

**UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA**

JUNIPER NETWORKS, INC.,

Plaintiff

v.

Case No.: 1:07-cv-01771-PLF (AK)

ABDULLAH ALI BAHATTAB,

Defendant.

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**DR. BAHATTAB'S RESPONSE TO JUNIPER'S MAY 22, 2009 NOTICE REGARDING  
THE STATUS OF PLAINTIFF'S OBJECTIONS TO MAGISTRATE JUDGE'S ORDER  
GRANTING DEFENDANT'S MOTION TO COMPEL AND PENDING REQUEST FOR  
STAY**

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Defendant Dr. Abdullah Ali Bahattab (“Dr. Bahattab”) submits this response to Plaintiff Juniper Networks, Inc.’s (“Juniper”) notice regarding the status of its objections to magistrate judge’s order granting Defendant’s motion to compel and request for stay (Docket No. 95).

## **I. INTRODUCTION**

On March 17, 2009, Juniper objected to two portions of the Magistrate Judge’s discovery order “(1) compel[ling] Juniper to produce its own patents and their related prosecution histories in response to Dr. Bahattab’s document request no. 5, and (2) award[ing] costs and reasonable attorneys’ fees to Dr. Bahattab.” On May 14, 2009, this Court ordered Juniper to “notify the court in writing . . . whether its objections to Magistrate Judge Kay’s order granting defendant’s motion to compel and request for stay [] are moot” in light of the entry of summary judgment of noninfringement in favor of Juniper. Instead of providing a concise notice that it did not consider its objections moot, Juniper filed a four-page brief on May 22, 2009 arguing that the Magistrate erred in compelling the production of documents and awarding fees merely because Dr. Bahattab did not counterclaim for infringement. Juniper’s arguments are without merit, and Dr. Bahattab remains entitled to the fee awarded by the Magistrate notwithstanding Juniper’s misdirected, self-effecting stay.<sup>1</sup>

As to Juniper’s first objection, Magistrate Kay did not err in ordering Juniper to produce the patents that it marks on its products because the patents are relevant and responsive to Dr. Bahattab’s requests. The patent documents are rendered no less relevant or responsive merely because Dr. Bahattab was unable to counterclaim for infringement in their absence, and Juniper continues to withhold these documents in

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<sup>1</sup> See Dr. Bahattab’s Opposition to Juniper’s Objections at Section III (Docket No. 68).

contempt of the Magistrate Judge's order and has not obtained any stay excusing its actions. Notwithstanding Dr. Bahattab's right to production of Juniper's marked patents, he is willing to forego insistence on their production because of Juniper's intervening production of key patents to the Dubai court and his own continued investigation of infringement based on Juniper's source code, expert reports, and Juniper's supplemental production of documents describing the operation of its source code that Juniper was forced to provide pursuant to those portions of Magistrate Judge Kay's order that it has complied with. (Docket No. 56).

As to Juniper's second objection, the Magistrate Judge correctly awarded fees to Dr. Bahattab because Juniper was not substantially justified in withholding its marked patents *as well as a host of other documents moved for by Dr. Bahattab to which Juniper does not object*. Mere entry of summary judgment of noninfringement is not ground to moot the Magistrate's award of fees because Juniper's "conduct necessitated the motion" and a subsequent production of the patents – a small subset of the documents whose production was successfully compelled by Dr. Bahattab – or a change in circumstances cannot alter the entry of a fee award. *See* Fed. R. Civ. P. 37(a)(5)(A).

## **II. DR. BAHATTAB WAS ENTITLED TO AND NEEDED JUNIPER'S PATENTS WHEN HE FILED HIS MOTION TO COMPEL.**

### **A. Dr. Bahattab is entitled to production of Juniper's patents, notwithstanding summary judgment of noninfringement.**

Juniper has not shown and cannot show that Judge Kay's Order that Juniper produce patents marked on its products was "clearly erroneous" under the stringent standard set forth in LCvR 72.2(c). To properly determine whether Juniper should have produced patents marked on its products, the Magistrate Judge needed to consider only (1) whether the material sought is relevant to Dr. Bahattab's defense of Juniper's

allegations of noninfringement, (2) whether the material is responsive to Dr. Bahattab's requests, and (3) whether the requested material could be produced without undue burden to Juniper. Fed. R. Civ. P. 26(b)(1), (b)(2). When granting Dr. Bahattab's motion to compel, Judge Kay succinctly explained the relevance and responsiveness of Juniper's patents:

