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 DISPUTES RE: ESET'S INTERROGATORIES 4 AND 6

This Order addresses two discovery disputes currently pending before the Court, ESET's Interrogatory Nos. 4 and 6 to Finjan. Each has been raised by the parties, discussed during a discovery conference, and briefed in joint statements. (ECF 300.)[1] The Court rules as set forth below as to each.

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[1] There are additional discovery disputes raised in this joint statement that the Court will address separately.

DISCUSSION

I. Interrogatories 4 and 6

ESET seeks further responses to two of its contention interrogatories. Interrogatory No. 4 seeks very specific information in a chart regarding Finjan's positions on ESET's positions on invalidity of the patents-in-suit. Interrogatory No. 6 seeks a chart providing priority dates on a claim-by-claim basis with mapping of each claim element to the portions of the specification in support.

The Federal Rules of Civil Procedure provide that "[p]arties may obtain discovery regarding any non-privileged matter that is relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit." Fed. R. Civ. P. 26(b)(1). District courts have broad discretion in determining what is relevant. *Facedouble, Inc. v. Face.com*, No. 12cv1584 DMS (MDD), 2014 WL 585868, at *1 (S.D. Cal. Feb. 13, 2014). And, the 2015 Amendments to Rule 26 made clear that "[r]elevancy alone is no longer sufficient—discovery must also be proportional to the needs of the case." *In re Bard IVC Filters Prods. Liability Litig.*, 317 F.R.D. 562, 564) D. Ariz. 2016). Limits on discovery may be issued where the "burden or expense outweighs the likely benefits." *Facedouble, Inc.*, 2014 WL 585868, at *1 (citing Fed. R. Civ. P. 26(b)). "The court's responsibility, using all the information provided by the parties, is to consider these, [undue burden or expense and importance of information sought,] and all the other factors in reaching a case-specific determination of the appropriate scope of discovery." Fed. R. Civ. P. 26 advisory committee's notes.

"An interrogatory may relate to any matter that may be inquired into under Rule 26(b)." Fed. R. Civ. P. 33(a)(2). "Each interrogatory must, to the extent it is not objected to, be answered separately and fully in writing under oath." Rule 33(b)(3). Interrogatories that seek an opposing party's contentions on a topic within the scope of

Rule 26(b) are permitted. Fed. R. Civ. P. 33(a)(2) ("An interrogatory is not objectionable merely because it asks for an opinion or contention that relates to fact or the application of law to fact.") Contention interrogatories are generally distinguished by, as the name suggests, their request for an opposing party to state its position, or contention, on a particular point. *See In re Grand Casinos Inc. Sec. Litig*., 181 F.R.D. 615, 618 (D. Minn. 1998). They may also ask the opposing party to identify the facts, law, or evidence supporting the party's contention. *Id.* Among other reasons, contention interrogatories are used to "narrow the issues that will be addressed at trial and to enable the propounding party to determine the proof required to rebut the respondent's position." *Former S'holders of Cardiospectra, Inc. v. Volcano Corp.*, Case No. 12-CV-1535-WHO, 2013 WL 5513275, * 1 (N.D. Cal. 2013) (quoting *Lexington Ins. Co. v. Commonwealth Ins. Co.*, C98-3477CRB (JCS), 1999 WL 33292943, *7 (N.D. Cal. Sept. 17, 1999)). They are often considered more appropriate after substantial discovery is completed. *Id.* at *2.

A. Interrogatory No. 4 – Invalidity Positions

ESET's Interrogatory No. 4 seeks Finjan's contentions regarding ESET's invalidity contentions. It broadly seeks "all legal and factual bases" for Finjan's contention that a claim is valid and very specifically requests the answer in the form of a claim chart broken out by each claim element Finjan contends is not covered by the prior art identified by ESET, a particularized description of how and why it is not covered with citation to specific portions of prior art, and "all Documents and Things" in support. It requests the response include a complete explanation for any disagreements with ESET's invalidity contentions.

