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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.,
 20 Plaintiff,
 21 v.
 22 JUNIPER NETWORKS, INC.,
 23 Defendant.

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

**MEMORANDUM OF LAW IN SUPPORT
 OF FINJAN’S JURY INSTRUCTIONS**

Trial Date: December 10, 2018
 Time: 7:30 a.m.
 Place: Courtroom 12 – 19th Floor
 Judge: Hon. William Alsup

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1 Pursuant to the Court’s Guidelines for Trial and Final Pretrial Conference in Civil Jury
2 Cases, Finjan, Inc. (“Finjan”) submits this Memorandum of Law in support of its proposed
3 language for Disputed Jury Instructions, which are Jury Instruction Nos. 3, 5, 6, 9-11, 14-17 and
4 19-20.

5 **I. DISPUTED INSTRUCTION NO. 3 REGARDING SUMMARY OF**
6 **CONTENTIONS**

7 Finjan’s Preliminary Instruction No. 3 follows the language of the Federal Circuit Bar
8 Association Model Patent Jury Instructions, July 2016, No. A.2. It is a concise and non-
9 argumentative instruction that identifies the parties’ respective positions to the jury and accurately
10 reflects the law. The only language that Finjan added to the model instruction is an explanation
11 that the jury will need to determine (1) whether the accused products meet the “database”
12 limitation and (2) whether Claim 10 contains an inventive concept, which are specific to the
13 upcoming trial. Finjan focused this instruction to the limited issues to be tried regarding the ‘494
14 Patent and provides an overview of the contentions in the case.

15 By contrast, Juniper’s proposed instruction modifies the language of the Northern District
16 of California’s model instructions that distorts the law, is argumentative, includes details that are
17 repetitive of later instructions, and adds extraneous instructions that do not apply to this case.
18 Thus, Juniper’s proposed instruction is an improper, particularly for a preliminary instruction that
19 is only intended to generally identify the parties’ contentions in the case.

20 Most notably, Juniper’s proposed instruction refers to “notice” of the patent to Juniper at
21 least four times. In the fourth paragraph of Juniper’s proposed preliminary instruction, Juniper
22 attempts to obtain a favorable instruction regarding Juniper’s arguments regarding constructive
23 notice, which is unnecessary at this stage of the case. The second reference is in the same
24 paragraph, whereby Juniper misstates law, claiming that Finjan was required to give “actual
25 *written* notice.” This is not the law for 35 U.S.C. § 271(a), which is the only portion of the
26 infringement statute at issue for trial. Actual notice can be met even with oral communications,
27 as the actual notice requirement is met when the accused infringer is notified with sufficient
28 specificity that the patent holder believes the accused infringer may infringe its patent. *See SRI*

1 *Int'l, Inc. v. Advanced Tech. Labs., Inc.*, 127 F.3d 1462, 1470 (Fed. Cir. 1997) (“[a]lthough there
2 are numerous possible variations in form and content, the purpose of the actual notice
3 requirement is met when the recipient is notified, with sufficient specificity, that the patent holder
4 believes that the recipient of the notice may be an infringer.”).

5 The only time “written” notice is required for actual notice is when infringement is being
6 considered under 35 U.S.C. § 271(g). Thus, Juniper is attempting to recite law that applies to a
7 different portion of Section 271, namely 271(g). *See* 35 U.S.C. § 271(g) (“Whoever without
8 authority imports into the United States or offers to sell, sells, or uses within the United States a
9 product which is made by a process patented in the United States shall be liable as an infringer, if
10 the importation, offer to sell, sale, or use of the product occurs during the term of such process
11 patent.”) The **only** written notice requirement in section 287 refers to specialized notice
12 procedures for patentees seeking to obtain damages for infringement of a patented process
13 pursuant to section 271(g). 35 U.S.C. § 287(b)(2) (“No remedies for infringement **under section**
14 **271(g)** shall be available with respect to any product in the possession of, or in transit to, the
15 person subject to liability under such section before that person had notice of infringement with
16 respect to that product.”) (emphasis added); *see also* 35 U.S.C. § 287(b)(5) (defining that “notice
17 of infringement means actual knowledge, or receipt by a person of a written notification, or a
18 combination thereof, of information sufficient to persuade a reasonable person that it is likely that
19 a product was made by a process patented in the United States.”) Even then, section 287(b)(5)
20 considers “actual knowledge” or a combination of actual knowledge with written notification to
21 constitute notice. *Id.* A written notice requirement is conspicuously absent from section 287(a),
22 which governs the general notice requirements for all types of infringement, and Section 271(g) is
23 not at issue for trial.

