

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA
THE HONORABLE CATHY ANN BENCIVENGO

FINJAN, INC.,)
)
Plaintiff,) CASE NO. 17CV183-CAB-BGS
)
vs.) FRIDAY, FEBRUARY 21, 2020
)
ESET, LLC and ESET SPOL. S.R.O.,) 2:00 P.M.
)
Defendants.)

Reporter's Transcript of Motions in Limine Hearing
Pages 1-70

For The Plaintiff:

Kramer Levin Naftalis & Frankel, LLP
Paul Andre
James Hannah
Kristopher Kaskins
990 Marsh Road
Menlo Park, California 94025

For The Defendants:

Eversheds Sutherland (US) LLP
Justin E. Gray
Nicola A. Pisano
Scott A. Penner
Jose Patino
Regis Worley
12255 El Camino Real, Suite 100
San Diego, California 92130

Proceedings recorded by stenography, transcript produced by
computer assisted software

Mauralee Ramirez, RPR, CSR No. 11674
Federal Official Court Reporter
ordertranscript@gmail.com

1 San Diego, California; Friday, February 21, 2020; 2:00 p.m.

2 (Case called)

3 MR. ANDRE: Good afternoon, your Honor. Paul Andre
4 for Finjan. With me today is James Hannah and Kris Kastens.

5 MR. KATSTENS: Good afternoon, your Honor.

6 MR. ANDRE: And with me today is our client, Ms. Julie
7 Mar-Spinola and Ann Taylor.

8 THE COURT: Thank you.

9 MR. PISANO: Good morning, your Honor. Nic Pisano of
10 Eversheds Sutherland on behalf of the defendants. With me
11 today is Scott Penner, Justin Gray, Joe Patino, and Regis
12 Worley.

13 THE COURT: Thank you. Good afternoon. We'll start
14 with the motions in limine and then we'll talk about the
15 pretrial order and then some trial specifics. I'll start with
16 Finjan's motions. The first one is at 746, motion in limine 1,
17 precluding irrelevant evidence of Finjan products. And I guess
18 to some extent, the Court thinks this sort of counterparts with
19 the preliminary filed by ESET at 745, number 5 -- I'm sorry,
20 not 5 -- yes, at 5. The commercial success issue. If I'm
21 following this correctly, you don't want them talking about
22 your products but you want to offer your products as evidence
23 of commercial success. So you can't have it both ways. If you
24 are going to have someone testify -- and I know I have an
25 outstanding issue on the commercial success expert as to

1 whether or not he can lay a foundation that he has determined
2 that these patents were practiced in these products and what
3 his basis for that is and that there's nexus to the sale of the
4 products based on them encompassing the patented technology.
5 He can testify to that subject to a motion to strike if he
6 doesn't prove it, but they want to then argue, as I understand,
7 that those products, in fact, do not practice the patents. Is
8 that right?

9 MR. ANDRE: Well, your Honor, I think what we're
10 concerned about is they're going to use the product-to-product
11 comparison. And they actually somewhat admitted that in their
12 opposition.

13 THE COURT: Well, they're not going to do that and I'm
14 not going to let them do that and they know that would be
15 improper. But, again, in the aspect of using your products to
16 the extent that you're going to offer them in your case as
17 evidence of a commercial success of these patents, they're
18 certainly entitled to talk about them.

19 MR. ANDRE: The only thing we're going to offer our
20 products for in the secondary considerations of non-obviousness
21 for the praise at the time that the products were released.
22 And so it's not the commercial success, it's praise of the
23 people. But if that's going to be an issue, we prefer not to
24 do -- not to bring them up at all.

25 THE COURT: If you use your products and that the

1 products are praised as evidence that the patents are not
2 obvious, you still have to establish that the reason they're
3 being praised is because they encompass the patented subject
4 matter, and then they can fully and fairly address whether or
5 not those products that you're using as evidence of praise do,
6 in fact, encompass the patented subject matter.

7 MR. ANDRE: And I think that's fair, your Honor. I
8 think what we were concerned about in this particular instance
9 is them saying that our product was no good and their product
10 is great. That's what they said in their opposition that's
11 what they're going to do. They said, and quote, that they're
12 going to show that the bio-superior planes did not work for its
13 intended purpose, unlike ESET's product which performed
14 superbly. And so that's what we're concerned about.

15 It's like, we have a great product, their product is
16 no good so, therefore we, can't infringe their patents. That's
17 our big issue. And so if it comes down to it, like I said, we
18 may not use the praise issue. But that's the only thing we'd
19 use our products for, other than the fact we had products at
20 one time, we sold products, but nothing other than the fact we
21 sold them, so.

22 THE COURT: All right. I'm going to deny this without
23 any prejudice. If somehow they start down that road, you're
24 certainly free to object, and the Court will consider any
25 relevant motions to strike and disregard.

1 MR. ANDRE: Yeah.

2 THE COURT: But if your concern was that the intent
3 was to say our product is better than their product and,
4 therefore, our product doesn't infringe, that's a non-sequitur,
5 and I can't imagine they'd be going there. If it comes up as a
6 matter of damages though or as a matter of obviousness,
7 saying -- and there's no loss profits claim here --

8 MR. ANDRE: That's right.

9 THE COURT: -- so what your products did and how they
10 performed is, again, not really relevant.

11 MR. ANDRE: In that regard, they brought in a testing
12 expert who went back and bought a product on eBay from Lord
13 knows where. It wasn't from us. Tried getting an old product
14 and they tested and said, See, it doesn't work. And they're
15 going to try to present that testing expert and say we tested
16 one of their old products and it didn't work.

17 THE COURT: I don't think he's in here.

18 MR. ANDRE: So that's what we're concerned about.
19 It's that inference that our product doesn't work, therefore,
20 they can't infringe the patent.

21 THE COURT: Well, again, understanding your point of
22 reference for this motion, the motion is denied. It's not
23 precluding them from discussing Finjan products that are
24 brought into the case as evidence either with regard to the
25 damages analysis or commercial success or praise or anything

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.