

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

LEADER TECHNOLOGIES, INC., a  
Delaware corporation

Plaintiff and Counterdefendant,

v.

FACEBOOK, INC., a Delaware  
corporation

Defendant and Counterclaimant.

Civil Action No. 1:08-cv-00862-JJF

**DEFENDANT'S REPLY BRIEF IN SUPPORT OF MOTION FOR ORDER  
COMPELLING RESPONSE TO FACEBOOK INTERROGATORY NO. 1**

Dated: May 21, 2009

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## I. INTRODUCTION

Facebook has asked simply for a straightforward, detailed explanation of how LTI believes Facebook infringes its patent. Facebook needs the information that LTI currently has, at least at the level of detail that was necessary for LTI to bring this case, in order to understand what this case is about and how discovery should be circumscribed going forward. LTI's repeated assertion that it has nothing more to say is belied in every writing it makes to justify not supplementing its response. First in letters, and now in its opposition brief LTI provides more detail about its infringement accusations than it ever has in its actual interrogatory response. Respectfully, the Court should now compel LTI to supplement its responses to fully describe how it believes the outward-facing elements of Facebook's website meet all of the outward-facing elements of the claims it is asserting. If it can not, then it should dismiss this case as unfounded.

## II. ARGUMENT

### A. **The Deficiency of LTI's Interrogatory Response is Proven By The Extra Information it Provides at Every Turn, Yet Refuses to Put into a Supplemental Response**

Facebook remains at a loss as to which aspects of its website are at issue in this case. Remarkably, every time LTI attempts to justify its insufficient response to Facebook Interrogatory No. 1, more information trickles in. Originally, LTI claimed everything about "the Facebook Website" infringed. *See e.g.*, D.I. 40, Clark Decl., Ex. D. When Facebook confronted LTI, it appeared to drop any claim as to third party features and added some color to its response through unsworn correspondence limited to claim 1. *Id.* Ex. G. But, it steadfastly refused to supplement its response to include even that information. Now, in opposing this motion, LTI provides yet more detail (which is not in its interrogatory response) about how it believes Facebook infringes that claim. In fact, the most lucid description (though still far from complete) of what LTI is accusing to date is found in its opposition papers. LTI argues:

[LTI's] provided screenshots show Facebook's infringement of Claim 1 by operation of an application called "Gifts." In one particular screenshot, it is evident that a "context component" of the Facebook Website captures context

information associated with user-defined data when a user selects a “gift.” *See* [LTI000868-69.] As shown in the provided screenshots, a user who selects a gift is automatically associated with the “gift” in different areas of the website.

Pl. Opp’n Br. at 7. While still less than clear and not linked directly to any claim limitations, this language is a revelation compared to LTI’s claim chart, which does not even cite the screenshots referenced in LTI’s papers. *See* Def. Opening Br. at 3-4. In fact, LTI’s opposition provides a clearer explanation of LTI’s infringement contentions than its sworn response. *Compare* Def. Opening Br. at 3-4 to Pl. Opp’n Br. at 7-8. LTI clearly has more information about how it believes Facebook to be allegedly infringing the claims. Respectfully, why are they not disclosing this information in response to Facebook’s interrogatory? LTI has demonstrated that it can and should supplement its responses, and Facebook respectfully asks this Court to compel LTI do so for all asserted claims.

#### **B. The ’761 Patent Claims Are Directed at User Action**

Facebook has had to examine the claims of the ’761 patent in a vacuum due to LTI’s deficient discovery responses. However, that examination shows that each asserted claim of the ’761 patent recites multiple steps that a user of a covered system or method must take to infringe. Stephan Gray<sup>1</sup> sets forth the likely elements of claim 1 as follows:

1. A computer-implemented network-based system that facilitates management of data, comprising:
  - [a] a computer-implemented context component of the network-based system
  - [b] for capturing context information associated with user-defined data
  - [c] created by user interaction of a user in a first context of the network-based system,
  - [d] the context component dynamically storing the context information in metadata associated with the user-defined data,
  - [e] the user-defined data and metadata stored on a storage component of the network-based system; and

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<sup>1</sup> LTI’s unjustified attack on Mr. Gray is yet another distraction. Mr. Gray has been a computer scientist for more than 30 years and his *C.V.* speaks for itself. *See* D.I. 41, Ex. A.

- [f] a computer-implemented tracking component of the network-based system
- [g] for tracking a change of the user from the first context to a second context of the network-based system and
- [h] dynamically updating the stored metadata based on the change,
- [i] wherein the user accesses the data from the second context.

See D.I. 41, Gray Decl., ¶ 4. Each of the underlined portions of claim 1, above, are either input by or visible to a user. Thus, LTI should be able to demonstrate where it contends each of these limitations appear on the website, since it must have used the Facebook website in performing its pre-filing analysis.

Nothing prevents LTI from mapping the user-facing functions of the website that it contends read on claim 1 against the user-facing limitations of the asserted claims. For example, as to limitation 1[d], the “context component,” the “associated metadata,” and the “user-defined data” must, by definition, appear on the user interface of a claimed system. An identification of where these elements allegedly exist would point to where and how the allegedly hidden “dynamic storing” occurs. Thus, mapping the user-facing elements of an accused system will identify the back-end components used in that system. Facebook has maintained this position all along, and LTI should be made to answer the interrogatory fully so that both parties know what pieces of Facebook’s massive website are actually at issue.

### **C. LTI’s Excuses Lack Merit**

While ignoring all of the user-facing elements of the claims in an attempt to avoid mapping claims, LTI asserts that two elements, a “tracking component” and a “storage component,” are invisible and therefore prevent it from providing any *more* detail without resort to source code. Their position is spurious. Notwithstanding its failure to provide *any* detail in its formal discovery response, LTI has demonstrated that it *can* provide detail in its communications and briefings.

Moreover, Facebook is not convinced that access to source code is required merely because the ’761 patent contains the words “computer implemented.” First, the recitation of

“computer implemented” in the claims does not change the fact that they are written in terms of user action. Second, the “computer implemented” language was not even introduced into the file history of the ’761 patent until *after* the application was *rejected* for attempting to claim non-patentable ideas.

