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14 IN THE UNITED STATES DISTRICT COURT
15 SOUTHERN DISTRICT OF CALIFORNIA

16 FINJAN, INC.,

17 Plaintiff,

18 v.

19 ESET, LLC and ESET SPOL. S.R.O.,
20

21 Defendants.
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23
24
25

Case No. 17-cv-0183 CAB (BGS)

**FINJAN, INC.’S RESPONSE TO
DEFENDANTS’ MOTION FOR
ADDITIONAL DISCOVERY AND
ISSUANCE OF LETTER OF
REQUEST**

District Judge: Hon. Cathy Ann
Bencivengo
Magistrate Judge: Hon. Bernard G.
Skomal

1 **I. INTRODUCTION**

2 Plaintiff Finjan, Inc. (“Plaintiff” or “Finjan”) opposes Defendants ESET, LLC
3 and ESET SPOL. S.R.O.’s (“Defendants” or “ESET”) Motion for Additional
4 Discovery and Issuance of Letter of Request. (D.I. 833) ESET fails to show good
5 cause exists for a costly, redundant, and unrestrained second deposition of nonparty
6 foreign witness, Mr. Shlomo Touboul, which is duplicative of ESET’s March 28,
7 2018 Subpoena to Produce Documents and July 23, 2018 deposition. Failing to show
8 good cause for why nonparty Touboul should sit for a second deposition in this case
9 or why Finjan should have to spend the resources of having to attend the same, Finjan
10 respectfully requests the motion be denied.

11 **II. BACKGROUND**

12 On May 7, 2018, the Court stayed discovery as to U.S. Patent No. 7,975,305
13 (“the ’305 Patent”), which was subject to review under *Inter Partes* Review (“IPR”).
14 (See D.I. 251) However, the Court expressly permitted limited discovery given
15 international nonparty inventor issues, and the Hague Convention. (See D.I. 277 at
16 6:22-10:6) The Court explained “it makes more sense to get an exclusion from the
17 Court to continue to pursue discovery, at least that limited discovery that is out of the
18 country so that if the patent is affirmed and comes back from the PTO, we’ll be more
19 ready to go rather than having to start from square one.” (D.I. 277 at 6:22-7:7) Thus,
20 the Court ordered “to the extent the parties wish to jointly pursue discovery on the
21 ’305 for economic and efficiency reasons, particularly with regard to international
22 discovery, *the stay is lifted for that purpose.*” (D.I. 277 at 9:20-10:6) (emphasis
23 added)

24 On July 23, 2018, ESET deposed Mr. Touboul, founder of Finjan and a named
25 inventor on the ’305 Patent, in Tel Aviv, Israel.¹ (See Exh. A) ESET questioned
26 _____

27 ¹ All exhibits are attached to the Decl. of Jason W. Wolff ISO Finjan’s Resp. to Mot.
28 for Add’l Discovery, filed contemporaneously herewith.

1 Mr. Touboul about his July 6, 2018 document production, which he produced in
2 response to ESET’s March 28, 2018 subpoena *duces tecum*. (Exh. A at 89:3-95:3;
3 Exh. B) On November 10, 2020, ESET attempted to serve counsel for Finjan with a
4 second notice of subpoena and request for documents to Mr. Touboul. Mr. Touboul,
5 however, is not represented by counsel for Finjan and it cannot accept service on his
6 behalf. ESET subsequently filed its discovery motion on November 23, 2020.
7 Having already incurred the burden and expense of defending nonparty
8 Mr. Touboul’s deposition in Israel—which included the ability for ESET to question
9 Mr. Touboul regarding the ’305 Patent—Finjan opposes a second deposition.

10 **III. LEGAL STANDARDS**

11 A nonparty may be commanded by subpoena to testify at a deposition. Fed. R.
12 Civ. P. 45(a). Further, “a party must obtain leave of court, and the court must grant
13 leave to the extent consistent with Rule 26(b)(2),” if “the deponent has already been
14 deposed.” Fed. R. Civ. P. 30(a)(2)(A)(ii). “Unless otherwise stipulated or ordered by
15 the court, a deposition is limited to 1 day of 7 hours. The court must allow additional
16 time consistent with Rule 26(b)(2) if needed to fairly examine the deponent.” Fed. R.
17 Civ. P. 30(d)(1); *see also* Fed. R. Civ. P. 26(b)(2)(A) (“By order, the court may alter
18 the limits in these rules on . . . the length of depositions under Rule 30.”).

19 Moreover, “[a] party seeking a court order to extend the time of a deposition
20 must show good cause to justify such an order.” *Evenchik v. Avis Rent A Car Sys.,*
21 *LLC*, 2014 WL 12899139, at *2 (S.D. Cal. Mar. 28, 2014) (citing *Stonebreaker v.*
22 *Guardian Life Ins. Co. of Am.*, 2012 U.S. Dist. LEXIS 13307, at *5 (S.D. Cal. Feb. 3,
23 2012)). Rule 30(d)(1)’s reference to Rule 26(b)(2) requires the Court to limit the use
24 of any discovery method if: “(i) the discovery is unreasonably cumulative or
25 duplicative, or can be obtained from another source that is more convenient, less
26 burdensome, or less expensive; (ii) the party seeking discovery has had ample
27 opportunity to obtain the information by discovery in the action; or (iii) the proposed
28

1 discovery is outside the scope permitted by Rule 26(b)(1).” Fed. R. Civ. P. 26(b)(2).

