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12 *Attorneys for Defendant*  
 13 JUNIPER NETWORKS, INC.

14 **UNITED STATES DISTRICT COURT**  
 15 **NORTHERN DISTRICT OF CALIFORNIA**  
 16 **SAN FRANCISCO DIVISION**

17 FINJAN, INC.,	)	Case No. 3:17-cv-05659-WHA
	)	
18 Plaintiff,	)	<b>DEFENDANT JUNIPER NETWORKS,</b>
	)	<b>INC.'S NOTICE OF MOTION AND</b>
19 vs.	)	<b>MOTION FOR LEAVE TO AMEND ITS</b>
	)	<b>ANSWER TO FINJAN, INC.'S SECOND</b>
20 JUNIPER NETWORKS, INC.,	)	<b>AMENDED COMPLAINT FOR PATENT</b>
	)	<b>INFRINGEMENT AND COUNTER-</b>
21 Defendant.	)	<b>CLAIMS</b>
	)	
22	)	
	)	
23	)	Date: November 1, 2018
	)	Time: 8:00 a.m.
24	)	Judge: William Alsup
	)	Courtroom: 12 - 19th Floor

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**NOTICE OF MOTION AND MOTION**

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that on November 1, 2018, at 8:00 a.m., or as soon thereafter as the matter may be heard, in Courtroom 12, 19th Floor, of the San Francisco Courthouse, 450 Golden Gate Avenue, San Francisco, California 94102, before the Honorable Williams Alsup, Defendant Juniper Networks, Inc. (“Juniper”) will and hereby does move for leave to amend its answer and counterclaims to Finjan, Inc.’s (“Finjan”) Second Amended Complaint (“SAC”) for patent infringement. This motion is based on this Notice of Motion, the Memorandum of Points and Authorities, the exhibits attached thereto, the proposed amended answer and counterclaims, all documents in the Court’s file, and such other written or oral argument as may be presented at or before the time this motion is heard by the Court.

**STATEMENT OF RELIEF REQUESTED**

Juniper seeks an order granting its motion for leave to file the proposed amended answer and counterclaims attached hereto, pursuant to the Court’s order dated August 31, 2018. *See* Dkt. No. 190.

**STATEMENT OF ISSUES TO BE DECIDED**

Whether Juniper’s proposed amended answer and counterclaims sufficiently address the issues identified by this Court in its August 31, 2018 Order Granting in Part and Denying in Part Motion to Dismiss Counterclaims and Strike Affirmative Defenses (Dkt. No. 190), and is thus ready to be filed at this time.

**MEMORANDUM OF POINTS AND AUTHORITIES**<sup>1</sup>**I. INTRODUCTION**

On May 18, 2018, Finjan filed its First Amended Complaint (“FAC”) for patent infringement. On June 1, 2018, Juniper filed an answer and counterclaims to the FAC. On June 15, 2018, Finjan filed a motion to dismiss certain of Juniper’s counterclaims and affirmative defenses. On July 27, 2018 Finjan filed its Second Amended Complaint (“SAC”), to which Juniper filed an initial answer and counterclaims on August 10, 2018. Subsequently, on August 31, 2018, this Court denied in part and granted in part Finjan’s motion to dismiss. *See* Dkt. No. 190. Juniper’s initial answer and counterclaims to the SAC asserted the same counterclaims and affirmative defenses that Finjan moved to dismiss<sup>2</sup>.

More specifically, in the August 31, 2018 Order, the Court denied Finjan’s motion to dismiss and strike Juniper’s allegations of unclean hands (Sixth Counterclaim and Tenth Affirmative Defense); granted Finjan’s motion to strike Juniper’s ensnarement defense (Twelfth Affirmative Defense); granted Finjan’s motion to dismiss Juniper’s allegations of prosecution laches (Third Counterclaim and Eleventh Affirmative Defense); and granted Finjan’s motion to dismiss and strike Juniper’s allegations of inequitable conduct related to the ’494 Patent and ’154 Patent (Fourth and Fifth Counterclaims and Fourteenth Affirmative Defense). The Court identified the additional allegations necessary to overcome Finjan’s objections to these counterclaims and affirmative defenses, and allowed Juniper to seek leave to file an amended responsive pleading within 21 calendar days. Juniper now timely moves for leave to amend these affirmative defenses and counterclaims.

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<sup>1</sup> All emphasis is added unless indicated otherwise.

<sup>2</sup> Given that Juniper’s response to the FAC and SAC assert the same counterclaims and affirmative defenses that Finjan moved to dismiss, the redlined copy of the proposed amended responsive pleading attached as Exhibit 4 hereto is relative to Juniper’s initial answer and counterclaims to the SAC.

