

) Civil Action No. 3:20-cv-6900  
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)  
) **COMPLAINT FOR**  
) **TRADEMARK**  
) **INFRINGEMENT, FALSE**  
) **DESIGNATION OF ORIGIN,**  
) **AND UNFAIR COMPETITION,**  
)  
) **DEMAND FOR JURY TRIAL**

1 Plaintiff Fortinet, Inc. (“Fortinet”) hereby complains of Defendant Fortanix, Inc.  
2 (“Fortanix”) and alleges as follows:

3 **JURISDICTION AND VENUE**

4 1. This is an action for: (a) trademark infringement arising under 15 U.S.C. § 1114,  
5 (b) false designation of origin arising under 15 U.S.C. § 1125(a), (c) unfair competition arising  
6 under California Business & Professions Code § 17200 *et seq.*, (d) unfair competition arising  
7 under the common law of the State of California, and (e) cancellation of U.S. Trademark  
8 Registration No. 5,289,135.

9 2. This Court has subject matter jurisdiction pursuant to 15 U.S.C. § 1121 and 28  
10 U.S.C. §§ 1331, 1338(a) and (b), and 1367(a).

11 3. Venue is proper in this Judicial District pursuant to 28 U.S.C. § 1391(b) and (c).

12 **THE PARTIES**

13 4. Plaintiff Fortinet is a Delaware corporation having a principal place of business at  
14 899 Kifer Rd, Sunnyvale, California 94086.

15 5. Upon information and belief, Defendant Fortanix is a Delaware corporation  
16 having a place of business at 444 Castro St., Ste. 305, Mountainview, California 94041.

17 6. Defendant is subject to the general and specific jurisdiction of this Court by virtue  
18 of its continuous, systematic, and substantial presence within this Judicial District, and by  
19 committing acts of trademark infringement, false designation of origin, unfair competition, and  
20 dilution in this Judicial District, which acts form a substantial part of the events or omissions  
21 giving rise to Plaintiff’s claims.

22 **ALLEGATIONS FOR ALL CLAIMS OF RELIEF**

23 7. Fortinet is a global leader in the networking and security space and provides a  
24 wide range of software, hardware, and networking solutions and related services to consumers  
25 worldwide. Founded in 2000, Fortinet has spent considerable time, effort and money developing  
26 its reputation as a leader in the networking and security industries. Fortinet has continuously  
27 used its well-known trade name and house mark FORTINET since its inception.

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1           8. As a result of its substantial investment, Fortinet now has annual revenues of over  
2 a billion dollars, and the FORTINET mark has acquired great value as a specific identifier of  
3 Plaintiff's products and services. The FORTINET mark serves to distinguish Plaintiff's products  
4 and services from that of others.

5           9. Fortinet also brands its goods and services under an extensive list of various other  
6 "FORTI-" inclusive marks, such as, FORTIGUARD, FORTIGATE, FORTIMANAGER,  
7 FORTIMAIL, FORTIANALYZER, FORTICARE, FORTICLIENT, FORTICLOUD,  
8 FORTISANDBOX, FORTIOS, FORTIWIFI, FORTIAP, FORTIDDOS, among many others  
9 (hereinafter referred to as the "FORTINET Family of Marks").

10          10. Fortinet owns numerous domain names to promote its goods and services,  
11 including the domain names <www.fortinet.com> <www.fortiguard.com>  
12 <www.fortimail.com> and <www.forticloud.com>, among many others.

13          11. As a result of Fortinet's investment in the FORTINET Family of Marks, and the  
14 widespread commercial success of its products and services, Fortinet has developed a  
15 tremendous amount of goodwill in its FORTINET Family of Marks and owns over 100  
16 trademark registrations worldwide for its FORTINET Family of Marks.

17          12. On February 5, 2013, the United States Patent and Trademark Office issued to  
18 Plaintiff, U.S. Trademark Registration No. 4,285,497 for the mark FORTINET for "[m]onitoring  
19 of computer systems for security purposes; consulting services in the field of maintaining the  
20 security and integrity of databases." A true and correct copy of this registration is attached to  
21 this Complaint as Exhibit 1. This registration is owned by Plaintiff.

