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 25 Network Protection Sciences, LLC

26 UNITED STATES DISTRICT COURT
 27 NORTHERN DISTRICT OF CALIFORNIA
 28 SAN FRANCISCO DIVISION

29 NETWORK PROTECTION SCIENCES,
 30 LLC

31 Plaintiff,

32 vs.

33 FORTINET, INC.

34 Defendants.

No. 3:12-CV-01106-WHA

**LETTERS OF REQUEST FOR
 INTERNATIONAL JUDICIAL
 ASSISTANCE (LETTERS
 ROGATORY)– JOHN ALSOP**

1 The United States District Court for the Northern District of California presents its
2 compliments to the appropriate judicial authority of Canada, and requests judicial assistance
3 to obtain evidence to be used in a civil proceeding before this Court in the above-captioned
4 matter. A trial on this matter is scheduled to commence on September 30, 2013, in San
5 Francisco, State of California, United States of America.

6 This Court requests the assistance described herein as necessary in the interests of
7 justice. The assistance requested is that the appropriate judicial authority of the Ontario
8 Superior Court of Justice, or such other Court as may be applicable, compel the appearance
9 of the individual identified below to appear for an oral deposition and to produce documents.

10 **A. Name of Witness**

11 John Alsop, resident of Toronto, Ontario, Canada.

12 **B. Nature of the Action and This Court's Jurisdiction**

13 This matter is an action for infringement of United States Patent No. 5,623,601 ("the
14 '601 Patent") brought by Plaintiff Network Protection Sciences LLC ("NPS") against
15 Defendant Fortinet Inc. ("Fortinet"). (Eastern District of Texas Docket No. 1). The matter
16 was transferred from the Eastern District of Texas to this Court under Title 28, Section
17 1404(a), of the United States Code on March 6, 2012, and is now pending in this Court
18 before the undersigned United States District Court Judge. (*See* Docket No. 123).

19 As a patent infringement matter, this case arises under the patent laws of the United
20 States, Title 35 of the United States Code. This Court has subject matter jurisdiction over
21 this case pursuant to Title 28, Sections 1331 and 1338, of the United States Code.

22 **C. The Relevant Facts and Witnesses**

23 Defendant Fortinet's defenses in this action include an assertion that the '601 Patent
24 is invalid in light of prior art. In particular, Fortinet contends *inter alia* that a computer
25 network firewall product from Border Network Technologies, Inc. ("BTNi"), a company
26 located in Ontario, Canada, which was subsequently acquired by WatchGuard Technologies,
27 is prior art to and invalidates the '601 patent. This firewall product was known as the
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1 JANUS Firewall Server, and later as BorderWare (the “JANUS/BorderWare Prior Art
2 Product”).

3 Fortinet has identified non-party witnesses believed to have information relevant to
4 the allegedly invalidating JANUS/BorderWare Prior Art Product prior art. Mr. Alsop is
5 among those witnesses, and is located in the Province of Ontario, Canada. Based upon
6 Fortinet’s contentions, Mr. Alsop is believed to have information pertinent to the conception
7 and reduction to practice of the JANUS/BorderWare Prior Art Product that Fortinet contends
8 invalidates the patent-in-suit.

9 In particular, Fortinet contends that Mr. Mackintosh will explain at trial that the May
10 1994 version of the source code for the JANUS/BorderWare Prior Art Product contained
11 specific kernel modifications and proxy code that enabled the firewall to operate in a manner
12 that Fortinet contends anticipates and/or renders obvious the inventions claims by the ’601
13 Patent. Fortinet further contends that Mr. Mackintosh and others contributed posts to an
14 electronic bulletin board concerning firewall technology that disclosed information
15 concerning the JANUS/BorderWare Prior Art Product in 1994, and that the
16 JANUS/BorderWare Prior Art Product was publicly known and available in the United States
17 by at least July 1994. Fortinet has further represented that Mr. Alsop was the founder and
18 president of trial that Border Network Technologies, Inc. (“BNTi”), which was founded to
19 develop and produce the JANUS/BorderWare Prior Art Product. Fortinet contends that Mr.
20 Alsop will testify at trial: “That he and several technical people, including Rayan
21 Zachariassen, Steven Lamb, and Glenn Mackintosh worked on the idea” for the
22 JANUS/BorderWare Prior Art Product, That “BNTi built the [the JANUS/BorderWare Prior
23 Art Product] to be “transparent”; and That “he subscribed to the Great Circle Firewall
24 electronic bulletin board, a moderated electronic forum focused specifically on firewall
25 technology,” on which Fortinet contends information about the JANUS/BorderWare Prior
26 Art Product was publicly disclosed.
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1 These assertions by Defendant Fortinet, if true, may impact the enforceability of the
2 '601 Patent and may serve as a defense to the pending claim against Fortinet for infringement
3 thereof.

