IRELL & MANELLA LLP
A REGISTERED LIMITED LIABILITY LAW PARTNERSHIP
INCLUDING PROFESSIONAL CORPORATIONS

840 NEWPORT CENTER DRIVE, SUITE 400
NEWPORT BEACH, CA 92660-6324
TELEPHONE (949) 760-0991
FACSIMILE (949) 760-5200

1800 AVENUE OF THE STARS, SUITE 900
LOS ANGELES, CALIFORNIA 90067-4276

TELEPHONE (310) 277-1010
FACSIMILE (310) 203-7199
WEBSITE: www.irell.com

WRITER'S DIRECT
TELEPHONE (310) 203-7189

December 11, 2018

Hon. William Alsup
U.S. District Court
Northern District of California

Re: *Finjan, Inc. v. Juniper Networks, Inc.*, Case No. 3:17-cv-05659-WHA

Dear Judge Alsup:

Finjan's letter regarding 35 U.S.C. § 282 (Dkt. No. 312) is baseless. It appears that Finjan seeks to create some "purely formalistic" notice requirement under Section 282 wherein expert reports somehow do not constitute sufficient notice, but that is simply not the law. *See Eaton Corp. v. Appliance Valves Corp.*, 790 F.2d 874, 879 (Fed. Cir. 1986).

As background, Finjan objects to Juniper's disclosure of several prior art references for use with Juniper's expert Dr. Rubin because, according to Finjan, Juniper did not provide any disclosure regarding such prior art as required under 35 U.S.C. § 282. *See* Dkt. No. 312. Section 282(c) requires the party asserting invalidity to "give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial [of the documents] showing the state of the art…." The Federal Circuit has noted that "section 282 does not dictate an arbitrary or absolute rule barring introduction of relevant, material evidence on the purely formalistic fact that notice of reliance was lacking." *See Eaton*, 790 F.2d at 879. The ultimate question is "whether a party has been deprived of an adequate opportunity to present its case." *Id.*

Although Finjan never explicitly identifies exactly which prior art references Finjan claims were not properly noticed, at least some if not all of the prior art on which Juniper's expert Dr. Rubin intends to rely was disclosed back in ***April 2018*** when Juniper provided its invalidity contentions (which included invalidity contentions under § 101) pursuant to Patent Local Rule 3-3. *See* Exhibit 1 (April 23, 2018 invalidity contention disclosing prior art references such as Gryaznov (p. 19) on which Dr. Rubin intends to rely). More importantly, every single one of the references upon which Dr. Rubin intends to rely was disclosed in one or more of his expert reports served on September 11, October 11, and November 7, which are all more than 30 days in advance of trial. Finjan fails to identify a single reference disclosed by Juniper to be used during Dr. Rubin's direct examination that did not appear in one or more of his timely expert reports, if not also disclosed in Juniper's invalidity contentions served more than ***seven months*** in advance of trial.

It is especially odd for Finjan to allege that "Juniper did not provide any disclosure…regarding prior art or publications showing the state of the art" given that the Court already denied Finjan's motion *in limine* no. 3 directed precisely to the prior art references relied upon by Dr. Rubin in his reports—the same references that Dr. Rubin intends to rely on at trial for the same purpose. *See* Dkt. No. 301 at 3 ("The request to exclude Dr. Rubin's 'reliance on

documents or systems that do not establish that Claim 10 was 'well-known, routine, and conventional'' is DENIED."). This context is why the case on which Finjan relies, *Ferguson Beauregard/Logic Controls v. Mega Sys., LLC*, 350 F.3d 1327, 1347 (Fed. Cir. 2003) is distinguishable. In that case (which only held there was no abuse of discretion rather than setting forth any standard to follow), the references relied upon were not noticed for the purpose for which they were going to be used; by contrast with the present situation, Dr. Rubin discussed certain prior art references in the context of § 101 and damages in his expert reports, and now Dr. Rubin intends to present testimony related to § 101 and damages based on the same references.

In addition to the fact that Finjan's allegation regarding insufficient notice is plainly incorrect, Finjan fails to allege that it would suffer any prejudice from Dr. Rubin's reliance on these documents, let alone that Finjan "has been deprived of an adequate opportunity to present its case." *See Eaton*, 790 F.2d at 879. For this reason alone, Finjan's letter brief should be denied. *See also Lectec Corp. v. Chattem, Inc.*, No. 5:08-CV-130, 2011 WL 13086026, at *8 (E.D. Tex. Jan. 4, 2011) ("Plaintiff has not shown that Defendants' [] delay has significantly prejudiced Plaintiff's ability to respond to Defendant's references regarding the state of the art. This *in limine* item is therefore hereby DENIED."). Of course, Finjan's inability to articulate any alleged prejudice is not surprising given that, again, all of the prior art that Dr. Rubin intends to rely on were disclosed in his expert reports months ago, and Finjan's own § 101 expert, Dr. Orso, had a full and fair opportunity to present his own rebuttal report.

In short, all of the documents on which Dr. Rubin intends to rely at trial were disclosed to Finjan (at least) in one or more of Dr. Rubin's expert reports served on September 11, October 11, and November 7, and therefore Finjan's argument that it has not received timely notice of such prior art references is just wrong. Juniper respectfully requests that the Court deny Finjan's letter brief regarding Juniper's use of prior art with its expert, Dr. Rubin.

Respectfully submitted,

*/s/ Joshua Glucoft*

Joshua Glucoft
IRELL & MANELLA LLP
*Attorneys for Defendant Juniper Networks, Inc.*