22          13. Plaintiff's U.S. Trademark Registration No. 4,285,497 for the mark FORTINET is  
23 now incontestable under the provisions of the Lanham Act, 15 U.S.C. § 1065. The declaration of  
24 incontestability was filed on April 18, 2018.

25          14. On December 10, 2002 the United States Patent and Trademark Office issued  
26 U.S. Trademark Registration No. 2,659,631 for the mark FORTINET for "computer network  
27 operating system featuring network security, network management, processing of network  
28 traffic, provision of network security based applications and application enhancement." A true

1 and correct copy of this registration is attached to this Complaint as Exhibit 2. Plaintiff is the  
2 owner by assignment of this registration.

3 15. Plaintiff's U.S. Trademark Registration No. 2,659,631 for the mark FORTINET is  
4 now incontestable under the provisions of the Lanham Act, 15 U.S.C. § 1065. The declaration of  
5 incontestability was filed on December 9, 2008.

6 16. On January 25, 2011 the United States Patent and Trademark Office issued to  
7 Plaintiff, U.S. Trademark Registration No. 3,909,699 for the mark FORTINET for "[c]omputer  
8 network operating system featuring network security, network management, processing of  
9 network traffic, provision of network security based applications and application enhancement;  
10 computer hardware; computer software and firmware for protecting the integrity of computer  
11 hardware, software, networks and electronic data; computer software and firmware for analyzing  
12 and filtering of network traffic and for the detection, filtering, and/or removal of computer  
13 intrusions, viruses, spam, or other malicious applications or threats, and for providing virtual  
14 private networking and security functions; computer software and firmware for monitoring,  
15 analyzing or reporting of network information, data and traffic; electronic software updates,  
16 namely, downloadable computer software and associated data files for updating computer  
17 software in the fields of computer intrusions, viruses, spam, or other malicious applications or  
18 threats and security functions protecting the integrity of computer hardware, software, networks  
19 and electronic data, provided via computer and communication networks" and for "[c]omputer  
20 consulting services; computer software and network security research and development services;  
21 computer software and network security management and analysis; technical support services  
22 related to the provision of antivirus, anti-spam, anti-spyware, anti-malware, web-content filtering  
23 and/or intrusion detection and prevention for network and computer security; troubleshooting of  
24 computer software and hardware problems and monitoring of network systems; maintenance,  
25 upgrading, and updating of computer software; computer services, namely, providing a web-  
26 based system comprised of the temporary use of non-downloadable software to be used by others  
27 in the monitoring of computer systems for security purposes." A true and correct copy of this  
28 registration is attached to this Complaint as Exhibit 3. Plaintiff is the owner of this registration.

1           17. Plaintiff's U.S. Trademark Registration No. 3,909,699 for the mark FORTINET is  
2 now incontestable under the provisions of the Lanham Act, 15 U.S.C. § 1065. The declaration of  
3 incontestability was filed on January 20, 2017.

4           18. On August 30, 2011, the United States Patent and Trademark Office issued to  
5 Plaintiff, U.S. Trademark Registration No. 4,017,505 for the mark

6 **FORTINET** (the "Fortinet Logo mark")  
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9 for "[c]omputer network operating system featuring network security, network management,  
10 processing of network traffic, provision of network security based applications and application  
11 enhancement; computer hardware; computer software and firmware for protecting the integrity  
12 of computer hardware, software, networks and electronic data; computer software and firmware  
13 for analyzing and filtering of network traffic and for the detection, filtering, and/or removal of  
14 computer intrusions, viruses, spam, or other malicious applications or threats, and for providing  
15 virtual private networking and security functions; computer software and firmware for  
16 monitoring, analyzing or reporting of network information, data and traffic; electronic software  
17 updates, namely, downloadable computer software and associated data files for updating  
18 computer software in the fields of computer intrusions, viruses, spam, or other malicious  
19 applications or threats and security functions protecting the integrity of computer hardware,  
20 software, networks and electronic data, provided via computer and communication networks"  
21 and for "Computer consulting services; computer software and network security research and  
22 development services; computer software and network security management and analysis,  
23 namely, remote and on-line system management and analysis of the information technology (IT)  
24 systems and networks of others; computer software and network security management and  
25 analysis services that allows users to view risk posture and network performance, to track  
26 network activity and to access reports regarding the same; computer network security  
27 management and analysis, namely, scanning and penetration testing of computers and networks  
28 to assess information security vulnerability; computer network security management and analysis