Legally, Facebook’s entire set of source code is not relevant to this case. Practically, it makes little sense for Facebook to produce, or for LTI to review, terabytes of data before LTI streamlines the discovery process by providing sufficient infringement contentions. LTI’s “dump truck” approach carries great risk. Facebook can envision counsel for LTI becoming frustrated as it swims through terabytes of data in search of relevant source code. That frustration would no doubt lead it to ask Facebook to identify specific portions of source code responsible for broadly defined functionality. This Court is familiar with just such problems. *See CIF Licensing, LLC v. Agere Sys., Inc.*, No. 07-170-JJF, 2009 WL 187823 \*2 (D. Del., Jan. 23, 2009) (denying patentee’s motion to compel accused infringer to identify relevant lines of source code). The parties can avoid such inefficiencies if LTI would simply provide detailed infringement contentions based on publicly available information. The law requires no less.

**D. LTI Ignores Case Law Requiring a Showing of Infringement Based on Publicly Available Information**

Facebook only seeks what the law requires of LTI: that LTI provide a complete response to the interrogatory asking it for its basic infringement contentions. *See e.g., Rates Tech. Inc. v. Mediatrice Telecom, Inc.*, No. CV 05-2755(JS)(AKT), 2007 WL 2581777 \*5 (E.D.N.Y. Sept 5, 2007) (denying patentee’s motion to compel as to products for which the patentee had not provided adequate infringement contentions); *see also, Orion IP v. Staples, Inc.*, 407 F. Supp. 2d 815, 817 (E.D. Tex. 2006) (describing accused infringer’s duty to challenge an infringement allegation that accuses an entire website); *New York Univ. v. E. Piphany, Inc.*, No 05Civ.1929(LTS)(RLE), 2006 WL 559573, \*2-3 (S.D.N.Y. March 6, 2006) (stating patentee must demonstrate that it exhausted other ways of showing infringement before production of source code would be warranted). LTI seems to agree that the purpose of infringement

contentions is to “streamline the discovery process.” *See* Pl. Opp’n Br. at 11. This is exactly what Facebook is attempting to accomplish through its interrogatory and this motion. Streamlining the discovery process here requires LTI to provide detailed infringement contentions based on publicly available information that it obtained before filing this suit.

Facebook has explained since the beginning of this case that (1) LTI can access [www.facebook.com](http://www.facebook.com), (2) walk Facebook through the allegedly infringing scenarios, and (3) Facebook will produce relevant technical documentation.<sup>2</sup> *See e.g.*, D.I. 40, Clark Decl., Ex. H at 2-3; Def.’s Opening Br. at 5-6. LTI’s response has been that Facebook “knows” its website. *See* Pl. Opp’n Br. at 4. However, Facebook’s knowledge of its own website is not in dispute. What Facebook does not know, and what LTI refuses to explain, is how LTI believes any of the asserted claims of the ’761 patent apply to any instrumentality present on Facebook’s website.

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<sup>2</sup> Facebook is not “refusing” to produce source code. Indeed, it spent a great deal of time negotiating the Stipulated Protective Order entered by the Court in anticipation of doing just that. *See* D.I. 35 at 8-11. As set forth in Facebook’s Opposition to LTI’s concurrent motion, what Facebook sees as unnecessary and unduly burdensome is the production of *all* of its source code. *See* D.I. 48 and 3-4.



**III. CONCLUSION**

For the foregoing reasons, Facebook respectfully requests the Court grant its motion and enter an order compelling LTI to provide a complete response to Facebook Interrogatory No. 1.

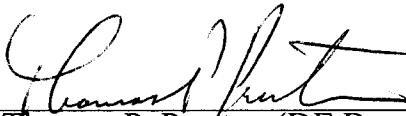
Dated: May 21, 2009

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## **EXHIBITS – UNREPORTED CASES**



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**This decision was reviewed by West editorial staff and not assigned editorial enhancements.**

United States District Court,  
D. Delaware.  
CIF LICENSING, LLC, d/b/a Ge Licensing,  
Plaintiff,  
v.  
AGERE SYSTEMS INC., et al., Defendants.  
**Civil Action No. 07-170-JJF.**

Jan. 23, 2009.

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**MEMORANDUM OPINION**

FARNAN, District Judge.

\*1 Presently before the Court are Plaintiff CIF Licensing's ("Plaintiff") Motion to Compel Production and Responses (D.I.135) and Defendant Agere System's ("Defendant") Motion for Protective Order (D.I.138).

**I. Background**

These motions follow a discovery dispute addressed earlier by the Court in the Memorandum Order of May 9, 2008. (D.I.104) In that Order, the Court found that "neither party has been straightforward throughout the discovery process" and "both parties' efforts to reach agreement regarding their discovery obligations were insufficient."The parties were ordered to meet and confer. Afterward, the parties were to file a joint letter succinctly depicting their remaining disputes, which this Court would resolve or refer to a Special Master.

The resulting letter (D.I.118) outlined many new disputes. Plaintiff complained that Defendants had not produced all versions of the relevant modem source code. On the other hand, Plaintiff also complained that the source code Defendants produced was too vast and complex to provide targeted answers. Finally, Plaintiff also complained that Defendants' 30(b)(6) witnesses, though generally knowledgeable, were unprepared on certain topics.

Plaintiff repeats these contentions and seeks remedy through its present Motion to Compel (D.I.135) and through deposition of third-party Dr. Jinguo Yu, a former employee of Defendant Agere Systems. Defendants' Motion for Protective Order seeks to prevent the deposition as untimely. (D.I.138)

**II. Discussion**

**A. Plaintiff's Motion to Compel Production and Responses (D.I. 13 5)**

Specifically, Plaintiff seeks an Order compelling Defendants to provide: 1) a "properly-prepared and knowledgeable" 30(b)(6) witness to testify about Defendants' source code; or 2) an answer, in detail, to Plaintiff's Fourth Set of Interrogatories and First Set of Requests for Admissions, which are also directed to the source code; or 3) an answer to the Interrogatories and an Order deeming the Admissions admitted.

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Defendants placed the source code and all prior versions in escrow in accordance with the Stipulated Protective Order of May 14, 2008, (D.I.106) so Plaintiff now has access to it. All of Plaintiff's requests, as well as its effort to depose Dr. Yu, embody its effort to find, through discovery, specific sections of Defendants' source code that perform specific functions claimed in the patents at issue. Plaintiff's Interrogatories are illustrative:

Identify the lines of code in each of the files named "main.s" ... used "for selecting one of the plurality of bit rates" as recited in claim 46 of the '054 patent. As the construction of this phrase from the asserted claims is disputed, use Agere's proposed construction to respond to this interrogatory.

