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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)– STEVEN LAMB**

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 Steven Lamb, 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 Fortinet's defenses in this action include an assertion that the '601 Patent is invalid in
24 light of prior art. In particular, Fortinet contends *inter alia* that a computer network firewall
25 product from Border Network Technologies, Inc. ("BTNi"), a company located in Ontario,
26 Canada, which was subsequently acquired by WatchGuard Technologies, is prior art to and
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1 invalidates the '601 patent. This firewall product was known as the JANUS Firewall Server,
2 and later as BorderWare (the "JANUS/BorderWare Prior Art 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. Lamb is
5 among those witnesses, and is located in the Province of Ontario, Canada. In its pre-trial
6 contentions concerning the alleged invalidity of the patent-in-suit Fortinet asserted that Mr.
7 Lamb was involved in the creation of the JANUS/BorderWare Prior Art Product and is
8 believed to have information pertinent to the conception and reduction to practice of the
9 JANUS/BorderWare Prior Art Product that Fortinet contends invalidates the patent-in-suit.
10 In particular, Fortinet contends that Mr. Lamb and other Border Network engineers conceived
11 of the idea for the firewall product, that along with another witness (Glenn Mackintosh) he
12 personally outlined the concept for the JANUS/BorderWare Prior Art Product and wrote the
13 underlying source code for the software used in the product. Fortinet specifically contends
14 that Mr. Lamb has knowledge that the May 1994 version of the source code for the
15 JANUS/BorderWare Prior Art Product contained specific kernel modifications and proxy
16 code that enabled the firewall to operate in a manner that Fortinet contends anticipates and/or
17 renders obvious the inventions claims by the '601 Patent. Fortinet further contends that Mr.
18 Lamb and others contributed posts to an electronic bulletin board concerning firewall
19 technology that disclosed information concerning the JANUS/BorderWare Prior Art Product
20 in 1994.

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22 These assertions by Defendant Fortinet, if true, may impact the enforceability of the
23 '601 Patent and may serve as a defense to the pending claim against Fortinet for infringement
24 thereof.

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

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

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1. The discovery requested is relevant.

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

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

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

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

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

A court’s decision whether to issue a letter rogatory requires an application of United States Federal Rule of Civil Procedure, Rule 28(b), in light of the scope of discovery provided for by the Federal Rules of Civil Procedure. *See Evanston Ins. Co. v. OEA, Inc.*, No. CIV S-02-1505 DFL PAN, 2006 WL 1652315 at* 2 (E.D. Cal. June 13, 1990) (stating that Rule 28(b) “must be read together” with Rule 26(c) in determining whether to issue letter

1 rogatory); *see also* *DBMS Consultants Ltd. v. Computer Assocs. Int’l, Inc.*, 131 F.R.D. 367,
2 369-70 (D. Mass. 1990); *B & L Drilling Elecs. v. Totco*, 87 F.R.D. 543, 545 (W.D. Ok.
3 1978).

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

11 **4. Reciprocity.**

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

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

16 Mr. Lamb is an individual residing in Toronto, Ontario, Canada.

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

18 As discussed above, Defendant Fortinet contends that the witness, Mr. Lamb,
19 worked on and has knowledge of the conception and reduction to practice of a product that
20 constitutes prior art that would invalidate the patent-in-suit. In particular, Fortinet contends
21 that that Mr. Lamb has knowledge and may testify at trial that he and other BTNi engineers
22 conceived of the idea for the firewall product, that and another engineer named Glenn
23 Mackintosh came up with the idea for the JANUS/BorderWare Prior Art Product while
24 waiting for an elevator, sat down and quickly outlined the concept and then immediately
25 began writing the underlying source code for the software.
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1 **7. The evidence sought will be used at trial if admissible.**

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

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

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

19 NPS seeks testimony specifically relevant to this action, including the conception,
20 reduction to practice, implementation, adoption and publication of information about the
21 Janus/BorderWare Prior Art Product. The related requests for documents, as set forth below,
22 are specifically calculated to obtain such evidence. An additional request seeks discovery of
23 communications with Fortinet (including its counsel or representatives) concerning the ‘601
24 Patent or this lawsuit, which is warranted insofar as Fortinet identified this witness in its
25 invalidity contentions as one who will testify at trial. In particular, Fortinet contends that Mr.
26 Lamb will testify that “that modification to the [source code for the Janus/BorderWare Prior
27 Art Product] was very simple and only required changes to a few lines of code in a few
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