IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

FINJAN, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	C.A. No. 18-1519-MN
	)	
RAPID7, INC., et al.,	)	
	)	
Defendants.	)	

MEMORANDUM OPINION

On September 17, 2020, Special Master Order #4 (D.I. 189) granted-in-part and denied-in-part Defendants Rapid7, Inc. and Rapid7 LLC's (collectively, Rapid7) Motion to Strike Portions of the Expert Report of Dr. Mitzenmacher (D.I. 183). Order #4 was issued on an expedited basis because Dr. Mitzenmacher's deposition was scheduled for September 21, 2020. This memorandum opinion explains the reasoning for the rulings in Order #4.

BACKGROUND

At the scheduling conference in this case, Plaintiff Finjan, Inc. (Finjan) requested, and the Court ordered, that Rapid7 was to make its source code available for inspection at the time of core technical document production, which is earlier than usual. In doing so, the Court warned Finjan that it was "going to expect that the infringement contentions be pretty full and pretty informative" and "[if] they're giving you the source code on these products, I expect you [Finjan] to incorporate that and explain how the products infringe." 1/30/19 Teleconference Transcript at 9:21-24; 9:25-10:2.

After producing its source code for inspection and receiving Finjan's preliminary infringement contentions, Rapid7 believed the contentions were lacking and moved to compel

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more detailed contentions. At a December 13, 2019 hearing on Rapid7's motion to compel, Finjan's counsel distinguished its contentions from the greater level of detail offered in an expert report. 12/13/2019 Hearing Transcript at 11. Judge Noreika then ruled as follows:

> It's up to Finjan, you can by January 10th supplement again to address some of these concerns. It's up to you. But if you don't, you're not going to be able to raise new issues. Like when you said this is not an expert report, you're not going to suddenly be able to get into a lot more detail in actually fleshing out your contentions in an expert report if you haven't fairly disclosed them here. If you think this is sufficient to give notice of what your contentions are, I'm not going to make you supplement because I'm not sure exactly what you need, but if you don't supplement and get more specific with what you're claiming, what aspects of this meet the claim elements, you're not going to be able to do [that] for the first time and surprise them in the expert reports. I'm not saying that's what you're intending to do, it just caught my attention when you said this is not an expert report. The expert reports may want to flesh out a little bit more, but they shouldn't for the first time be giving what specific aspects of this [] meet the element.

Id. at 12.

Finjan proceeded to supplement its infringement contentions and then served Final Infringement Contentions (FICs) on February 26, 2020. *See* Rapid7's 9/3/2020 Letter Brief at Ex. D (excerpts from the FICs). On June 17, 2020, almost four months later, Finjan served the opening expert report of Dr. Mitzenmacher regarding infringement. *See id*. at Ex. C (excerpts from Dr. Mitzenmacher's report).

Rapid7 moves to strike allegedly new infringement theories disclosed for the first time in Dr. Mitzenmacher's report. These new infringement theories fall into two categories: (1) a literal infringement theory that a "Universal Translator" capability meets the requirement of "an input modifier" in claim 41 of the '289 patent for the InsightAppSec and AppSpider products; and (2) doctrine of equivalents (DOE) infringement theories on several elements of claims in the '154, '289, and '408 patents.

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Finjan's Allegedly New Universal Translator Literal Infringement Theory

As to the allegedly new Universal Translator capability theory, Rapid7 argues that Finjan's FICs do not reference the Universal Translator or its functionality. Rapid7 argues that while Finjan's FICs refer to a "scan engine," this disclosure did not put Rapid7 on notice that the more specific Universal Translator capability allegedly meets element 41(c). Rapid7 also points out that Finjan was aware of the Universal Translator capability well before its FICs, and Finjan even pointed to the Universal Translator capability in its FICs for another patent. *See* Rapid7's Opening Letter at Ex. D, Appendix F-5 at 7.

Finjan's letter brief admits that "the level of detail is greater in Dr. Mitzenmacher's report than in the FICs" and it did not use the term "Universal Translator" in the FICs with regard to element 41(c). 9/10/2020 Letter Brief at 2. But Finjan argues that it disclosed the same functionality as the Universal Translator when it disclosed "scan engines" and described their function. Finjan also argues that Rapid7 belatedly produced documents regarding the Universal Translator, which Dr. Mitzenmacher relies on in his report.