D.I. 135, Ex. A at 5 (Interrogatory No. 50). Defendants contend that Plaintiff's requests are untimely, that they improperly shift the burden of proof to the Defendants, and that they require legal conclusions that would be protected attorney work product.

\*2 Plaintiff admits that its present requests are untimely. As this Court previously observed, both parties are responsible for the delay in discovery in this case. Accordingly, this Court excused the untimeliness of Plaintiff's prior discovery requests. (D.I.104)

Now, however, Defendants have produced the complete source code where this information would be contained, if it exists, and Plaintiff is asking Defendants to take the further step of mapping specific lines of code to specific claim terms interpreted in specific ways. Defendants contend that their experts were unable to do this during their depositions because Defendants currently lack the information that Plaintiff seeks. But Defendants admit that this information, if it exists, could be gleaned after spending a significant amount of time analyzing the source code. The question is whether Defendants should be compelled to undertake this analysis or whether Plaintiff should retain experts to do the analysis itself. This is a different question than the

one presented before, where Plaintiff contended that Defendants had entirely failed to produce relevant discovery. (D.I.71)

In this instance, Plaintiff already has access to the information it seeks. The source code is available to Plaintiff's experts under the terms of a Stipulated Protective Order. Plaintiff negotiated, renegotiated, and agreed to this Order. Therefore, Plaintiff cannot now claim that the terms of the Order are unduly burdensome. Defendants' and Plaintiff's experts would undertake essentially the same process to glean the requested information from the source code.

Therefore, the Court will deny Plaintiff's Motion to Compel (D.I.135) on the ground that Plaintiff already has adequate access to the information it seeks, if that information exists. The Court declines to address whether an answer by Defendants would constitute attorney work product because the denial of Plaintiff's motion on other grounds renders that question moot.

#### **B. Defendants' Motion for Protective Order (D.I.138)**

Pursuant to the Court's Rule 16 Scheduling Order, all fact discovery, including depositions, was to be completed by June 1, 2008. (D.I.32) On May 21, Plaintiff issued a subpoena from the Southern District of New York to depose Dr. Jinguo Yu on May 30. Dr. Yu is a former employee of Defendant. Plaintiff's counsel, by an admitted "honest mistake," did not give notice of the deposition to Defendants until May 30, the originally scheduled date of the deposition and the last day of discovery.

The Local Rules of this Court provide: "[u]nless otherwise ordered by the Court, 'reasonable notice' [for a deposition under] Fed.R.Civ.P. 30(b)(1) and 30(b)(6) shall be not less than 7 days."D. Del. LR 30.1. In this case, Plaintiff provided less than two days' notice, which is deficient under the Local Rules, but no prejudice to Defendants resulted be-

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cause the deponent was unavailable.

Defendants oppose Plaintiff's Notice of Deposition as untimely and seeks a Protective Order to prevent the deposition. Plaintiff's counsel admits his own "honest mistake," but contends that the last-minute nature of the deposition is the result of Defendants' "Game-Playing" in producing witnesses.

\*3 After reviewing the parties' submissions, the Court is persuaded that Plaintiff's failure to provide timely notice was an error. The course of discovery so far suggests that both parties bear responsibility for the delay, as noted in the Court's prior Memorandum Order. (D.I.104) In that Order, the Court excused an untimely request in view of the parties' equal culpability and the relevance of the information sought. Accordingly, the Court will permit the deposition and deny Defendants' Motion for Protective Order.

An appropriate Order will be entered.

#### **ORDER**

At Wilmington, this 23rd day of January 2009, for the reasons set forth in the Memorandum Opinion issued on this date,

IT IS HEREBY ORDERED that:

- 1) The Motion to Compel Production and Responses (D.I.135) filed by Plaintiff CIF Licensing, LLC, d/b/a GE Licensing is **DENIED**; and
- 2) The Motion for Protective Order (D.I.138) filed by Defendant Agere Systems Inc. is **DENIED**.

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CIF Licensing, LLC v. Agere Systems Inc.  
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(Cite as: 2006 WL 559573 (S.D.N.Y.))

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**C**  
Only the Westlaw citation is currently available.

United States District Court,  
S.D. New York.  
NEW YORK UNIVERSITY, Plaintiff,  
v.  
E.PIPHANY, INC. and Ssa Global Tech. Inc., De-  
fendants.

**No. 05Civ.1929(LTS)(RLE).**

March 6, 2006.

**OPINION & ORDER**

ELLIS, Magistrate J.

**I. BACKGROUND**

\*1 Plaintiff New York University ("NYU") filed this patent infringement action against defendant E.piphany, Inc., ("E.piphany") on February 8, 2005. The complaint was amended on October 31, 2005, to include defendant SSA Global Technologies, Inc., when that company acquired E.piphany. NYU alleges E.piphany's software infringes one of NYU's patents, U.S. Patent No. 6,236,978 ("the '978 patent"). NYU has filed a motion to compel responses to certain outstanding discovery requests. The discovery dispute which led to the instant motion has been ongoing before the undersigned since November 2005.

In its complaint, NYU challenged forty of E.piphany's products but referred only to one product by name, Interaction Advisor. To date, E.piphany has produced documents only for Interaction Advisor and none of its other products. NYU asks the Court to compel E.piphany to produce all documents responsive to Plaintiff's First Set of Requests for Production of Documents to Defendant E.Piphany, Inc. served August 15, 2005. Plaintiff NYU's Memorandum in Support of its Motions

("NYU Mem.") at 1. Specifically, NYU focuses on the following areas of production which E.piphany has withheld: 1) software architecture documents for Interaction Advisor; 2) the source code and software architecture documents for E.piphany's products: E.piphany Real-Time, E.piphany Sales and Service, E.piphany Customer Relationship Backbone, E.piphany Marketing/E-Marketing, and E.piphany E6 and E6.5 Suite which are related to E.piphany's Interaction Advisor; 3) the source code and software architecture documents for commercial versions of Interaction Advisor other than 6.5; and 4) Preliminary Invalidity Contentions and supporting documents, if any, relating to claims 1, 15, 25-34 and 37 of the '978 patent. *Id.* at 3. Consistent with this Court's previous oral rulings, the motion is GRANTED, in part, and DENIED, in part.

NYU has also asked the Court to adjourn the parties' claim construction schedule. However, E.piphany has filed a motion to limit claim construction before Judge Swain. As Judge Swain will be reviewing the claim construction process in this case, this Court will not rule on that aspect of NYU's motion at this time.

