

UNITED STATES DISTRICT COURT  
MIDDLE DISTRICT OF FLORIDA  
FORT MYERS DIVISION

WHEREVERTV, INC.,

Plaintiff,

v.

Case No. 2:18-cv-529-JLB-NPM

COMCAST CABLE  
COMMUNICATIONS, LLC,

Defendant.

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**ORDER**

This is a patent infringement case in which Plaintiff WhereverTV, Inc. alleges that Comcast Cable Communications, LLC's Xfinity X1 Platform infringes on a patent owned by WhereverTV, U.S. Patent No. 8,656,431 B2, titled Global Interactive Program Guide Application and Device (the '431 Patent) (Docs. 30, 30-1). Comcast responds with several affirmative defenses, including invalidity due to prior art. (Doc. 64, p. 9).

On June 12, 2020, the court held a *Markman* hearing during which the parties agreed it would be productive for the court to defer a written ruling on claim construction pending continued settlement discussions. (Docs. 163, 167). Therefore, the court administratively closed the case and provided that, if the parties did not settle, the court would reestablish discovery and other deadlines and take up

consideration of the then-pending discovery motions. (Doc. 164). With notification from the parties that they were unable to resolve the matter (Doc. 169), the court issued its claim construction ruling and reopened the case. (Doc. 172).

Prior to the *Markman* hearing and before the close of discovery, Comcast filed a consolidated motion to extend fact discovery and compel responses to interrogatories 9 and 13 (Doc. 137). And between the close of discovery and the *Markman* hearing, Plaintiff filed a motion to quash and for protection from a nonparty subpoena served on Edward Drake (Doc. 148).<sup>1</sup> To ascertain whether the claim construction ruling narrowed the issues presented in these motions, the court discussed them with the parties during a status conference on December 4, 2020. (Doc. 175). While the parties advised that the motion for more time to conduct fact discovery and the motion for a protective order remained fully unresolved, Comcast advised that it would withdraw the motion to compel if the court allowed more time for fact witness depositions. For the following reasons, the court grants more time to conduct fact witness depositions and denies Plaintiff's motion for protection from Comcast's desire to depose Drake (an inventor of a purported form of prior art). Accordingly, the motion to compel is denied as moot.

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<sup>1</sup> The parties have extensively briefed these motions. (Docs. 141, 142, 143, 144, 147, 154, 159).

**I. With Good Cause to Extend Time for Fact Witness Depositions and the Need to Reestablish Other Deadlines, There Is No Need for Protection from the Deposition Subpoena Served on Edward Drake**

Comcast argues that, prior to the close of discovery, depositions of several WhereverTV employees were tentatively and jointly postponed due to the COVID-19 pandemic; and it seeks to extend the fact discovery period for about fifteen weeks to complete them. (Doc 169, p. 2; Doc. 137-4, pp. 4-5). Comcast also seeks to obtain information about a “Myrio system” by deposing its inventor, Edward Drake. (Doc. 159, pp. 5-6). Comcast asserts that Myrio predated the patent at issue and could potentially invalidate it as prior art. (Doc. 159, pp. 14-15).

WhereverTV claims Comcast is trying to “redo its entire legal defense by adding new fact witnesses, serving new document and depositions subpoenas, and to add new prior art.” (Doc. 141, p. 14). WhereverTV argues Comcast does not provide good cause to allow more time for discovery and so Comcast’s subpoena for Drake to appear for deposition is untimely. (Doc. 141 pp. 12-17; Doc. 148, pp. 8-11, 14-15, 17-19, 22-24). And WhereverTV also seeks to prohibit a deposition of Drake based on the assertion that Myrio should have been more fully disclosed in Comcast’s *initial* disclosures and its *initial* invalidity contentions (Doc. 141, p. 13; Doc. 148, pp. 8-11, 14, 17-19).

*Comcast's Motion for Extension of Time (Doc. 137)*

Under Rule 16(b), the court may extend a deadline only upon a showing of “good cause and with the judge’s consent.” Fed. R. Civ. P. 16(b)(4). Under this standard, the party requesting the extension demonstrates good cause only if, despite its diligence, the party cannot meet the deadline. *See* Fed. R. Civ. P. 16, 1983 Advisory Committee Notes; *S. Grouts & Mortars, Inc. v. 3M Co.*, 575 F.3d 1235, 1241 (11th Cir. 2009) (citing *Sosa v. Airprint Sys., Inc.*, 133 F.3d 1417, 1418 (11th Cir. 1998)). For the following reasons, the court finds good cause to extend the fact discovery deadline.

