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**UNITED STATES DISTRICT COURT**  
**NORTHERN DISTRICT OF CALIFORNIA**  
**SAN JOSE DIVISION**

FINJAN, LLC, a Delaware Limited Liability  
Company,

Plaintiff,

v.

SONICWALL INC., a Delaware Corporation,

Defendant.

Case No.: 5:17-cv-04467-BLF-VKD

**SONICWALL INC.’S RESPONSE TO  
FINJAN’S MOTION IN LIMINE NO. 3 TO  
PRECLUDE ARGUMENT THAT  
SONICWALL IS NOT SUCCESSOR-IN-  
INTEREST TO DELL**

Date: March 18, 2021  
Time: 1:30 PM  
Courtroom: 3, 5<sup>th</sup> Floor  
Judge: Hon. Beth Labson Freeman

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**TABLE OF REFERENCED EXHIBITS<sup>1</sup>**

August 18, 2020 Transcript of Proceedings by Zoom Webinar	Ex. 35
August 15, 2018 Defendant SonicWall Inc.'s Responsive Damages Contentions Pursuant to Patent L.R. 3-9	Ex. 36

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<sup>1</sup> All exhibits are attached to the Declaration of Jarrad M. Gunther.

1 Finjan’s Motion *in Limine* (“MIL”) No. 3 seeks to preclude SonicWall from responding to  
2 Finjan’s claim of pre-suit notice by contending that pre-suit notice communications with Dell cannot  
3 be imputed to SonicWall. Dkt. 368 (redacted version) at 1 (relying on Federal Rules of Evidence  
4 401, 402, 403, and 611). Specifically, Finjan argues that SonicWall “attempted to unveil a new  
5 defense, never before presented—or preserved—in any part of the case to date.” *Id.*

6 The Court should deny Finjan’s motion. Finjan – not SonicWall – bears the burden of proof  
7 as to its compliance with the marking statute. To the extent the identification of this defense was  
8 sought during discovery, SonicWall identified it. Indeed, the parties argued a discovery dispute  
9 before Judge DeMarchi on this exact issue, on which SonicWall prevailed. Far from “forfeit[ing]”  
10 the argument, SonicWall successfully defended itself against Finjan’s meritless claim for discovery  
11 sanctions, and the record reflects that Finjan’s counsel was fully aware of SonicWall’s position.

12 Finjan’s effort to go further and have the Court adjudicate the merits of SonicWall’s  
13 contention is an untimely request for summary judgment that is not a proper subject for a motion *in*  
14 *limine*.

#### 15 **I. Finjan Bears the Burden of Proving Notice of Infringement to SonicWall**

16 Finjan argues that SonicWall’s Answer, written discovery, and damages contentions  
17 “forfeited” an argument that Finjan’s alleged pre-suit notice of infringement to non-party Dell does  
18 not apply to SonicWall Inc., the present defendant. Finjan has it backwards. The marking statute is  
19 “not a statutory *defense* to an action for infringement; it [is] a limitation on damages.” *Bradford Co.*  
20 *v. Jefferson Smurfit Corp.*, 2001 WL 35738792, \*9 (Fed. Cir. 2001)). **Finjan** thus bears the burden  
21 of proof on the issue. *Arctic Cat Inc. v. Bombardier Recreational Prod. Inc.*, 876 F.3d 1350, 1366  
22 (Fed. Cir. 2017) (“There is no dispute that the patentee bears the burden of pleading and proving he  
23 complied with § 287(a)’s marking requirement.”); 35 U.S.C. § 287(a) (“In the event of failure so to  
24 mark, no damages shall be recovered by the patentee in any action for infringement, except on proof  
25 that the infringer was notified of the infringement and continued to infringe thereafter.”). Part and  
26 parcel of this burden is the burden to show that the alleged notice can be imputed to the defendant.  
27 *Cf. Fed. Mach. & Welder Co. v. Mesta Mach. Co.*, 27 F. Supp. 747, 751 (W.D. Pa. 1939), *decree*  
28 *rev’d on other grounds*, 110 F.2d 479 (3d Cir. 1940) (“The oral notice given by McBerty to Bedell,

1 an employee of defendant, was not notice to the defendant. The burden rested upon the plaintiff to  
2 prove that the receipt of such a notice and the communication thereof to the defendant was within the  
3 authority of the employee. Plaintiff failed to meet this burden.”). Absent such proof, Finjan’s  
4 damages claim is limited to that period after it provided *SonicWall* actual notice of infringement.