1 in the field of updating of computer software relating to computer security and prevention of  
2 computer risks; technical support services related to the provision of antivirus, anti-spam, anti-  
3 spyware, anti-malware, web-content filtering and/or intrusion detection and prevention for  
4 network and computer security; troubleshooting of computer software and hardware problems  
5 and monitoring of network systems; maintenance, upgrading, and updating of computer  
6 software; computer services, namely, providing a web-based system comprised of the temporary  
7 use of non-downloadable software to be used by others in the monitoring of computer systems  
8 for security purposes.” A true and correct copy of this registration is attached to this Complaint  
9 as Exhibit 4. This registration is owned by Plaintiff.

10 19. Plaintiff’s U.S. Trademark Registration No. 4,017,505 for the Fortinet Logo mark  
11 is now incontestable under the provisions of the Lanham Act, 15 U.S.C. § 1065. The declaration  
12 of incontestability was filed on January 31, 2017.

13 20. Plaintiff’s incontestable trademark registrations are conclusive evidence of the  
14 validity of the registered mark and of the registration of the mark, of Plaintiff’s ownership of the  
15 mark, and of Plaintiff’s exclusive right to use the registered mark in commerce.

16 21. Customers in this Judicial District and elsewhere readily recognize Plaintiff’s  
17 FORTINET mark as a distinctive designation of origin of Plaintiff’s products and services.

18 22. Long after Plaintiff began using the FORTINET mark, Defendant began using the  
19 confusingly similar mark FORTANIX for cybersecurity, encryption, and network security goods  
20 and services, including computer software platforms for ensuring secure execution of  
21 applications for providing security solutions across mobile, cloud, and enterprise platforms.  
22 Defendant’s FORTANIX mark is highly similar in appearance and in sound to Plaintiff’s  
23 FORTINET mark and Plaintiff’s FORTINET Family of Marks. Defendant’s use of the mark  
24 FORTANIX causes a likelihood of consumer confusion when used with Defendant’s goods and  
25 services.

26 23. Also, long after Plaintiff began using the FORTINET mark, Defendant began  
27 promoting its goods and services through the domain name <fortanix.com>. Defendant’s use of  
28 the <fortanix.com> domain name causes a likelihood of consumer confusion when used to

1 promote, market, and/or sell Defendant's goods and services.

2 24. Without permission or authority from Plaintiff, Defendant has infringed Plaintiff's  
3 FORTINET mark in interstate commerce by making, using, promoting, advertising, selling,  
4 and/or offering to sell Defendant's products and services under the mark FORTANIX.

5 25. Plaintiff is informed and believes, and on that basis alleges, that Defendant's  
6 unauthorized use of the mark FORTANIX is intended to trade upon the goodwill and substantial  
7 recognition associated with Plaintiff's FORTINET mark and FORTINET Family of Marks.

8 26. Plaintiff is informed and believes, and on that basis alleges, that Defendant is  
9 using its FORTANIX mark in an attempt to associate its products with Plaintiff and Plaintiff's  
10 FORTINET mark, to cause mistake or deception as to the source of Defendant's products and/or  
11 to otherwise trade upon Plaintiff's valuable reputation and customer goodwill in its mark.

12 27. Plaintiff is informed and believes, and on that basis alleges, that Defendant's use  
13 of the FORTANIX mark is designed to cause confusion, mistake, or deception.

14 28. By virtue of the acts complained of herein, Defendant has created a likelihood of  
15 injury to Plaintiff's business reputation, caused a strong likelihood of consumer confusion,  
16 mistake, and deception as to the source of or origin or relationship of Plaintiff's and Defendant's  
17 goods, has caused actual confusion, and has otherwise competed unfairly with Plaintiff by  
18 unlawfully trading on and using Plaintiff's FORTINET mark without Plaintiff's permission or  
19 consent.

20 29. Plaintiff is informed and believes, and on that basis alleges, that Defendant's acts  
21 complained of herein are willful and deliberate.

