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 15 FINJAN, INC.

16 **IN THE UNITED STATES DISTRICT COURT**
 17 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**
 18 **SAN FRANCISCO DIVISION**

19 FINJAN, INC., a Delaware Corporation,

20 Plaintiff,

21 v.

22 JUNIPER NETWORKS, INC., a Delaware
 23 Corporation,

24 Defendant.

Case No.: 3:17-cv-05659-WHA

**PLAINTIFF FINJAN, INC.'S LETTER
 BRIEF REGARDING MOTION TO
 COMPEL**

Date: July 5, 2018
 Time: 8:00 a.m.
 Courtroom: 12, 19th Floor
 Before: Hon. William H. Alsup

1 Plaintiff Finjan, Inc. (“Finjan”) moves to compel Juniper Networks, Inc. (“Juniper”) and its
2 counsel to comply with Local Rule 11-4 and engage in a meaningful meet and confer regarding the
3 parties’ Stipulated Protective Order, consistent with Juniper’s counsel’s other representations of
4 plaintiff-patentees. In the alternative, Finjan seeks an Order clarifying the scope of the Interim
5 Model Protective Order (“Model PO”) to permit Paul Andre (CA Bar 196585), James Hannah
6 (CA Bar 237978), Michael Lee (CA Bar 264592), and Jeff Price (NY Bar 5171350) (“Counsel”)
7 to participate in *inter partes* review (“IPR”) provided they will not draft or amend patent claims.

8 On May 10, 2018, the Court rejected the parties’ “stipulated” proposed protective order,
9 which contained competing provisions, finding “no good reason to deviate from the [Model PO]”
10 and instructed the parties to jointly agreed on a proposal. Dkt. No. 83. Since then, Finjan has
11 attempted to meet and confer by phone and email with Juniper to prepare a Stipulated Protective
12 Order. Declaration of James Hannah in Support of Finjan, Inc.’s Letter Brief Regarding Motion
13 to Compel (“Hannah Decl.”) filed herewith, ¶ 3. It has become apparent, however, that the
14 parties’ interpretations of the Model PO vary greatly. Finjan’s interpretation is consistent with the
15 Model PO’s plain language, which issued before the America Invents Act introduced IPRs and
16 was never amended to bar IPRs alongside other prosecution activities. Unlike prosecution, IPRs
17 only allow a patentee to narrow its claims. 35 U.S.C. §§ 305, 314; 37 C.F.R. § 1.530(j). Thus,
18 the prosecution bar should not apply to Finjan’s trial counsel because the PO does not address
19 IPRs, and the typical risk associated with prosecution does not apply when counsel cannot use
20 confidential information from litigation to broaden a patentee’s rights through PTO proceedings.

21 Contrary to the plain language of the Model PO, Juniper insists that counsel involved in
22 Cisco Systems, Inc. pending IPR against Finjan regarding the ‘633 Patent (IPR2018-00391) must
23 not have access to any of Juniper’s confidential information. To that end, Juniper has refused to
24 engage in any meaningful meet and confer regarding mutually acceptable language for a
25 Stipulated Protective Order. To overcome the impasse, Finjan proposed clarifying language that
26 prohibits litigation counsel who view confidential information to participate in IPRs if there are
27 any amendments to the claims during the proceedings. This language is consistent with District
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28 precedent of this District’s Protective Orders in Finjan’s cases, and Orders that Juniper’s

1 counsel, Irell & Manella LLP, has agreed to in cases in which it represents plaintiff-patentees.
2 *See, e.g., Grobler v. Apple Inc.*, No. C 12-01534 JST (PSG), 2013 WL 3359274, at *2 (N.D. Cal.
3 May 7, 2013)(holding that litigation counsel may participate in IPRs, but not draft or amend
4 claims); *EPL Holdings, LLC v. Apple Inc.*, No. 12-cv-04306 JST (JSC), 2013 WL 2181584, at *4
5 (N.D. Cal. May 20, 2013)(same); Hannah Decl., ¶¶ 4-5.