1 **II. ARGUMENT**

2 **A. Inequitable Conduct (Fourth and Fifth Counterclaims and Fourteenth**  
3 **Affirmative Defense)**

4 To plead a claim of inequitable conduct, a party must allege that “(1) an individual associated  
5 with the filing and prosecution of a patent application made an affirmative misrepresentation of a  
6 material fact . . . or submitted false information; and (2) the individual did so with a specific intent  
7 to deceive the PTO.” *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1327 n.3 (Fed. Cir.  
8 2009). Under Federal Circuit law a breach of the “duty to prosecute patent applications in the Patent  
9 Office with candor, good faith, and honesty” involves affirmative misrepresentations of material  
10 facts “coupled with an intent to deceive [] constitutes inequitable conduct.” *Honeywell Int’l Inc. v.*  
11 *Universal Avionics Sys. Corp.*, 488 F.3d 982, 999 (Fed. Cir. 2007). Further, “knowledge and intent  
12 may be alleged more generally” as long as a party “allege[s] sufficient facts to justify an inference  
13 that a specific individual had knowledge of the material information withheld or the falsity of the  
14 material misrepresentation and withheld or misrepresented that information with the intent to  
15 deceive.” *Oracle Corp. v. DrugLogic, Inc.*, 807 F. Supp. 2d 885, 896-97 (N.D. Cal. 2011); *see also*  
16 *Dkt. No. 190 at 5.*

17 **I. Fourth Counterclaim**

18 Juniper’s Fourth Counterclaim for declaratory judgment of unenforceability of the ’494  
19 Patent due to inequitable conduct is based in part on Juniper’s allegations that named inventor  
20 Shlomo Touboul submitted a false declaration to the USPTO stating that he was the “sole” inventor  
21 on various claims of the ’494 Patent. Touboul submitted this declaration to allow Finjan to claim  
22 an earlier priority date for its patent application—which, in turn, would allow Finjan to overcome  
23 the Examiner’s rejection of the ’494 application based on U.S. Patent No. 5,983,348 to Ji.

24 In the August 31, 2018 Order, the Court held that Juniper “adequately pled the ‘who, what,  
25 when, where, and why’ of Touboul’s alleged misrepresentation” that he was the “sole” inventor of  
26 claims 1, 3-6, 9, 10, 12-15, and 18 of the ’494 Patent, but that Juniper had not pled sufficient facts  
27 to show that Mr. Touboul’s statements were false. *Dkt. No. 190 at 7-8.* In particular, the Court  
28 found that Finjan’s discovery responses in the *Symantec* case—which stated that the other inventors

1 were involved in the conception and reduction to practice of the claims of the '494 Patent—were  
2 not necessarily inconsistent with Mr. Touboul's statement that he was the "sole" inventor of certain  
3 claims because "it is ambiguous whether Finjan admitted that all four of the originally named  
4 inventors had contributed to the conception of claims 10, 14, and 15" of the '494 Patent. *Id.*

5 Juniper now seeks to amend its Fourth Counterclaim to include additional factual allegations  
6 that establish that Mr. Touboul's statement to the USPTO about the inventorship of Claim 10 was  
7 in fact false. Specifically, Juniper now alleges that one of Mr. Touboul's co-inventors—Mr. David  
8 R. Kroll—testified under oath that he contributed to Claim 10 while he was working at Finjan. Mr.  
9 Kroll testified as follows:

10 Q. Great. But you are an inventor on the '494 Patent; Right?

11 A. Yes.

12 Mr. Kroll then testified:

13 Q. Yes. *You helped come up with the idea behind claim 10 during*  
14 *your time at Finjan; is that right?*

15 A. *Yes.*

16 See Dkt. No. 446 (Trial Transcript) at 459:23-24, 460:24-461:1, *Finjan, Inc. v. Blue Coat Sys., Inc.*,  
17 No. 5:15-cv-03295-BLF (N.D. Cal. Nov. 28, 2017) (Ex. 1). Mr. Kroll also testified that he began  
18 his employment at Finjan in 1999, which is at least three years *after* the November 18, 1996 date  
19 that Mr. Touboul submitted in his declaration to the USPTO. Ex. 1 at 451:11-12. Mr. Kroll's sworn  
20 testimony provides additional<sup>3</sup> factual support for Juniper's allegation that Mr. Touboul's  
21 declaration to the USPTO that he was the "sole inventor" of Claim 10 was an affirmative  
22 misrepresentation; if Mr. Kroll's sworn testimony is true, then Mr. Touboul's statement to the  
23 USPTO must be false. Juniper also pleads that Mr. Touboul's misrepresentation was material  
24 because the USPTO would not have withdrawn the Ji reference as prior art but for Mr. Touboul's  
25 false testimony that he was the sole inventor of certain claims of the '494 Patent and that he

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27 <sup>3</sup> Juniper has also added allegations that Mr. Kroll, among others, signed an inventor's oath  
28 declaration stating that he was one of the original and first inventors of the subject matter  
disclosed in U.S. Patent No. 7,058,822, which has a substantially identical specification shared by  
the '494 Patent. These additional factual allegations further bolster the inference that at least Mr.  
Kroll was involved in the invention of claim 10 of the '494 Patent.

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