

**UNITED STATES DISTRICT COURT
DISTRICT OF DELAWARE**

JOHNSON CONTROLS TECHNOLOGY
COMPANY,

Plaintiff and Counterclaim
Defendant,

v.

WILLOW TECHNOLOGIES, LLC and
WILLOW TECHNOLOGY OPERATIONS
PTY LIMITED,

Defendants and
Counterclaim Plaintiffs.

C.A. No. 21-1796 (JDW)

**PLAINTIFF’S SUPPLEMENTAL RESPONSES AND OBJECTIONS TO
WILLOW TECHNOLOGY USA, INC.’S FIRST SET OF INTERROGATORIES**

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure, Plaintiff Johnson Controls Technology Company (“Johnson Controls”), by its undersigned counsel, hereby submits Supplemental Responses and Objections to the First Set of Interrogatories issued by Defendant Willow Technology USA, Inc., dated July 13, 2022 (the “Interrogatories”).

GENERAL OBJECTIONS

Johnson Controls makes the following general objections, which are hereby incorporated by reference and made part of its response to each and every Interrogatory:

1. Johnson Controls objects and responds to the Interrogatories to the best of its present knowledge. Johnson Controls expressly reserves the right to supplement, clarify, revise, or correct any of the responses or objections hereto.

2. Johnson Controls does not admit, adopt, or acquiesce in any factual or legal contention, assertion, assumption, characterization, or implication contained in the Interrogatories, including in the Definitions and Instructions contained therein, nor does any written response or

production of information constitute an admission by Johnson Controls that such information is relevant to any claims or defenses in this action. In making these Responses, Johnson Controls does not admit or concede the relevance, materiality, or admissibility of any information provided, and does not waive any right to object on any ground to the use of any information provided in response. All objections to the use, at trial or otherwise, of any document or thing produced in response to the Requests and to any further production are hereby expressly reserved.

3. Johnson Controls objects to each Interrogatory to the extent it purports to impose upon Johnson Controls discovery obligations that exceed those provided for in the Federal Rules of Civil Procedure or the Local Rules for the United States District Court for the District of Delaware, orders entered in this case, or agreements among the parties.

4. Johnson Controls objects to each Interrogatory, including the definition and instructions that Willow purports to incorporate therein, to the extent that each Interrogatory is overbroad, unduly burdensome, not limited to a reasonable time frame, vague and ambiguous, irrelevant, and/or not reasonably calculated to lead to the discovery of admissible evidence.

5. Any documents that may be produced in response to the Interrogatories shall be subject to the Stipulation and Order Regarding Discovery of Electronically-Stored Information (the “ESI Stipulation”), and the protective order to be entered in this action (the “Protective Order”).

6. Johnson Controls objects to the Interrogatories to the extent they improperly contain multiple discrete subparts that each amount to a separate interrogatory. Johnson Controls reserves the right to count each subpart as a separate interrogatory against Defendants’ interrogatory limit.

RESPONSES AND SPECIFIC OBJECTIONS

INTERROGATORY NO. 1

For each claim of each Asserted Patent, state the date of invention for such claim, including but not limited to, identifying the dates of conception and actual reduction to practice of that claim, and the contribution of each inventor to the conception and reduction to practice of that claim, and describing in detail any diligence between such conception and reduction to practice, and identifying all documents that corroborate such dates and diligence and all persons who can corroborate such dates and diligence.

RESPONSE TO INTERROGATORY NO. 1:

Johnson Controls objects to this Interrogatory as compound, overly broad, unduly burdensome, and as not proportional to the needs of the case, including without limitation to the extent it seeks information regarding “all documents that corroborate such dates and diligence,” and “all persons who can corroborate such dates and diligence.” Johnson Controls further objects to this Interrogatory to the extent it seeks information or documents that are protected from disclosure by the attorney-client privilege, the work product doctrine, and/or any other applicable privilege or immunity. Johnson Controls further objects to this Interrogatory as premature to the extent that it seeks contentions, information, expert discovery, or opinions in a manner inconsistent with the Federal Rules of Civil Procedure, the Local Rules, and/or the Court’s Scheduling Order, and insofar as Johnson Controls’ response may depend on, without limitation, fact discovery, which has just begun. Discovery in this case is in its early stages, Johnson Controls’ investigation is ongoing, and Johnson Controls’ response is based on information reasonably available to Johnson Controls at this time. Johnson Controls’ response may require subsequent amendment, modification, or supplementation, pursuant to Rule 26(e) of the Federal Rules of Civil Procedure, including supplementation through additional document and fact and expert discovery.