22 30. Defendant's acts complained of herein have caused damage to Plaintiff in an  
23 amount to be determined at trial, and such damages will continue to increase unless Defendant is  
24 enjoined from its wrongful actions and infringements.

25 31. Defendant's acts complained of herein have caused Plaintiff to suffer irreparable  
26 injury to its business. Plaintiff will suffer substantial loss of goodwill and reputation unless and  
27 until Defendant is preliminarily and permanently enjoined from its wrongful actions complained  
28 of herein.

**FIRST CLAIM FOR RELIEF**

**(Trademark Infringement Under 15 U.S.C. § 1114)**

32. Plaintiff realleges Paragraphs 1-31, as if fully set forth herein.

33. This is a claim for trademark infringement arising under 15 U.S.C. § 1114.

34. Defendant has used in commerce, without permission of Plaintiff, a mark that is confusingly similar to Plaintiff's federally registered FORTINET mark. Defendant has infringed Plaintiff's FORTINET mark by using the confusingly similar mark FORTANIX with Defendant's cybersecurity, encryption, and network security goods and services, including computer software platforms for ensuring secure execution of applications for providing security solutions across mobile, cloud, and enterprise platforms, and related goods and services.

35. Plaintiff is informed and believes, and on that basis alleges, that Defendant did so with the intent to cause confusion and mistake among customers and the public, and to deceive the public into believing that Defendant's products are associated with, sponsored by or approved by Plaintiff, when they are not.

36. Plaintiff is informed and believes, and on that basis alleges, that Defendant had actual knowledge of Plaintiff's ownership and prior use of the FORTINET mark and without the consent of Plaintiff, has willfully violated 15 U.S.C. § 1114.

37. Defendant's aforementioned acts have injured Plaintiff and damaged Plaintiff in an amount to be determined at trial.

38. By its actions, Defendant is irreparably injuring Plaintiff. Such irreparable injury will continue unless Defendant is preliminarily and permanently enjoined by this Court from further violation of Plaintiff's rights, for which Plaintiff has no adequate remedy at law.

**SECOND CLAIM FOR RELIEF**

**(False Designation of Origin Under 15 U.S.C. § 1125(a))**

39. Plaintiff hereby realleges Paragraphs 1-38, as if fully set forth herein.

40. This is a claim for false designation of origin arising under 15 U.S.C. § 1125(a).

41. Defendant's use of the mark FORTANIX with Defendant's cybersecurity, encryption, network security, and computer software goods and services is confusingly similar to



1 Plaintiff's FORTINET mark.

2 42. Defendant's use of the mark FORTANIX without Plaintiff's consent constitutes a  
3 false designation of origin, false or misleading description of fact, or false or misleading  
4 representation of fact, which is likely to cause confusion, or to cause mistake, or to deceive as to  
5 the affiliation, connection, or association of Defendant with Plaintiff, or as to the origin,  
6 sponsorship, or approval of Defendant's goods in violation of 15 U.S.C. § 1125(a).

7 43. Such conduct by Defendant is likely to confuse, mislead, and deceive Defendant's  
8 customers, purchasers, and members of the public as to the origin of Defendant's products and  
9 services or cause said persons to mistakenly believe that Defendant and/or its products and  
10 services have been sponsored, approved, authorized, or licensed by Plaintiff or are in some way  
11 affiliated or connected with Plaintiff, all in violation of 15 U.S.C. § 1125(a).

12 44. Plaintiff is informed and believes, and on that basis alleges, that Defendant did so  
13 with the intent to unfairly compete against Plaintiff, to trade upon Plaintiff's reputation and  
14 goodwill by causing confusion and mistake among customers and the public, and to deceive the  
15 public into believing that Defendant's products are associated with, sponsored by or approved by  
16 Plaintiff, when they are not.

17 45. Plaintiff is informed and believes, and on that basis alleges, that Defendant had  
18 knowledge of Plaintiff's ownership and prior use of the FORTINET mark, and without the  
19 consent of Plaintiff, has willfully violated 15 U.S.C. § 1125(a).

20 46. Defendant's aforementioned acts have injured Plaintiff and damaged Plaintiff in  
21 an amount to be determined at trial.

