

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA**

BORTEX INDUSTRY COMPANY LIMITED,	:	
	:	CIVIL ACTION
Plaintiff,	:	
	:	
v.	:	NO. 12-4228
	:	
FIBER OPTIC DESIGNS, INC.,	:	
Defendant.	:	

ORDER

AND NOW, this 3rd day of June, 2013, upon consideration of the attached correspondence from defense counsel indicating that Plaintiff has not appropriately responded to certain discovery requests, we find as follows:

1. This case involves a patent dispute between Bortex Industry Company Limited (“Bortex”) and Fiber Optic Designs, Inc. (“FOD”), wherein Bortex seeks a declaratory judgment that certain FOD patents are invalid, unenforceable and have not been infringed upon. FOD has responded by asserting a counterclaim against Bortex for patent infringement. To that end, FOD filed its first motion for preliminary injunction on October 12, 2012. (Doc. No. 22.) On May 24, 2013, after an expedited discovery schedule, FOD filed a substitute motion for preliminary injunction. (Doc. No. 58.) A Markman hearing and a hearing on FOD’s motion for preliminary injunction are scheduled to begin June 12, 2013.
2. The current discovery dispute between the parties involves document requests and requests for admission propounded by FOD. This discovery pertains to New England Pottery, LLC (“NEP”), Bortex’s former customer. FOD alleges that Bortex funded NEP’s reexamination request of FOD’s ‘022 patent in the U.S. Patent and Trademark

Office, and therefore, was a real party in interest in those proceedings. According to FOD, Bortex has failed to adequately respond to this discovery. (See Attached Correspondence, pp. 6-7.)

3. “The petitioner in an inter partes review of a claim in a patent under [Chapter 31] that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 . . . that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.” 35 U.S.C. § 315(e)(2); see also ACCO Brands, Inc. v. PC Guardian Anti-Theft Prods., Inc., 529 F. Supp. 2d 1208, 1216 (N.D. Cal. 2008).¹
4. Bortex claims that the ACCO case and others cited by FOD are inapplicable because those cases pertain to applying re-exam estoppel against the actual party that participated in the reexamination of a patent. Bortex urges that FOD is not contending that Bortex participated in or controlled the reexamination of the ‘022 patent, but rather only indemnified NEP for its costs. This argument misses the point, however, because FOD is seeking discovery to discern the extent of Bortex’s financial involvement in the reexamination, which if extensive could implicate estoppel principles.
5. We are also satisfied that FOD has made a sufficient showing that the discovery requested is propounded in good faith. In its correspondence, FOD points to Bortex’s complaint, wherein Bortex indicates that NEP sought indemnification for the lawsuit between FOD and NEP. (Compl. ¶ 60.) Additionally, FOD attached the declaration of James Wenz to its original motion for preliminary injunction. (Doc. No. 23-3.) Mr.

¹ Although the court in ACCO refers to 35 U.S.C. § 315(c) when discussing estoppel, an amendment enacted on September 16, 2012 moved the estoppel provision to § 315(e).

Wenz is the General Manager of GKI/Bethlehem Lights, which was previously acquired by NEP, and his declaration states that “Bortex reimbursed NEP for fees and costs incurred in the Colorado suit and reexamination proceedings.” (Id. at ¶ 5.)

6. “It is well recognized that the federal rules allow broad and liberal discovery.” Pacitti v. Macy’s, 193 F.3d 766, 777 (3d Cir. 1999); see also FED. R. CIV. P. 26(b)(1) (“Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense”).

WHEREFORE, it is hereby **ORDERED** that, on or before **June 10, 2013**, Bortex shall provide FOD with any and all documents in its possession, custody or control relating to NEP’s reexamination of the ‘022 patent, as well as any documents that reference or discuss indemnification or payment made to NEP related to the reexamination. Further, to the extent Bortex has not responded to Requests for Admission Nos. 6-9 and No. 8 (second occurrence) propounded by FOD,² Bortex must respond on or before **June 10, 2013**.³

BY THE COURT:

/s/ **Mitchell S. Goldberg**

Mitchell S. Goldberg, J.

² As explained in FOD’s correspondence to the Court, due to a typographical error, the numbers 8 and 9 appear twice in FOD’s requests for admission.

³ After the drafting of this Order, the Court received notice from Bortex’s counsel via e-mail dated May 31, 2013, stating that “Bortex did not control or participate in the re-exam instituted by NEP and was not copied on any documents relating to the re-exam.” Counsel also confirmed that “Bortex did not pay NEP’s costs related to the re-exam.” Counsel for FOD should notify the Court should he believe that Bortex has still not complied with discovery requests on this issue.