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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)– GLENN
 MACKINTOSH**

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 Glenn Mackintosh, 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. Mackintosh is among
5 those witnesses, and is located in the Province of Ontario, Canada. Based upon Fortinet’s
6 contentions, Mr. Mackintosh 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. Mackintosh and other Border
9 Network engineers conceived of the idea for the firewall product, that he personally
10 developed a proof of concept for it within weeks, and that and another engineer named
11 Steven Lamb immediately began outlining the concept and writing the underlying source
12 code for the software.

13 Fortinet specifically contends that Mr. Mackintosh will explain at trial that the May
14 1994 version of the source code for the JANUS/BorderWare Prior Art Product contained
15 specific kernel modifications and proxy code that enabled the firewall to operate in a manner
16 that Fortinet contends anticipates and/or renders obvious the inventions claims by the ’601
17 Patent. In particular, Fortinet contends that Mr. Mackintosh “will testify” at trial that: “he
18 developed a proof of concept for [the JANUS/BorderWare Prior Art Product] within weeks”
19 and “that modification to the [source code for the JANUS/BorderWare Prior Art Product]
20 was very simple and only required changes to a few lines of code in a few modules and that
21 most of the coding was adapting the existing Unix-based operating system and various
22 readily available proxy processes for common applications.” Fortinet further contends that
23 Mr. Mackintosh and others contributed posts to an electronic bulletin board concerning
24 firewall technology that disclosed information concerning the JANUS/BorderWare Prior Art
25 Product in 1994.
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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.**

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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. S

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. Mackintosh 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. MacKintosh,
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. Mackintosh will testify at trial that he and other BTNi engineers conceived of
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1 the idea for the firewall product, that he personally developed a proof of concept for it within
2 weeks, and that he and another engineer named Steven Lamb immediately began outlining
3 the concept and writing the underlying source code for the software.

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

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

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

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

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

1 sessions directly to the destination without considering or even being aware that the JANUS
2 Firewall Server was using a proxy method which made the JANUS' proxy operation
3 "transparent" to both the sender and receiver of the packets.

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

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

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

14 **Request No. 6:** All prior art that may invalidate U.S. Patent No. 5,623,601 ("the
15 '601 patent").

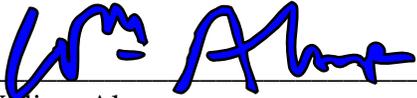
16 **Request No. 7:** All communications between you, Glenn Mackintosh, and Fortinet,
17 including in particular, counsel for Fortinet or concerning conception or reduction to practice
18 of the JANUS Firewall Server or the '601 Patent.

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

20 IT IS SO ORDERED

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

24 Date: April 23, 2013.

25 
26 William Alsup
27 United States District Judge
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