**II. DISCUSSION**

**A. Production of Documents for Products Other than Interaction Advisor**

E.piphany opposes production related to its other products primarily because it believes that NYU has failed to provide sufficiently detailed Preliminary Infringement Contentions ("PICs") under Patent Local Rule 3-1 for those products. Defendants' Memorandum of Law in Opposition to NYU's Motion ("E.piphany Mem.") at 7. Judge Swain issued a scheduling order which provides that, for discovery, the following Patent Local Rules of the United States District Court for the Northern District of California apply: 3-1, 3-2, 3-3, and 3-4. Pre-Trial Scheduling Order, July 1, 2005, at 6. Under these



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 (Cite as: 2006 WL 559573 (S.D.N.Y.))

rules, plaintiffs are to provide PICs to better define the scope of discovery. Patent Local Rule 3-1 states:

\*2 Not later than 10 days after the Initial Case Management Conference, a party claiming patent infringement must serve on all parties a "Disclosure of Asserted Claims and Preliminary Infringement Contentions"... which shall contain the following information: ...

(b) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality ("Accused Instrumentality") of each opposing party of which the party is aware. This identification shall be as specific as possible....

(c) A chart identifying specifically where each element of each asserted claim is found within each Accused Instrumentality, including for each element that such party contends is governed by 35 USC § 112(6), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function.

The rule is "essentially a 'discovery device' intended to streamline the discovery process by 'tak[ing] the place of a series of interrogatories that defendants would likely have propounded.'" *Renesas Tech. Corp. v. Nanya Tech. Corp.*, 2004 WL 2600466, at \*2 (N.D.Cal. Nov. 10, 2004) (quoting *Network Caching Tech., LLC v. Novell, Inc.*, 2002 WL 32126128, at \*3-4 (N.D.Cal. Aug. 13, 2002)). The plaintiff must include all facts known to it that could support its claim of infringement. *Id.* "[T]he standard of [Federal Rule of Civil Procedure ("FRCP") ] 11 pre-filing inquiry establishes a minimum level of detail that Patent LR 3-1 requires." *Network Caching*, 2002 WL 32126128, at \*4. "FRCP 11 requires that a plaintiff compare an accused product to its patents on a claim by claim, element by element basis for at least one of each defendant's products." *Id.* at \*5. In order to provide such detail, parties often demonstrate that they have done what is called "reverse engineering," but that

is not required if the plaintiff has an equivalent way of showing the level of detail the rule requires. *Renesas*, 2004 WL 2600466, at \*2. The "party claiming infringement does not have to reverse engineer every one of a defendant's products. Instead, a plaintiff must only demonstrate 'why it believed before filing the claim that it had a reasonable chance of proving infringement.'" *Id.* (quoting *View Eng'g, Inc. v. Robotic Vision Sys., Inc.*, 208 F.3d 981, 986 (Fed.Cir.2000)). In *Renesas*, the plaintiff did reverse engineer three products, and then provided declarations pointing out why reverse engineering for the others would be burdensome, expensive, and provide no additional information. *Id.* at \*4. The court found the PICs to be adequate. *Id.*

In some situations, a plaintiff must first obtain information from the defendant in order to provide sufficiently detailed PICs. In *Network Caching*, for example, the defendants moved to strike plaintiff's PICs and dismiss the complaint for failure to comply with Patent LR 3-1. 2002 WL 32126128, at \*4. The court ordered the plaintiff to amend its PICs after receiving more discovery from defendants, finding that the only way to be more specific as to their claims was to analyze the source code which was in the defendant's sole possession. *Id.* at \*7. Similarly, in *Renesas*, the court refused to strike plaintiff's PICs and found that "[r]equiring Renesas to prove more ... seems inappropriate, as it alleges it has not yet received the discovery necessary to run the voltage tests properly." 2004 WL 2600466, at \*5.

\*3 Plaintiffs in computer software infringement cases apparently often find themselves in this particular "Catch-22:"

Software cases present unique challenges for the parties and the courts because, prior to discovery, plaintiffs usually only have access to the manifestation of the defendants' allegedly infringing source code and not the code itself. From this manifestation, plaintiffs must somehow divine whether the defendants' code infringes. Although

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defendants vigorously and rightly guard their source code, until plaintiffs have access to it, plaintiffs are typically unable to give highly specified infringement contentions. To the extent defendants are given vague infringement contentions, they are hampered in their ability to prepare their defense.

*Am. Video Graphics, L.P. v. Elec. Arts, Inc.*, 359 F.Supp.2d 558, 560 (E.D.Tex.2005). The court may therefore require a defendant to provide source code so that the plaintiff may be more specific about its claims. *Id.* The plaintiffs, of course, may first be required to demonstrate that they exhausted other ways of exploring potential infringement. See *Connectel, LLC v. Cisco Sys., Inc.*, 391 F.Supp.2d 526, 528 (E.D.Tex.2005) (“The plaintiff in [*Am. Video Graphics*] did not just allege infringement of hundreds of video games, submit those games’ user manuals as evidence, and expect to narrow its claims upon the receipt of source code.”). See also *Network Caching*, 2002 WL 32126128, at \*5.

In a conference before this Court on November 8, 2005, NYU made an application to compel the same discovery requested in the current motion, and E.piphany raised the same concerns about NYU’s PICs. NYU had provided detailed PICs for six of E.piphany’s products, including Interaction Advisor. The undersigned reviewed the PICs for the other thirty-six products and questioned the adequacy of NYU’s PICs for products without ruling on whether they were inadequate as E.piphany had not made any formal application to strike NYU’s claims or compel more detailed PICs. While a plaintiff is not required to reverse engineer all the accused products, the courts have required other evidence of infringement in place of reverse engineering. For all other “accused products,” NYU simply referred to the PIC charts for Interaction Advisor, and then contended that E.piphany had not produced sufficient information for NYU to complete the PIC charts. See Letter from NYU, November 1, 2005, Exh. A. In some cases, plaintiffs request specific *pieces* of source code for a particular

product. In comparison, NYU’s request for all documents and complete source code for all forty products was strikingly broad and it has not made a showing of its alternative efforts to develop infringement contentions for those products for which it has not provided detailed PICs.

