet’s motion, especially as
Sophos’s opposition addresses the merits of Fortinet’s responsive brief.

1 Generally, “[t]he definiteness requirement focuses on whether ‘a patent’s claims, viewed in
2 light of the specification and prosecution history, inform those skilled in the art about the scope of
3 the invention with reasonable certainty.’” *Id.* For a means-plus-function claim, there must be
4 corresponding structure, material, or acts described in the specification or the claim will be
5 deemed indefinite. *See Media Rights Techs., Inc. v. Capital One Fin. Corp.*, No. 2014-1218, 2015
6 U.S. App. LEXIS 15767, at *16 (Fed. Cir. Sept. 4, 2015); *see also See Williamson v. Citrix*
7 *Online*, 792 F.3d 1339, 1347 (Fed. Cir. 2015) (en banc) (noting that, means-plus-function claiming
8 allows “patentees to express a claim limitation by reciting a function to be performed rather than
9 by reciting structure for performing that function, [but] plac[es] specific constraints on how such a
10 limitation is to be construed, namely, by restricting the scope of coverage to only the structure,
11 materials, or acts described in the specification as corresponding to the claimed function and
12 equivalents thereof”); *Saffran v. Johnson & Johnson*, 712 F.3d 549, 562 (Fed. Cir. 2013) (stating
13 that the “‘duty to link or associate structure to function is the quid pro quo for the convenience of
14 employing § 112, ¶ 6”).

15 Whether a claim is indefinite or definite is a question of law. *See DDR Holdings, LLC v.*
16 *Hotels.com, L.P.*, 773 F.3d 1245, 1260 (Fed. Cir. 2014). But while “[i]ndefiniteness is . . . a legal
17 determination arising out of the court’s performance of its duty construing the claims,” “[I]ike
18 enablement, definiteness, too, is amenable to resolution by the jury where the issues are factual in
19 nature.” *BJ Servs. Co. v. Halliburton Energy Servs.*, 338 F.3d 1368, 1372 (Fed. Cir. 2003).

20 In the instant case, Fortinet asserts that the first means-plus-function limitation in claim 9
21 is indefinite because it lacks corresponding structure for the claimed function. As indicated above,
22 to evaluate this argument, the Court must consider the specification for the ‘587 patent to
23 determine if there is corresponding structure. According to Sophos, the corresponding structure
24 identified in the specification “is ‘any of the workstations 2-A, 2-B, or 2-C.’” Opp’n at 9; *see also*
25 ‘587 patent, col. 3:39-41 (“FIG. 1 shows a data processing system in the form of a network
26 including data processors configured as a file server 1 and workstations 2a, 2b and 2c.”) (emphasis
27 added).

28 Workstations are, in essence, computers. Sophos admits that, in *Aristocrat Technologies*

1 *Australia Pty Ltd. v. International Game Technology*, 521 F.3d 1328 (Fed. Cir. 2008), the Federal
2 Circuit stated, “[i]n cases involving a computer-implemented invention in which the inventor has
3 invoked means-plus-function claiming, this court has consistently required that the structure
4 disclosed in the specification be more than simply a general purpose computer or microprocessor.”
5 *Id.* at 1333. This is because “[f]or a patentee to claim a means for performing a particular function
6 and then to disclose only a general purpose computer as the structure designed to perform that
7 function amounts to pure functional claiming.” *Id.* “[I]n a means-plus-function claim ‘in which
8 the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm,
9 the disclosed structure is not the general purpose computer, but rather the special purpose
10 computer programmed to perform the disclosed algorithm.’” *Id.*

11 While Sophos concedes the holding in *Aristocrat*, it points out that the Federal Circuit has
12 also held that a general purpose computer or microprocessor *can* serve as sufficient structure
13 where the claimed function can be done *without* special programming. Sophos cites, *inter alia*,
14 *Katz Interactive Call Processing Patent Litigation v. American Airlines, Inc.*, 639 F.3d 1303 (Fed.
15 Cir. 2011), and *EON Corp. IP Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616 (Fed. Cir.
16 2015).

17 In *Katz*, the lower court held that “claims directed to a ‘means for processing’ were
18 indefinite” under *Aristocrat* because “the specifications of each of the patents at issue disclosed
19 only general purpose processors and did not disclose the algorithms that those processors used to
20 perform the recited functions.” *Katz*, 639 F.3d at 1314. On appeal, the Federal Circuit agreed that
21 some of the claims were indefinite. For example, certain claims “recite[d] a ‘processing means . . .
22 for receiving customer number data entered by a caller and for storing the customer number data .
23 . . . and based on a condition coupling an incoming call to the operator terminal, the processing
24 means visually displaying the customer number data.’” *Id.* The Federal Circuit explained that the
25 claims were indefinite because they did “not disclose an algorithm that corresponds to the ‘based
26 on a condition coupling an incoming call to the operator terminal’ function.” *Id.*

27 The court, however, went on to reject the indefiniteness conclusion reached by the district
28 court for other claims. More specifically, the district court had interpreted *Aristocrat* “too

1 broadly” by understanding *Aristocrat* to mean that the specification in a patent must disclose an
2 algorithm for any recited function performed solely or predominantly by a general purpose
3 computer. *Id.* at 1315-16.