22 47. By its actions, Defendant is irreparably injuring Plaintiff. Such irreparable injury  
23 will continue unless Defendant is preliminarily and permanently enjoined by this Court from  
24 further violation of Plaintiff's rights, for which Plaintiff has no adequate remedy at law.

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**THIRD CLAIM FOR RELIEF**

**(California Statutory Unfair Competition**

**Under Cal. Bus. & Prof. Code § 17200)**

48. Plaintiff hereby realleges Paragraphs 1-47, as if fully set forth herein.

49. This is a claim for unfair competition arising under Cal. Bus. & Prof. Code § 17200, *et seq.*

50. By virtue of the acts complained of herein, Defendant has intentionally caused a likelihood of confusion among the consumers and public and have unfairly competed in violation of Cal. Bus. & Prof. Code § 17200, *et seq.*

51. Defendant's acts complained of herein constitute unlawful, unfair, malicious or fraudulent business practices, which have injured and damaged Plaintiff.

52. As a direct and proximate result of Defendant's acts complained of herein, Plaintiff has and will continue to suffer great harm and damage. Plaintiff will continue to be irreparably damaged unless Defendant is enjoined from further committing unfair and unlawful business practices against Plaintiff.

**FOURTH CLAIM FOR RELIEF**

**(California Common Law Unfair Competition)**

53. Plaintiff hereby realleges Paragraphs 1-52, as if fully set forth herein.

54. This is a claim for common law unfair competition arising under the common law of the State of California.

55. By virtue of the acts complained of herein, Defendant has intentionally caused a likelihood of confusion among the purchasing public in this Judicial District and elsewhere, thereby unfairly competing with Plaintiff in violation of the common law of the State of California.

56. By its actions, Defendant has injured and violated the rights of Plaintiff in an amount to be determined at trial.

57. By its actions, Defendant is irreparably injuring Plaintiff. Such irreparable injury will continue unless Defendant is preliminarily and permanently enjoined by this Court from

1 further violation of Plaintiff's rights, for which Plaintiff has no adequate remedy at law.

2 58. Defendant's willful acts of unfair competition under California common law  
3 constitute fraud, oppression, and malice. Accordingly, Plaintiff is entitled to exemplary  
4 damages.

5 **FIFTH CLAIM FOR RELIEF**

6 **(Cancellation of U.S. Trademark Registration No. 5,289,135)**

7 59. Plaintiff hereby realleges Paragraphs 1-58, as if fully set forth herein.

8 60. This is a claim for cancellation of U.S. Trademark Registration No. 5,289,135  
9 under 15 U.S.C. § 1119.

10 61. U.S. Trademark Registration No. 5,289,135 for the mark FORTANIX used in  
11 connection with "[c]omputer software platforms for ensuring secure execution of applications for  
12 providing security solutions across mobile, cloud, and enterprise platforms" has a registration  
13 date of September 19, 2017. A true and correct copy of this registration is attached to this  
14 Complaint as Exhibit 5.

15 62. Defendant's use of the mark FORTANIX in connection with the goods listed in  
16 U.S. Trademark Registration No. 5,289,135 causes a likelihood of confusion with Plaintiff's  
17 earlier registered mark FORTINET, U.S. Trademark Registrations Nos. 4,285,497; 2,659,631;  
18 3,909,699; and 4,017,505.

19 63. Plaintiff is being competitively harmed by the continued registration of  
20 Defendant's U.S. Registration No. 5,289,135.

21 64. In view of the foregoing, Defendant's U.S. Trademark Registration No. 5,289,135  
22 should be cancelled pursuant to 15 U.S.C. § 1119.

23 **CLAIM FOR RELIEF**

24 **WHEREFORE**, Plaintiff respectfully requests the Court to award Plaintiff the following  
25 relief:

26 A. That the Court render a final judgment in favor of Plaintiff and against Defendant  
27 on all claims for relief alleged herein;

28 B. That the Court render a final judgment declaring that Defendant has violated and

1 willfully violated the provisions of 15 U.S.C. § 1114 by infringing Plaintiff's trademark rights in  
2 its federally registered FORTINET mark;