At the same time, E.piphany has the responsibility to produce information that NYU can use to substantiate its claims. Where a plaintiff’s PICs are found to be adequate, the court will not stay discovery. *Teknowledge Corp. v. Akamai Tech., Inc.*, 2003 WL 23861926, at \*1 (N.D.Cal. Oct. 21, 2003) (“Plaintiff has sufficiently identified the accused products, indicated where the elements of the asserted claims are found and specified where means-plus-function elements are found.”). The court in *Teknowledge* cited Patent Local Rule 2-5, which was not specifically incorporated into Judge Swain’s order but applies to discovery under the rules and provides that “it shall not be a legitimate ground for objecting to an opposing party’s discovery request ... that the discovery request is premature ... or otherwise conflicts with, these Patent Local Rules.” *Id.* E.piphany has not moved to strike NYU’s PICs or compel further detail, but instead has continued to raise lack of detail as a defense to discovery.

\*4 At the November 8, 2005 conference, the parties discussed this discovery dispute and came to an agreement: E.piphany would produce responsive documents for those six products for which NYU had presented more detailed PICs. These products were presented to the Court as part of a “suite” of documents for which Interaction Advisor was the backbone. See NYU Mem. at 18; E.piphany Mem. at 3. This Court then issued a ruling requiring E.piphany to produce responsive documents for Interaction Advisor and “related products.” Apparently, E.piphany then did produce documents, but only those pertaining specifically to Interaction Advisor. At the time, the parties seemed to agree about which other products were subject to this order, but the agreement proved illusory.

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As noted, NYU has focused its discussion here on the five products for which it provided more detailed PICs and which have been described as related to Interaction Advisor. E.piphany does not respond directly to the contention that this Court already ordered it to produce documents for those five products or that the parties agreed to their production. Instead, E.piphany argues that production on any product other than Interaction Advisor is unnecessary or unwarranted. First, E.piphany asserts that NYU's sole infringement contention pertains to "the functionality provided by [Interaction Advisor]." E.piphany Mem. at 6. E.piphany then argues that all forty products NYU has accused in its complaint may be sold in conjunction with Interaction Advisor and that producing the source code for all forty would be both burdensome and inappropriate given that NYU has not provided detailed infringement contentions for all those products. *Id.* E.piphany does not respond to NYU's contention that the five products it has listed are "related to Interaction Advisor."

E.piphany also argues that the source code for its "unrelated" products is a trade secret and that NYU carries the burden to demonstrate that production of the source code is necessary and relevant to this action. *Id.* at 7. See *Synopsis, Inc. v. Nassda Corp.*, 2002 WL 32749138, at \*1 (N.D.Cal. Sept. 16, 2002) (finding that plaintiff had not demonstrated that the source code beyond the date of the pertinent patent application was both relevant and necessary and denying plaintiff's motion to compel). Again, E.piphany has not distinguished between the five products referred to in the November 8, 2005 conference as "related" to Interaction Advisor, and appears to lump all its other products in this "unrelated" category. Confidential information and trade secrets are covered by the protective order both parties have signed. Furthermore, this Court's previous order reflecting the parties' agreement that E.piphany would produce responsive documents only for those products for which NYU had presented detailed PICs limits the scope of production, undermining the claim of burden by E.piphany.

Consistent with this Court's November 8, 2005 order, NYU's motion to compel production of responsive documents for the following products is GRANTED: E.piphany Real-Time, E.piphany Sales and Service, E.piphany Customer Relationship Backbone, E.piphany Marketing/E-Marketing, and E.piphany E6 and E6.5 Suite which the parties represented as related to Interaction Advisor and for which NYU has presented detailed PICs. However, NYU's motion to compel responsive documents for the other E.piphany products for which NYU has not provided detailed PICs is DENIED.

## B. Outstanding Production for Interaction Advisor

### 1. Software Architecture Documents

\*5 At a conference on January 11, 2006, NYU complained that while E.piphany had produced source code for Interaction Advisor, it had not produced any of the "software architecture documents" which would facilitate analysis of the source code. E.piphany argues that to the extent any software architecture documents exist, those documents have been produced. E.piphany Mem. at 5. NYU argues that E.piphany has produced one document that "approach[es] the software architecture level of detail," which according to their expert Dr. Robert Grossman, indicates there are other such documents which E.piphany has failed to produce. Declaration of Dr. Robert Grossman in Support of NYU's Motion to Compel, ¶ 12. E.piphany contends that, as a small company, it has not had the time or resources to develop such documentation of the design process. E.piphany Mem. at 5. E.piphany submits a declaration from Maksim Kouznetsov, current development manager at SSA Global Technologies and former Manager of Analytics within Interaction Advisor at E.piphany. Declaration of Maksim Kouznetsov in Opposition to NYU's Motion, ¶ 6. He states that he has worked on the design of Interaction Advisor since 1998 and that defendants did not "create the complex documentation system hypothesized by Dr. Grossman." *Id.*

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At the January 11 conference, this Court ordered E.piphany to produce any such documents to the extent they exist. Therefore, with respect to such documents, NYU's motion is GRANTED. Should it later be discovered that other documents exist, but were not produced, E.piphany should note that "where ... the nature of the alleged breach of a discovery obligation is the non-production of evidence, a District Court has broad discretion in fashioning an appropriate sanction, including the discretion to delay the start of a trial ..., to declare a mistrial ..., or to proceed with a trial with an adverse inference instruction ... [which] may be imposed upon a party that has breached a discovery obligation not only through bad faith or gross negligence, but also through ordinary negligence." *Residential Funding Corp. v. DeGeorge Fin. Corp.*, 306 F.3d 99, 113 (2d Cir.2002).

## 2. Versions of Interaction Advisor Other than 6.5

E.piphany has refused to produce source code of versions of Interaction Advisor sold prior to the date it received actual notice of NYU's claim of infringement, December 11, 2003. E.piphany Mem. at 8. E.piphany argues those versions are not relevant because it cannot be held liable for infringement before having actual notice since NYU has alleged indirect infringement which requires proof that defendants "knowingly induced" its customers' infringement. *Id.* See *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 553 (Fed.Cir.1990). NYU contends it has also alleged direct infringement and that knowledge of its patent is imputed to potential infringers on the date the patent was issued. Plaintiff NYU's Reply Memorandum in Further Support of its Motions at 7. See *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1219-20 (Fed.Cir.2002). NYU's Amended Complaint does allege both direct and indirect infringement. Amended Complaint ¶ 13-14. Whether NYU will be able to meet the burden of proof of direct infringement at trial should not be confused with E.piphany's responsibilities to produce materials in discovery. NYU's motion with respect to other ver-

sions of Interaction Advisor is GRANTED. E.piphany must produce source code and other documents for versions of Interaction Advisor dating back to the date NYU's patent was issued: May 22, 2001.

