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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)– RAYAN
 ZACHARIASSEN**

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 Rayan Zachariassen, 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. Zachariassen is among
5 those witnesses, and is located in the Province of Ontario, Canada. Based upon Fortinet’s
6 contentions, Mr. Zachariassen is believed to have information pertinent to the conception and
7 reduction to practice of the JANUS/BorderWare Prior Art Product that Fortinet contends
8 invalidates the patent-in-suit. Fortinet contends that Mr. Zachariassen, along with other non-
9 party witnesses and BTNi engineers Glenn Mackintosh and Steven Lamb, worked on the
10 concept for the JANUS/BorderWare Prior Art Product and was involved in the creation of the
11 product, which it contends was publicly known and used in the United States since July 1994
12 and about which Mr. Zachariassen is a knowledgeable witness.

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

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

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

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

19
20 The evidence sought by the letters rogatory is necessary for trial and intended to be
21 adduced at trial, if admissible. This required evidence is relevant to the American proceeding
22 in that it is anticipated to have bearing on a central defense – invalidity of the patent at issue –
23 to the Plaintiff’s primary cause of action for patent infringement.

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

4 The Ontario Court may properly authorize the witness to provide the responsive
5 evidence, if any, pursuant to Section 60 of the Ontario Evidence Act and consistent with Rule
6 31.10 of the Rules of Civil Procedure.

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

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

18 A court’s decision whether to issue a letter rogatory requires an application of United
19 States Federal Rule of Civil Procedure, Rule 28(b), in light of the scope of discovery
20 provided for by the Federal Rules of Civil Procedure. *See Evanston Ins. Co. v. OEA, Inc.*,
21 No. CIV S-02-1505 DFL PAN, 2006 WL 1652315 at* 2 (E.D. Cal. June 13, 1990) (stating
22 that Rule 28(b) “must be read together” with Rule 26(c) in determining whether to issue letter
23 rogatory); *see also DBMS Consultants Ltd. v. Computer Assocs. Int’l, Inc.*, 131 F.R.D. 367,
24 369-70 (D. Mass. 1990); *B & L Drilling Elecs. v. Totco*, 87 F.R.D. 543, 545 (W.D. Ok.
25 1978).

26 This Court has considered the Unopposed Administrative Motion for Issuance of
27 Letters Rogatory (the “Motion”, Northern District of California Docket No. 192, including
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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 issued these
5 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. Zachariassen 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.
15 Zachariassen, worked on and has knowledge of the conception and reduction to practice of
16 a product that constitutes prior art that would invalidate the patent-in-suit. In particular,
17 Fortinet contends that that Mr. Zachariassen will testify at trial that he and other BTNi
18 engineers conceived of the idea for the firewall product, and that it was publicly known and
19 available in the United States since at least July 1004.

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

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

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

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

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

18 **9. The evidence cannot be secured except by the intervention of the**
19 **Canadian courts.**

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

1 For the foregoing reasons, this Court hereby issues these letters rogatory authorizing
2 the taking of oral evidence from Rayan Zachariassen and the pursuit of the production of
3 documentary evidence in his custody and control as follows:

4 **TESTIMONY**

5 If acceptable to the governing Canadian authority, (1) each of the witnesses shall be
6 required to sit for deposition for no longer than seven (7) total hours, and both the Plaintiff
7 and the Defendant will be limited to 50% of that hourly total; and (2) Counsel for Plaintiff
8 and Defendant shall conduct themselves consistent with the Federal Rules of Civil Procedure
9 of the United States, as well as any Local Rules and Standing Orders governing the above-
10 captioned case.

11 **REQUESTS FOR PRODUCTION OF DOCUMENTS**

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

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

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

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

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

6 **Request No. 6:** All prior art that may invalidate U.S. Patent No. 5,623,601 (“the
7 ‘601 patent”).

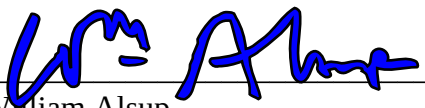
8 **Request No. 7:** All communications between you, Rayan Zachariassen, and Fortinet,
9 including in particular, counsel for Fortinet or concerning conception or reduction to practice
10 of the JANUS Firewall Server or the ‘601 Patent.

11
12 For the foregoing reasons, these letters rogatory hereby issue.

13 IT IS SO ORDERED

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

17 Date: April 23, 2013.

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19 William Alsup
20 United States District Judge
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