

1 PAUL ANDRE (State Bar No. 196585)  
pandre@kramerlevin.com  
2 LISA KOBIALKA (State Bar No. 191404)  
lkobialka@kramerlevin.com  
3 JAMES HANNAH (State Bar No. 237978)  
jhannah@kramerlevin.com  
4 KRISTOPHER KASTENS (State Bar No. 254797)  
kkastens@kramerlevin.com  
5 KRAMER LEVIN NAFTALIS & FRANKEL LLP  
6 990 Marsh Road  
7 Menlo Park, CA 94025  
8 Telephone: (650) 752-1700  
Facsimile: (650) 752-1800

9 *Attorneys for Plaintiff*  
10 FINJAN, INC.

11 **IN THE UNITED STATES DISTRICT COURT**  
12 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**  
13 **SAN FRANCISCO DIVISION**

14 FINJAN, INC., a Delaware Corporation,

15 Plaintiff,

16 v.

17 JUNIPER NETWORKS, INC., a Delaware  
18 Corporation,

19 Defendant.

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

**PLAINTIFF’S FINJAN INC.’S MOTION  
TO PRECLUDE JUNIPER FROM  
RELYING ON LATE-DISCLOSED  
PRIOR ART REFERENCES**

Trial: December 10, 2018  
Courtroom: 12, 19<sup>th</sup> Floor  
Before: Hon. William Alsup

1 The relevant portions of 35 U.S.C. § 282(c), as underlined below, require in an action involving  
2 allegations of invalidity that the party asserting invalidity (Juniper) “shall give notice in the pleadings  
3 or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number,  
4 date and name of the patentee of any patent, the title date, and page numbers of any publication to be  
5 relied upon as anticipation of the patent in suit or, except in actions in the United States Court of  
6 Federal Claims, as showing the state of the art, and the name and address of any person who may be  
7 relied upon as the prior inventor or as having prior knowledge of or as the prior inventor or as having  
8 prior knowledge of or as having previously used or offered for sale the invention of the patent in suit.”  
9 Finjan requests the Court to prevent Juniper from using the following Trial Exhibits due to its failure to  
10 comply with this provision and affirmatively state the asserted publication date regarding certain  
11 printed publications. 35 U.S.C. § 282(c) (“In the absence of such notice proof of the said matters may  
12 not be made at the trial except on such terms as the court requires.”). Additionally, no disclosure was  
13 made for 35 U.S.C. 101 purposes. Thus, Dr. Rubin, Juniper’s expert, should not be able to introduce at  
14 least these trial exhibits, as identified below.

15 **No Asserted Publication Date**

16 Juniper’s expert, Dr. Rubin, and Juniper have not affirmatively represented the publication  
17 dates of a number of printed publications that are being used for Juniper’s invalidity claim pursuant to  
18 35 U.S.C. § 101. In addition, while there are dates (and in the case of Trial Exhibit 1550, multiple  
19 dates) referenced on the printed publications, there is no evidence that this is the date referenced on the  
20 publication is the actual publication date. Each trial exhibit is identified below:

21 **(1) Trial Exhibit 1070:** “Dynamic Detection and Classification of Computer Viruses using  
22 General Behaviour Patterns,” Morton Swimmer. This document references September 1995. There is  
23 no evidence that this is the date of publication and Juniper has not affirmatively asserted the date of  
24 publication.

25 **(2) Trial Exhibit 1075:** “Virus Bulletin,” Edward Wilding. This document references  
26 “November 1991.” There is no evidence that this is the date of publication and Juniper has not  
27 affirmatively asserted the date of publication.

1           **(3) Trial Exhibit 1550:** “Scanners of the Year 2000: Heuristics,” Gryaznov. This document  
2 lists multiple dates on the cover including November 2, 2015 and 1999. There is no evidence of the  
3 date of publication and Juniper has not affirmatively asserted the date of publication.

4           **(4) Trial Exhibit 1553:** “Automated Assistance for Detecting Malicious Code,”  
5 Crawford. This document references June 18, 1993. There is no evidence that this is the date of  
6 publication and Juniper has not affirmatively asserted the date of publication.

7           **(5) Trial Exhibit 1554:** “Detecting Unusual Program Behavior Using the Statistical  
8 Component of the Next-generation Instruction Detection Expert System (NIDES),” Anderson. The  
9 document references May 1995. There is no evidence that this is the date of publication and Juniper  
10 has not affirmatively asserted the date of publication.

11           **(6) Trial Exhibit 1241:** “SQL for Dummies.” This exhibit does not have any publication date.

12           **(7) Trial Exhibit 1555:** “The Diffusion of Database Machines,” Hoffer. Only lists “Spring  
13 1992,” but does not affirmatively state that this was the publication date.

14           **(8) Trial Exhibit 1556:** “The Relation Model for Database Management,” Codd. Only lists a  
15 copyright date of “1990,” but does not affirmatively state that this was the publication date.