## C. E.piphany's Preliminary Invalidity Contentions

\*6 NYU asks the Court to compel E.piphany to provide Preliminary Invalidity Contentions and supporting documents relating to claims 1, 15, 25-34 and 37 of the '978 patent. At this point, E.piphany has provided such contentions solely for claim 25, which is the only claim E.piphany maintains NYU has properly asserted. E.piphany Mem. at 8. E.piphany points out that NYU's Preliminary Infringement Contentions are only detailed as to claim 25, obviating E.piphany's responsibility to respond with further Preliminary Invalidity Contentions. *Id.* For every other claim, NYU's PICS refer to claim 25 and states that E.piphany has not produced sufficient documents to allow NYU to provide further detail. Declaration of Timur E. Slonim in Support of NYU's Motion to Compel ("Slonim Decl."), Exhs. A-G.

NYU does not explain why claims 1, 15, 25-34, and 37 are targeted here. Nor does NYU explain how E.piphany is expected to respond to its additional claims despite the lack of detail in NYU's PICS. NYU merely points out that E.piphany has treated claims other than claim 25 as properly asserted by stating that claims "4, 5, 23, 34, 38, and 39 of the '978 Patent are also invalid" in E.piphany's Preliminary Invalidity Contentions submitted for claim 25, without stating the reasons for their assertion of invalidity. *Id.*, Exh. 11.

Pursuant to this order, NYU should receive the additional production it has been seeking on the five additional products mentioned above. Should NYU seek to amend its infringement contentions as a result of receiving this information, E.piphany will then be obligated to respond and amend its corresponding invalidity contentions. At this point, there-

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fore, NYU's motion to compel E.piphany's additional Preliminary Invalidation Contentions is DENIED without prejudice.

### III. CONCLUSION

For the foregoing reasons, NYU's motion to compel production of responsive documents for the following products is GRANTED: E.piphany Real-Time, E.piphany Sales and Service, E.piphany Customer Relationship Backbone, E.piphany Marketing/E-Marketing, and E.piphany E6 and E6.5 Suite which the parties represented as related to Interaction Advisor and for which NYU has presented detailed PICs. However, NYU's motion to compel responsive documents for the other E.piphany products for which NYU has not provided detailed PICs is DENIED.

NYU's motion with respect to the production of documents pertaining to versions of Interaction Advisor is GRANTED: E.piphany must produce source code and other documents for versions of Interaction Advisor dating back to the date NYU's patent was issued: May 22, 2001. NYU's motion is also GRANTED with respect to software architecture documents to the extent they exist. However, NYU's motion to compel in regard to E.piphany's Preliminary Invalidation Contentions is DENIED without prejudice.

SO ORDERED

S.D.N.Y., 2006.  
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**H**

Only the Westlaw citation is currently available.

United States District Court,  
E.D. New York.  
RATES TECHNOLOGY INC., Plaintiff,  
v.  
MEDIATRIX TELCOM, INC. and Media5 Corpor-  
ation, Defendants.  
No. CV 05-2755(JS)(AKT).

Sept. 5, 2007.

James B. Hicks, Hicks Park Law, LLP, Los Angeles, CA, David Lazer, Jennifer Marie Rosen, Zachary Murdock, Lazer, Aptheke, Rosella & Yedid, P.C., Melville, NY, for Plaintiff.

Daniel Carl Miller, Ethan Horwitz, King & Spalding LLP, New York, NY, for Defendants.

**ORDER**

A. KATHLEEN TOMLINSON, Magistrate Judge.

**I. PRELIMINARY STATEMENT**

\*1 The subject of this Order has given rise to a series of motions to compel brought by both parties concerning the claim construction of the patents at issue here, namely, the @085 and '769 patents. A detailed factual and procedural history of this case is set forth in the Court's Report and Recommendation of March 16, 2007, familiarity with which is assumed for purposes of these motions. For the following reasons, Plaintiff's motions to compel [DE 94, 118] are hereby DENIED and Defendants' motion [DE 93] is hereby GRANTED, provided that Plaintiff does not fully and adequately respond to Interrogatory No. 3 within the time frame set forth herein.

**II. STANDARD OF REVIEW**

A motion to compel is entrusted to the sound discretion of the district court. *American Sav. Bank, FSB v. UBS Paine Webber, Inc.*, ( *In re Fitch, Inc.*), 330 F.3d 104, 108 (2d Cir.2003); *United States v. Sanders*, 211 F.3d 711, 720 (2d Cir.2000). The Second Circuit has noted that this is because a "trial court enjoys wide discretion in its handling of pre-trial discovery, and its rulings with regard to discovery are reversed only upon a clear showing of an abuse of discretion." *DG Creditor Corp. v. Dabab*, ( *In re DG Acquisition Corp.*), 151 F.3d 75, 79 (2d Cir.1998) (citing *Cruden v. Bank of N.Y.*, 957 F.2d 961, 972 (2d Cir.1992)). A district court is considered to have abused its discretion "if it bases its ruling on a mistaken application of the law or a clearly erroneous finding of fact." *Milanese v. Rust-Oleum Corp.*, 244 F.3d 104, 110 (2d Cir.2001).

**III. DISCUSSION**

Although there are several motions to compel pending before the Court, the gravamen of the parties' arguments and the fundamental issue at stake here are the same and relate to the ongoing issue of specific Interrogatory responses which date to the beginning of this case but are still not resolved.

Defendants' letter motion [DE 93] seeks a "dismissal of this action with prejudice and attorney fees" based upon Plaintiff's failure to provide a response to Interrogatory No. 3 which calls for Plaintiff to identify on an "element-by-element basis" the "component, structure, feature, functionality, method or process of each accused Mediatrice product that allegedly satisfies each element." [DE 93] Defendants argue that the severe sanction of dismissal is warranted because Plaintiff has repeatedly flouted the Orders of this Court by failing to adequately respond to this Interrogatory. In opposition, Plaintiff argues that it cannot produce in-

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formation which it does not have and asserts that it has "no further responsive information at this time." [DE 99] Plaintiff also adds that "the main reason RTI doesn't have further information is that Mediatrix won't meaningfully respond to RTI's own discovery (as detailed by RTI's pending motion to compel Mediatrix to answer interrogatories and produce documents)." *Id.* The motion to compel referred to by Plaintiff, docketed as entry 94, seeks Defendants' response to its Interrogatory Nos. 2 and 4 which, curiously, also seeks "an element-by-element analysis of RTI's infringement claims." [DE 94] Specifically, Plaintiff argues that:

\*2 Mediatrix should be ordered, separately for each claim limitation of the Patents-in-suit that it identified in its original responses to RTI's Interrogatories Nos. 2 and 4, to state the basis for its contention that each of its accused products and services, and/or the telephone system to which they are connected, fails to meet such claim limitations, including by identifying on an element-by-element basis why they allegedly fail to meet such elements of those claim limitations.