First, both parties initially agreed to a brief extension beyond the April 14, 2020 discovery deadline to conduct depositions due to the Covid-19 pandemic. (Doc. 147, pp. 8-10; Doc. 137, p. 20; Doc. 137-1). However, on April 13, 2020—one day before the discovery deadline—WhereverTV objected to Comcast’s proposed motion for extension of time. (Doc. 147, p. 9; Doc. 137-4). Thus, while Comcast’s discovery motion (Doc. 137) was filed on the discovery deadline,<sup>2</sup> it was not due to any lack of diligence to actively conduct discovery or resolve the discovery dispute without court involvement. And in a similar vein, on April 3, 2020, the Court continued the *Markman* hearing due to Covid-19. (Docs. 132, 134, 135).

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<sup>2</sup> Because the motion was filed before the expiration of the deadline, WhereverTV’s argument that Comcast must show “excusable neglect” has no merit.

Second, it was evident prior to the close of discovery that more time was needed. (Doc. 141, p. 16). Both parties were actively conducting discovery, including scheduling depositions, just weeks before the discovery deadline. (Doc. 147, p. 8). And on the previously scheduled day for the close of fact discovery, both parties exchanged thousands of pages of documents. (Doc. 141, p. 16). In fact, after the previously scheduled close of fact discovery, the parties continued to search for and produce documents responsive to written discovery requests. (Doc. 147, p. 10; Doc. 141, pp. 16-17; Doc. 147-11).

Finally, the case was administratively closed to allow for settlement discussions after the *Markman* hearing. (Doc. 164). A written ruling was to be entered and discovery deadlines reestablished if the parties did not settle. (*Id.*, p. 1 n. 1; *see* Doc. 172, p. 9). They did not settle, and the case was reopened on November 13, 2020. (Docs. 168, 172).<sup>3</sup> So, providing a brief amount of time to complete discovery poses no prejudice to trial preparation because a new trial date and pre-trial deadlines will be set by separate order.

Cases should be decided on their merits and not unduly truncated discovery. *See* Fed. R. Civ. P. 36(b) (“the court may permit withdrawal or amendment [of a

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<sup>3</sup> While the parties’ expert reports were initially scheduled to be due 30 days and 60 days after the claim construction ruling, the court advised the parties during the December 4, 2020 status conference that the scheduling order was effectively vacated by the administrative closure of the case on June 15, 2020, and that the parties were relieved from those and any other deadlines until the court issues an amended case management and scheduling order. (See Doc. 137, p. 24; Doc. 147, p. 5).

response to a request for admission] if it would promote the presentation of the merits of the action and if the court is not persuaded that it would prejudice the requesting party in maintaining or defending the action on the merits.”); *Granite State Ins. Co. v. Am. Bldg. Materials, Inc.*, No. 8:10-cv-1542-T-24 EA, 2011 WL 2446633, \*2 (M.D. Fla. June 15, 2011) (While delaying resolution of a dispositive motion to allow for additional discovery may result in further expense for the defendant, “the Court prefers to decide this case on the merits.”); *United States v. Everglades Univ., Inc.*, No. 12-60185-CIV, 2014 WL 11531791, \*4 (S.D. Fla. June 4, 2014) (“The goal of Federal Rule of Civil Procedure 16 is to get cases decided on the merits of issues that are truly meritorious and in dispute.”). And no prejudice to WhereverTV will arise by extending the deadline for limited fact discovery.

In short, given the parties’ apparent need for more time to complete discovery, the effect of Covid-19 on the course of discovery, and the administrative closure of this case for the discovery schedule to be revisited after the *Markman* ruling, the Court finds good cause to extend the time to complete fact discovery.

***WhereverTV’s Motion to Quash Nonparty Subpoena and for Entry of Protective Order (Doc. 148)***

In light of the extension of time to complete fact discovery and the forthcoming entry of an amended case management schedule, most if not all of WhereverTV’s arguments in support of its request for protection from the deposition of Edward Drake are moot, such as its claims of unfair surprise and untimeliness.

