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15 JUNIPER NETWORKS, INC.

16 UNITED STATES DISTRICT COURT
17 NORTHERN DISTRICT OF CALIFORNIA
18 SAN FRANCISCO DIVISION

19 FINJAN, INC., a Delaware Corporation,) Case No. 3:17-cv-05659-WHA
20)
Plaintiff,) **DEFENDANT JUNIPER NETWORKS,**
21) **INC.’S OPPOSITION TO PLAINTIFF**
vs.) **FINJAN INC.’S MOTION *IN LIMINE***
22) **NO. 3 TO EXCLUDE IRRELEVANT**
JUNIPER NETWORKS, INC., a Delaware) **TESTIMONY FROM DR. AVIEL RUBIN**
23 Corporation,)
24 Defendant.) Date: December 4, 2018
Time: 9:00 a.m.
25) Courtroom: Courtroom 12, 19th Floor
Before: Hon. William Alsup
26)
27)
28)

1 Finjan’s Motion *in Limine* No. 3 (“MIL3”) is a poorly disguised effort to address the
2 issues Finjan identified in its letter to the Court seeking two *Dauberts*. Dkt. 221 at 2. These
3 issues are not appropriate for either a *Daubert* motion or a motion *in limine*, as they amount to
4 critiques of Dr. Rubin’s analysis that should be addressed through cross-examination. Indeed,
5 Finjan never identifies any specific Federal Rule of Evidence and instead generally just includes
6 (if anything) vague allegations of “prejudice” or “confusion” without any explanation for exactly
7 what prejudice or confusion might accrue. Finjan’s complaints are baseless and do not warrant
8 exclusion of any of Dr. Rubin’s opinions.

9 **A. Expert Opinions On Whether Claim 10 Is Abstract Should Not Be Admitted,**
10 **But The Jury Must Be Provided With Context On Alice Step 1.**

11 Juniper does not intend to have Dr. Rubin provide an opinion that Claim 10 is abstract, as
12 the Court has already determined this issue under Step 1 of the *Alice* test. Dkt. 189 at 18-19.
13 Thus, Juniper agrees with Finjan that it would be inappropriate for either party’s expert to opine
14 on this issue.¹ Because Step 2 of the *Alice* test expressly depends on the Court’s finding of
15 abstractness under Step 1, however, the jury will need to be informed that the Court found this
16 claim abstract. The Supreme Court has explained that when a patent is directed to “patent-
17 ineligible concepts” such as an abstract idea, then one must ask “what else is there in the claims
18 before us?” *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S.Ct. 2347, 2355 (2014). To answer
19 this, one must “determine whether the additional elements ‘transform the nature of the claim’ into
20 a patent-eligible application.” *Id.* This involves a “search for an ‘inventive concept’—*i.e.*, an
21 element or combination of elements that is ‘sufficient to ensure that the patent practice **amounts to**
22 **significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (citations omitted).²
23 Therefore, in order to apply this test, the jury must be told what the “ineligible concept” is—*i.e.*,
24 the jury must be provided with the Court’s finding that “the thrust of Claim 10 is on analyzing a
25 file and extracting information” which is “merely an abstract idea” (Dkt. 189 at 19); otherwise,
26 they will not have the background necessary to assess Step 2.**

27 ¹ Finjan’s expert Dr. Orso includes an entire section in his report titled “Claim 10 Is
28 Directed to Patent-eligible Subject Matter at Step 1.”

² All emphasis added, unless otherwise noted.

1 **B. Dr. Rubin’s Testimony On The Prosecution History Is Relevant To Damages.**

2 Juniper agrees with Finjan that inequitable conduct and prosecution laches are not at issue
3 in the December trial and Juniper does not intend to introduce testimony solely directed to these
4 issues. Finjan overreaches, however, when it suggests that certain testimony offered by Dr. Rubin
5 is “*only* relevant to prosecution laches and inequitable conduct.” MIL3 at 2.

6 For example, Mr. Kroll, a named inventor on the ‘494 Patent, testified that it “was Finjan’s
7 practice to promptly file patents on important technology.” Ex. 15 (Kroll Depo. Tr.) at 99:7-10.
8 Despite this, Finjan waited roughly 15 years to file the ‘494 Patent, which is relevant to the
9 importance of the ‘494 Patent. If, therefore, Finjan argues that the ‘494 Patent is “important” (or
10 more important than the other patents in its portfolio), evidence regarding the delay in filing is
11 directly relevant to rebut these assertions.

12 As to Mr. Kroll’s and Mr. Touboul’s statements about who invented Claim 10, Juniper will
13 not address this topic unless Finjan does. For example, if Mr. Kroll provides testimony that is
14 inconsistent with his prior statements that he invented Claim 10 or that is inconsistent with Mr.
15 Touboul’s declaration to the USPTO, Juniper would need to impeach Mr. Kroll with that prior
16 testimony and/or evidence. *See U.S. v. Hale*, 422 U.S. 171, 176 (1975) (“A basic rule of evidence
17 provides that prior inconsistent statements may be used to impeach the credibility of a witness.”).

18 **C. Finjan Mischaracterizes Dr. Rubin’s Opinions Related to Damages and § 101.**

19 Finjan next argues that “Dr. Rubin includes many specious arguments that directly touch
20 on anticipation and obviousness, but are couched as being relevant to damages and non-
21 infringement.” MIL3 at 3. Finjan’s argument is disingenuous, given that the testimony it protests
22 is a direct rebuttal to the opinions of Finjan’s own experts on damages and § 101 issues.

