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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,
Plaintiff,
v.
JUNIPER NETWORK, INC.,
Defendant.

Case No. 17-cv-05659-WHA (TSH)

**ORDER REGARDING DISCOVERY
LETTER BRIEF**

Re: Dkt. No. 484

United States District Court
Northern District of California

This discovery dispute concerns Juniper’s tenth affirmative defense and fifth counterclaim based on unclean hands, as well as its third counterclaim for inequitable conduct. *See* ECF No. 218, ¶¶ 193-212, 232-60. The essence of the unclean hands claim is that Finjan’s patent prosecutor, non-party Dawn-Marie Bey, allegedly routinely claims a late priority date in patent applications to prolong the length of the patent, which is to Finjan’s benefit in licensing negotiations. But when it becomes clear that a PTO examiner will find the original priority date to be ineffective to support a valid invention because of prior art, Bey routinely files a “Petition to Accept Unintentionally Delayed Priority Claim” under 37 C.F.R. § 1.78(e), backdating priority to escape invalidation. *See* ECF No. 190 at 9-11 (order summarizing the unclean hands claim). Juniper’s theory is that the sheer number of times Bey has filed these petitions for Finjan belies her representations to the PTO that the delayed priority claims were unintentional.

The inequitable conduct claim is a specific example of this backdating allegedly done in connection with the ‘494 patent. There, Bey allegedly filed one of these petitions to backdate the patent to overcome an invalidity problem, but at the earlier date not all of the authors had started working for Finjan, so Bey also filed an amendment falsely getting rid of three of them as authors.

Or at least that’s what Juniper says

1 To explore these claims, Juniper served a document subpoena on Bey. ECF No. 484-1.
2 The parties have met and conferred and have five disputes concerning the subpoena. ECF No.
3 484.

4 **A. Invoices for Bey’s Work on All of Finjan’s Patents, Not Just the Patents-in-Suit or**
5 **Their Families**

6 Bey was not the original prosecuting attorney of record on many of Finjan’s patents where
7 she later filed a petition to accept an “unintentionally” delayed claim of priority. Juniper reasons
8 that she would have had to discuss with the prior counsel their failure to claim priority before she
9 could submit such a petition in good faith. Juniper believes she didn’t do this and would like to
10 use the absence of such discussions as evidence that she had no basis to claim the delay was
11 unintentional because she couldn’t possibly have known.

12 To that end Juniper wants all of Bey’s invoices for her work on all of Finjan’s patents.
13 Juniper acknowledges that some entries in the invoices might be privileged and could be redacted,
14 but it argues that non-privileged facts such as names, dates, and the general subject matter of any
15 communications about Finjan’s patents is relevant. Presumably, for example, Juniper would find
16 the date of a Finjan petition to accept an unintentionally delayed claim of priority, and then search
17 the entries for the weeks or months leading up to that filing for any evidence of a communication
18 with the original patent prosecutor, and if it didn’t find any, would say this is circumstantial
19 evidence that the petition was a fraud. Bey agrees, as a compromise, to produce invoices only for
20 work on the asserted patents but not for work on any others. She disputes their relevance and also
21 argues the subpoena didn’t ask for them. As a backup at the telephonic hearing, she offered the
22 invoices for work concerning priority for patents in the same families as the asserted patents.

23 Let’s start with the subpoena. RFP No. 2 asked for “all invoices related to the Patents-in-
24 Suit.” The subpoena defined the patents-in-suit to mean the ‘494 patent, then ‘844 patent, the ‘780
25 patent, the ‘731 patent, the ‘633 patent, and the ‘154 patent. It also stated that “‘related’ shall be
26 construed broadly, and shall mean mentioning, discussing, referring to, pertaining to, reflecting, or
27 consulting.” Juniper argues that all of Bey’s invoices to Finjan come within the broad definition
28 of “related.” As a backstop, Juniper argues that even if they are not responsive to RFP No. 2, they

1 are certainly responsive to RFP No. 27, which asked for “all documents related to Finjan.” The
 2 Court accepts the latter argument. Invoices for work on patents other than the patents-in-suit do
 3 not come within the scope of RFP No. 2 because they do not mention, discuss, refer to (and so on)
 4 the patents-in-suit, but they do come within RFP No. 27 because they relate to Finjan.

5 But are they relevant and proportional? The Court believes they are. The District Judge’s
 6 order allowing the unclean hands claim to proceed stated that “[l]ooking at the forest instead of the
 7 trees, we see a pattern and practice of bringing to the attention [of] the PTO critical information
 8 only after the PTO examiner or industry itself has exposed the original priority date as ineffective
 9 to support a valid invention. In light of this practice, it then becomes all the more suspicious that
 10 Attorney Bey, time and again, would — only after potentially invalidating prior art is interposed
 11 — give the same story of ‘unintentional delay’ in petitioning for a priority date conveniently
 12 predating prior art.” ECF No. 190 at 11. This claim is about the forest, not the trees. It’s about a
 13 pattern, a practice in which Bey time and again allegedly did something. To see if this claim has
 14 merit, Bey cannot limit her production to invoices concerning the patents-in-suit or their families.
 15 At the same time, to lessen burden, “[a]s a compromise, Juniper proposes that Ms. Bey produce all
 16 invoices related to work analyzing priority or inventorship for Finjan’s patents, redacted to protect
 17 any privileged legal advice.” ECF No. 484 at 2. In response to the Court’s questions at the
 18 telephonic hearing, Juniper acknowledged that while the fifth counterclaim (concerning priority) is
 19 about the forest, the third (inventorship) is a tree, meaning that it is limited to the ‘494 patent.
 20 Accordingly, the Court adopts a modification of Juniper’s compromise and **ORDERS** Bey to
 21 produce all invoices related to work analyzing priority for any of Finjan’s patents, or related to
 22 work analyzing inventorship for the ‘494 patent, redacted to protect any privileged legal advice.

