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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)– ROD ADKINS**

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 Rod Adkins, 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. ("BNTi"), 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
28

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. Adkins is
5 among those witnesses, and is located in the Province of Ontario, Canada. In particular,
6 Fortinet contends that Mr. Adkins was the Director of Marketing for BNTi and “confirms that
7 the [JANUS/BorderWare Prior Art Product] has been available in both the U.S. and Canada”
8 since February 1994. Fortinet further contends that Mr. Adkins made additional postings to
9 the Great Circle Firewall electronic bulletin board, a moderated electronic forum focused
10 specifically on firewall technology about the JANUS/BorderWare Prior Art Product prior art,
11 including technical details “such as changes to the kernel” of the operating system to
12 JANUS/BorderWare Prior Art Product and regarding the availability of the
13 JANUS/BorderWare Prior Art Product in 1994.

14 These assertions by Defendant Fortinet, if true, may impact the enforceability of the
15 ‘601 Patent and may serve as a defense to the pending claim against Fortinet for infringement
16 thereof.

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

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

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

20
21 The evidence sought by the letters rogatory is necessary for trial and intended to be
22 adduced at trial, if admissible. This required evidence is relevant to the American proceeding
23 in that it is anticipated to have bearing on a central defense – invalidity of the patent at issue –
24 to the Plaintiff’s primary cause of action for patent infringement.

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1 the Declaration of Jill F. Kopeikin in support thereof, Docket No. 192-1), and has found that
2 the evidence requested is well within the scope of the discovery sanctioned by the Federal
3 Rules of Civil Procedure and would be permitted in this action. Accordingly, upon the
4 Motion and finding good cause therefore, this Court has granted the Motion and now issues
5 these letters.

6 **4. Reciprocity.**

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

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

11 Mr. Adkins is an individual residing in Toronto, Ontario, Canada.

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

13
14 As discussed above, Defendant Fortinet contends that the witness, Mr. Adkins has
15 knowledge of the conception and reduction to practice of a product that constitutes prior art
16 that would invalidate the patent-in-suit. In particular, Fortinet contends that Mr. Adkins was
17 the Director of Marketing for BNTi and “confirms that the [JANUS/BorderWare Prior Art
18 Product] has been available in both the U.S. and Canada” since February 1994. Fortinet
19 further contends that Mr. Adkins made additional postings to the Great Circle Firewall
20 electronic bulletin board, a moderated electronic forum focused specifically on firewall
21 technology about the JANUS/BorderWare Prior Art Product prior art, including technical
22 details “such as changes to the kernel” of the operating system to JANUS/BorderWare Prior
23 Art Product and regarding the availability of the JANUS/BorderWare Prior Art Product in
24 1994.

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

26
27 Defendant Fortinet has been asked whether it will, and has reserved the right to,
28 introduce testimony from Mr. Adkins at trial concerning the conception and reduction to

1 practice of the Janus/BorderWare Prior Art Product, upon which Fortinet will rely to argue
2 that the '601 Patent is invalid. To the extent this evidence may be used for the purposes of
3 pre-trial discovery in this civil matter, the discovery should nonetheless be permitted because
4 it would be unfair to require NPS to proceed to trial without the evidence, and obtaining the
5 evidence would not entail unreasonable expense or unfairness to the non-party. Permitting
6 such discovery will not infringe on Canadian sovereignty and justice demands the
7 examination.

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

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

16 NPS seeks testimony specifically relevant to this action, including the conception,
17 reduction to practice, implementation, adoption and publication of information about the
18 Janus/BorderWare Prior Art Product. The related requests for documents, as set forth below,
19 are specifically calculated to obtain such evidence. An additional request seeks discovery of
20 communications with Fortinet (including its counsel or representatives) concerning the '601
21 Patent or this lawsuit, which is warranted insofar as Fortinet identified this witness in its
22 invalidity contentions as one who may testify at trial.

23 **9. The evidence cannot be secured except by the intervention of the**
24 **Canadian courts.**

25
26 Insofar as the witness is a resident of Canada, this Court has no jurisdiction over and
27 cannot compel the witness to submit evidence. Nor does this Court have any authority to
28 order the taking of evidence in Canada. However, the Canadian court has the jurisdiction to

1 do so and pursuant to Section 60 of the Ontario Evidence Act and consistent with Rule 31.10
2 of the Rules of Civil Procedure may give the Letters Rogatory effect. *See AstraZeneca v.*
3 *Wolman*, [2009] O.J. No. 5344.

4 For the foregoing reasons, this Court hereby issues these letters rogatory authorizing
5 the taking of oral evidence from Rod Adkins and the pursuit of the production of
6 documentary evidence in his custody and control as follows:

7 **TESTIMONY**

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

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

14 **REQUESTS FOR PRODUCTION OF DOCUMENTS**

15 **Request No. 1:** All documents relating to the conception, reduction to practice and
16 diligence in reduction to practice of the JANUS Firewall Server (the term “Janus Firewall
17 Server” includes the later known BorderWare), including in particular documents relating to
18 the proof of concept or the idea that, rather than creating a special dedicated piece of
19 hardware, one could take an ordinary personal computer and install software that would
20 turn it into a dedicated firewall.

21 **Request No. 2:** All documents relating to the development of the JANUS Firewall
22 Server to be “transparent,” such that the users could simply address their communication
23 sessions directly to the destination without considering or even being aware that the JANUS
24 Firewall Server was using a proxy method which made the JANUS’ proxy operation
25 “transparent” to both the sender and receiver of the packets.
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