

made the basis of its motion were "indisputably" added to the case over a year ago when the court in the Eastern District of Texas allowed plaintiff to supplement its preliminary infringement contentions. Now, plaintiff asks this court to confirm that the VoIP, DIA, and iQ services are "in the case" and order Qwest to provide discovery with respect to those services. The parties have briefed their respective positions in a joint status report filed on July 11, 2011, and the motion is ripe for determination.

The court need not decide whether plaintiff's infringement contentions sufficiently identify the VoIP, DIA, and iQ services in order to rule on the instant motion.² Under the Patent Rules for the Northern District of Texas, which now govern this proceeding, "the scope of discovery is not limited to the preliminary infringement contentions . . . but is governed by the Federal Rules of Civil Procedure." Misc. Order No. 62, ¶ 2-5(a). Rule 26(b)(1) allows the parties to "obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense[.]" FED. R. CIV. P. 26(b)(1). In *epicRealm Licensing LLC v. Autoflex Leasing, Inc.*, Nos. 2-07-CV-163-DF-CMC & 2-05-CV-356-DF-CMC, 2007 WL 2580969 at *3 (E.D. Tex. Aug. 27, 2007), a judge in the Eastern District of Texas rejected the very argument made by Qwest in this case -- that discovery can be obtained only if it relates to an accused product or service identified in a party's preliminary infringement contentions. Instead, the court recognized that the scope of discovery in a patent case may include products and services "reasonably similar" to those accused in the infringement contentions. *Id.*, 2007 WL 2580969 at *3; *see also Honeywell Intern. Inc. v. Acer America Corp.*, 655 F.Supp.2d 650, 655 (E.D. Tex. 2009) (rule limiting discovery to products and services identified

² Although the court need not decide this issue, it notes that the court in the Eastern District of Texas allowed plaintiff to supplement its preliminary infringement contentions to include VoIP, DIA, and iQ as accused services. In so ruling, the court rejected Qwest's argument that the new accused services would greatly expand the scope of this litigation.

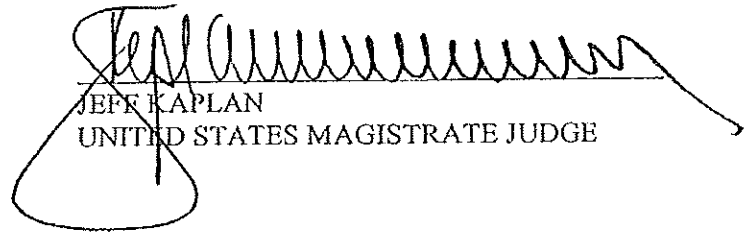
in preliminary infringement contentions would be "inconsistent with the broad discovery regime created by the Federal Rules").

The court has little difficulty concluding that Qwest's VoIP, DIA, and iQ services are "reasonably similar" to the other services charted by plaintiff in its preliminary infringement contentions. The patent-in-suit, U.S. Patent No. 5,555,478 ("the '478 Patent"), claims a unique fiber optic transmission system that provides for the transmission of packets of information by way of three levels of intelligent routing devices connected by fiber optic lines. (*See* Jt. Stat. Rep. at 11). Plaintiff alleges that Qwest's fiber optic network -- which is comprised of switches, routers, and fiber optic lines connecting the various devices -- functions in the manner described in the '478 Patent and, thus, infringes on the patent. (*Id.*). In its supplemental preliminary infringement contentions, plaintiff states that Qwest provides a number of commercial products and services, including VoIP, DIA, and iQ, to customers over its allegedly infringing network. (*See* Jt. Stat. Rep. App., Exh. 1 at A1). The infringement contentions also set forth plaintiff's theory that all the identified services use the accused network in the same or a substantially similar manner. (*See id.*, Exh. 1 at A2-A29). Although the chart provided by plaintiff may provide greater detail with respect to Qwest's Fiber to the Home ("FTTH"), Metro Optical Ethernet ("MOE"), and hosting services, the supplemental preliminary infringement contentions clearly identify VoIP, DIA, and iQ as similar services offered over the allegedly infringing network. Plaintiff is therefore entitled to discovery as to those services. *See epicRealm Licensing*, 2007 WL 2580969 at *3 (where entire system is adequately described in infringement contentions, discovery is not limited only to products specifically accused).

For these reasons, plaintiff's motion to compel discovery [Doc. #281] is granted. Qwest shall respond to all outstanding discovery requests pertaining to its VoIP, DIA, and iQ services within 20 days from the date of this order.

SO ORDERED.

DATED: July 22, 2011.



JEFF KAPLAN
UNITED STATES MAGISTRATE JUDGE