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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)– ANDREW FLINT**

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 Andrew Flint, 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. Mr. Flint is among those
5 witnesses, and is located in the Province of Ontario, Canada. In particular, Fortinet contends
6 that Mr. Flint has information pertinent to the conception and reduction to practice of the
7 JANUS/BorderWare Prior Art Product that Fortinet contends invalidates the patent-in-suit.
8 Fortinet has asserted that Mr. Flint has knowledge that the prior art for the
9 JANUS/BorderWare Prior Art Product was made publicly available by no later than July 13,
10 1994 and that it was not abandoned, suppressed or concealed. Fortinet has further asserted
11 that Mr. Flint was a participant in the installation of the JANUS/BorderWare Prior Art
12 Product along with another non-party witness (Omayya Elguindi) at two companies in the
13 spring of 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.**

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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.

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

1 The Ontario Court may properly authorize the witness to provide the responsive
2 evidence, if any, pursuant to Section 60 of the Ontario Evidence Act and consistent with Rule
3 31.10 of the Rules of Civil Procedure.

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

7 Pursuant to United States Federal Rule of Civil Procedure 28(b)(2), a deposition may
8 be taken in a foreign country “under a letter of request, whether or not captioned a ‘letter
9 rogatory.’” This Court has the inherent authority to issue letters rogatory. *See United States*
10 *v. Reagan*, 453 F.2d 165, 172 (6th Cir. 1971); *United States v. Staples*, 256 F.2d 290, 292
11 (9th Cir. 1958). Under governing United States law, a letter rogatory can also include
12 requests for the production of documents. *See Reagan*, 453 F.2d at 168 (affirming district
13 court’s issuance of letters rogatory seeking documents relating to an investigation conducted
14 by German authorities).

15 A court’s decision whether to issue a letter rogatory requires an application of United
16 States Federal Rule of Civil Procedure, Rule 28(b), in light of the scope of discovery
17 provided for by the Federal Rules of Civil Procedure. *See Evanston Ins. Co. v. OEA, Inc.*,
18 No. CIV S-02-1505 DFL PAN, 2006 WL 1652315 at* 2 (E.D. Cal. June 13, 1990) (stating
19 that Rule 28(b) “must be read together” with Rule 26(c) in determining whether to issue letter
20 rogatory); *see also DBMS Consultants Ltd. v. Computer Assocs. Int’l, Inc.*, 131 F.R.D. 367,
21 369-70 (D. Mass. 1990); *B & L Drilling Elecs. v. Totco*, 87 F.R.D. 543, 545 (W.D. Ok.
22 1978).

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

3 **4. Reciprocity.**

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

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

8 Mr. Flint is an individual residing in Toronto, Ontario, Canada.

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

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11 As discussed above, Defendant Fortinet contends that the witness, Mr. Flint, has
12 knowledge of the conception and reduction to practice of a product that constitutes prior art
13 that allegedly would invalidate the patent-in-suit. Fortinet contends Mr. Flint has
14 knowledge that the JANUS/BorderWare Prior Art Product was made publicly available by no
15 later than July 13, 1994 and that it was not abandoned, suppressed or concealed. Fortinet has
16 further asserted that Mr. Flint was involved in the installation of the JANUS/BorderWare
17 Prior Art Product at two companies in the spring of 1994.

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

19
20 Defendant Fortinet has been asked whether it will, and has reserved the right to,
21 introduce testimony from Mr. Flint at trial concerning the conception and reduction to
22 practice of the Janus/BorderWare Prior Art Product, upon which Fortinet will rely to argue
23 that the '601 Patent is invalid. To the extent this evidence may be used for the purposes of
24 pre-trial discovery in this civil matter, the discovery should nonetheless be permitted because
25 it would be unfair to require NPS to proceed to trial without the evidence, and obtaining the
26 evidence would not entail unreasonable expense or unfairness to the non-party. Permitting
27 such discovery will not infringe on Canadian sovereignty and justice demands the
28 examination.

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

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

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

16 **9. The evidence cannot be secured except by the intervention of the**
17 **Canadian courts.**

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

24 For the foregoing reasons, this Court hereby issues these letters rogatory authorizing
25 the taking of oral evidence from Andrew Flint and the pursuit of the production of
26 documentary evidence in his custody and control as follows:

27 **TESTIMONY**

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

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

7 **REQUESTS FOR PRODUCTION OF DOCUMENTS**

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

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

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

22 **Request No. 4:** All documents relating to modifications to the BSDi Unix source
23 code to disable IP forwarding and route everything up to the application layer on the firewall,
24 to adapt existing Unix-based operating system and various readily available proxy processes
25 for common applications such as FTP, Telnet, HTTP, Gopher, and Ping, for example.
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Request No. 5: All documents relating to posts to the Great Circle Firewall electronic bulletin board describing the JANUS firewall development or the JANUS FireWall Server product.

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


Request No. 7: All communications between you, Andrew Flint, and Fortinet, including in particular, counsel for Fortinet or concerning conception or reduction to practice of the JANUS Firewall Server or the ‘601 Patent.

For the foregoing reasons, these letters rogatory hereby issue.

IT IS SO ORDERED

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

Date: April 23, 2013.



William Alsup
United States District Judge