Those patents, and related prosecution histories, that Plaintiff has already determined to be incorporated by particular routers, or where the patent number is marked on the products, are relevant in that they may provide additional or confirmatory evidence of the internal operations of Plaintiff's routers and the particular mechanisms and processes at work therein. Defendant's proposed limitation on scope of this request is appropriate, as it will alleviate much of Plaintiff's burden in producing patent information by encompassing only materials related to those patents that Plaintiff has identified as incorporated into particular routers.<sup>2</sup>

Judge Kay's Order compelling Juniper to produce these patents was appropriate, and his "decision is entitled to great deference unless it is clearly erroneous or contrary to law, that is, if on the entire evidence the court is left with the definite and firm conviction that a mistake has been committed." *Moore v. Chertoff*, 577 F. Supp. 2d 165, 167 (D.D.C. 2008) (overruling an objection to magistrate judge's order compelling documents and awarding attorneys' fees).

B. Dr. Bahattab's "need" for Juniper's patents under Rule 56(f) was alleviated by events following his Motion to Compel.

Dr. Bahattab is entitled under Rule 26 to Juniper's marked patents and the Magistrate correctly ordered Juniper to produce them. Dr. Bahattab did not file a Rule 56(f) affidavit seeking further discovery because, *inter alia*, Juniper's identification and reliance on its patents in Dubai made formal production of Juniper's patents no longer "essential" for opposing Juniper's motion for summary judgment of noninfringement under Rule 56(f). Dr. Bahattab has always sought only that discovery regarding matters

“that [are] relevant to any party’s claim or defense,” particularly his defense of Juniper’s claim of noninfringement. *See* Fed. R. Civ. P. 26(b)(1). Juniper is not at liberty to pick and choose the discovery that it will provide Dr. Bahattab based solely on Juniper’s unilateral determination of what documents will prove Juniper’s allegations.

Since moving for production of Juniper’s patents on January 26, 2009, Dr. Bahattab’s own investigation has otherwise satisfied his diligent investigation of Juniper’s allegation of noninfringement in three primary ways.

First, on March 4, 2009, *the day after Juniper was ordered to produce responsive patents*, Kaye Scholer attorneys representing Juniper in both the U.S. and Dubai cases wrote a letter to the Dubai court’s appointed expert that highlighted Juniper patents as evidence of noninfringement of the ‘457 patent.<sup>3</sup> In complete disregard of its arguments to the Dubai court, Juniper renews its arguments to this Court that its patents are “irrelevant” and that producing patents marked on its products would be “burdensome” and “particularly onerous.”<sup>4</sup> Juniper’s argument cannot be reconciled with its actions in Dubai and should be rejected.

Second, Dr. Bahattab undertook extensive investigation of Juniper’s source code throughout the months of January through April of 2009, with further review in light of the expert report filed by Juniper on March 20, 2009.<sup>5</sup> This source code review, all of

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<sup>2</sup> Order Granting Mot. to Compel at 9-10, March 3, 2009 (Docket No. 56) (Kay, Mag.).

<sup>3</sup> *See* Ex. A, Letter from Alan M. Fisch, counsel for Juniper, to Hatim Mohammed Ahmed AbdulRahim, court-appointed expert for the Dubai Court of First Instance, at 5-7 (March 4, 2009) (“Juniper patents applied for in 2000 - nearly two years before Dr. Bahattab first contacted Juniper in May 2002 - describe the same architecture and the use of active routes. For example, United States Patent Number 6,885,635, filed on November 21, 2000 by Juniper contains the same figure showing the architecture of the Routing Engine, routing table Packet Forwarding Engine, and forwarding table . . . .”) (footnotes omitted).

<sup>4</sup> Juniper’s Objections at 5-6 (Docket No. 64).