4
5 [T]hat interpretation of our prior cases [including *Aristocrat*] is too
6 broad. Those cases involved specific functions that would need to
7 be implemented by programming a general purpose computer to
8 convert it into a special purpose computer capable of performing
9 those specified functions. By contrast, in the seven claims identified
10 above, Katz has not claimed a specific function performed by a
11 special purpose computer, but has simply recited the claimed
12 functions of “processing,” “receiving,” and “storing.” *Absent a*
13 *possible narrower construction of the terms “processing,”*
14 *“receiving,” and “storing,”* discussed below, those functions can be
15 achieved by any general purpose computer without special
16 programming. As such, it was not necessary to disclose more
17 structure than the general purpose processor that performs those
18 functions. Those seven claims do not run afoul of the rule against
19 purely functional claiming, because the functions of “processing,”
20 “receiving,” and “storing” are coextensive with the structure
21 disclosed, i.e., a general purpose processor.

22 *Id.* at 1316 (emphasis added).

23
24 Ultimately, the Federal Circuit remanded to the district court to determine what the terms
25 “processing,” “receiving,” and “storing” meant. “Based on its construction, the district court can
26 then determine whether the functions recited in those seven contested claims can be performed by
27 a general purpose processor or, instead, constitute specific computer-implemented functions as to
28 which corresponding algorithms must be disclosed.” *Id.* at 1317.

29
30 In *EON*, the Federal Circuit expanded on the exception to the algorithm rule created in
31 *Katz*. It noted that, since *Katz*, it had analyzed the exception only once and found that it did not
32 apply.

33
34 The *Ergo* court explained that “[i]t is only in the rare circumstances
35 where any general-purpose computer without any special
36 programming can perform the function that an algorithm need not be
37 disclosed.” The court found that an algorithm was needed to lend
38 sufficient structure to the terms at issue because “[t]he EON ‘control
39 means’ at issue in this case cannot be performed by a general-
40 purpose computer without any special programming. The function
41 of ‘controlling the adjusting means’ requires more than merely
42 plugging in a general purpose computer.”

1 *EON*, 785 F.3d at 621.

2 The Federal Circuit then went on to emphasize that “special programming” had nothing to
3 do with how complex or simple the function was to implement. *See id.* at 623 (stating that
4 “‘special programming’ does not denote a level of complexity” and that “the district court erred in
5 holding that ‘special programming’ does not encompass commercially available off-the-shelf
6 software”).

7
8 To the contrary, . . . “special programming” includes any
9 functionality that is not ‘coextensive’ with a microprocessor or
10 general purpose computer. In other words . . . the general purpose
11 computer becomes a special purpose computer when loaded with the
12 special programming, so a general purpose computer or
13 microprocessor no longer lends sufficient structure to the claim. . . .
14 A microprocessor or general purpose computer lends sufficient
15 structure only to basic functions of a microprocessor. All other
16 computer-implemented functions require disclosure of an algorithm.

17 *Id.*

18 Finally, the Federal Circuit rejected the contention that “a microprocessor can serve as
19 sufficient structure for a software function if a person or ordinary skill in the art could implement
20 the software function” because that argument improperly conflated the definiteness requirement in
21 35 U.S.C. § 112 with the enablement requirement in the statute. *Id.* at 623-24. The court
22 elaborated: “[A] person of ordinary skill in the art plays no role whatsoever in determining
23 whether an algorithm must be disclosed as structure for a functional claim element.” *Id.* at 623.

24 “[O]ur case law regarding special purpose computer-implemented
25 means-plus-functions claims is divided into two distinct groups:
26 First, cases in which the specification discloses no algorithm; and
27 second, cases in which the specification does disclose an algorithm
28 but a defendant contends that disclosure is inadequate.” Where the
specification discloses no algorithm, the skilled artisan’s knowledge
is irrelevant. Where the specification discloses an algorithm that the
accused infringer contends is inadequate, we judge the disclosure’s
sufficiency based on the skilled artisan’s perspective.

29 *Id.* at 623-24. In *EON* itself, the parties agreed that the specification of the patent at issue
30 disclosed no algorithms, “so this case falls in the first category, in which the skilled artisan’s
31 knowledge is irrelevant.” *Id.* at 624.