6 Regardless, Juniper refused to dialogue about language addressing IPRs for the Stipulated
7 Protective Order, claiming that “it cannot think of any language” that would satisfy its concerns,
8 chiefly because it “did not think it was possible” for counsel to avoid adjusting the scope of
9 claims in IPR. *Id.*, ¶ 2, Ex. 1 at 4. Not only has this District held otherwise (see *supra*), but Irell
10 & Manella LLP has been both plaintiff and IPR counsel in at least 7 cases in the last 3 years—
11 none of which prohibited IPR participation, and at least 2 of which expressly allowed counsel to
12 make “submissions to and appearances at the [post-grant] proceeding, formulate reasons and
13 argue for patentability of such claim amendments”: (1) *B/E Aerospace v. Zodiac Aerospace*; (2)
14 *Fraunhofer-Gesellschaft v. Sirius XM*; (3) *FISI v. LG*; (4) *FISI v. Samsung*; (5) *FISI v. ZTE*; (6)
15 *Immersion v. Apple*; (7) *Kaist IP v. Samsung*. Hannah Decl., ¶¶ 6-7, Exs. 2-3. When Finjan
16 alerted Juniper of its inconsistent position, it ignored Finjan’s request. Thus, Finjan is forced to bring
17 this issue to the Court’s attention, to require that Juniper’s counsel practice with appropriate decorum
18 and fairness when it finds itself on the other side of the table. N.D. Cal. L.R. 11-4.

19 To the extent the Court interprets the Model PO to preclude litigation counsel with access
20 to confidential information from participating in IPRs, good cause exists to modify it to allow
21 Finjan’s Counsel to participate. First, the modification is narrowly tailored to four attorneys that
22 view Juniper’s confidential information. Moreover, Finjan has already represented that Counsel
23 will not amend patent claims in IPRs. This concession alone should alleviate Juniper’s concerns:
24 “if the PTO and district court are just two fronts in the same battle, allowing a limited role for
25 litigation counsel while prohibiting counsel from crafting or amending claims is only reasonable.”
26 *Grobler*, 2013 WL 3359274, at *2. This District has routinely recognized that patentees such as
27 Finjan would suffer significant injury, and defendants like Juniper may profit from an unfair

28 advantage if choice of counsel was restricted in IPR, causing additional cost and duplicative

1 preparation. *Software Rights Archive, LLC v. Facebook, Inc.*, No. 5:12-cv-03970-RMW-PSG,
2 2014 WL 116366, at *3 (N.D. Cal. Jan. 13, 2014)(holding that litigation counsel may participate
3 in IPRs, as there is danger in permitting a party to “box-out” another party’s chosen counsel);
4 *LifeScan Scotland, Ltd. v. Shasta Techs., LLC*, No. 11-cv-04494-WHO, 2013 WL 5935005, at *5
5 (N.D. Cal. Nov. 4, 2013)(holding that an IPR ban causes unwarranted expense, and a limited role
6 is sufficient protection); *Shared Memory Graphics, LLC v. Apple, Inc.*, No. C-10-2475 VRW
7 (EMC), 2010 WL 4704420, at * 4 (N.D. Cal. Nov. 12, 2010)(allowing participation in
8 reexamination proceedings with an affirmation of no misuse of confidential information). Finally,
9 good cause exists here because Finjan’s trial counsel is already participating in several IPRs that
10 do not involve Juniper.

11 Finally, there is no risk to Juniper if Finjan’s Counsel also participates in a limited role in
12 IPRs. Each of Finjan’s patents has been through several IPRs; the record has largely been set
13 prior to Juniper’s involvement. Also, Finjan has numerous litigations in this District; there is no
14 reason to believe that Finjan would somehow tailor its validity arguments to Juniper, and Finjan is
15 statutorily prohibited from broadening its claims in IPR to cover **any** defendant’s accused product.
16 Further, it is presumed that counsel’s obligations of confidentiality are sufficient protection
17 against misuse. *X One, Inc. v. Uber Techs., Inc.*, No. 16-cv-06050-LHK (SVK), 2017 WL
18 1020982, at *3-4 (N.D. Cal. Mar. 16, 2017) (holding that counsel’s confidentiality obligations
19 sufficiently protect against the risk of use of confidential information in IPRs); *see also Grobler*,
20 2013 WL 3359274, at *2 (“the risk of counsel ignoring its duties is inherent even under
21 [Juniper’s] proposed total ban, and in any event counsel is presumed to follow its obligations to
22 adhere to this court’s orders.”). Thus, good cause exists to allow a reasonably limited role for
23 Finjan’s Counsel in IPRs.

24 For these reasons, Finjan requests the Court to compel Juniper and its counsel to comply with
25 Local Rule 11-4 by participating in the drafting of a Stipulated Protective Order consistent with
26 Juniper’s counsel’s past representations, or alternatively, to order that Finjan’s litigation Counsel may
27 participate in IPR proceedings under the current PO so long as no amendments are made to the claims.

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Respectfully submitted,

Dated: June 22, 2018

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