Finjan's Allegedly New DOE Theories

Rapid7 argues that Dr. Mitzenmacher disclosed new DOE theories for claim element 1(b) of the '154 patent, element 1(d) of the '154 patent, elements 41(c) and 41(e) of the '289 patent, and element 1(b) of the '408 patent. Finjan's FICs for element 1(d) of the '154 patent, elements 41(c) and 41(e) of the '289 patent, and element 1(b) of the '408 patent do not identify a DOE theory of infringement. For element 1(b) of the '154 patent, however, the FICs disclose a DOE theory. Rapid7 argues that Finjan's DOE theory in its FICs relates to only one part of element 1(b) ("Only if…such invocation is safe"), while Dr. Mitzenmacher's report sets forth a

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DOE theory on another part of element 1(b) ("processing content…including a call to a first function").

Finjan argues that Dr. Mitzenmacher's DOE opinions are not new but rather "modest elucidations" of the functionalities accused in the FICs. Finjan also argues that each challenged DOE opinion corresponds to an equivalent literal infringement theory in the FICs. That is, according to Finjan, its literal infringement theories in the FICs put Rapid7 on notice of the accused functionalities and the DOE theories in the expert report should have come as no surprise given the functionalities accused in the FICs.

LEGAL STANDARDS

Fed. R. Civ. P. 37(c)(1) provides that "[i]f a party fails to provide information . . . as required by Rule 26(a) or (e), the party is not allowed to use that information . . . to supply evidence on a motion, at a hearing, or at trial, unless the failure was substantially justified or is harmless." Infringement contentions are considered to be "initial disclosures" under Rule 26(a). *Intellectual Ventures I LLC v. AT&T Mobility LLC,* 2017 WL 658469, at *1 (D. Del. Feb. 17, 2017).

To determine whether a failure to disclose is harmless, courts in the Third Circuit consider the "*Pennypack*" factors, which include: (1) the prejudice or surprise to the party against whom the evidence is offered; (2) the possibility of curing the prejudice; (3) the potential disruption of an orderly and efficient trial; (4) the presence of bad faith or willfulness in failing to disclose the evidence; and (5) the importance of the information withheld. *See Konstantopoulos v. Westvaco Corp.,* 112 F.3d 710, 719 (3d Cir. 1997) (citing *Meyers v. Pennypack Woods Home Ownership Ass'n,* 559 F.2d 894, 904-05 (3d Cir. 1977)). The

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determination of whether to exclude evidence is within the discretion of the court. *See In re Paoli*, 35 F.3d 717, 749 (3d Cir. 1994).

DISCUSSION

I. Rapid7's motion to strike the portions of paragraphs 552-554 of Dr. Mitzenmacher's report relating to the "Universal Translator" is GRANTED.

In its FICs, Finjan accused the broad functionality of the "scan engine" of meeting the claim element "an input modifier" in claim 41 of the '289 patent for the InsightAppSec and AppSpider products. The parties agree that the broad functionality accused in the FICs includes the Universal Translator capability. But Finjan failed to accuse the Universal Translator capability until its opening expert report. Finjan provides no reason why it failed to accuse the Universal Translator capability in its FICs. In fact, Finjan's counsel admitted "if I could go back in time to moot this issue, would I have pointed that [Universal Translator] out there, of course." Tr. 46:1-3.

If those were the only relevant facts, this would be a closer call. Here, however, Finjan received at least two warnings from the Court to provide specificity in its infringement contentions. The second warning addressed the situation here: "if you don't supplement and get more specific with what you're claiming, what aspects of this meet the claim elements, you're not going to be able to do [that] for the first time and surprise them in the expert reports." 12/13/2019 Hearing Transcript at 12. Because Finjan's new reliance on the Universal Translator capability violates the Court's warning, the new disclosure must be stricken.

Finjan's letter brief cites several decisions where an expert was allowed to provide more specific infringement opinions based on broad theories disclosed in infringement contentions. This case is different from those decisions in two important respects. First, none of these decisions involved prior, direct warnings from the Court like the ones made here. Second, Finjan

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