1 Ultimately, the *EON* court held that there was no clear error in any of the district court’s
2 factual findings, “based on expert testimony, that each of the eight claim terms at issue recited
3 complicated, customized computer software” – and consequently there was no error in the lower
4 court’s conclusion of indefiniteness either.

5
6 Significantly, EON does not contend on appeal that the terms at issue
7 recite functions that are coextensive with a microprocessor. . . . In
8 fact, EON cites to testimony from its expert that a person skilled in
9 the art would need to consult algorithms outside the specification to
10 implement the claimed functions. Similarly, based on expert
11 testimony, the district court found that “special code would have to
12 be written in order to accomplish the claimed functionality.”

13 *Id.*

14 In its supplemental briefing, Sophos argues that the claimed function in the first means-
15 plus-function limitation of claim 9 falls within the *Katz/EON* exception to the *Aristocrat* rule –
16 *i.e.*, that the claimed function is something that can be done with a general purpose computer
17 because the claimed function simply involves accessing, processing, and sending. *See* Docket No.
18 297 (Supp. Br. at 3) (“To achieve the claimed function, a standard microprocessor performs the
19 basic functions of ‘accessing’ (to obtain the stored data), ‘processing’ (to provide the item of data
20 to the second processor) and ‘sending’ (transmitting the item of data to the second processor).”).
21 Fortinet contends otherwise. *See* Docket No. 298-1 (Resp. Br. at 2) (“Whether some ‘copying’ in
22 the abstract may fall within *Katz* is not the issue; instead, the issue is whether the specific recited
23 function within Claim 9(a) is a basic function of a microprocessor.”).

24 But for Fortinet to prevail at summary judgment, it must show that there is clear and
25 convincing evidence that the claimed function (*i.e.*, providing a copy from one processor to
26 another) is a function that can only be accomplished through special programming. In contrast to
27 *EON*, where there was expert testimony that the claims at issue recited complicated, customized
28 computer software, here, Fortinet has not offered any evidence, expert or otherwise. This is
especially troubling given that, as *Katz* indicates, copying and sending are arguably functions that
can be accomplished by a general purpose computer. Accordingly, the Court denies Fortinet’s
motion for summary judgment on this issue. This ruling, however, does not bar Fortinet from later

1 arguing indefiniteness (a legal question which may or may not be informed by disputed facts) at
2 trial.

3 The Court acknowledges that Sophos, in its opposition to Fortinet’s motion for summary
4 judgment, has suggested that the Court could sua sponte grant summary judgment in Sophos’s
5 favor. *See* Opp’n at 19; *see also Cool Fuel, Inc. v. Connett*, 685 F.2d 309, 311 (9th Cir. 1982)
6 (stating that, “if one party moves for summary judgment and, at the hearing, it is made to appear
7 from all the records, files, affidavits and documents presented that there is no genuine dispute
8 respecting a material fact essential to the proof of movant’s case and that the case cannot be
9 proved if a trial should be held, the court may sua sponte grant summary judgment to the non-
10 moving party”). But the Court refuses to do so for several reasons. First, Sophos could have, but
11 did not, move for summary judgment on the affirmative defense of indefiniteness in its own
12 motion for summary judgment. Second, while copying and sending are arguably functions that
13 can be accomplished by a general purpose computer, it is not clear that that is the case here.
14 Notably, even in *Katz*, the Federal Circuit remanded so that a determination could be made as
15 whether the functions recited in the contested claims could actually be performed by a general
16 purpose computer. *See Katz*, 639 F.3d at 1317. Sophos has not demonstrated on the present
17 record that it is entitled to summary judgment.

18 The Court also acknowledges Sophos’s argument that, even if the *Aristocrat* rule is
19 applicable, it should still prevail because expert testimony (whether from its own expert, *see* Jaffe
20 Decl., Ex. 16 (Stillerman Report ¶¶ 176, 131), or from Fortinet’s,³ *see* Cunningham Decl., Ex. O
21 (Crovella Depo. at 88-89)) establishes that a person of ordinary skill in the art would find
22 corresponding structure. But, as explained in *EON*, expert testimony can only “fill in the blanks”
23 where there is a *partially disclosed* algorithm; it cannot be relied upon in the absence of any
24 disclosure of an algorithm. *See Noah Sys. Inc. v. Intuit Inc.*, 675 F.3d 1302, 1313 (Fed. Cir. 2012)
25 (noting that, “[w]here no structure appears, the question ‘is not whether the algorithm that was

26 _____
27 ³ Contrary to what Sophos suggests, it is not clear from the deposition of Fortinet’s expert that he
28 found no indefiniteness problem. Dr. Crovella stated, for example, that “I had difficulty
identifying the structure” and “that was the best structure I could come up with.” Cunningham
Decl., Ex. O (Crovella Depo. at 88-89).

