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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 OPPOSITION
TO DEFENDANT JUNIPER NETWORKS,
INC.'S MOTION FOR LEAVE TO AMEND
ITS ANSWER TO FINJAN, INC'S SECOND
AMENDED COMPLAINT FOR PATENT
INFRINGEMENT AND COUNTER-CLAIMS**

Date: November 1, 2018

Time: 8:00 a.m.

Judge: William Alsup

Courtroom: 12 - 19th Floor

1 Plaintiff Finjan, Inc. ("Finjan") submits this Opposition to Defendant Juniper Networks, Inc.'s
2 ("Juniper") Motion for Leave to Amend its Answer to Finjan's Second Amended Complaint for Patent
3 Infringement and Counterclaims, filed at Dkt. 197 ("Motion").

4 **I. INTRODUCTION**

5 The Court should deny this Motion because Juniper's Amended Answer fails to remedy the
6 deficiencies in its prior allegations. While the Court gave Juniper the opportunity to request leave to
7 amend, the Court also ordered that Juniper "must explain why the new pleading overcomes all
8 deficiencies, including those this order need not reach." *See* Dkt. No. 190. Juniper has not done so.

9 First, Juniper fails to add *any* new facts to support its baseless inequitable conduct accusations
10 against attorney Dawn-Marie Bey. Instead, Juniper doubles down on pure speculation that an officer
11 of the Court must have had intent to deceive, and recasts Ms. Bey's petitions as "unmistakably false"
12 and "egregious misconduct" without any new facts to support such claims. Second, with regard to Mr.
13 Touboul's declaration, Juniper's reliance on a one-word answer given by a lay-person, in response to a
14 vague question that did not call for a legal opinion on inventorship, does not establish that Mr. Touboul
15 himself made any sort of misrepresentation or that he intended to do so. Thus, Juniper's amended
16 allegations of inequitable conduct still do not meet the Federal Circuit's heightened pleading standards
17 for showing a "material misrepresentation" with a specific "intent to deceive."

18 Juniper's amended claim of prosecution laches fares no better. As an initial matter, due to a
19 change in the law on how patent terms are measured there is no longer any incentive for a patentee to
20 delay filing. In any event, the only new facts that Juniper alleges to support its prosecution laches
21 claim concern terminal disclaimers and Finjan's lack of explanation to the PTO, which have nothing to
22 do with unreasonable delay. Juniper's proposed amendments fail to address unreasonable delay or
23 demonstrate any prejudice to Juniper, and are therefore insufficient. Accordingly, the Court should
24 deny Juniper's request for leave to amend its inequitable conduct and prosecution laches claims.¹

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26
27 ¹ Finjan does not oppose Juniper's amendment to the ensnarement doctrine affirmative defense.
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1 **II. STATEMENT OF ISSUE TO BE DECIDED**

2 Whether the Court should deny this Motion where Juniper’s proposed amendments to its
3 allegations of inequitable conduct and prosecution laches do not cure its prior deficiencies.

4 **III. ARGUMENT**

5 **A. Alleged Inequitable Conduct of the ‘494 Patent (Fourth Counterclaim) and ‘154**
6 **Patent (Fifth Counterclaim)**

7 Juniper still does not allege facts showing that Ms. Bey’s statements during prosecution of the
8 ‘494 or ‘154 Patents constitute a misrepresentation, or that Mr. Touboul’s statement—that he is the
9 sole inventor of *certain* claims of the ‘494 Patent—were false. Instead, Juniper doubles down on the
10 same deficiencies in its original answer by continuing to rely on speculation with no evidence showing
11 any false statements were made.

12 **1. Ms. Bey’s Petitions Do Not Contain Any Misrepresentations**

13 Juniper does not plead any new facts to support an allegation that Ms. Bey made any
14 misrepresentations to the PTO during prosecution of the ‘494 or ‘154 Patents. Motion at 5. Rather,
15 Juniper’s proposed amendments merely add the vague allegation that “Ms. Bey has an unusually
16 abundant history of filing petitions to accept ‘unintentionally’ delayed claims of priority” and
17 incorporate by reference its unclean hands counterclaim. Juniper, Ex. 4 at ¶231. This bare insinuation
18 does not provide any factual support for Juniper’s claims. Juniper does not make a single factual
19 allegation that would support an inference that the priority claims were not “unintentionally delayed.”
20 Juniper also fails to explain what an “unusually abundant history” means. Juniper provides no factual
21 support that Ms. Bey’s filing of an unintentionally delayed petition is anything out of the ordinary for a
22 patent prosecutor, particularly one with a docket of hundreds of patents and applications. Ms. Bey’s
23 petitions are allowed under USPTO rules and were considered and accepted by the USPTO. Further,
24 inequitable conduct, which requires pleading with “particularity,” has a higher pleading standard than
25 unclean hands. So merely incorporating by reference Juniper’s preexisting allegations for unclean
26 hands is insufficient to meet the heightened pleading standard for inequitable conduct. *Exergen Corp.*
27 *v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1328 (Fed. Cir. 2009) (“In sum, to plead the ‘circumstances’
28

1 of inequitable conduct with the requisite “particularity” under Rule 9(b), the pleading must identify the
2 specific who, what, when, where, and how of the material misrepresentation or omission committed
3 before the PTO.”).