23 **B. All of Bey’s Petitions to Accept Unintentionally Delayed Claims of Priority, Not Just**
 24 **the Ones She Filed for Finjan**

25 Bey has agreed to produce all of the backdating petitions she filed for Finjan, but Juniper
 26 wants all the petitions she filed for her *other* clients as well. Juniper states that it “requested all of
 27 Ms. Bey’s petitions to accept ‘unintentionally’ delayed claims of priority because they are critical
 28 to understanding whether Ms. Bey’s pattern of behavior is unique to her relationship with Finjan,

1 or whether it is a common part of her practice for other clients.” ECF No. 484 at 2. The parties
2 primarily dispute the burden involved in this request, but the Court is struggling with its relevance.

3 The unclean hands claim is asserted against Finjan, obviously, not Bey. The gist of the
4 claim is that “Finjan has an unusually abundant history of petitioning for allegedly
5 ‘unintentionally’ delayed claims of priority, particularly after one of Finjan’s patents is under
6 examination and has been rejected over prior art that predates the filing of the patent but post-dates
7 the belatedly claimed priority document.” ECF No. 218 ¶ 235. The idea is that Finjan is doing
8 something *unusual* in its patent prosecution, a departure from common practice that is suggestive
9 of wrongdoing. Well, that begs the question: *unusual compared to what?*

10 Surely the answer has to be something like: compared to what is normal in patent
11 prosecution generally, or at least what is normal in patent prosecution in the industry Finjan is in.
12 The problem with Juniper’s request is that what Bey does for her other clients is irrelevant because
13 she’s just one person. Her conduct simply does not establish what is normal in patent prosecution
14 generally or within a given industry.

15 If this were an attorney disciplinary proceeding, the Court would care whether Bey is
16 constantly filing these petitions for just Finjan or for all of her clients – although even then we
17 would still need to know if this behavior is objectively uncommon in the industry or in patent
18 prosecution generally before we could know if this looks like misconduct. But that’s not what this
19 case is about. Juniper is asserting its unclean hands claim not against Bey but against her client
20 Finjan. To show that Finjan in fact has an unusually abundant history of filing these petitions,
21 Juniper will need to compare Finjan’s history to some relevant measure of what is normal. Bey’s
22 conduct on behalf of her other clients in no way establishes what is normal. Getting all of her
23 petitions is not even a step in the direction of proving what is normal. A comparison of what Bey
24 does for Finjan against what she does for her other clients is just a random and meaningless
25 comparison.

26 As to burden, Bey makes a good case that the request is overly burdensome. According to
27 both sides, even though these petitions are public, there is no easy way to search for them. Bey
28 asserts that in her 20 years of being a patent prosecutor, she has had hundreds of clients. She says

1 it is no easier for her to search the public files than for Juniper to, and that she would have to
2 search through her client files to find the petitions. For clients predating 2013, she has 200 boxes
3 of archived files she would have to go through manually. For clients from 2013 to the present, she
4 can do an electronic search based on words to find documents in her document management
5 system, but then she would need to determine if each petition she finds actually got filed. As a
6 compromise, Juniper says it can provide search terms that would yield no more than a thousand
7 hits for Bey to review before her deposition. Juniper says nothing about the 200 boxes of
8 documents.

9 Juniper's compromise would keep Bey busy before her deposition, but it also calls into
10 question the value of what would be produced. As explained above, the Court does not believe
11 that a comparison of Finjan's practice of filing these petitions to how often Bey's other clients
12 have filed these petitions has any relevance. But a comparison of a complete set of Finjan's
13 petitions to an incomplete set of what Bey is able to find in a few days, and excluding everything
14 before 2013, for her other clients – well, the Court doesn't even know how to characterize what
15 that is. That comparison is not apples to apples, or even apples to oranges. It's an apple compared
16 to something of unknown quality.

17 Because the requested documents are irrelevant and any meaningful effort to produce them
18 is disproportional to the needs of the case, the Court **DENIES** Juniper's request for Bey's petitions
19 on behalf of her other clients.

20 **C. Communications with Prior Attorneys of Record About Priority or Inventorship.**

21 Juniper requests communications between Bey and the prior attorneys of record who
22 prosecuted Finjan's patents so Juniper can determine whether she had any communications
23 regarding the prior attorneys' failure to claim priority or who they listed as inventors. This is
24 essentially the same issue as with the invoices. They want Bey ordered to produce the
25 communications so they can review them and argue there weren't any. Bey agrees to produce
26 communications concerning the asserted patents, as well as communications related to family
27 members of the asserted patents, but that's too narrow. The issue for the unclean hands claim is
28 the forest – the pattern, the practice, which goes to Finjan's patents generally. However, as to the

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