1 disclosed was described with sufficient specificity, but whether an algorithm was disclosed at
2 all’[;] [w]hen the specification discloses some algorithm, on the other hand, the question is
3 whether the disclosed algorithm, from the viewpoint of a person of ordinary skill, is sufficient to
4 define the structure and make the bounds of the claim understandable”).

5 As for Sophos’s suggestion that the specification contains at least a partially disclosed
6 algorithm, *see* Docket No. 297 (Supp. Br. at 4) (asserting that “any of workstations 2a-2c, which
7 include communication means 8 and storage means 6, is the structure corresponding to ‘providing
8 a second data processor of the network with a copy of an item of data which is stored for access by
9 the first data processor’”), the Court does not agree. The Court finds the PTAB’s analysis during
10 the IPR proceedings – although not binding in any way⁴ – persuasive.

11 The PTAB decision cited by Fortinet can be found at Exhibit 18 to the Jaffe declaration.
12 The relevant portion of the decision is as follows:

13
14 Claim 9 recites “means in a first data processor of the
15 network for providing a second data processor of the network with a
16 copy of an item of data which is stored for access by the first data
17 processor.” . . .

18 The written description of the ‘587 patent discloses that “the
19 first data processor is a workstation of the network,” while “the
20 second data processor is a file server of the network.” Petitioner
21 directs us to the written description which further discloses that a
22 workstation of the network includes “storage means 6, data
23 processing means 7 and communication means 8 for communication
24 with the file server.”

25 Petitioner contends that “[t]he corresponding structure for
26 this [means-plus-function] limitation is the data processing system,
27 including communications means 8 within workstations 2a, 2b, 2c in
28

23 ⁴ As Sophos points out, the PTAB was not asked to invalidate based on indefiniteness, *see* Jaffe
24 Decl., Ex. 18 (PTAB Decision at 5) (taking note of contention that claims were unpatentable under
25 35 U.S.C. §§ 102 and 103), nor could it technically do so during inter partes review. *See* 35
26 U.S.C. § 311(b) (providing that “[a] petitioner in an inter partes review may request to cancel as
27 unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102
28 or 103 and only on the basis of prior art consisting of patents or printed publications”). *But see*
Inter Partes Review And Indefinite Claims (Apr. 6, 2015), available at
<http://www.law360.com/articles/630498/inter-partes-review-and-indefinite-claims> (last visited
October 16, 2015) (noting that “a petitioner requesting IPR must proposed how the challenged
claim(s) should be construed,” and “[t]hree PTAB panels, with no overlapping administrative
judges between the panels, have now denied or terminated IPR proceedings on the ground that the
claims could not be construed because they were indefinite”).

1 Fig. 1 . . . and box 13 of Fig. 2a.” We are unpersuaded by
2 Petitioner’s contention in this regard. First, Petitioner does not
3 identify any portion of the written description that offers guidance as
4 to the structure of the communication means 8 or the structure for
5 performing the function recited in box 13 (i.e., “copy the item to a
6 central server where it will be scanned for data of characteristic
7 forms”). Second, the written description links the communication
8 means 8 to the function of communicating with the file server, not
9 the function of providing the file server with a copy of an item of
10 data. Finally, Petitioner does not direct us to any disclosure in the
11 written description of structure that is linked to the function of
12 providing the file server with a copy of an item of data. Nor can we
13 identify such disclosure.

14 Based on the record before us, we determine that claim 9 is
15 not amenable to construction because the Specification does not
16 disclose structure that performs the function of providing a second
17 data processor of the network with a copy of an item of data which
18 is stored for access by the first data processor.

19 Jaffe Decl., Ex. 18 (PTAB Decision at 8-10).

20 II. CONCLUSION

21 For the foregoing reasons, the Court grants in part and denies in part Fortinet’s motion for
22 summary judgment. More specifically, the Court rules as follows:

- 23 (1) Fortinet’s motion is granted with respect to the issue of pre-suit damages for Sophos’s ‘587
24 and ‘347 patents.
- 25 (2) Fortinet’s motion is granted with respect to the issue of infringement of Fortinet’s ‘430
26 patent.
- 27 (3) Fortinet’s motion is denied with respect to Sophos’s ‘002, ‘050, and ‘687 patents, but (in
28 light of the covenant) all claims and counterclaims regarding the patents are dismissed with
prejudice.

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(4) Fortinet’s motion is denied with respect to claim 9 of the ‘587 patent (indefiniteness). Sophos’s request that this Court sua sponte grant summary judgment in its favor is likewise denied.

This order disposes of Docket No. 218.

IT IS SO ORDERED.

Dated: October 28, 2015



EDWARD M. CHEN
United States District Judge