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UNITED STATES DISTRICT COURT

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NORTHERN DISTRICT OF CALIFORNIA

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FINJAN, INC.,

Plaintiff,

8

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v.

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CHECK POINT SOFTWARE
TECHNOLOGIES, INC., et al.,

11

Defendants.

Case No. 18-cv-02621-WHO

**ORDER GRANTING MOTION TO
STRIKE IN PART; GRANTING
MOTIONS TO SEAL; GRANTING
MOTION TO AMEND CLAIM
CONSTRUCTION SCHEDULE**

Re: Dkt. Nos. 54, 55, 58, 60, 69, 75

12

13   This is a patent infringement action. Plaintiff Finjan, Inc. ("Finjan") accuses defendant

14 Check Point Software Technologies, Inc. and Check Point Software Technologies Ltd.

15 (collectively "Check Point") of directly and indirectly infringing on several of its patents related to

16 cyber security. Complaint at ¶¶ 8-9 [Dkt. No. 1]. Check Point moves to strike a number of

17 Finjan's infringement contentions for violations of my Order Re Case Narrowing and

18 Infringement Contentions (the "Narrowing Order") [Dkt. No. 29] and the Patent Local Rules.

19 Check Point's Motion to Enforce Court Order and Strike Infringement Contentions ("Mot.") [Dkt.

20 No. 55]. The motion to strike is granted in part and Finjan must amend its infringement

21 contentions.

22   **BACKGROUND**

23   After receiving briefing from the parties on how to manage this litigation in compliance

24 with Federal Rule of Civil Procedure 1's mandate of a "just, speedy, and inexpensive

25 determination of this action," I ordered Finjan to serve its infringement contentions under

26 specifications that largely follow the provisions of this Court's Patent Local Rules as well as the

27 guidance provided in the 2013 Model Order. Narrowing Order. Finjan was instructed to "include

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Local Rule 3-2" and to also:

> (i) avoid open-ended citations to "exemplary" products and use of the terms "such as" and "for example"; (ii) set forth any infringement theories based on the doctrine of equivalents with limitation-by-limitation analyses; and (iii) for any indirect theories of infringement, identify the alleged direct infringement, the alleged acts of inducement or contribution to that infringement, and the relationship between them.

Id. at 2. On November 2, 2018, Finjan served its infringement contentions on Check Point. Mot. at 1.

The infringement contentions consist of a cover pleading, a list of every instrumentality that allegedly infringes, and thirty-four claim charts. The cover pleading provides information on Finjan's initial disclosure of asserted claims, infringement contentions, and document production pursuant to Patent Local Rules 3-1 and 3-2. Plaintiff Finjan, Inc.'s Initial Disclosure of Asserted Claims and Infringement Contentions and Document Production Pursuant to Patent Local Rules 3-1 and 3-2 (the "Initial Disclosures"), attached as Exhibit C to Declaration of Clement Roberts ("Roberts Decl.") [Dkt. No. 55-21]. The instrumentality list sets forth every instrumentality made by Check Point that allegedly infringes Finjan's patents, divided into five product categories: (1) Network Security Products, (2) Endpoint Enterprise Products, (3) Endpoint Consumer Products, (4) Mobile Products, and (5) Cloud Services Products. *Id.* at Ex. A. Within each product category, Finjan identified "Model/Product Identifiers" that include discrete software components and what Check Point alleges are marketing terms, product bundles, and packages. *Id.* It accuses 42 discrete blades, software, components, and services. Declaration of Tamir Zegman ("Zegman Decl.") at ¶ 18 [Dkt. No. 55-2].

Finjan produced seven sets of claim charts (34 total), with one set for each patent asserted in this case. Roberts Decl. at ¶¶ 9-10. Each set contains a chart for each allegedly infringing product category mentioned above. *Id.* Each chart identifies elements of the patent, provides some information about the location of that element within Check Point's products using materials found on Check Point's website, and then references Check Point's source code. Opposition at 3-4 [Dkt No. 60-4]. Check Point notes that the source code citations largely overlap across all the charts within a product category, regardless of which element or patent is being charted. Zegman

1   Decl. at ¶¶ 28-29.

2   Check Point moves to strike a number of Finjan's infringement contentions for violating

3   the Narrowing Order and the Patent Local Rules because the contentions: (1) improperly combine

4   multiple instrumentalities into a single claim chart; (2) fail to provide pinpoint source code

5   citations to each accused instrumentality; (3) improperly use open-ended exemplary product

6   definitions; (4) fail to provide its infringement theory with pinpoint citations sufficient to identify

7   how each accused instrumentality infringes each claim element in each asserted patent; and (5)

8   improperly accuse irrelevant instrumentalities and previously-unidentified instrumentalities

9   without showing good cause. Mot. at 15-24. Taken together, Check Point contends that it is

10   impossible to determine whether Finjan is accusing each product on a stand-alone basis or as part

11   of a combination. *Id.* at 2-3. Check Point asks that I strike the 25 instrumentalities that lack

12   source code citations and to require Finjan (i) to specify whether each remaining instrumentality is

13   being accused alone or as part of a combination (and if so, to specify the combination) and (ii) to

14   disclose its theories about how each source code citation satisfies each claim limitation for which

15   it is cited. *Id.* at 16.

