

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN**

SIGNIFY NORTH AMERICA CORPORATION
and SIGNIFY HOLDING B.V.,

Plaintiffs,

v.

MENARD, INC.,

Defendant, Third-Party Plaintiff

v.

LUMINEX INTERNATIONAL COMPANY,
LTD.; RICHPOWER INDUSTRIES, INC.; EAST
WEST COMMERCE CO., INC.; ALERT REEL
MANUFACTURING, LLC; BEST LIGHTING
PRODUCTS, INC.; K LIVE D/B/A BULB STAR;
CL CORPORATION D/B/A PINEGREEN
LIGHTING; GOOD EARTH LIGHTING, INC.;
GT INDUSTRIAL PRODUCTS, L.L.C.;
SOARING TECHNOLOGY CO., LTD; ZONE
INDUSTRY CORPORATION

Third-Party Defendants.

Case No: 3:22-cv-00706-jdp

District Judge: James D. Peterson

Magistrate Judge: Stephen L. Crocker

**UPDATED JOINT PRELIMINARY PRETRIAL CONFERENCE REPORT
AND DISCOVERY PLAN**

Pursuant to Federal Rule of Civil Procedure 26(f) and this Court’s Order dated September 7, 2023 (Dkt. 187), and further to the Joint Preliminary Pretrial Conference Report dated March 3, 2023 (Dkt. 128), Plaintiffs Signify North America Corporation and Signify Holding B.V. (collectively, “Plaintiff” or “Signify”), Defendant Menard, Inc. (“Defendant” or “Menard”), and Third-Party Defendants Luminex International Company, Ltd.; Richpower Industries, Inc.; East West Commerce Co., Inc.; Alert Reel Manufacturing, LLC; Best Lighting Products, Inc.; K Live

d/b/a Bulb Star; CL Corporation d/b/a Pinegreen Lighting; Good Earth Lighting, Inc.; GT Industrial Products, L.L.C.; Soaring Technology Co., Ltd; and Zone Industry Corporation (collectively, “Third-Party Defendants”) submit this updated Joint Preliminary Pretrial Report and Discovery Plan.

I. AGREEMENT AMONG THE PARTIES ON PREFERRED TRIAL DATE

The parties have conferred and agree that, subject to the Court’s availability, this case should be set for trial in March 2025. The Court’s online calendar currently indicates there may be space available to conduct a two-week trial starting on either March 10, 2025, or March 17, 2025. Accordingly, the parties jointly request the trial date be reset to one of those dates.

Should the Court be able to set trial for March 2025, the parties have also agreed on many of the interim dates in the schedule. *See infra* at Section IV.A (Signify’s “Option 1” proposed schedule). The parties disagree on certain points relating to the schedule and with respect to certain proposed discovery rules and limitations, as outlined in more detail below.

II. PRELIMINARY STATEMENTS

A. Plaintiff Signify’s Preliminary Statement

In this action, Signify asserts that Defendant Menard has infringed six U.S. patents owned by Signify, based on Menard’s acts of offering to sell, selling and using numerous Menard-branded LED lighting products. Signify initially filed this lawsuit in the Northern District of Ohio over a year ago on August 12, 2022. Soon after filing, and pursuant to the local rules governing the case at that time, Signify served infringement contentions on October 31, 2022. Beyond this step, however, little progress has been made in the case due to a series of preliminary motions regarding transfer and Menard’s third party complaint against various third party suppliers. *See, e.g.*, Dkts. 100, 104, 115, 129, 154, 155, 163 (collectively, “the Third Party Motions”). Last March, the Court set a January 27, 2025, trial date, with the expectation that it would set a full case schedule after

deciding the Third Party Motions, in a scheduling conference to be held on August 24, 2023.

Now that the Court has ruled on those motions, Signify believes that all parties should focus their efforts on the conduct of discovery and trial preparation. While the Court did not grant Signify's motion to sever the third party claims, it stayed Menard's indemnity claims and made clear that it "expects Menard and the third-party defendants to coordinate a litigation strategy, acting as a united front wherever possible." Dkt. 183 at 5.

Signify believes that if Menard and the Third-Party Defendants cooperate in the conduct of discovery, and comply with the letter and the spirit of the above-referenced order, this case can and should be ready for trial in Q1 2025. In Section IV.A below, Signify presents two alternative scheduling options to do so. The first option would lead to trial in March 2025, which all parties agree is preferred. The second option would retain the current January 27, 2025, trial date, in the event the Court's schedule does not allow for a trial in March of 2025.