Subject to and without waiving the foregoing objections, Johnson Controls responds as follows:

U.S. Patent No. 7,031,880 was conceived and reduced to practice no later than May 7, 2004. U.S. Patent No. 10,055,114 was conceived and reduced to practice no later than January 17, 2017. U.S. Patent No. 10,921,972 was conceived and reduced to practice no later than January 17, 2017. U.S. Patent No. 11,073,976 was conceived and reduced to practice no later than January 17, 2017. U.S. Patent No. 10,515,098 was conceived and reduced to practice no later than September 26, 2018. Patent No. 11,038,709 was conceived and reduced to practice no later than January 28, 2019. U.S. Patent No. 11,108,587 was conceived and reduced to practice no later than January 28, 2019. U.S. Patent No. 10,534,326 was conceived and reduced to practice no later than October 21, 2015. U.S. Patent No. 11,024,292 was conceived and reduced to practice no later than September 26, 2018. Johnson Controls reserves the right to supplement this response in accordance with the Federal Rules of Civil Procedure and the Scheduling Order.

INTERROGATORY NO. 2

Describe all facts and circumstances relating to any offer to license, sell, assign, or otherwise convey any rights to or under any or all of the Asserted Patents, the Related Patents and Applications, and any patent owned by JCTC relating to building management technology, including any license to any affiliate of JCTC, and further including the person(s) involved, the proposed terms, the related negotiations or discussions, and the results of those negotiations, discussions, or offers, including by identifying all related documents and communications, as well as the three persons most knowledgeable of the same.

RESPONSE TO INTERROGATORY NO. 2:

Johnson Controls objects to this Interrogatory as compound, overly broad, unduly burdensome, not relevant to any party's claims or defenses, and as not proportional to the needs of the case, including without limitation to the extent it seeks information regarding "all facts and circumstances," "any or all of . . . the Related Patents and Applications, and any patent owned by JCTC relating to building management technology," "any license to any affiliate of JCTC," and

seeks “all related documents and communications.” Johnson Controls further objects to this Interrogatory because the phrases used—including, without limitation, the phrases “offer to license, sell, assign, or otherwise convey,” “any rights,” “all facts and circumstances,” “negotiations or discussion,” “the results of those negotiations, discussions, or offers,” and “most knowledgeable”—are vague, ambiguous, and undefined. Johnson Controls further objects to this Request to the extent that the definition of the term “Related Patents and Application(s)” is overly broad, not relevant to any party’s claims or defenses, and is not proportional to the needs of the cases. Johnson Controls further objects to this Interrogatory as premature to the extent that it seeks contentions, information, expert discovery, or opinions in a manner inconsistent with the Federal Rules of Civil Procedure, the Local Rules, and/or the Court’s Scheduling Order, and insofar as Johnson Controls’ response may depend on, without limitation, fact discovery, which has just begun. Johnson Controls further objects to this Interrogatory to the extent it seeks information or documents that are protected from disclosure by the attorney-client privilege, the work product doctrine, and/or any other applicable privilege or immunity.