<sup>5</sup> *See* Ex. B, Juniper Source Code Review Log.

which occurred after Dr. Bahattab was forced to file his motion to compel, has no bearing on whether the patents were relevant and responsive to his January 26, 2009 motion to compel pursuant to Rule 26 – as opposed to Rule 56(f) pleading that was *not* filed – or whether the Magistrate’s fee award was clearly erroneous. Even if Dr. Jeffay determined that he had not found evidence of infringement *after* Dr. Bahattab was forced to file his motion to compel but *before* Juniper partially complied with the Magistrate’s order to produce responsive documents, it does not alter the correctness of Magistrate Judge Kay’s ruling. Moreover, Dr. Jeffay’s testimony shows that Dr. Bahattab’s investigation of Juniper’s products was ongoing. On March 17, 2009, Dr. Jeffay communicated to Dr. Bahattab’s counsel that what he had reviewed *to-date* did not constitute evidence of infringement – consistent with Dr. Bahattab’s unwillingness to allege infringement in this case. (Juniper’s Notice at Ex. 1, May 8, 2009 Dep. Tr. of K. Jeffay at 57:19-58:7; 254:3-255:14).<sup>6</sup> Dr. Jeffay also noted that he “made it clear what [he] had reviewed and what

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<sup>6</sup> Omitted portions of Dr. Jeffay’s deposition testimony put Dr. Bahattab’s ongoing investigation into its proper context:

Q. And did you go back on March 1st to review the source code just to double-check that Dr. Bhattacharjee had gotten it right?

A. April.

Q. Oh, April 1st. Excuse me.

A. I was asked to, yeah, just double-check Dr. Bhattacharjee’s analysis.

Q. And his conclusion, Dr. Bhattacharjee’s conclusion that your conclusion were the same as with respect to the fact that Juniper doesn’t infringe Dr. Bahattab’s patent, correct?

A. Well, I think we -- we had different tasks. I mean, I wasn’t asked to opine on in -- infringement. I was asked to determine whether or not how the products operated, and whether or not there was any evidence of this. And that’s -- that’s what I did. And that’s what I communicated to attorneys at Dewey & LeBoeuf.

Q. And you communicated the fact that there was no evidence that Juniper infringed the patent, correct?

A. Well, I think the way I phrased it was that given the work I had done, I haven’t seen -- I had not -- hadn’t -- I had not seen any evidence.

Ex. C, May 8, 2009 Dep. Tr. of K. Jeffay at 58:8-59:12 (objections omitted).

[he] had not reviewed, and sought further input from [Dr. Bahattab's attorneys]." *Id* at 254:6-8. Dr. Jeffay, as plaintiff is well aware, reviewed Juniper's source for an additional seven hours on April 1, 2009. Clearly, Dr. Bahattab, who has never been permitted personally to review Juniper's source code, had not completed his review through Dr. Jeffay on March 17, 2009 as Juniper alleges.<sup>7</sup>

Third, Dr. Bahattab reviewed Juniper's supplemental document production beginning on March 17, 2009. Notably, these documents were produced only because Dr. Bahattab successfully moved to compel their production. Prior to this supplemental production, Juniper had only provided Dr. Bahattab with publicly-available user manuals that did not describe the internal operation of Juniper's source code.

With this additional investigation behind him, Dr. Bahattab chose not to oppose Juniper's motion for summary judgment as to noninfringement. Juniper does not now argue that the Magistrate erred in his conclusion because the patents Juniper was ordered to produce were irrelevant or non-responsive under Rule 26, but instead argues Dr. Bahattab did not file "a Rule 56(f) affidavit in response to Juniper's motion for summary judgment of noninfringement explaining that he could not effectively respond prior to the production of Juniper's patents and prosecution histories." (Juniper's Notice at 2, Docket No. 95). Rule 56(f) would have required Dr. Bahattab to submit an affidavit that he "could not present facts essential to justify [his] opposition" to Juniper's motion. Fed. R. Civ. P. 56(f). Dr. Bahattab concluded that filing a Rule 56(f) affidavit in response to Juniper's motion for summary judgment was inappropriate because his additional investigation, including review of the key patents Juniper provided to the Dubai court,

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<sup>7</sup> See Ex. B, Juniper Source Code Review Log.



rendered the formal production of Juniper's patents nonessential to opposing such a motion.