ESET argues the interrogatory is equivalent to a Finjan interrogatory seeking ESET's position on which elements of the asserted claims were not practiced by ESET's accused products and seeks the response in a similar chart format. In essence, ESET argues Finjan should have to provide the same level of detail explaining its position with

regard to ESET's invalidity contentions as Finjan demanded of ESET regarding its position on Finjan's infringement contentions.

Finjan has responded to the interrogatory, incorporating its response to Interrogatory No. 3 which includes citation of prior decisions of the Patent Office, district court, and Federal Circuit decisions addressing the validity of the patents-in-suit. Finjan's response also indicates that it disagrees that any of the alleged prior art references invalidates any element of the asserted claims.[2] Finjan argues the detail demanded and the chart format is unduly burdensome, seeks explanations that are the subject of expert opinions that will be provided later, and that it cannot provide a detailed response to ESET's invalidity contentions when the underlying invalidity contentions ESET seeks a response to are not detailed enough to permit the response demanded. Finjan also argues the interrogatory is compound with numerous subparts and improperly shifts the burden of proof on validity to Finjan.

As a threshold issue, Finjan argues that requiring it to explain why its patents are valid shifts the burden of proving invalidity, ESET's burden, to Finjan. However, importantly "[t]he ultimate burden of invalidity . . . does not dictate the scope of discovery. *SPH Am., LLC v. Research in Motion, Ltd.*, No. 13CV2320 CAB (KSC), 2016 WL 6305414, at *2 (S.D. Aug. 15, 2016) (quoting Rule 26(b)(1) regarding scope of discovery). If ESET is able to present a *prima facie* case of invalidity, Finjan would need to present rebuttal evidence as to validity. *Innovative Scuba Concepts, Inc. v. Feder Indus.*, 26 F.3d 1112, 1115 (Fed. Cir. 1994). To the extent ESET has set out its position on invalidity, it is essentially asking for Finjan's rebuttal positions. That ESET always has the burden of proving invalidity, does not mean Finjan's positions on validity are not relevant or potentially within the scope of permissible discovery. *See Apple, Inc. v. Wi-LAN Inc.*, Case No. 14CV2235 DMS (BLM), 2018 WL 733740, at *5 (S.D. Cal. Feb. 6,

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[2] The Court is not addressing any objections that haven not been specifically raised with the Court.

2018) ("not required to establish a *prima facie* case of invalidity before . . . seeking discovery on . . . validity contentions"). However, as noted above, relevance alone is not sufficient, the discovery sought must also be proportional to the needs of the case.

Interrogatory No. 4 is overbroad. As the Court explained in a prior order on an interrogatory propounded by Finjan, asking the opposing party to "identify all legal and factual bases" and for "all documents and things in support" of a position is overly broad and unduly burdensome. (March 23, 2018 Order on Finjan's Interrogatory No. 6 at 5.) In addition to the additional limitations set forth below, the Court narrows this interrogatory to only require Finjan to state the principal and material factual and legal bases for its positions. (*Id.*)

As to whether the interrogatory is unduly burdensome based on the format and specificity required, the parties principally rely on two cases., *SPH Am., LLC v. Research in Motion* and *Apple, Inc. v. Wi-LAN. SPH Am., LLC*, 2016 WL 6305414, at *1-3; *Apple*, 2018 WL 733740, at *5.[3] However, the interrogatories in these cases did not request a response as detailed as that demanded by ESET here and, even though both courts required a complete response to less burdensome interrogatories, neither required a response in a chart. *SPH Am.*, 2016 WL 6305414, at *1-2 (requiring complete explanation for any disagreements with defendant's invalidity contentions, but not in a chart); *Apple*, 2018 WL 733740, *5 (requiring "comprehensive responses to these interrogatories, including the factual and legal bases for . . . validity contentions," but denying claim charts for each asserted prior art reference for each asserted claim as unduly burdensome).[4]

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[3] The parties cite other cases in their briefing on this interrogatory, but those cases address different issues.

[4] *Friskit v. Real Networks*, also found a plaintiff was not required to produce and element-by-element validity claim chart, but relied primarily on the absence of a requirement for it under the Patent Local Rules and the presumption of validity addressed above. No. C 03-5085 WWS (MEJ), 2006 WL 1305218, at *2 (N.D. Cal. May 11, 2006).

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