*Id.* Plaintiff maintains that it is entitled to obtain this information through discovery in order to develop its infringement claims and supplement its pre-filing investigation. *Id.* In opposition to Plaintiff's motion to compel, Defendants argue that Plaintiff is seeking to have it "disprove infringement" which is not the appropriate standard here. Additionally, Defendants assert that it is impossible to answer "why" various claim elements are not present in the accused Mediatrix products and services because, as Defendants' answers states, Defendants' products physically lack the elements. [DE 100]

Plaintiff's letter motion to compel, docketed as entry 118, renews its prior motion to compel responses to Interrogatories Nos. 2 and 4 and seeks a response to Interrogatory No. 25 which requests the same information sought in Interrogatories Nos. 2 and 4.<sup>FN1</sup> Additionally, in this letter motion to compel, Plaintiff seeks a further response to Inter-

rogatory No. 25 which calls for a description of the factual basis of a statement made by defense counsel that Cablevision cut Gerald Weinberger's cable service due to so-called "erratic behavior." [DE 118] This information was brought to the Court's attention tangentially in earlier motion practice which the Court found "not germane" as noted in the Court's August 24 Order. [DE 70] I find that this information is still not relevant to any of the claims and defenses in this action. Accordingly, Defendants are not required to furnish a response to Interrogatory No. 25.

FN1. Plaintiff's Interrogatory No. 25 provides: "Separately for each claim limitation of the Patents-in-suit that identified in original responses to Interrogatories Nos. 2 and 4, to state the basis for contention that each accused products and services, and/or telephone system to which they are connected, fails to meet such claim limitations, including by identifying on an element-by-element basis why they allegedly fail to meet such elements of those claim limitations."

Both parties seek to have the other provide an element-by-element claim construction analysis. Defendants seek to have Plaintiff show where the elements of the claims are found in the Mediatrix products at issue. Plaintiff seeks to have Defendants provide information (1) why their products do not infringe RTI's patents; and (2) specifically, why each of Defendants' claims fails to meet such claim limitations, including, on an element-by element basis, why they fail to meet such elements of those claim limitations. This issue is not new and has been revisited by the Court on several occasions. On November 4, 2005, Magistrate Judge Orenstein directed Plaintiff to provide detailed answers to these interrogatories by December 19, 2005. [DE 14] On January 19, 2006, Magistrate Judge Orenstein found Plaintiff's responses to be inadequate and ordered Plaintiff to properly respond by February 15, 2006. [DE 19] On July 20, 2006, the parties



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appeared before me for a status conference at which time I also found that Plaintiff had not adequately responded to Defendants' Interrogatory Nos. 2 and 3 and granted Defendants' motion to compel as to these interrogatories. [DE 60] Further, I gave Plaintiff until August 28, 2006 to supplement its responses and emphasized that, based on the prior history of this issue, this is "Plaintiff's *final* opportunity to comply with this Court's orders and the rules of discovery. Should Plaintiff fail to do so, the Court will fashion an appropriate remedy." *Id.* (emphasis in original). Evidently, Plaintiff's counsel did not heed the Court's directives and this latest motion practice ensued.

\*3 It is well settled that a *prima facie* case of literal infringement (which Plaintiff asserts is the basis of his infringement claim, as well as a claim of contributory infringement) requires the accused matter to fall clearly within the patent claim, and this means that "every limitation of a claim [must] be met to establish literal infringement." *Honeywell Int'l, Inc. v. United States*, 70 Fed. Cl. 424, 446 (Fed.Cl.2006) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.3d 1384, 1389 (Fed.Cir.1992)); see also *Angelo Mongiello's Children, LLC, v. Pizza Hut, Inc.*, 70 F.Supp.2d 196, 206 (E.D.N.Y.1999). As stated in *Honeywell*, "federal trial courts are to compare each of the 'properly construed' claims to the alleged infringing device." *Honeywell*, 70 Fed. Cl., at 446. "To prove literal infringement, the patentee must show by a preponderance of the evidence that the device accused of infringement contains every limitation in the asserted claims." *Windbrella Prods. v. Taylor Made Golf Co.*, 414 F.Supp.2d 305, 311 (S.D.N.Y.2006). Therefore, as stated in my July 20, 2006 Order, Defendants' counsel, in order to properly defend this case, has a right to know, on an element-by-element basis, every limitation of a claim that Plaintiff expects to proffer to establish literal infringement of the respective patents at issue here. Plaintiff is not relieved of this burden simply because it has requested the same information in a different way and filed motions to compel for the same relief.

Plaintiff is charged with the prosecution of this action and it is its sole responsibility to demonstrate infringement. See *Under Sea Indus., Inc. v. Dacor Corp.*, 833 F.2d 1551, 1557 (Fed.Cir.1987) (holding that "the burden is always on the patentee to show infringement"). A plaintiff in a patent infringement action is relieved of this burden only in certain limited circumstances as noted by the court in *New York University v. E.piphany, Inc.*, No. 05-CV-1929, 2006 WL 559573, at \*3 (S.D.N.Y. Mar. 6, 2006). There, the court noted that parties in computer software infringement cases often find themselves in the following "Catch-22:"

Software cases present unique challenges for the parties and the courts because, prior to discovery, plaintiffs usually only have access to the manifestation of the defendants' allegedly infringing source code and not the code itself. From this manifestation, plaintiffs must somehow divine whether the defendants' code infringes. Although defendants vigorously and rightly guard their source code, until plaintiffs have access to it, plaintiffs are typically unable to give highly specified infringement contentions. To the extent defendants are given vague infringement contentions, they are hampered in their ability to prepare their defense.

*Id.* at \*3 (quoting *Am. Video Graphics, L.P. v. Elec. Arts, Inc.*, 359 F.Supp.2d 558, 560 (E.D.Tex.2005)). The court noted that under these limited circumstances, a defendant may be required to provide source code for the software so that the plaintiff can be more specific about its claims. *Id.* at \*3. But, as the court emphasized in *E.piphany, Inc.*, the plaintiffs may first be required to demonstrate that they exhausted all other ways of exploring potential infringement. *Id.* at \*3 (citing *Connectel, LLC v. Cisco Sys., Inc.*, 391 F.Supp.2d 526, 528 (E.D.Tex.2005)).