16           **(9) Trial Exhibit 1558:** “Heterogeneous Distributed Database Manager: The HD-DBMS,”  
17 Cardenas. Only lists “1987,” but does not affirmatively state that this was the publication dates.

18           **(10) Trial Exhibit 1559:** “Bringing Telecommunication Services to the People – IS&N ’95,”  
19 lists October 16-19, 1995 and a 1995 copyright date, but does not affirmatively state the publication  
20 date that is being asserted.

21           Federal Circuit precedent has found that it is not an abuse of discretion to prevent a party  
22 asserting invalidity from relying on prior art not disclosed properly under 35 U.S.C. § 282, irrespective  
23 of whether that party disclosed it in discovery. *Ferguson Beauregard/Logic Controls, Div. of Dover*  
24 *Res., Inc. v. Mega systems, LLC*, 350 F.3d 1327, 1347 (Fed. Cir. 2003) (affirming preclusion of prior  
25 art where the defendant disclosed it in a deposition and interrogatories and argued that the plaintiff  
26 “was served with multiple notices of [Defendant]’s intent to assert invalidity of the ’991 patent and that  
27 the district court therefore erred.”). Moreover, “[m]erely disclosing underlying documents, such as  
28

1 copies of patents, is not enough. Failure to comply with the very specific notice requirements of  
2 Section 282 is grounds for prohibiting introduction of evidence of the prior art.” *Finisar Corp. v.*  
3 *DirecTV Grp., Inc.*, 424 F. Supp. 2d 896, 899 (E.D. Tex. 2006) (citing *Ferguson*, 350 F.3d at 1347).  
4 Finjan requests the same relief here due to Juniper’s failure to comply with this explicit requirement  
5 that has been part of the Patent Act, when it was enacted in 1952 as 35 U.S.C. § 282 and its  
6 predecessor has existed since 1840. *See* Section 15 of the Patent Act of 1836.

7 Juniper relied on a single case that predates *Ferguson* by nearly thirty years (*Eaton Corp. v.*  
8 *Appliance Valves Corp.*, 790 F.2d 874 (Fed. Cir. 1986)) to make the same argument that the Federal  
9 Circuit rejected in *Ferguson* – i.e. that disclosure in discovery is sufficient notice under 35 U.S.C. §  
10 282. But *Eaton* expressly relied two legal principles, one of which has since changed: (1) “To this end,  
11 section 282 should be read in context with the Federal Rules of Civil Procedure” and (2) “Federal Rule  
12 26 indicates Congress’s clear intent that courts be permissive in the introduction of relevant evidence.”  
13 *Eaton*, 790 F.2d at 879. Although the first legal principle still holds true, the second has been amended  
14 by statute since *Eaton* was decided in 1986. Specifically, the Rules of Civil Procedure were amended  
15 in 1993 to provide more restrictive penalties and automatic sanctions for failure to disclose  
16 information, including with regard to Rule 26 on which *Eaton* relied. *See, e.g.*, Fed. R. Civ. P. 37 (“If  
17 a party fails to provide information or identify a witness as required by Rule 26(a) or (e), the party is  
18 not allowed to use that information or witness to supply evidence on a motion, at a hearing, or at a  
19 trial, unless the failure was substantially justified or is harmless.”) (emphasis added); *see also* Advisory  
20 Committee Notes to the 1993 Amendment of Fed. R. Civ. P. 37 (“Paragraph (1) prevents a party from  
21 using as evidence any witnesses or information that, without substantial justification, has not been  
22 disclosed as required by Rules 26(a) and 26(e)(1). This automatic sanction provides a strong  
23 inducement for disclosure of material that the disclosing party would expect to use as evidence,  
24 whether at a trial, at a hearing, or on a motion, such as one under Rule 56.”) (emphasis added).

25 Thus, because no prior art was cited for 35 U.S.C. 101 purposes, all identified references  
26 should be excluded.  
27  
28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Respectfully submitted,

DATED: December 11, 2018

By: /s/ Paul J. Andre  
Paul J. Andre (State Bar No. 196585)  
Lisa Kobialka (State Bar No. 191404)  
James Hannah (State Bar No. 237978)  
Kristopher Kastens (State Bar No. 254797)  
KRAMER LEVIN NAFTALIS  
& FRANKEL LLP  
990 Marsh Road  
Menlo Park, CA 94025  
Telephone: (650) 752-1700  
[pandre@kramerlevin.com](mailto:pandre@kramerlevin.com)  
[lkobialka@kramerlevin.com](mailto:lkobialka@kramerlevin.com)  
[jhannah@kramerlevin.com](mailto:jhannah@kramerlevin.com)  
[kkastens@kramerlevin.com](mailto:kkastens@kramerlevin.com)

*Attorneys for Plaintiff*  
FINJAN, INC.