4 Juniper tries to sidestep its obligation to show but-for materiality by arguing that its inequitable
5 conduct claims fall within an exception to this requirement. While the Federal Circuit has found that
6 but-for proof of materiality is not required in certain “extraordinary circumstances,” Juniper falls far
7 short of pleading facts to show such circumstances here. *Therasense, Inc. v. Becton, Dickinson & Co.*,
8 649 F.3d 1276, 1292–93 (Fed. Cir. 2011). Indeed, Juniper’s pleading is devoid of facts that would
9 show that Ms. Bey’s statements were “unmistakably false” or that she engaged in “an affirmative act
10 of egregious misconduct.” *Id.* Thus this Motion should be denied with regard to Ms. Bey’s alleged
11 inequitable conduct.

12 2. Mr. Touboul’s Declaration Does Not Contain Any Misrepresentations

13 Mr. Kroll’s statements do not provide factual support for Juniper’s claim that Mr. Touboul
14 made any misrepresentation to the PTO. First, the question posed to Mr. Kroll in the *Blue Coat* action
15 was whether he “helped come up with the idea behind claim 10.” Juniper, Ex. 1 at 460:14-15. Mr.
16 Kroll was not asked any questions about Mr. Touboul’s contribution or Mr. Touboul’s declaration. *Id.*
17 There is also no indication that Mr. Kroll, a layperson, understood the question to be related to the
18 legal question of inventorship of a certain claim. Motion at 4. As such, this single statement by a
19 third-party in response to a vague question does nothing to establish that Mr. Touboul himself made
20 any false statement in his declaration to the PTO, or that he had any intent to deceive the PTO.

21 Further, Juniper’s reliance on the declarations submitted for another patent (U.S. Patent No.
22 7,058,822 (the “’822 Patent”)) are a red herring and have no relationship to any purported inequitable
23 conduct for the ‘494 Patent because the declaration for the ‘822 Patent is for entirely different patent
24 claims. Juniper concedes that the ‘822 Patent and ‘494 Patent are not identical, and instead claims that
25 they are purportedly “substantially identical.” Mot. at 4 n.3. The declaration that Juniper refers to was
26 submitted by other inventors of the ‘822 Patent and is related to the claims that were set forth in the
27 ‘822 Patent, with no reference to those in the ‘494 Patent. Juniper, Ex. 4 (First Amended Answer)

¶226; Kastens Decl., Ex. 1 (‘822 Patent – Inventor Declaration). None of the inventors of the ‘822 Patent, including Mr. Kroll, stated in this declaration that they are inventors of Claim 10 of the ‘494 Patent. Thus, this declaration submitted during prosecution of the ‘822 Patent provides no factual support for Juniper’s inequitable conduct claim with respect to the ‘494 Patent.

Again, Juniper cannot sidestep its requirement to show but-for materiality because its allegations do not come close to pleading “an affirmative act of egregious misconduct.” *Therasense*, 649 F.3d at 1292–93. Juniper alleges no facts that establish Mr. Touboul made any untrue statement. Motion at 5. Mr. Touboul simply stated that he is the inventor of certain claims of the ‘494 Patent, and Juniper cites to no statement from Mr. Touboul that contradict his declaration to the PTO or show that it was false. Therefore, because Juniper’s factual allegations are not inconsistent with Mr. Touboul’s declaration, they do not give rise to an inequitable conduct claim.

3. Juniper Still Fails to Allege Specific Intent to Deceive For Any of its Inequitable Conduct Allegations

Juniper still fails to allege with “particularity” under Rule 9(b) that Ms. Bey or Mr. Touboul deliberately withheld or misrepresented material information with the specific intent to deceive the PTO during prosecution of the ‘494 Patent or ‘154 Patent. *Exergen*, 575 F.3d at 1326-27; *Therasense*, 649 F.3d at 1287 (citations omitted). Indeed, “a court must weigh the evidence of intent to deceive independent of its analysis of materiality.” *Id.* Under prevailing law, Juniper must make allegations showing specific intent by specific individuals to deceive the PTO, and must prove that deceptive intent is the “single most reasonable inference able to be drawn from the evidence.” *Id.* at 1290 (citation and internal quotation omitted); *see also Exergen*, 575 F.3d at 1326-27; *see also Zep Solar Inc. v. Westinghouse Solar Inc.*, No. C 11-06493 JSW, 2012 WL 1293873, at *2 (N.D. Cal. Apr. 16, 2012) (granting motion to strike affirmative defense of inequitable conduct); *BlackBerry Ltd. v. Typo Prods. LLC*, No. 14-cv-00023-WHO, 2014 WL 1867009, at *1-4 (N.D. Cal. May 8, 2014) (same).

Juniper’s Motion should be denied because Juniper does not adequately address the “specific intent” element that is required to sufficiently plead inequitable conduct. *See* Dkt. No. 190 at 12 (“The motion must include a proposed amended responsive pleading (and a redlined copy) and must explain

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