\*4 Although the allegations in the First Amended Complaint here make reference to certain "Unit Manager Network" and "IP Communications Server" software, this case is not entirely a computer

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software infringement action nor have the parties ever asserted that access to Defendants' software source code is the root of the problem here. Indeed, the software issue here is tangential as shown by a copy of a March 15, 2005 opinion letter by consulting engineer Shlomo Shur which was submitted by Plaintiff in opposition to Defendants' Rule 11 motion. The letter states "I carefully reviewed and tested one of the Mediatrix ATA product series and I also reviewed the website literature of the other products and services ..." See Declaration of James B. Hicks, Esq. ¶ 5, Ex. D. In his letter, Shur offers the following,

it is my opinion that contributory and induced infringement are clearly present with the functionality of the Product. Direct infringement is also present, in so far as the Doctrine of Equivalents part of direct infringement; I cannot tell about literal infringement (the other part of direct infringement) until we can get discovery and I can see the schematics, firmware, software and electronics drawings of the product, so I will not at this time express my opinion about the literal infringement part of direct infringement.

*Id.*

Therefore, based on this letter and the discovery produced by Defendants thus far, which from the Court's perspective is substantial, Plaintiff should be able to make an element-by-element claim construction analysis at this point. It is routine practice in patent infringement actions to require a plaintiff to provide defendant with its claim construction. See, e.g., *Whitserve LLC v. Computer Patent Annuities*, No. 04-CV-1897, 2006 WL 1273740, at \*3 (D.Conn. May 9, 2006); *Tritek Tech., Inc. v. United States*, 63 Fed. Cl. 740, 742 (Fed.Cl.2005); *Refac Int'l, Ltd. v. Hitachi, Ltd.*, 921 F.2d 1247, 1255 (Fed.Cir.1990). This case is no different.

Rule 37 provides in pertinent part as follows:

If a party ... fails to obey an order to provide or permit discovery, ... the court in which the action is

pending may make such orders in regard to the failure as are just, and among others the following:

....

(C) An order ... dismissing the action or proceeding ...

Fed.R.Civ.P. 37(b)(2)(C). This Rule 37 sanction lies within the broad discretion of the district court. See, e.g., *Corp. of Lloyd's v. Lloyd's U.S.*, 831 F.2d 33, 36 (2d Cir.1987). "[D]ismissal with prejudice is a harsh remedy to be used only in extreme situations, and then only when a court finds willfulness, bad faith, or any fault on the part of the [sanctioned party]." *Bobal v. Rensselaer Polytechnic Inst.*, 916 F.2d 759, 764 (2d Cir.1990). As the Supreme Court has noted, however, "the most severe in the spectrum of sanctions provided by statute or rule must be available to the district court in appropriate cases, not merely to penalize those whose conduct may be deemed to warrant such a sanction, but to deter those who might be tempted to such conduct in the absence of such a deterrent." *National Hockey League v. Metro. Hockey Club, Inc.*, 427 U.S. 639, 643, 96 S.Ct. 2778, 49 L.Ed.2d 747 (1976); see also *Update Art, Inc. v. Modiin Pub., Ltd.*, 843 F.2d 67, 73 (2d Cir.1988) (affirming magistrate judge's decision to award summary judgment against party who failed to comply with discovery orders: "[W]e wish to emphasize the importance we place on a party's compliance with discovery orders. Such compliance is necessary to the integrity of our judicial process. A party who flouts such orders does so at his peril. If one suggests that our decision today is strong medicine, that is precisely what it is intended to be.").

\*5 Although Plaintiff repeats caselaw for the proposition that it is entitled to take discovery to support its claims, this action is well past the pleading stage and Plaintiff's ongoing history of noncompliance here borders on a finding that such action is willful. See, e.g., *Refac Int'l, Ltd.*, 921 F.2d at 1255 (holding that the extent of plaintiff's noncompliance

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supports a willfulness finding and plaintiff's "inability to spell out a proper basis for charging infringement more than a year after bringing suit highlights its willfulness."). I find the best way to determine which claims are in dispute here is to have the party asserting infringement provide their interpretations to the alleged infringer so that the Defendant can determine which terms they agree on and which they do not. This is basic claim construction which Plaintiff should be able to provide at this juncture.

Consequently, in light of the above information and the prior orders of this Court, I am giving Plaintiff one final opportunity to respond to Defendants' Interrogatory No. 3. Plaintiff is directed to do so no later than September 27, 2007. This final opportunity is being given so as not to prejudice the Plaintiff's rights in this action. I am cautioning Plaintiff however, that this is indeed its last opportunity to comply with the directives of this Court and Plaintiff proceeds at its own peril. If a full and complete response is not provided to Defendants with respect to Interrogatory No. 3, I shall recommend to District Judge Seybert that this matter be dismissed pursuant to Fed.R.Civ.P. 37(b)(2)(C).

Finally, in its letter motion, docket entry 94, Plaintiff argues that:

Mediatrix should also be ordered to produce all of its product, technical and application manuals; part lists; electronics schematics, bills of material; systems and network diagrams' and software and firmware, in its accused gateways, edge routers, ATA devices, voice modems, IP and legacy PBX's, IP telephones, and core routers which comprise an IP system or network handling VoIP-type calls; and to organize and label its documents to correspond to RTI's requested categories.

In opposition, defense counsel argues that it has provided this information electronically and notes that Plaintiff's counsel advised him "that it could not open some of the electronic files that Mediatrix

produced." [DE 100] Defendants' counsel notes that "he does not understand how Rates could claim that it does not have sufficient information to analyze Mediatrix's products without being able to open the files that Mediatrix produced." *Id.*

It appears that the parties have not engaged in the good faith "meet and confer" required under Local Civil Rule 37.3. Since this information is important to the claim construction issue, I am directing the parties to meet and confer to resolve this issue no later than September 14, 2007. If necessary, I am directing the parties are to meet and open the electronic files together so that the information contained therein may be accessed. If the parties have any issues they are directed to notify me immediately.

**IV. CONCLUSION**

\*6 Accordingly, Plaintiff's motions to compel [DE 94, 118] are hereby DENIED and Defendants' letter motion [DE 93] is hereby GRANTED provided that Plaintiff does not fully and adequately respond to Interrogatory No. 3 by September 27, 2007.

**SO ORDERED.**

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