Subject to and without waiving the foregoing objections, Johnson Controls responds as follows:

Pursuant to Federal Rule of Civil Procedure 33(d), after a reasonable search, and to the extent such documents exist, Johnson Controls has produced or will produce relevant, responsive, and non-privileged documents from which Willow may ascertain the requested information. Documents responsive to this Interrogatory include JCTC-00004812-4816; JCTC-00004817-4824; JCTC-00004825-4835; JCTC-00004836-4844; JCTC-00004845-4849; JCTC-00004850-4857; JCTC-00004858-4864; JCTC-00004865-4869; JCTC-00004870-4878; JCTC-00005504-

5517. Johnson Controls reserves the right to supplement this response in accordance with the Federal Rules of Civil Procedure and the Scheduling Order.

INTERROGATORY NO. 3

For each claim of each Asserted Patent that JCTC contends is infringed by Willow USA, describe all facts and circumstances relating to JCTC's belief of such alleged infringement, including by identifying when JCTC first learned or believed of the alleged infringement, how JCTC learned of or developed such a belief, all involved person(s), including those person(s) affiliated with JCTC that formed such a belief, and all related documents and communications.

RESPONSE TO INTERROGATORY NO. 3:

Johnson Controls objects to this Interrogatory as compound, overly broad, unduly burdensome, and as not proportional to the needs of the case, including without limitation to the extent it seeks information regarding "all facts and circumstances," "all involved person(s), including those person(s) affiliated with JCTC," and "all related documents and communications." Johnson Controls further objects to this Interrogatory because the phrases used—including, without limitation, the phrases "first learned or believed," "learned of or developed such a belief," "all involved person(s), and "person(s) affiliated with JCTC"—are vague, ambiguous, and undefined. Johnson Controls further objects to this Interrogatory to the extent it seeks a legal conclusion and/or legal analysis, including without limitation as to what constitutes "infringement." Johnson Controls further objects to this Interrogatory as premature to the extent that it seeks contentions, information, expert discovery, or opinions in a manner inconsistent with the Federal Rules of Civil Procedure, the Local Rules, and/or the Court's Scheduling Order, and insofar as Johnson Controls' response may depend on, without limitation, fact discovery, which has just begun. Johnson Controls further objects to this Interrogatory to the extent it seeks

information or documents that are protected from disclosure by the attorney-client privilege, the work product doctrine, and/or any other applicable privilege or immunity.

Subject to and without waiving the foregoing objections, Johnson Controls responds as follows:

Johnson Controls formed a belief that Willow infringed and continues to infringe the Asserted Patents as early as a couple months prior to the filing of the original Complaint in this case. The Scheduling Order provides a date on which Johnson Controls must provide infringement contentions. Johnson Controls incorporates by reference its forthcoming infringement contentions. Johnson Controls reserves the right to supplement this response in accordance with the Federal Rules of Civil Procedure and the Scheduling Order.

INTERROGATORY NO. 4

For each Asserted Patent, describe any extent to which Karl Reichenberger was involved in, and/or had responsibility for, the patent prosecution process (e.g., drafting, supervising, overseeing, mentoring, overseeing, developing, researching, consulting, counseling, advising, directing, strategizing, and/or analyzing); explain what conduct or type of involvement Mr. Reichenberger was describing when he stated on his LinkedIn profile that, at JCTC, “Karl led the development and advancement of patent strategy within the area of Internet of Things (IoT) and cloud analytics;” describe in detail the “patent strategies” referred to by Mr. Reichenberger when he stated on his LinkedIn profile that “Karl continued leading the development and execution of patent strategies in the areas of IoT, computing architecture, and cloud analytics;” describe in detail how Mr. Reichenberger built portfolios and built sets of patents, and the strategies he used to “build portfolios” and “build sets of patents,” as referred to by him in the statements on his LinkedIn profile that “[i]n his Co-Chief Patent Counsel capacity, Karl leveraged his software background and experiences as business unit general counsel to build portfolios that protect innovative products in smart buildings and technologies,” and that “Karl is particularly proud of his continuing work to build sets of patents that protect Johnson Controls’ innovations”

RESPONSE TO INTERROGATORY NO. 4:

Johnson Controls objects to this Interrogatory as compound, overly broad, unduly burdensome, not relevant to any party’s claims or defenses, and as not proportional to the needs of the case, including without limitation to the extent it seeks information regarding “any extent to

which Karl Reichenberger was involved in, and/or had responsibility for, the patent prosecution process,” “what conduct or type of involvement Mr. Reichenberger was describing when he stated on his LinkedIn profile,” and “how Mr. Reichenberger built portfolios and built sets of patents.” Johnson Controls further objects to this Interrogatory because the phrases used—including without limitation the phrases “involved in, and/or had responsibility for” and “conduct or type of involvement”—are vague, ambiguous, and undefined. Johnson Controls further objects to this Interrogatory to the extent it seeks documents that are protected from disclosure by the attorney-client privilege, the work product doctrine, and/or any other applicable privilege or immunity.

Subject to and without waiving the foregoing objections, Johnson Controls responds as follows:

Karl Reichenberger is the Chief Intellectual Property Counsel at Johnson Controls. In that role, he oversees and leads the effort to build Johnson Controls’ patent portfolio that protects Johnson Controls’ innovative products. The prosecution of each of the patent applications that led to the Asserted Patents was carried out by Johnson Controls’ outside counsel, Foley & Lardner LLP. Pursuant to Federal Rule of Civil Procedure 33(d), after a reasonable search, and to the extent such documents exist, Johnson Controls has produced relevant, responsive, and non-privileged documents from which Willow may ascertain the requested information. Documents responsive to this Interrogatory include JCTC-00000001-0133; JCTC-00000134-0479; JCTC-00000480-0805; JCTC-00000806-1346; JCTC-00001347-2402; JCTC-00002403-2808; JCTC-00002809-3229; JCTC-00003230-3764; JCTC-00003765-4811. Johnson Controls reserves the right to supplement this response in accordance with the Federal Rules of Civil Procedure and the Scheduling Order.

INTERROGATORY NO. 5

Identify all conferences, trade shows, industry groups or meetings, government events, or any other gathering attended by each Named Inventor relating to digital twin technology, identify the specific dates and locations of each such conference, show, meeting, event, or gathering, and state whether a Named Inventor made a presentation or gave a talk or speech at each such conference, show, meeting, event, or gathering, and if so, state the title of such presentation, talk or speech.

RESPONSE TO INTERROGATORY NO. 5:

Johnson Controls objects to this Interrogatory as compound, overly broad, unduly burdensome, not relevant to any party's claims or defenses, and as not proportional to the needs of the case, including without limitation to the extent it seeks information regarding "all conferences, trade shows, industry groups or meetings, government events, or any other gathering attended by each Named Inventor relating to digital twin technology." Johnson Controls further objects to this Interrogatory on the grounds that the phrases "conferences," "trade shows," "industry groups or meetings," "government events," "any other gathering," "such conference, show, meeting, event, or gathering," "presentation," "gave a talk or speech," and "such presentation, talk or speech" are vague, ambiguous, and undefined. Johnson Controls further objects to this Interrogatory to the extent the discovery sought is publicly available or is available to F45. Johnson Controls further objects to this Interrogatory as improperly containing multiple discrete subparts that each amount to a separate interrogatory. Johnson Controls reserves the right to count each subpart as a separate interrogatory against Defendants' interrogatory limit.

Subject to and without waiving the foregoing objections, Johnson Controls responds as follows:

Johnson Controls will meet and confer with Willow to discuss the scope and relevance of this Interrogatory. Johnson Controls reserves the right to supplement this response in accordance with the Federal Rules of Civil Procedure and the Scheduling Order.

INTERROGATORY NO. 6

For each claim of each Asserted Patent that JCTC contends is infringed by Willow USA, identify the pertinent field of art and describe the level of ordinary skill in that art, including the date as of which you contend the level of ordinary skill in the art is to be measured, and identify all legal and factual support for your contentions.

