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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,

Plaintiff,

v.

ESET, LLC and ESET SPOL. S.R.O.,

Defendants.

Case No.: 17CV183 CAB (BGS)

**ORDER ON DISCOVERY DISPUTE
REGARDING INTERROGATORY
NO. 6**

[ECF 215]

Plaintiff Finjan, Inc. (“Finjan”) seeks to compel further responses to Finjan’s Interrogatory No. 6 (“ROG 6”) which seeks ESET, LLC and ESET spol. S.R.O.’s (“ESET”) noninfringement contentions. (Joint Statement on Discovery Issue Relating to ESETs Response to Finjan’s Interrogatory No. 6, ECF 215 at 1-3¹.) ESET opposes providing any further response. (*Id.* at 4-6.) For the reasons set forth below, Finjan’s request is **GRANTED in part and DENIED in part.**

¹ The Court references the CM/ECF pagination. ECF 215 corresponds to the parties’ Joint Statement and ECF 215-1 corresponds to Exhibit A, ESET’s Response to Plaintiff’s Second Set of Interrogatories.

1 **I. BACKGROUND**

2 ROG 6 states:

3 Separately for each Asserted Claim of the Asserted Patents, identify all legal
4 and factual bases for your contention that ESET does not infringe such claim,
5 including a chart that identifies each claim element that ESET contends is not
6 satisfied by the Accused Instrumentality(ies) for that claim, and a substantive,
7 particularized description of how and why that element is not satisfied,
8 including citation to specific components and functions of the Accused
Instrumentality(ies) and all documents and things in support of your position,
including source code modules.

9 (ECF No. 215-1 at 8.)

10 ESET responded without waiving its general and specific objections. (ECF No.
11 215-1 at 8.) As to each patent-in-suit it provided a chart which listed in italics the
12 limitations the accused instrumentalities do not infringe. (*Id.* at 10-20.) As to some of
13 the patents-in-suit ESET also provided a brief explanation as to how the products do not
14 infringe the asserted claims. For example, “it does not practice the claimed methods”
15 (ECF 215-1 at 11, 15); “its products only function downstream of the web server” (*id.* at
16 11); “[it] does not provide ‘memory storing a first rule set’” (*id.*); “it does not provide the
17 ‘network interface’ component of the system” (*id.* at 14); “its products do not modify
18 Downloadables to append any information to the end of the Downloadable, nor do any of
19 the products generate a Downloadable Security Profile” (*id.* at 16); “it does not supply at
20 least the ‘processor,’ ‘memory,’ ‘operating system probes,’ or ‘interrupter.” (*Id.* at 18.)

21 **II. DISCUSSION**

22 Finjan argues that ESET’s response is insufficient. As to ESET’s chart, Finjan
23 seeks explanation why any element is not met since Finjan’s infringement contentions
24 explain how that element is in fact met. (ECF No. 215 at 2.) Finjan cites to various
25 districts’ local patent rules and decisions applying them that require detailed explanations
26 in support of noninfringement contentions. (*Id.* at 3 nn. 1-4.) As to the additional
27 descriptions ESET set forth as to some of the patents-in-suit, (detailed above), Finjan
28 complains that ESET does not tie these short descriptions to claim elements nor does

1 ESET provide any support for its position. (*Id.*) Finjan claims prejudice for this
2 conclusory response in that it is not on fair notice of ESET's noninfringement
3 contentions, and it cannot focus its discovery efforts and develop its case. (*Id.* at 4.)

4 ESET argues the ROG goes beyond the permitted 25 interrogatories, is premature,
5 and overly burdensome. (ECF No. 215 at 5.) Further, it asserts that its response is
6 sufficient, identifying the specific elements missing from the claims, and has explained
7 why those elements are missing. (*Id.*) ESET contends it cannot prove a negative. (*Id.* at
8 It is not possible for it to identify specific source code and documents to prove what
9 ESET's code does not do. (*Id.* at 7.)

10 **A. Legal Standards**

11 In general, the Federal Rules of Civil Procedure provide that "parties may obtain
12 discovery regarding any non-privileged matter that is relevant to any party's claim or
13 defense and proportional to the needs of the case." Fed. R. Civ. P. 26(b)(1). District
14 courts have broad discretion in determining what is relevant regarding discovery.
15 *Facedouble, Inc. v. Face.com*, No. 12cv1584 DMS (MDD), 2014 WL 585868, at *1
16 (S.D. Cal. Feb. 13, 2014). Limits on discovery may be issued where the "burden or
17 expense outweighs the likely benefits." *Id.* (citing Fed. R. Civ. P. 26(b)).

18 "An interrogatory may relate to any matter that may be inquired into under Rule
19 26(b)." Fed. R. Civ. P. 33(a)(2). Furthermore, "[e]ach interrogatory must, to the extent it
20 is not objected to, be answered separately and fully in writing under oath." Rule
21 33(b)(3). In certain circumstances the responding party has the option to answer the
22 interrogatory by specifying responsive records and making those available to the
23 interrogating party. Rule 33(d).