3 C. That the Court render a final judgment declaring that Defendant has violated and  
4 willfully violated the provisions of 15 U.S.C. § 1125(a) by falsely designating the origin of  
5 Defendant's products and unfairly competing with Plaintiff through the marketing, sale and  
6 promotion of Defendant's products and services using the mark "FORTANIX";

7 D. That Defendant be adjudged to have unfairly competed with Plaintiff under Cal.  
8 Bus. & Prof. Code § 17200, *et seq.*;

9 E. That Defendant be adjudged to have unfairly competed with Plaintiff under the  
10 common law of the State of California;

11 F. That Defendant, its officers, principals, agents, servants, employees, attorneys,  
12 successors, and assigns, and all other persons in active concert or participation with any of them  
13 who receive actual notice of the injunction by personal service or otherwise, be forthwith  
14 preliminarily and permanently enjoined from:

- 15 1. using the mark FORTANIX in connection with advertising, marketing,  
16 promoting, selling, or offering to sell Defendant's cybersecurity,  
17 encryption, network security, and/or computer software goods or services  
18 and/or any related goods or services;
- 19 2. manufacturing, distributing, shipping, importing, selling, and/or offering  
20 to sell any products bearing the mark FORTANIX;
- 21 3. registering or applying to register in the United States the mark  
22 FORTANIX for use with cybersecurity, encryption, network security,  
23 and/or computer software goods or services, and/or any related goods or  
24 services;
- 25 4. using any trademark confusingly similar to Plaintiff's FORTINET mark in  
26 any manner that is likely to create the impression that Defendant's goods  
27 originate from Plaintiff, are endorsed by Plaintiff, or are connected in any  
28 way with Plaintiff;

5. marketing and/or selling products through the domain name <www.fortanix.com>;
6. otherwise infringing Plaintiff's FORTINET mark;
7. falsely designating the origin of Defendant's goods;
8. unfairly competing with Plaintiff in any manner whatsoever; and
9. causing a likelihood of confusion or injury to Plaintiff's business reputation.

G. That Defendant be directed to file with this Court and serve on Plaintiff within thirty (30) days after the service of the injunction, a report, in writing, under oath, setting forth in detail the manner and form in which Defendant has complied with the injunction pursuant to 15 U.S.C. § 1116;

H. That ownership of the <fortanix.com> domain name be transferred to Plaintiff;

I. That Defendant be required to account to Plaintiff for any and all profits derived by Defendant and all damages sustained by Plaintiff by virtue of Defendant's acts complained of herein;

J. That Defendant be ordered to pay over to Plaintiff all damages which Plaintiff has sustained as a consequence of the acts complained of herein, subject to proof at trial;

K. That Defendant's actions complained of herein be deemed willful, and that this be deemed an exceptional case pursuant to 15 U.S.C. § 1117, and further, that Plaintiff be entitled to enhanced damages pursuant to 15 U.S.C. § 1117;

L. That Plaintiff recover exemplary damages pursuant to California Civil Code § 3294;

M. That interest be awarded on all applicable damages under California Civil Code § 3288;

N. That Plaintiff recover the costs of this civil action, including reasonable attorneys' fees;

O. That Defendant be required to deliver and destroy within thirty (30) days all devices, literature, advertising, packaging, goods and other materials bearing the infringing

1 trademarks pursuant to 15 U.S.C. § 1118;

2 P. That the United States Patent and Trademark Office is directed to cancel  
3 Defendant's U.S. Trademark Registration No. 5,289,135; and

4 Q. That Plaintiff be awarded such other and further relief as this Court may deem  
5 just.

6  
7 Respectfully submitted,

8 KNOBBE, MARTENS, OLSON & BEAR, LLP  
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10 Dated: April 5, 2018

By: /s/ Lauren Keller Katzenellenbogen

11 Michael K. Friedland

12 Susan M. Natland

13 Lauren Keller Katzenellenbogen

14 Attorneys for Plaintiff  
15 FORTINET, INC.  
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**DEMAND FOR JURY TRIAL**

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Plaintiff demands a trial by jury of all issues raised by the pleadings which are triable by jury.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: April 5, 2018

By: /s/ Lauren Keller Katzenellenbogen

Michael K. Friedland

Susan M. Natland

Lauren Keller Katzenellenbogen

Attorneys for Plaintiff  
FORTINET, INC.

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