Rule 45 governs subpoenas issued to nonparties. Fed. R. Civ. P. 45. The scope of discovery under Rule 45 is the same as set forth in Rule 26(b)(1). *See Woods v. On Baldwin Pond, LLC*, No. 6:13-cv-726-Orl-19DAB, 2014 WL 12625078, \*1 (M.D. Fla. Apr. 2, 2014). Generally, discovery must be relevant to any party's claim or defense and proportional to the needs of the case. Fed. R. Civ. P. 26(b)(1). The starting point to ascertain relevancy is with the complaint, or in this case, the Amended Complaint (Doc. 30) and the defenses (Doc. 64). *Id.*, 2000 Advisory Committee Notes (“The Committee intends that the parties and the court focus on the actual claims and defenses involved in the action.”). The parties have “no entitlement to discovery to develop new claims or defenses that are not already identified in the pleadings.” *Id.* And acknowledging as much, Comcast concedes that its “noninfringement and invalidity defenses are set.” (Doc. 147, pp. 6-7).

Pursuant to Rule 26(c)(1), any “party or any person from whom discovery is sought may move for a protective order,” and the Court “may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense.” Fed. R. Civ. P. 26(c)(1). “The party seeking a protective order has the burden to demonstrate good cause, and must make ‘a particular and specific demonstration of fact as distinguished from stereotyped and conclusory statements’ supporting the need for a protective order.” *Auto-Owners Ins. Co. v.*

*Southeast Floating Docks, Inc.*, 231 F.R.D. 426, 429-30 (M.D. Fla. 2005) (citing *United States v. Garrett*, 571 F.2d 1323, 1326 n.3 (5th Cir. 1978)).

Additionally, “in a discovery dispute involving a nonparty, the nonparty’s status is considered by the court in assessing the burden of complying with the discovery request.” *In re Photochromic Lens Antitrust Litig.*, No. 8:10-md-2173-T-27EAJ, 2012 WL 12904391, \*2 (M.D. Fla. Dec. 20, 2012) (citation omitted). Rule 45 requires a party issuing and serving a subpoena to “take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena.” Fed. R. Civ. P. 45(d)(1).

As “potentially invalidating prior art” (Doc. 159, pp. 14-15), discovery concerning Myrio is relevant in this patent infringement dispute. *See MiMedx Grp., Inc. v. Nutech Med., Inc.*, 310 F. Supp. 3d 1368, 1369 (N.D. Ala. 2018); *McKesson Info. Sols. LLC v. Epic Sys. Corp.*, 242 F.R.D. 689, 691-92 (N.D. Ga. 2007). WhereverTV’s argument that Myrio “is not part of this case” because Comcast purportedly failed to properly disclose Myrio holds no merit. (Doc. 148, p. 20; Doc. 154, p. 4). Indeed, WhereverTV’s own conduct belies its related contention that, because Drake was not previously identified in Comcast’s initial disclosures, Comcast should not be allowed to depose him, as it appears WhereverTV served deposition notices on March 13, 2020 for witnesses never previously disclosed by either party. (Doc. 147, p. 8; Docs. 147-9, 147-10).



Besides, Rule 26(e)(1)(A) provides that a party must supplement or correct its disclosure “in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and *if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.*” Fed. R. Civ. P. 26(e)(1)(A) (emphasis added).

Here, the additional or corrective information was made known to WhereverTV through several channels. Comcast disclosed Myrio in its initial invalidity contentions served in May 2019, stating that it anticipated taking further discovery on Myrio and other prior art systems and devices while reserving the right to supplement or amend its contentions pursuant to the Case Management and Scheduling Order (Doc. 58). (Doc. 159-1; *see also* Doc. 147, p. 7; Doc. 159, p. 4).

Comcast further indicated its interest in Myrio, and by extension Edward Drake, by serving subpoenas concerning Myrio on eleven nonparty entities in January 2020, to which WhereverTV voiced no objection. (Docs. 147-3, 159-2; Doc. 147, p. 7; Doc. 159, p. 4). Comcast served these document and deposition subpoenas on former customers of Myrio who appeared to have previously deployed the system. (Docs. 147-3, 159-2; Doc. 147, p. 7; Doc. 159, p. 5). From January through March of 2020, Comcast forwarded to WhereverTV the Myrio-related documents produced in response to these subpoenas. (Doc. 159, p. 4; Doc. 147, p. 7; Doc. 147-5, pp. 1-2). During this period, WhereverTV did not complain to Comcast about the

sufficiency of Comcast's contentions or disclosures regarding the Myrio system. (Doc. 159, p. 4). While Comcast ultimately decided not to depose any representatives of these eleven entities, Comcast continued to believe that the Myrio system could be invalidating prior art in light of WhereverTV's changing discovery responses and redefinition of the claims intended to cover Comcast's Xfinity X1 system. (Doc. 159, p. 10).