24 Contention interrogatories are distinct from interrogatories seeking the
25 identification of witnesses or documents related to allegations. *In re Grand Casinos Inc.*
26 *Sec. Litig.*, 181 F.R.D. 615, 618 (D. Minn. 1998). Contention interrogatories may ask
27 another party to state all the facts on which it bases its contentions. *Id.* Further, a
28 contention interrogatory is appropriate during the early phases of discovery where

1 answering them would “‘contribute meaningfully’ to (1) clarifying the issues of the case;
2 (2) narrowing the scope of the dispute; (3) setting up early settlement discussion; or (4)
3 exposing a substantial basis for a motion under Rule 11 or Rule 56.” *HTC Corp. v. Tech.*
4 *Props. Ltd.*, No. C08-00882, 2011 WL 97787, at *2 (N.D. Cal. Jan. 12, 2011) (quoting *In*
5 *re Convergent Techs. Sec.Litig.*, 108 F.R.D. 328, 338-39 (N.D. Cal. 1985)). “A non-
6 infringement contention interrogatory is appropriate where plaintiff has provided its
7 infringement contentions with corresponding claim charts, thereby allowing defendant to
8 respond.” *Audatex N. Am. Inc. v. Mitchell Int’l, Inc.*, No. 13cv1523 BEN (BLM), 2014
9 WL 4961437, at *3 (S.D. Cal. Oct. 3, 2014); *see also Facedouble, Inc.* 2014 WL 585868,
10 at *2.

11 **B. Analysis**

12 **1. Waiver of Objections**

13 In its response to ROG 6, ESET objected generally and specifically, alleging in
14 part that it was premature and well beyond the twenty-five limit for interrogatories. (ECF
15 No. 215-1 at 8-9.) However, ESET then responded “subject to and without waiving”
16 these objections. (*Id.* at 9.) This language is typically referred to as a conditional
17 response.

18 Written responses to requests for production of documents must be unconditional,
19 and may not reserve the right to raise objections in the future. Language such as “without
20 waiving objections” preserves nothing. *Consumer Elecs. Ass’n v. Compras and Buys*
21 *Magazine, Inc.*, No. 08-21085-CIV, 2008 WL 4327253, at *3 (S.D. Fla. Sept. 18, 2008).
22 Objections preceding such language are deemed waived, and the response to the
23 discovery request stands. *Estridge v. Target Corp.*, No. 11-61490-CIV, 2012 WL
24 527051, at *2 (S.D. Fla. Feb. 16, 2012). Notwithstanding, if the response puts the
25 requesting party on notice that the responding party is withholding certain documents,
26 that objection is preserved so long as the requesting party is not left guessing as to what
27 documents are being withheld. *Sprint Commc’ns Co., v. Comcast Cable Commc’ns,*
28 *LLC*, Nos 11-2684, 2685, 2686 –JWL, 2014 WL 1569963, at *3 (D. Kan. April 18,

1 2014). In such a case the objection is not waived. Instead, the proper procedure is to
2 challenge the objection by bringing a motion to compel and requiring the responding
3 party to defend the merits of its response.

4 The Court finds that ESET's objections based on prematurity and excessive
5 interrogatories waived. However, it finds ESET's response to ROG 6 has preserved its
6 objections as to overly broad and unduly burdensome.

7 **2. Whether the Scope of Interrogatory 6 is Overly Broad and** 8 **Burdensome; and Whether Supplemental Responses are Necessary**

9 As an initial matter, the Court notes that ROG 6 asks ESET to "identify *all*
10 legal and factual bases," as well as citations to *all* documents and things in
11 support" of its position. (ECF 215-1 at 8 (emphasis added).) The Court finds this
12 request is overly broad and unduly burdensome. An interrogatory may reasonably
13 ask for the material and principal facts which support a contention. However, to
14 require all facts, applications of law, all documents and things "would too often
15 require a laborious, time consuming analysis." *IBP, Inc. v. Mercantile Bank of*
16 *Topeka*, 179 F.R.D. 316, 321 (D. Kan. 1998). The burden to answer then
17 outweighs its benefit. *Id.* The request's excessively burdensome nature becomes
18 especially clear when considering Finjan's stated purpose for asking it: to be given
19 fair notice of ESET's noninfringement contentions and to be able to focus its
20 discovery efforts. (ECF No. 215 at 4.) Satisfying these purposes does not
21 however, require ESET to reply with the entire body of legal and factual evidence
22 in its possession. Therefore, the Court narrows this interrogatory to require ESET
23 to state the principal and material factual and legal bases for asserting its non-
24 infringement contentions, including identifying the principal and material evidence
25 upon which it relies. *See e.g. High Point SARL v. Sprint Nextel Corp.*, No. 09-
26 2269, 2011 WL 197875, at *2 (D. Kan. Jan. 20, 2011) (citing *Anderson v. UPS,*
27 *Inc.*, No. 09-2526, 2010 WL 4822564, at *6 (D. Kan. Nov. 22, 2010)).
28

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