RESPONSE TO INTERROGATORY NO. 6:

Johnson Controls objects to this Interrogatory as compound, overly broad, unduly burdensome, not relevant to any party's claims or defenses, and as not proportional to the needs of the case, including without limitation to the extent it seeks information regarding "all legal and factual support for your contention." Johnson Controls further objects to this Interrogatory to the extent it seeks a legal conclusion, legal analysis, and/or expert opinion, including without limitation as to what "the pertinent field of art," "the level of ordinary skill in that art," and "all legal . . . support for your contentions." Johnson Controls further objects to this Interrogatory as premature to the extent that it seeks contentions, information, expert discovery, or opinions in a manner inconsistent with the Federal Rules of Civil Procedure, the Local Rules, and/or the Court's Scheduling Order, and insofar as Johnson Controls' response may depend on, without limitation, fact discovery, which has just begun. Johnson Controls further objects to this Interrogatory to the extent it seeks information or documents that are protected from disclosure by the attorney-client privilege, the work product doctrine, and/or any other applicable privilege or immunity.

Subject to and without waiving the foregoing objections, Johnson Controls responds as follows:

Johnson Controls incorporates by reference its forthcoming infringement contentions and claim construction issue disclosures and briefing. Johnson Controls reserves the right to

supplement this response in accordance with the Federal Rules of Civil Procedure and the Scheduling Order.

09-15-2022 SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 6

Subject to and without waiving any objections, Johnson Controls further responds as follows:

Johnson Controls contends that a person of ordinary skill in the art is someone with at least a bachelor's degree in computer science and/or engineering, or electrical engineering, or a closely related scientific field such as mathematics, and two years of work experience with digital twin and/or entity modeling software. Alternatively, any lack of experience could be remedied with additional education (*e.g.*, a Master's degree), and likewise, a lack of education can be remedied with additional work experience (*e.g.*, 6-8 years).

Johnson Controls reserves the right to supplement this response in accordance with the Federal Rules of Civil Procedure and the Scheduling Order.

Dated: September 15, 2022

YOUNG CONAWAY STARGATT &
TAYLOR, LLP

OF COUNSEL:

Indranil Mukerji
Stephen Marshall
John B. Goerlich
WILLKIE FARR & GALLAGHER LLP
1875 K Street, N.W.
Washington, DC 20006-1238
(202) 303-1000
imukerji@willkie.com
smarshall@willkie.com
jgoerlich@willkie.com

Gabrielle K. Antonello
Eric L. Saunders
WILLKIE FARR & GALLAGHER LLP

/s/ Samantha G. Wilson
Adam W. Poff (No. 3990)
Anne Shea Gaza (No. 4093)
Samantha G. Wilson (No. 5816)
Rodney Square
1000 North King Street
Wilmington, DE 19801
(302) 571-6600
apoff@ycst.com
agaza@ycst.com
swilson@ycst.com

*Attorneys for Plaintiff Johnson Controls
Technology Company*

747 Seventh Avenue
New York, New York 10019-6099
(212) 728-8000
gantonello@willkie.com
esaunders@willkie.com

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on September 15, 2022, a copy of the foregoing document was served on the persons listed below in the manner indicated:

BY EMAIL

Jack B. Blumenfeld
Jennifer Ying
MORRIS, NICHOLS, ARSHT
& TUNNELL LLP
1201 North Market Street
Wilmington, DE 19899
jblumenfeld@morrisnichols.com
jying@morrisnichols.com

*Attorneys for Defendants and Counterclaim
Plaintiffs*

Russell E. Levine, P.C.
Jay Emerick
Adam M. Janes
KIRKLAND & ELLIS LLP
300 North LaSalle
Chicago, IL 60654
russell.levine@kirkland.com
jay.emerick@kirkland.com
adam.janes@kirkland.com

Dated: September 15, 2022

YOUNG CONAWAY STARGATT
& TAYLOR, LLP

/s/ Samantha G. Wilson
Adam W. Poff (No. 3990)
Anne Shea Gaza (No. 4093)
Samantha G. Wilson (No. 5816)
Rodney Square
1000 North King Street
Wilmington, DE 19801
(302) 571-6600
apoff@ycst.com
agaza@ycst.com
swilson@ycst.com

Attorneys for Plaintiff