In the middle of March 2020, Comcast made one last attempt to find individuals with information about Myrio. (Doc. 159, p. 6). On March 17, 2020, counsel for Comcast spoke with a past chief executive of Myrio. (Doc. 159, p. 6; Doc. 159-4). That chief executive identified Drake as someone who may remember the system as implemented in the 2005 time period. (Doc. 159, p. 6; Docs. 159-4; 147-6). Comcast contacted Drake, who provided two videos relating to a 2005 implementation of Myrio. (Doc. 159, p. 6; Docs. 147-7, 147-8, 159-5, 159-6). Comcast immediately served its subpoena on Drake before the fact discovery deadline (Doc. 148-3) and amended its initial disclosures (Doc. 148-2) to include Drake and Myrio. (Doc. 147, p. 7).<sup>4</sup>

In sum, WhereverTV was on notice well before the previously scheduled close of fact discovery that Comcast was pursuing a potential prior art defense by

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<sup>4</sup> Comcast's amended initial disclosures also identified Comcast employees Nancy Capocasale and Brendan Benzing.

exploring facts related to the Myrio system and associated entities and individuals. Contrary to WhereverTV's arguments, Myrio was part of this case from the start.

The parties may depose Drake and the fact witnesses who they anticipated deposing last year. Such discovery will be confined to the claims and defenses asserted in the pleadings. The parties may not conduct discovery to investigate new theories or claims. The new deadlines, entered by separate order, will mirror the parties' former tentative agreement for a three-month extension for fact depositions. (*See* Doc. 159, p. 7).

As for WhereverTV's complaints about Drake, Capocasale,<sup>5</sup> and Benzing<sup>6</sup> being added to Comcast's initial disclosures after the parties' written discovery was complete, upon a showing that with due diligence WhereverTV could not have served timely written discovery requests concerning them during the original discovery period, WhereverTV may seek leave to serve such discovery. Otherwise, there will be no further written discovery, as the parties initially intended. (Doc. 147, p. 9 (draft joint motion from March 31, 2020 stated, "the parties agree that neither

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<sup>5</sup> Comcast added Comcast employee Nancy Capocasale to its amended Rule 26 disclosures because she "may have relevant information depending on the contours of WhereverTV's infringement and damages claim." (Doc. 159, p. 8).

<sup>6</sup> Comcast added Comcast employee Brendan Benzing to its amended Rule 26 disclosures "because he was designated to testify as to certain topics in WhereverTV's Rule 30(b)(6) deposition notice that WhereverTV had yet to cover in deposition." (Doc. 159, p. 7).

party will serve additional written discovery under Rules 33, 34, or 36 of the Federal Rules of Civil Procedure without a showing of good cause.”)).

## II. Conclusion

The court **GRANTS in part** Defendant’s Motion to Extend Fact Discovery (Doc. 137). As described above, the parties will have until April 30, 2021, to complete fact discovery. Plaintiff’s Motion to Quash Comcast’s Untimely Nonparty Subpoena and for Entry of a Protective Order (Doc. 148) is **DENIED**. Defendant’s Motion to Compel (Doc. 137) is **DENIED as moot**. The Court will separately issue an amended case management and scheduling order.<sup>7</sup>

If WhereverTV can show good cause (and court intervention appears necessary after conferring with opposing counsel), WhereverTV may seek leave to serve document requests regarding Edward Drake, Nancy Capocasale, or Brendan Benzing by filing a motion within two weeks of the date of this Order. If WhereverTV files such a motion, Comcast’s response will be due one week later.

**DONE and ORDERED** in Fort Myers, Florida on February 1, 2021.

  
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NICHOLAS P. MIZELL  
UNITED STATES MAGISTRATE JUDGE

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<sup>7</sup> The court has initially reviewed today’s filing of WhereverTV’s “Time Sensitive” motion (Doc. 179) to enforce the court’s May 20, 2019 discovery order and finds that, in light of the amended case management schedule, it is not time sensitive within the meaning of Local Rule 3.01(e).