2 **IV. ARGUMENT**

3 ESET has not met its burden to establish each of the three requirements under
4 Rule 26(b)(2) to take a second deposition of Mr. Touboul—a *nonparty foreign*
5 *witness*. After failing to reasonably manage the seven hours it was allowed under
6 Rule 30(d)(1), ESET seeks an unrestricted, second full day of deposition on topics
7 that were either covered or could have been covered in his first deposition.

8 **First**, Rule 26(b)(2) asks whether the discovery sought is “unreasonably
9 cumulative or duplicative.” Mr. Touboul was already deposed for a full seven hours.
10 Further, the subject matter of the examination described in ESET’s Letter of Request
11 is duplicative of topics covered in Mr. Touboul’s July 23, 2018 deposition. For
12 example, ESET seeks to examine Mr. Touboul about his “employment, business
13 relationship, and communications with Finjan; Finjan’s products; ESET’s products,
14 participation in Finjan litigation; corporate, financial, and marketing history of Finjan,
15 and the state of the art of computer security as of 2000.” (D.I. 833 Ex. A at 3 ¶ 5)
16 However, Mr. Touboul has already testified on this at his first deposition, where he
17 described in his role as founder, CEO, and board member of Finjan (Exh. A at 23:19-
18 21, 26:13-27:10, 39:14-40:17); the patents-in-suit (Exh. A at 165:21-172:11, 218:3-
19 223:5, 232:7-236:3); Finjan’s Surfin and Vital Security products (Exh. A at 28:1-
20 29:21, 44:7-45:10, 61:18-22, 65:17-68:9, 101:11-104:5, 277:11-279:2; 281:7-283:2,
21 286:13-288:4); ESET’s products, such as NOD32, NOD-iCE, and HMVS (Exh. A at
22 70:14-72:2); and the corporate, financial, and marketing history of Finjan (Exh. A at
23 34:18-36:22, 40:18-42:13, 46:21-50:7, 306:6-311:6). Moreover, ESET asked Mr.
24 Touboul about the ’780 Patent, grandparent to ’305 Patent, and about products
25 embodying the shared disclosure of the ’780 Patent. (Exh. A at 171:7-12, 179:7-
26 180:20; 181:10-186:16, 209:7-213:10) And ESET asked about prior art available in
27 the 2000 time period. (Exh. A at 323:3-329:14)

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1 Mr. Touboul testified about documents in his possession and produced in
2 response to the 2018 subpoena, which overlaps the requests in the new subpoena.
3 (Exh. A at 80:17-85:10; 89:3-95:3; *compare* Exh. B at 9-12 (Document Request Nos.
4 1-10, 12-13, 16, and 18) *with* D.I. 833 Ex. A at 3 ¶ 6) More discovery is duplicative
5 because Mr. Touboul and his then counsel confirmed his production was inclusive of
6 all relevant, responsive, and non-privileged documents regarding Finjan. (Exh. A at
7 84:22-85:10) ESET’s sought-after discovery is not limited in scope and covers topics
8 the Court, Finjan, and Mr. Touboul did not restrict ESET from covering in Mr.
9 Touboul’s first deposition. Thus, ESET fails to show the good cause required to
10 subject Mr. Touboul and Finjan to the expense of more discovery.

11 **Second**, ESET had “ample opportunity to obtain the information by discovery
12 in the action.” Fed. R. Civ. P. 26(b)(2). While ESET was not required to pursue
13 discovery on the ’305 patent, it was not prohibited either. Nonetheless, ESET deposed
14 Mr. Touboul on overlapping topics described above. Pursuant to the Court’s June 14
15 Order, ESET could have – but ultimately chose not to – pursue discovery on the ’305
16 Patent for efficiency and economic purposes. Indeed, Finjan warned ESET this would
17 be the appropriate opportunity to ask Mr. Touboul questions regarding the ’305
18 Patent. (*See* Exh. C) Nonetheless, ESET failed to pursue deposition testimony on the
19 ’305 Patent, even after Mr. Touboul testified that he was prepared to do so. (*See* Exh.
20 A at 435:1-22) Instead, ESET objected to Finjan’s examination of Mr. Touboul, and
21 argued that Finjan’s questions violated the Court’s order for the stay.² (*See id.* at
22 432:18-20) Moreover, while estoppel pursuant to 35 U.S.C. § 315(e) applies here,
23 ESET acknowledges it has not yet served amended invalidity contentions to address
24 the ’305 Patent; nor has it consulted with its expert to address potential issues to be
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26 ² Finjan did not violate the Court’s Order. (*See* D.I. 833 at 1) Finjan’s examination
27 falls squarely within the Court’s goal of achieving efficiency by allowing limited
28 discovery on the ’305 Patent. (*See* D.I. 277 at 8:17-24)

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