Throughout its notice, Juniper erroneously conflates the Rule 56(f) "essential" standard with Rule 26(b)(1), which properly entitles Dr. Bahattab to "any nonprivileged matter that is relevant to any party's claim or defense." Rule 26 and Rule 56 are directed to different issues and impose different standards, and Dr. Bahattab should not be punished for complying with both.

C. Dr. Bahattab will not insist on production because he will not burden the Court with policing discovery no longer critical to his case.

While it is inexcusable for Juniper to continue to withhold relevant and responsive documents that it was ordered by the Magistrate to produce almost three months ago, Dr. Bahattab consents to the non-production of Juniper's patents since he obtained key Juniper patents through Juniper's letter to the Dubai court, his own continued investigation, and in light of the entry of summary judgment as to noninfringement.

### **III. JUNIPER'S OBJECTION AS TO MAGISTRATE JUDGE KAY'S ORDER AWARDING FEES IS NOT MOOT, ALTHOUGH IT SHOULD BE OVERRULED.**

As to Juniper's second objection, the Magistrate correctly awarded fees to Dr. Bahattab because Juniper was not substantially justified in withholding its marked patents *as well as a host of other documents moved for by Dr. Bahattab to which Juniper has not objected*. Mere entry of summary judgment of noninfringement is not ground to moot the Magistrate's award of fees because Juniper's "conduct necessitated the motion" and neither a subsequent transmission of the patents to the Dubai court – a small subset of the documents successfully compelled by Dr. Bahattab – nor an entry of summary judgment of noninfringement alters the entry of a fee award. *See Fed. R. Civ. P. 37(a)(5)(A); United States ex rel. Pogue v. Diabetes Treatment Ctrs. of Am.*, No. 99-cv-3298, 2004

U.S. Dist. LEXIS 18763 (D.D.C. May 17, 2004) (“If the motion to compel is granted or if the requested discovery is provided *after* the motion is filed, Rule 37(a) also permits a court to award the victorious movant expenses for the cost of litigating the issue, including reasonable attorney’s fees.”) (emphasis in original); *Rhein Medical v. Koehler*, 889 F. Supp. 1511, 1518 (M.D. Fla. 1995) (“The fact that [Plaintiff] finally provided the [discovery] after a motion to compel was filed does not make its position ‘substantially justified.’ Nor do other circumstances make an award of sanctions unjust.”). Indeed, Juniper’s subsequent identification and reliance on its patents in the Dubai proceedings proved that Juniper lacked any justification, let alone the legally required “substantial justification,” for withholding documents that were both relevant and responsive to Dr. Bahattab’s requests.

Dr. Bahattab’s subsequent concession to summary judgment of noninfringement does not alter Juniper’s discovery obligations to Dr. Bahattab at the time of his motion to compel. Dr. Bahattab incurred considerable effort and expense when forced to move this Court for documents Juniper should have produced but refused to do so without any substantial justification. Dr. Bahattab has now filed five briefs regarding Juniper’s failure to produce, *inter alia*, its relevant patents.<sup>8</sup>

Judge Kay’s award of attorney’s fees was just and fully comports with the undisputed facts and the unambiguous language of the Federal Rules of Civil Procedure, and is not mooted by the subsequent entry of summary judgment of noninfringement.

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<sup>8</sup> See Dr. Bahattab’s Motion to Compel (Docket No. 45); Dr. Bahattab’s Reply in Support of his Motion to Compel (Docket No. 50); Dr. Bahattab’s Opposition to Juniper’s Motion for Leave to File Sur-Reply (Docket No. 54); Dr. Bahattab’s Response to Juniper’s Objections to Magistrate’s Order Compelling Production (Docket No. 68); and the instant memorandum.

#### IV. CONCLUSION

Dr. Bahattab consents to the non-production of Juniper's patents since he has obtained key Juniper patents through Juniper's identification and submission of those patents in letters to the Dubai court, has continued an investigation of source code and additional documents pursuant to the Court's order, and in light of the entry of summary judgment as to noninfringement. However, Dr. Bahattab respectfully submits that Magistrate Judge's fee award is not moot and should be upheld.

Date: May 29, 2009

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that on May 29, 2009, I electronically filed the foregoing document with the Clerk of the Court and served the same on all counsel of record via the Court's CM/ECF system.

Date: May 29, 2009

Respectfully submitted,

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