4 **D. Basis for the Issuance of These Letters Rogatory**

5 These letters have been issued based upon the following criteria:

6 **1. The discovery requested is relevant.**

7
8 The evidence sought by the letters rogatory is necessary for trial and intended to be
9 adduced at trial, if admissible. This required evidence is relevant to the American proceeding
10 in that it is anticipated to have bearing on a central defense – invalidity of the patent at issue –
11 to the Plaintiff’s primary cause of action for patent infringement.

12 **2. The discovery requested does not violate the laws of civil**
13 **procedure of the Canadian court, particularly as they concern**
14 **third parties.**

15 The Ontario Court may properly authorize the witness to provide the responsive
16 evidence, if any, pursuant to Section 60 of the Ontario Evidence Act and consistent with Rule
17 31.10 of the Rules of Civil Procedure.

18 **3. This Court is a Court of law before which the captioned matter**
19 **is pending and has the power under its enabling statutes and**
20 **rules to direct the taking of evidence abroad.**

21 Pursuant to United States Federal Rule of Civil Procedure 28(b)(2), a deposition may
22 be taken in a foreign country “under a letter of request, whether or not captioned a ‘letter
23 rogatory.’” This Court has the inherent authority to issue letters rogatory. *See United States*
24 *v. Reagan*, 453 F.2d 165, 172 (6th Cir. 1971); *United States v. Staples*, 256 F.2d 290, 292
25 (9th Cir. 1958). Under governing United States law, a letter rogatory can also include
26 requests for the production of documents. *See Reagan*, 453 F.2d at 168 (affirming district
27 court’s issuance of letters rogatory seeking documents relating to an investigation conducted
28 by German authorities).

1 A court's decision whether to issue a letter rogatory requires an application of United
2 States Federal Rule of Civil Procedure, Rule 28(b), in light of the scope of discovery
3 provided for by the Federal Rules of Civil Procedure. *See Evanston Ins. Co. v. OEA, Inc.*,
4 No. CIV S-02-1505 DFL PAN, 2006 WL 1652315 at* 2 (E.D. Cal. June 13, 1990) (stating
5 that Rule 28(b) "must be read together" with Rule 26(c) in determining whether to issue letter
6 rogatory); *see also DBMS Consultants Ltd. v. Computer Assocs. Int'l, Inc.*, 131 F.R.D. 367,
7 369-70 (D. Mass. 1990); *B & L Drilling Elecs. v. Totco*, 87 F.R.D. 543, 545 (W.D. Ok.
8 1978).

9 This Court has considered the Unopposed Administrative Motion for Issuance of
10 Letters Rogatory (the "Motion", Northern District of California Docket No. 192, including
11 the Declaration of Jill F. Kopeikin in support thereof, Docket No. 192-1), and has found that
12 the evidence requested is well within the scope of the discovery sanctioned by the Federal
13 Rules of Civil Procedure and would be permitted in this action. Accordingly, upon the
14 Motion and finding good cause therefore, this Court has granted the Motion and issued these
15 letters.

16 **4. Reciprocity.**

17 This Court has the authority to reciprocate by granting enforcement of letters
18 rogatory properly issued by an authorized Canadian court.

19 **5. The witness from whom the American court desires testimony
20 resides within the Canadian Court's jurisdiction.**

21 Mr. Alsop is an individual residing in Toronto, Ontario, Canada.

22 **6. The order sought is needed in the interest of justice.**

23 As discussed above, Defendant Fortinet contends that the witness, Mr. Alsop,
24 worked on and has knowledge of the conception and reduction to practice of a product that
25 constitutes prior art that would invalidate the patent-in-suit. In particular, Fortinet contends
26 that that Mr. Alsop will testify at trial that BorderWare Technologies, Inc. was founded to
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1 develop and offer the JANUS/BorderWare Prior Art Product, that he and several technical
2 people worked on the idea for the product, and that he subscribed to the Great Circle Firewall
3 electronic bulletin board, a moderated electronic forum focused specifically on firewall
4 technology,” on which Fortinet contends information about the JANUS/BorderWare Prior
5 Art Product was publicly disclosed in 1994.

6 **7. The evidence sought will be used at trial if admissible.**

7
8 Defendant Fortinet has specifically indicated that it intends to introduce testimony
9 from Mr. Alsop at trial concerning the conception and reduction to practice of the
10 Janus/BorderWare Prior Art Product, upon which Fortinet will rely to argue that the ‘601
11 Patent is invalid. To the extent this evidence may be used for the purposes of pre-trial
12 discovery in this civil matter, the discovery should nonetheless be permitted because it would
13 be unfair to require NPS to proceed to trial without the evidence, and obtaining the evidence
14 would not entail unreasonable expense or unfairness to the non-party. Permitting such
15 discovery will not infringe on Canadian sovereignty and justice demands the examination.

