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FINJAN, INC.

IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

FINJAN, INC., a Delaware Corporation,

Plaintiff,

v.

JUNIPER NETWORKS, INC., a Delaware Corporation,

Defendant.

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

PLAINTIFF'S FINJAN INC.'S MOTION *IN LIMINE* NO. 2 TO EXCLUDE IMPROPER CLAIM CONSTRUCTION TESTIMONY

Date: December 4, 2018
Time: 9:00 a.m.
Courtroom: Courtroom 12, 19th Floor
Before: Hon. William Alsup

INTRODUCTION

Dr. Rubin should be excluded from providing opinions regarding the construction of claim terms, as these arguments are not proper for the jury to consider, and are therefore irrelevant (FRE 401) and more prejudicial than prohibitive (FRE 403). In particular, Dr. Rubin has disclosed in his expert report that he intends to argue in front of the jury the proper construction of the term "database" and "database schema." Dr. Rubin should also be excluded from providing arguments that the use of "a" or "the" for an article means "one or more" of that article, *i.e.* "a database" should be construed only as a single unified database, as this is contrary to the law of claim interpretation. As such, the Court should exclude Dr. Rubin's rebuttal report and trial testimony because (i) claim construction is a matter of law for the Court, not a question of fact for the jury, and (ii) Dr. Rubin's rebuttal report applies terms in a manner that is inconsistent with the law of claim interpretation.

BACKGROUND

On June 22, 2018, Finjan and Defendant filed a joint claim construction statement pursuant to Patent Local Rule 4-3, where they agreed that "database" would be construed as "a collection of interrelated data organized according to a database schema to serve one or more applications." Dkt. No. 115; *see also* Dkt. No. 224. Juniper confirmed in response to a Request for Admission, that this was the proper construction of "database" in the context of claim 10 of the '494 Patent. Ex. 15[1] at Resp. to RFA No. 1. Despite this apparent agreement between the parties, in its Opposition to Finjan's motion for early summary judgment, Juniper argued that "database," in fact, should be further construed and premised non-infringement arguments entirely on shoehorning many additional limitations into this single well understood term. *See, e.g.*, Dkt. No. 125-4 at 29 (Juniper's Opp. Finjan's MSJ) ("does not square with the definition of database as requiring data being organized according to '***a*** database schema' not ***multiple different*** schemas."). When the Court issued a ruling on an early motion for summary judgment on the '494 Patent, it determined that there were still issues

[1] Unless otherwise noted, all exhibits are attached to the Declaration of Kristopher Kastens in Support of Finjan's Motions *in Limine* Nos. 1-4.

of fact to determine with respect to database, and it postponed construction of the terms within "database" until when it was instructing the jury at trial. Dkt. No. 185 at 17.

On October 11, 2018, Juniper served the rebuttal report of its infringement expert, Dr. Rubin, where it shows that it intends Dr. Rubin to argue claim construction to the jury and to make legally incorrect claim interpretation arguments. First, Dr. Rubin argues that statements made during the IPR proceedings require that "database" be additionally construed as including a "table" and that this table must have "rows and columns," even though this was not in the agreed construction. Ex. 6, 10/11 Rubin Rpt., ¶¶ 30, 156-159; *see also id*., Rubin Demonstrative slide 21.[2] Next, Dr. Rubin argued that the term "database schema" within the agreed construction must be construed (a construction of the construction) as "a description of a database to a database management system (DBMS) in the language provided by the DBMS." *Id.*,¶¶ 29, 137, 149, Rubin Demonstrative slides 12, 21, 61. Finally, Dr. Rubin disclosed that he intends to provide testimony that is contrary to the law of claim interpretation, namely that the use of "a database" and "a database schema" are limited to a single database and a single database schema. *See id.*, 10/11 Rubin Rpt., ¶¶ 120-122, 129-131, 135, 136-138, 144, 148, 149-151. For the Court's ease of reference, Dr. Rubin makes the following legally incorrect claim construction and claim interpretation arguments:

"database"	**Agreed Construction:** "a collection of interrelated data organized according to a database schema to serve one or more applications." **Rubin's Improper Construction 1**: "a database" should be additionally construed as requiring only a single database. *See* Ex. 6, 10/11 Rubin Rpt., ¶¶ 120-122, 129-131. **Rubin's Improper Construction 2:** "a database" should be additionally construed as being a table. *Id.*,¶¶ 30, 156-159; *see also id*., Rubin Demonstrative slides 21, 66-67.