23 In particular, Finjan takes issue with Dr. Rubin’s opinions and demonstratives on the issues
24 of whether Finjan invented behavior-based malware analysis, whether detecting unknown viruses
25 existed and was well-known before the ‘494 Patent, and whether Claim 10 provides any
26 meaningful benefits over the prior art. MIL3 at 3. But Finjan fails to acknowledge that these
27 opinions directly respond to the claims of Finjan’s experts. For example:

- 28 • Mr. Arst supports his analysis regarding the value of the ‘494 Patent by opining that Finjan

1 was “‘the inventor’ of proactive content behavior inspection.” Ex. 16 (Arst Report) at p. 5.

2 • Dr. Orso testified that Finjan’s “behavior-based analysis was novel. So this kind of
3 analysis used to detect unknown malware, based on this behavioral analysis, was novel.”

4 Ex. 17 (Orso Depo. Tr.) at 85:10-13.

5 • Dr. Cole opines that Claim 10 “provides tangible benefits over then-existing malware
6 detection technology” (Ex. 9 (Cole Report) at ¶ 25) and was innovative because it could
7 “detect potentially suspicious malware based on the potential behavior of the malware” and
8 because it protects “against viruses that had never been seen before” (*Id.* at ¶ 22-23).

9 To the extent that Finjan intends to present testimony from its experts on these issues, Juniper is
10 certainly entitled to rebut it with evidence and opinions from Dr. Rubin that behavior-based
11 analysis was well-known long before the alleged priority date of the ‘494 Patent and that there
12 were also many systems that existed for detecting unknown viruses. *See Mueller v. Aufer*, 700
13 F.3d 1180, 1191 (9th Cir. 2012) (affirming admissibility of expert’s “opinion testimony [because
14 it] was relevant ... as direct rebuttal to the [plaintiff’s] expert”); *PSM Holding Corp. v. National*
15 *Farm Financial Corp.*, 2013 WL 12080306, at *18 (C.D. Cal. Oct. 8, 2013).

16 Finjan’s other argument that Dr. Rubin should not be allowed to “show that elements of
17 the ‘494 Patent were already known in alleged prior art references” makes no sense. MIL3 at 3.
18 The Court specifically identified the issue of whether Claim 10 includes an “inventive concept” as
19 an issue to be decided at the December trial. Dkt. 189 at 20. Obviously, one way to show that
20 something was well-known, routine, or conventional—and thus does not contain an “inventive
21 concept”—is to show that it was disclosed in a mountain of prior art references. This is precisely
22 what Dr. Rubin has done here, and it is perfectly appropriate. *See, e.g., Pacific Biosciences of*
23 *Cal., Inc. v. Oxford Nanopore Techs., Inc.*, 2018 WL 1419082, at *7 (D. Del. Mar. 22, 2018)
24 (considering “eight prior art references ... which together provide ‘a timeline of the
25 development’” of the purported inventive concept).

26 In general, Finjan appears to have missed the forest for the trees with respect to Dr.
27 Rubin’s § 101 analysis. Juniper agrees with Finjan that the “mere fact that something is disclosed
28 in a piece of prior art, for example, does not mean it was well-understood, routine, and

1 conventional.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018). But *Berkheimer*—
2 which addressed an order on summary judgment, not a motion *in limine*—was not commenting on
3 the proper evidentiary sources for consideration by a jury; rather, *Berkheimer* merely held that a
4 statement in a patent’s specification that it comprised non-conventional activity was sufficient to
5 create a genuine issue of fact regarding whether the claimed activity was indeed routine and
6 conventional in the art. *Id.* The present situation is completely different, as Dr. Rubin relies on
7 dozens of references to support his conclusion that various limitations were indeed well known by
8 considering them collectively. For example, Dr. Rubin relies on a 1995 article by Morton
9 Swimmer titled “Dynamic Detection And Classification Of Computer Viruses Using General
10 Behaviour Patterns” (“Swimmer”). The PTAB determined that Swimmer rendered obvious Claim
11 1 of the ‘494 Patent, which is virtually identical to Claim 10. *See* Ex. 18 (Rubin Report) at ¶¶ 28-
12 29. It is thus difficult to see how Finjan could dispute that this prior art document supports Dr.
13 Rubin’s opinion. But, most importantly, Dr. Rubin does not rely on Swimmer alone, rather he
14 cites Swimmer as one of many references that in aggregate demonstrate that Claim 10 was well
15 known, routine, and conventional.

16 **D. Finjan’s Attempt To Prevent Dr. Rubin From Relying On Documentary**
17 **Evidence To Support His Opinions Is Meritless.**

18 Finjan next moves to exclude Dr. Rubin from relying on various references to support his
19 § 101 opinions. To advance this argument, Finjan baldly states that (1) Dr. Rubin cannot rely on
20 research papers or patent applications to establish what was well known or conventional because
21 they describe “new technologies” and (2) Dr. Rubin cannot rely on a patent publication as
22 evidence for § 101 unless it was published before the priority date of the ‘494 Patent. MIL3 at 4-
23 6. Finjan does not cite to any authority to support its positions. Finjan’s quibbles are nothing
24 more than factual critiques of Dr. Rubin’s analysis, which is not a proper basis for exclusion.

25 Moreover, Finjan appears to be missing the point. Dr. Rubin does not opine that the
26 computer security community *learned* from these references after they were published; rather, Dr.
27 Rubin opines that, when the many references cited in his report are considered together, the
28 references *in aggregate* show what was becoming routine in the community. In other words, Dr.

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