16 **8. The witness is not required to undergo a broader form of**
17 **inquiry than he would if he were subject to discovery in the**
18 **United States.**

19 Under the Rules 26, 28 and 34 of the United States Federal Rules of Civil Procedure,
20 non-party witnesses may be required to provide oral testimony at deposition and to produce
21 documents in the possession, custody or under the control of the witness the subject of
22 discovery seeking evidence insofar as the evidence constitutes non-privileged matter that is
23 relevant to any party's claim or defense.

24 NPS seeks testimony specifically relevant to this action, including the conception,
25 reduction to practice, implementation, adoption and publication of information about the
26 Janus/BorderWare Prior Art Product. The related requests for documents, as set forth below,
27 are specifically calculated to obtain such evidence. An additional request seeks discovery of
28 communications with Fortinet (including its counsel or representatives) concerning the ‘601

1 Patent or this lawsuit, which is warranted insofar as Fortinet identified this witness in its
2 invalidity contentions as one who will testify at trial.

3 **9. The evidence cannot be secured except by the intervention of the**
4 **Canadian courts.**

5 Insofar as the witness is a resident of Canada, this Court has no jurisdiction over and
6 cannot compel the witness to submit evidence. Nor does this Court have any authority to
7 order the taking of evidence in Canada. However, the Canadian court has the jurisdiction to
8 do so and pursuant to Section 60 of the Ontario Evidence Act and consistent with Rule 31.10
9 of the Rules of Civil Procedure may give the Letters Rogatory effect. *See AstraZeneca v.*
10 *Wolman*, [2009] O.J. No. 5344.

11 For the foregoing reasons, this Court hereby issues these letters rogatory authorizing
12 the taking of oral evidence from John Alsop and the pursuit of the production of documentary
13 evidence in his custody and control as follows:

14 **TESTIMONY**

15 If acceptable to the governing Canadian authority, (1) Each of the witnesses shall be
16 required to sit for deposition for no longer than seven (7) total hours, and both the Plaintiff
17 and the Defendant will be limited to 50% of that hourly total; and

18 (2) Counsel for Plaintiff and Defendant shall conduct themselves consistent with the
19 Federal Rules of Civil Procedure of the United States, as well as any Local Rules and
20 Standing Orders governing the above-captioned case.

21 **REQUESTS FOR PRODUCTION OF DOCUMENTS**

22 **Request No. 1:** All documents relating to the conception, reduction to practice and
23 diligence in reduction to practice of the JANUS Firewall Server (the term “Janus Firewall
24 Server” includes the later known BorderWare), including in particular documents relating to
25 the proof of concept or the idea that, rather than creating a special dedicated piece of
26 hardware, one could take an ordinary personal computer and install software that would
27 turn it into a dedicated firewall.
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1 **Request No. 2:** All documents relating to the development of the JANUS Firewall
2 Server to be “transparent,” such that the users could simply address their communication
3 sessions directly to the destination without considering or even being aware that the JANUS
4 Firewall Server was using a proxy method which made the JANUS’ proxy operation
5 “transparent” to both the sender and receiver of the packets.

6 **Request No. 3:** All documents relating to the development of source code for or used
7 in or by the JANUS FireWall Server or modifications to the kernel of the operating systems
8 to disable IP forwarding.

9 **Request No. 4:** All documents relating to modifications to the BSDi Unix source
10 code to disable IP forwarding and route everything up to the application layer on the firewall,
11 to adapt existing Unix-based operating system and various readily available proxy processes
12 for common applications such as FTP, Telnet, HTTP, Gopher, and Ping, for example.

13 **Request No. 5:** All documents relating to posts to the Great Circle Firewall
14 electronic bulletin board describing the JANUS firewall development or the JANUS
15 FireWall Server product.

16 **Request No. 6:** All prior art that may invalidate U.S. Patent No. 5,623,601 (“the
17 ‘601 patent”).

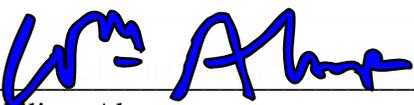
18 **Request No. 7:** All communications between you, John Alsop, and Fortinet,
19 including in particular, counsel for Fortinet or concerning conception or reduction to practice
20 of the JANUS Firewall Server or the ‘601 Patent.

21 For the foregoing reasons, these letters rogatory hereby issue.

22
23 IT IS SO ORDERED

24 This order is without prejudice to possible objections by the respondent that the discovery requests
25 are overbroad and burdensome, which objections will be heard in due course by the Canadian
26 courts.

27 Date: April 23, 2013.

28 

William Alsop
United States District Judge