[2] Dr. Rubin's demonstratives are attached at the end of his October 11th report.

	Rubin's Improper Construction 3: "a table" in Rubin's improper construction of "database" should be additionally construed as requiring only a single table. *Id.*,¶¶ 30, 156-159, demonstrative slide 21, 66-67. **Rubin's Improper Construction 4:** "a table" in Rubin's improper construction of "database" should be additionally construed as requiring rows and columns. *Id.*,¶¶ 30, 157, 159. **Rubin's Improper Construction 5**: a "database schema" in the agreed construction should be additionally construed as "a description of a database to a database management system (DBMS) in the language provided by the DBMS." *Id.*,¶¶ 29, 137, 149, 165; *see also id*., Demonstrative slide 12, 21, 61. **Rubin's Improper Construction 6**: "the database schema" in the agreed construction should be additionally construed as requiring only a single database schema. *See id.*, ¶¶ 129, 138, 144, 148, 149-151. **Rubin's Improper Construction 7**: "the language provided by the DBMS" in the Rubin's improper construction of "the database schema" should be additionally construed as requiring only a single language. *Id.*,¶¶ 137, 149-151, 165, 168.

A. Exclusion of Dr. Rubin's Improper Claim Construction Testimony

The construction of patent claims in light of the specification and prosecution history is a question of law for the Court, not a question of fact for the jury. *Icon-IP Pty Ltd. v. Specialized Bicycle Components, Inc.*, 87 F. Supp. 3d 928, 945 (N.D. Cal. 2015) (citing *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 387 (1996)). As is the case here, courts are permitted to construe claim terms on a rolling basis if they so desire and provide final constructions of specific limitations in the form of jury instructions. *See Pressure Prods. Med. Supplies, Inc. v. Greatbatch Ltd.*, 599 F.3d

1308, 1316 (Fed. Cir. 2010) ("district courts may engage in a rolling claim construction, in which the court revisits and alters its interpretation of the claim terms as its understanding of the technology evolves.") (citations omitted); *see also MediaTek Inc. v. Freescale Semiconductor, Inc.*, No. 11-cv-5341 YGR, 2014 WL 971765, at *2 (N.D. Cal. Mar. 5, 2014)("[T]he final determination of the construction of any claim occurs at the close of trial and manifests itself in the form of jury instructions."). Consequently, the parties are strictly forbidden from presenting evidence that amounts to arguing claim construction to the jury, as this will be decided by the Court.

Making these legal claim construction arguments in front of the jury would be highly confusing and potentially misleading. Courts uniformly agree that "[a]rguing claim construction to the jury is inappropriate because it risks confusion and the likelihood that a jury will render a verdict not supported by substantial evidence." *Apple, Inc. v. Samsung Elecs. Co.*, No. 12-cv-00630-LHK, 2014 WL 660857, at *3 (N.D. Cal. Feb. 20, 2014) (citing *CytoLogix Corp. v. Ventana Medical Sys., Inc.*, 424 F.3d 1168, 1173 (Fed. Cir. 2005)). This prejudicial effect on the jury verdict is not remedied through proper instruction by the Court. *See CytoLogix Corp.*, 424 F.3d at 1172-73 ("The risk of confusing the jury is high when experts opine on claim construction before the jury even when, as here, the district court makes it clear that the district court's claim constructions control.").

To that end, Courts should exclude experts from presenting evidence (including evidence based on prosecution history, specification, and provisional applications) when using it to "explain and expound upon a specific meaning and/or requirements of the terms identified" to the jury, even if such testimony would aid the Court in understanding the true meaning of the terms. *MediaTek Inc.*, 2014 WL 971765, at *5; *see Icon-IP Pty Ltd.*, 87 F. Supp. 3d at 945 (granting a motion to exclude portions of rebuttal expert report relying on specifications and preferred embodiments of the patent because they amounted to improper claim construction arguments).

Here, Dr. Rubin's rebuttal report and attached demonstratives reveal a clear intent to improperly argue claim construction to the jury, and should therefore be excluded. Dr. Rubin tries to import his desired construction of "database" and "database schema" into evidence by using his rebuttal to cite to papers submitted during IPR proceedings in order to argue narrowing of the scope of

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