16   **LEGAL STANDARD**

17   Patent Local Rule 3-1 requires:

18   [A] party claiming patent infringement shall serve on all parties a 'Disclosure of
          Asserted Claims and Infringement Contentions[]' . . . [which] shall contain the
19   following information:

20   (a) Each claim of each patent in suit that is allegedly infringed by each opposing
21   party, including for each claim the applicable statutory subsections of 35 U.S.C. §
          271 asserted;
22

23   (b) Separately for each asserted claim, each accused apparatus, product, device,
          process, method, act, or other instrumentality ("Accused Instrumentality") of each
24   opposing party of which the party is aware. This identification shall be as specific
          as possible. Each product, device, and apparatus shall be identified by name or
25   model number, if known. Each method or process shall be identified by name, if
          known, or by any product, device, or apparatus which, when used, allegedly results
26   in the practice of the claimed method or process;

27   (c) A chart identifying specifically where each limitation of each asserted claim is

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party contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function.

(d) For each claim which is alleged to have been indirectly infringed, an identification of any direct infringement and a description of the acts of the alleged indirect infringer that contribute to or are inducing that direct infringement. Insofar as alleged direct infringement is based on joint acts of multiple parties, the role of each such party in the direct infringement must be described.

(e) Whether each limitation of each asserted claim is alleged to be literally present or present under the doctrine of equivalents in the Accused Instrumentality.

"The overriding principle of the Patent Local Rules is that they are designed [to] make the parties more efficient, to streamline the litigation process, and to articulate with specificity the claims and theory of a plaintiff's infringement claims." *Bender v. Maxim Integrated Prods.*, No. 09-cv-01152-SI, 2010 WL 1135762, at *2 (N.D. Cal. Mar. 22, 2010) (alteration in original) (internal citation omitted). Patent Local Rule 3-1 is intended to require the plaintiff "to crystallize its theories of the case early in the litigation and to adhere to those theories once disclosed." *Bender v. Advanced Micro Devices, Inc.*, No. 09-cv-1149-EMC, 2010 WL 363341, at *1 (N.D. Cal. Feb. 1, 2010). It "takes the place of a series of interrogatories that defendants would likely have propounded had the patent local rules not provided for streamlined discovery." *Network Caching Tech., LLC v. Novell, Inc.*, No. 01-cv-2079-VRW, 2002 WL 32126128, at *4 (N.D. Cal. Aug. 13, 2002).

"[A]ll courts agree that the degree of specificity under Local Rule 3-1 must be sufficient to provide reasonable notice to the defendant why the plaintiff believes it has a 'reasonable chance of proving infringement.'" *Shared Memory Graphics LLC v. Apple, Inc.*, 812 F. Supp. 2d 1022, 1025 (N.D. Cal. 2010) (quoting *View Eng'g, Inc. v. Robotic Vision Sys., Inc.*, 208 F.3d 981, 986 (Fed. Cir. 2000)). The local rules do not "require the disclosure of specific evidence nor do they require a plaintiff to prove its infringement case . . . a patentee must nevertheless disclose what in each accused instrumentality it contends practices each and every limitation of each asserted claim to the extent appropriate information is reasonably available to it." *DCG Sys. v. Checkpoint Techs., LLC*, No. 11-cv-03792-PSG, 2012 WL 1309161, at *2 (N.D. Cal. Apr. 16, 2012).

1   **DISCUSSION**

2   **I.   MOTION TO STRIKE**

3   **A.   Use of Group Charts**

4   Check Point argues that Finjan's grouping of the instrumentalities into five groups of

5   products was improper. Mot. at 6-10. Instead, Finjan should have charted the 36 instrumentalities

6   identified by it in a communication to Check Point pursuant to the Narrowing Order because many

7   of the products now contained in the Infringement Contentions are actually marketing terms,

8   packages of products, or broad product categories. *Id.*; Finjan-Check Point – Identification Email

9   ("Identification Email") attached as Ex. A to Roberts Decl. [Dkt. No. 55-19]. According to Check

10   Point, rather than organize its charts to accuse the specific software or instrumentalities listed in

11   the Identification Email, Finjan has instead added previously unidentified software, physical

12   appliances, unspecified servers and devices that might interact with them, and a variety of

13   overarching marketing terms and general "technologies" that it has then grouped to assert that

14   some or all of these things infringe in one or more unspecified combinations. *Id.* at 8; Initial

15   Disclosure.

16   Patent Local Rule 3-1(c) requires an accusing party to provide "[a] chart identifying

17   specifically where each limitation of each asserted claim is found within each Accused

18   Instrumentality." Patent L. R. 3-1(c). The accusing party "must compare an accused product to its

19   patents on a claim by claim, element by element basis for at least one of each defendant's

20   products." *Finjan, Inc. v. Proofpoint, Inc.*, No. 13-cv-05808-HSG, 2015 WL 1517920, at *2

21   (N.D. Cal. Apr. 2, 2015). While under certain circumstances a plaintiff may use a single chart to

22   chart a number of representative products, plaintiff must still, at a minimum, "chart a single

23   product against all elements." *Cap Co. v. McAfee, Inc.*, No. 14-cv-05068-JD, 2015 WL 4734951,

24   at 2* (N.D. Cal. Aug. 10, 2015). A plaintiff does not satisfy this requirement by "mixing and

25   matching between different accused products" in its claim charts, as "[i]nfringement cannot be

26   shown by a muddled hash of elements from different products." *Id.* Combination claim charts

27   (whereby the party asserting infringement describes how multiple products infringe the asserted

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