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Attorneys for Defendant
JUNIPER NETWORKS, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

FINJAN, INC., a Delaware Corporation,)	Case No. 3:17-cv-05659-WHA
)	
Plaintiff,)	OBJECTION TO ATTORNEY
)	ARGUMENT IN FINJAN'S "NOTICE OF
vs.)	SUPPLEMENTAL AUTHORITY"
)	
JUNIPER NETWORKS, INC., a Delaware)	
Corporation,)	
)	
Defendant.)	

Juniper Networks, Inc. (“Juniper”) hereby objects to improper and inaccurate attorney argument contained in what Finjan, Inc. (“Finjan”) styles as a “Notice of Supplemental Authority” (Dkt. 572). Civil L.R. 7-3(d) provides that “[o]nce a reply is filed, no additional memoranda, papers or letters may be filed without prior Court approval,” although “counsel may bring to the Court’s attention a relevant judicial opinion published after [a] date [an] opposition or reply was filed by filing and serving a Statement of Recent Decision, containing a citation to and providing a copy of the new opinion—*without argument*” (emphasis added).

Finjan’s recent “Notice of Supplemental Authority” (Dkt. 572) violates Civil L.R. 7-3(d) by containing the following argument (Dkt. 572 at 1:7-12):

This decision is relevant because Juniper extensively relied on the PTAB obviousness determination with respect to Claim 1 to argue that there were no material difference between Claim 1 and Claim 10, and thus there is no inventive concept (Alice step 2) found in Claim 10. Putting aside that Juniper’s position is not a correct statement of law, now the Federal Circuit has determined that Claim 10 is patently distinct from Claim 1, thus mooted Juniper’s argument and evidence presented at trial.

This argument is not only in violation of the local rules; it is wrong. The Federal Circuit’s review of an IPR decision cannot “determine[]” any question as to whether claims are “patently distinct” from each other for purposes of a § 101 analysis, because the Patent Trial and Appeal Board does not engage in § 101 analysis in IPR proceedings—and, in fact is *statutorily prohibited* from doing so. 35 U.S.C. § 311(b) (scope of *inter partes* review is limited to grounds “that could be raised under section 102 or 103 . . .”). Thus, as Juniper previously explained, although the PTAB’s finding (as affirmed by the Federal Circuit) that each element of Claim 1 is taught by the prior art (including those also found in Claim 10) is *relevant* to the § 101 analysis, its finding is *not* determinative of the § 101 inquiry. Dkt. 569 at 4:15-17 (“while it is *not determinative* of the § 101 inquiry—the PTAB’s ruling that all of the functional elements of Claim 10 that overlap with Claim 1 existed in the prior art [as subsequently affirmed by the Federal Circuit] is relevant to the § 101 analysis in this case”) (emphasis added). In contrast, as Juniper explained, the PTAB’s *conclusions* about patentability pursuant to §§ 102-103 are not relevant to the § 101 analysis. *Id.* at 4:2-10 (explaining that “§ 101 analysis is distinct from invalidity analysis under §§ 102-103”).

1 Dated: July 3, 2019

Respectfully submitted,

2 IRELL & MANELLA LLP

3 By: /s/ Dennis Courtney

4 Dennis Courtney
5 *Attorneys for Defendant*
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