24 Juniper’s third and fourth reference to notice is in its summary of what the jury will need
25 to decide. Juniper’s continued reference to notice in its proposed instruction favors Juniper’s
26 arguments in the case and is unnecessarily argumentative for a preliminary instruction. In fact,
27 there is no need to refer the different types of notice in this preliminary instruction. At most, a
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1 general statement, as Finjan has, regarding notice of the patent at issue is sufficient for this
2 instruction.

3 Furthermore, Juniper's proposed instruction refers to specific infringement allegations,
4 which it repeats in its proposed instruction Nos. 5 and 6. Specifically, Juniper improperly
5 characterizes Finjan's infringement contention. Because Claim 10 is a system claim, Finjan's
6 contention is that (i) SRX Gateways with Sky ATP and (ii) Sky ATP by itself are the systems that
7 infringe. Juniper, however, attempts to instruct that SRX Gateways must be "used" in
8 combination with Sky ATP. This is not the law because a system claim can be infringed if the
9 system has all the elements. As stated in *Finjan, Inc. v. Secure Computing Corp.*, 626 F. 3d 1197,
10 1205 (Fed. Cir. 2010), the Federal Circuit found that activation or "use" is not necessary, as long
11 as the infringing code is present. Specifically, the Federal Circuit stated:

12 "Rejecting this contention, we explained that "although a user must activate the
13 functions programmed into a piece of software by selecting those options, the user
14 is only activating means that are *already present in the underlying*
15 *software.*" *Id.* at 1118. Infringement occurred because the code "was written in
16 such a way as to enable a user of that software to utilize the function... without
17 having to modify that code." *Id.* That analysis applies here. The code for proactive
18 scanning was "already present" in Defendants' accused products when sold. There
19 is no evidence that customers needed to modify the underlying code to unlock any
20 software modules. The fact that users needed to "activate the functions
21 programmed" by purchasing keys does not detract from or somehow nullify the
22 existence of the claimed structure in the accused software. Therefore, the jury's
23 infringement verdict on the system and media claims was based on a "legally
24 sufficient evidentiary basis" and consistent with the "weight of the
25 evidence." *Pediatrix*, 602 F.3d at 545-46 & n. 9. That portion of the verdict is
26 affirmed."

27 *Id.* at 1205. In light of the law, Juniper should not be instructing regarding the
28 requirements of infringement of a system claim in its preliminary instructions, and
29 mischaracterizing Finjan's contentions in this case. There is no need to repeat these
30 allegations in such a manner as set forth by Juniper.

31 Additionally, Juniper's proposal instructs regarding other patents and how that may be
32 "relevant to some issues you will be asked to decide." Other patents, including any Juniper
33 patents, are not relevant to the limited issues being presented in this trial. This is the subject of
34 Finjan's Motion *in limine* No. 4. As such, Juniper's instruction includes extraneous information

1 that is not necessary for a preliminary instruction. For these reasons, Finjan’s straightforward
2 statement of the parties’ contentions is appropriate for this preliminary jury instruction.

3 **II. DISPUTED INSTRUCTION ON CLAIM CONSTRUCTIONS**

4 There should not be any dispute regarding the claim construction at this point of the
5 case. The only difference between the parties’ construction regarding “database” is
6 Juniper’s addition of the following statement: “the court will provide further construction
7 after the trial.” There is no reason to instruct the jury on such a statement, as the jury is not
8 normally instructed regarding what the Court will do or not do after they render their verdict.
9 It is confusing and unnecessary for a preliminary instruction.

10 By way of background, Juniper stipulated and agreed with Finjan that “database”
11 should be construed as “a collection of interrelated data organized according to a database
12 schema to serve one or more applications.” *See* Dkt. No. 189 at 16. For this reason, the
13 parties agree on the construction for purposes of the instruction. The Court’s Summary
14 Judgment Order held that whether there is a “database” literally or under the doctrine of
15 equivalents will be tried to a jury. *Id.* at 17. It also stated that, to the extent Juniper insists
16 on continuing its belated reversal of position regarding the meaning of “database,” the Court
17 will “postpone any further claim construction on this limitation until the jury is instructed so
18 that the Court will have the benefit of the trial record before construing the term.” *Id.* Thus,
19 Finjan’s instruction provides the information that is appropriate for the jury to consider and
20 there should not be any instruction regarding what the Court might do after the jury renders
21 its verdict.

22 **III. DISPUTED INSTRUCTION NO. 5 REGARDING THE OUTLINE OF** 23 **TRIAL**

24 Both parties’ Preliminary Instruction No. 5 is based on the Northern District of
25 California’s Model Patent Jury Instructions. *See* N.D. Cal. Model Patent Jury Instruction No.
26 A.5. Finjan’s Preliminary Instruction No. 5 provides a straightforward explanation of the outline
27 of trial and includes a non-argumentative overview of what the parties will present in their
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