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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,
)	INC.'S MEMORANDUM OF LAW IN
21	vs.)	SUPPORT OF ITS PROPOSED JURY
)	INSTRUCTIONS
22	JUNIPER NETWORKS, INC., a Delaware)	
	Corporation,)	Date: December 4, 2018
23)	Time: 9:00 a.m.
)	Courtroom: Courtroom 12, 19th Floor
24	Defendant.)	Before: Hon. William Alsup
25	_____)	

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1 **I. DISPUTED INSTRUCTION NO. 3 RE SUMMARY OF CONTENTIONS**

2 With regard to the “Summary of Contentions” instruction, Juniper proposes that the Court
3 adopt the language of the Northern District of California’s (“N.D. Cal.”) Model Patent Jury
4 Instruction A.3, with the only substantive change being the addition of the defenses that will be
5 tried in addition to invalidity, which is contemplated by the bracketed text in the model instruction
6 (“[Add other defenses, if applicable]”).

7 Finjan, on the other hand, has proposed that the Court use Federal Circuit Bar Association
8 Model Patent Jury Instruction No. A.2 as a starting point, with the following substantive additional
9 modifications: (1) delete the language noting that infringing conduct must occur in the U.S.,
10 (2) delete the suggested language concerning invalidity, (3) omit any mention of Juniper’s other
11 defenses, and (4) insert self-serving language about infringement and invalidity. In addition,
12 Finjan attempts to reframe the accused products in a way that is not consistent with the Court’s
13 Summary Judgment Order.

14 As an initial matter, where the parties do not agree on which model instruction to use,
15 courts in the Northern District of California have expressed a strong preference to use the
16 *Northern District of California* Model Patent Jury Instructions. *See Apple, Inc. v. Samsung*
17 *Electronics Co., Ltd.*, 5:11-cv-01846-LHK, Dkt. No. 1296 at 1-2 (N.D. Cal. July 23, 2012) (Order
18 Requiring Lead Trial Counsel to Meet and Confer for Final Jury Instructions) (“In addition, to
19 give the parties further guidance, the Court has a strong preference for the use of the Ninth Circuit
20 Model Jury Instructions and the Northern District of California Model Patent Jury Instructions.”);
21 *Fujifilm Corporation v. Motorola Mobility LLC*, 3:12-cv-03587-WHO, Dkt. No. 316 at 19 (N.D.
22 Cal. April 28, 2015) (tentative order regarding final jury instructions rejecting proposed
23 instructions that unnecessarily deviate from the Northern District model instruction) (“**Note:** This
24 is Fujifilm’s proposed version. Motorola’s proposed version unnecessarily deviates from the
25 Northern District model instruction.”) (emphasis in original). Finjan has provided no explanation
26 for its departure and the Court should not adopt Finjan’s proposal.¹

27 _____
28 ¹ As a general matter, Juniper has consistently proposed the use of the N.D. Cal. Model
Patent Jury instructions with any alterations limited to addressing the unique circumstances of this
case. Finjan, on the other hand, has selectively chosen between a hodgepodge of the N.D. Cal.

1 To the extent that the Court chooses to adopt the language of the Federal Circuit Bar
2 Association Model Patent Jury Instruction instead, Juniper respectfully requests that the Court
3 reject Finjan's inappropriate modifications.

4 **First**, Finjan's proposal contains an inaccurate description of the Accused Products. As
5 noted in the parties' *Daubert* briefing, Finjan is making an untimely attempt to expand its
6 infringement theory to encompass SRX devices that were never used with Sky ATP, as well as
7 SRX devices that are not even compatible with Sky ATP. *See* Dkt. No. 230 at 12-15. To avoid
8 confusion, the Accused Products should be defined using the language that Finjan used in its
9 Motion for Summary Judgment, and which the Court used in its Order. Dkt. No. 98 at 1; Dkt. No.
10 189 at 3. In particular, the Accused Products should be defined as "(1) Juniper's SRX Gateways
11 used in combination with Sky ATP, and (2) Sky ATP alone." It is important to properly define the
12 Accused Products for purposes of infringement, notice under § 287, and damages.

13 **Second**, Finjan's deletion of the language making clear that the conduct comprising direct
14 infringement must occur in the United States, and providing a more detailed description of
15 invalidity is inappropriate and self-serving. If Finjan wants to use the Federal Circuit Bar
16 Association Model Patent Jury Instruction, it should not be allowed to delete the portions it does
17 not like.

18 **Third**, Finjan's description of Juniper's defense under § 287 is too abbreviated and fails to
19 adequately inform the jury on the scope of the issues that need to be decided. During summary
20 judgment briefing, Juniper expressly raised Finjan's failure to comply with the marking and notice
21 requirements of § 287, and explained that this failure precluded Finjan from recovering any
22 damages in this case because the '494 Patent expired before Finjan filed its lawsuit. In particular,
23 Juniper argued Finjan incurred a notice obligation pursuant to § 287 because it and its licensees
24 sold products that embody the '494 Patent, but failed to mark those products. Because (and only
25

26 Model Patent Jury Instructions, the Federal Circuit Bar Association Model Patent Jury
27 Instructions, and the American Intellectual Property Law Association Model Patent Jury
28 Instructions. Juniper has agreed to some of Finjan's proposals under these other instructions in an
effort to compromise and narrow the issues, but maintains that cherry picking between model
instructions is inappropriate.

1 because) of this failure to mark, Finjan is permitted to collect damages only after it provided
2 Juniper with actual and specific notice of infringement pursuant to § 287. Finjan disputed this
3 issue on summary judgment, and the Court determined that there were factual issues that needed to
4 be determined by the jury. Dkt. No. 189 at 20.

5 Finjan now seems to be taking the position that it will not contest that it failed to mark its
6 products (thus triggering an actual notice requirement pursuant to § 287), but it has not been clear
7 or forthright about its new position. Specifically, when Finjan sent Juniper a draft of the joint jury
8 instructions it noted in the draft that “*No instruction on marking is appropriate because marking is*
9 *not an issue for trial.*” When Juniper asked Finjan to clarify why it believed that marking is not an
10 issue for trial, it stated that “Finjan is not asserting constructive notice of the ’494 Patent at trial”
11 and took the position that only actual notice will be addressed. But actual notice is only an issue if
12 Finjan did not mark products embodying the ’494 Patent. Thus, it appears that Finjan is
13 conceding that it or its licensees had an obligation to mark and failed to do so. *See* § 287 (“***In the***
14 ***event of failure so to mark***, no damages shall be recovered by the patentee in any action for
15 infringement, except on proof that the infringer was notified of the infringement and continued to
16 infringe thereafter”) (emphasis added).

17 When Juniper pressed Finjan on this issue, it changed course, and provided an abbreviated
18 “constructive notice” instruction that addresses only the issue of whether a single Finjan-related
19 product, the Vital Security product offered by Finjan Mobile (a related entity) was marked.
20 Finjan’s proposed instructions do not address Finjan’s other products or products sold by its
21 licensees, which make up the vast majority of products sold that purportedly practice the ’494
22 Patent. In an attempt to clarify Finjan’s shifting position on marking, Juniper asked Finjan to
23 directly answer the following two questions: (1) Does Finjan intend to present evidence at trial
24 that its licensees’ products do not practice the ’494 Patent? And (2) Does Finjan intend to present
25 evidence at trial that it made reasonable efforts to ensure that its licensees complied with the
26 marking requirements of Section 287? Finjan refused to state its position on whether or not it
27 complied with § 287 with regard to its licensees. During summary judgment briefing, Finjan
28 argued that there were factual issues preventing summary adjudication on this topic. Does Finjan

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