## 5 **II. SonicWall’s Responsive Arguments Are Neither New Nor a Surprise**

6 Perhaps cognizant of its own evidentiary holes, Finjan argues here that SonicWall’s position  
7 should be deemed “forfeit.” But the record confirms that Finjan cannot credibly contend that it lacked  
8 notice of SonicWall’s position nor that it was “unveiled” for the first time in pre-trial correspondence.

### 9 **A. Finjan Conceded Notice of SonicWall’s Defense Via the RFA Motion Practice**

10 This issue of the imputation of knowledge from Dell to SonicWall was front-and-center in  
11 SonicWall’s discovery responses and in the resulting motion practice – which Finjan lost.  
12 Remarkably, Finjan now argues that the “only hint ... of SonicWall disputing inherited notice was  
13 when SonicWall unaccountably refused Requests for Admission on the subject.” MIL No. 3 at 3  
14 More than a mere “hint,” SonicWall’s contention that Finjan’s discussions with Dell could not be  
15 imputed to SonicWall was at the forefront of a vigorously fought dispute regarding SonicWall’s  
16 responses to Finjan’s Request for Admissions (“RFA”).

17 By way of background, those RFAs acknowledged that Finjan’s pre-suit communications  
18 were with Dell, not SonicWall. *See* Dkt. 276-1 at, e.g., RFA Nos. 13 (seeking an admission related  
19 to an email “to Dell”), 14 (“Admit that Finjan and Dell had a meeting ... .”), 15 (“Admit that on  
20 October 12, 2016, Finjan delivered a presentation to Dell ... .”). Then, in RFAs 17-22, Finjan sought  
21 admissions regarding SonicWall’s knowledge of Finjan’s patents, litigations, and licenses prior to the  
22 filing of the Complaint, and as far back as 2014. *Id.* SonicWall objected to and denied these RFAs  
23 on various bases, including that it “did not exist in 2014,” but where possible, responded as to its  
24 knowledge “post-divestiture from Dell in 2016.” Dkt. 276-1 at pp. 8-9.

25 Motion practice then ensued on the issue of imputation of corporate knowledge (the very  
26 subject of this MIL). Finjan asserted that these objections and denials were inappropriate attempts  
27 by SonicWall to “bury its head in the sand,” and Finjan even sought sanctions. Dkt. 276 at 2. In  
28 response, SonicWall argued, “[w]hile Finjan and SonicWall disagree regarding the legal consequence

1 of SonicWall's corporate form with respect to imputation of knowledge, that dispute is not properly  
2 resolved on a discovery motion regarding the adequacy of RFA responses." Dkt. 276 at 3.

3 Then, at the hearing before Magistrate Judge DeMarchi, Finjan's counsel fully appreciated  
4 the issue, asking rhetorically: "So if Finjan goes and puts a party on notice about other patents and  
5 other lawsuits and they change their corporate entity, is that a basis for denials?" Ex. 35 at 29:12-15.  
6 Judge DeMarchi denied Finjan's motion, finding that SonicWall's responses were appropriate. Dkt.  
7 281. In denying Finjan's motion, Judge DeMarchi further previewed that this would be an issue that  
8 would need to be resolved at trial:

9 I think SonicWall has responded to the substance of the matter in the sense that it has said  
10 "We're a corporate entity as of 2016. We were not a corporate entity before 2016. We were  
11 a business unit of some other organization," and they've answered on that basis. Now, the  
12 parties could have a fight about that and could also have a fight about whether information  
13 known to Dell and its business unit SonicWall and the employees of that organization is  
14 relevant to SonicWall's willfulness if it's known to infringe or relevant to the hypothetical  
15 negotiation. But going back to my earlier comment, I think what you're really after there is  
16 an admission about what individual people knew as opposed to the corporate entity. That's  
17 maybe the question you should have asked.

18 Ex. 35 at 30:16-31:4. In response, Finjan's counsel complained that SonicWall was "hiding behind  
19 a corporate shell game of changing the corporate structure," but conceded that he understood why  
20 Judge DeMarchi disagreed. *Id.* at 32:22-33:2.

21 Notably, Judge DeMarchi also gave Finjan the opportunity to present its argument—as it does  
22 here again—that SonicWall's response to Interrogatory No. 1 somehow contradicted its later RFA  
23 responses. But, upon hearing SonicWall's response to Interrogatory No. 1, Judge DeMarchi  
24 disagreed with Finjan's characterization that there was some sort of inconsistency:

25 **THE COURT:** Okay. But so your point is, it looked like -- or it sounds like in the answer [to  
26 Interrogatory No. 1] SonicWall distinguished between itself and its predecessor entity so it  
27 didn't answer based on sort of a unified theory of the predecessor entity and SonicWall, Inc.,  
28 are one and the same but did provide that information.

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