B. Preliminary Statement of Defendant Menard and Third-Party Defendants

Menard and the Third-Party Defendants fully intend to, and have taken various steps to, comply with the Court's request that Menard and the third-party defendants act as a united front when possible. Signify accused approximately 120 products supplied to Menards by the Third-Party Defendants.¹ While there is overlap in the issues in this case, each Third-Party Defendant will face unique issues, for example whether their products infringe the patents asserted by Signify. Naturally, this will require additional discovery, motions, etc. unique to each Third-Party Defendant and their products.

¹ Menard maintains that Signify should move to amend its Complaint if it intends to pursue allegations of infringement against products listed in Signify's infringement contentions, but not in their Complaint. This is the subject of Signify's pending motion to compel and subsequent response and reply briefs. Dkt. 166, 174 and 177.

Menard disagrees that two separate “options” are required. Menard proposed one schedule consistent with the rescheduling of the preliminary pretrial conference to September 28, 2023. On the September 7, 2023 call, the Court indicated that it was open to later dates. While Menard generally agrees with the March 2025 trial date, as indicated by the proposed schedule below, if a later date is necessary, Menard would be amendable to the later date. Menard disagrees that a January 2025 Court date is plausible and requests that the Court choose a date in April 2025 or later if the Court is unavailable in March 2025.

III. INFORMATION REQUIRED BY THIS COURT’S STANDING ORDER

A. A Concise Statement of the Nature of the Case

Plaintiff Signify alleges in its Complaint that Defendant Menard has infringed, and is continuing to infringe, six Signify patents² through its offer for sale, sale and use of certain Menard-branded LED Lighting products without Signify’s authorization. Dkt. 1. Signify’s Complaint alleges that Menard has infringed the Asserted Patents both directly and indirectly, and that Menard’s infringement has been willful. Through its Complaint, Signify seeks, among other things, monetary damages for past and ongoing infringement, and a permanent injunction barring any further infringement of the Asserted Patents by Menard.

Defendant Menard has filed an Answer in which it denies infringement and raises several other Affirmative Defenses. Dkt. 17. Menard has also filed a Third-Party Complaint (Dkt. 20), in which it asserts claims for indemnity against twelve third-party suppliers. Menard’s Third-Party Complaint seeks an “order declaring that Menard is entitled to be fully indemnified by the Third-

² These six patents asserted by Signify in this lawsuit are U.S. Patent Nos. 7,038,399 (“399 patent”); 7,256,554 (“554 patent”); 7,737,643 (“643 patent”); 7,348,604 (“604 patent”); 7,658,506 (“506 patent”); and 10,299,336 (“336 patent”) (collectively, “Asserted Patents”).

Party Defendants for all costs, expenses, damages, or judgments resulting from Plaintiffs' claims and the defense thereof." Dkt. 20.

Thus far, most, but not all³, of the Third-Party Defendants named in Menard's Third-Party Complaint have appeared and responded to the Third-Party Complaint. Third-Party Defendants Best Lighting Products, Inc., Alert Reel Manufacturing, LLC, Richpower Industries, Inc. and Luminex International Company, Ltd. have asserted crossclaims against Signify seeking declaratory judgment of non-infringement and invalidity for certain Asserted Patents. Dkts. 91, 146, 147, and 159.

B. The Names of Any Related Cases

Certain Asserted Patents are the subject of other ongoing lawsuits before different courts in different districts:

- the '399 and '604 patents are the subject of *Signify North America Corp. et al. v. LEPRO Innovation Inc. et al.*, No. 2:22-cv-02095 (D. Nev.);
- the '554 and '643 patents are the subject of *Signify North America Corp. et al. v. EGLO Leuchten GmbH et al.*, No. 6:22-cv-00812 (W.D. Tex.); and
- the '554, '643, and '604 patents are the subject of *Current Lighting Solutions, LLC v. Signify Holding BV et al.*, No. 1-23-cv-11398 (D. Mass.).

None of the defendants in this case (including Menard and all Third-Party Defendants) are named defendants in the Nevada, Texas, or Massachusetts proceedings.

C. Factual and Legal issues to be Resolved at Trial

The parties identify the following factual and legal issues to be resolved at trial:

1. Construction of any disputed terms identified in the Asserted Patents;

³ Third-Party Defendants East West Commerce Co., Inc. and K Live d/b/a Bulb Star have not filed responses to Menard's Third-Party Complaint or entered appearances.

2. Whether the Asserted Patents are valid and enforceable;
3. Whether Defendant Menard has infringed, directly or indirectly, any asserted claims of the Asserted Patents;
4. Whether any of the Accused Products, identified by SKU by Signify, infringe any valid and enforceable claim of the Asserted Patents, either literally or under the doctrine of equivalents.
5. If Defendant Menard is found to have infringed any asserted claims of the Asserted Patents, whether such infringement has been willful;
6. If Defendant Menard is found to have infringed any asserted claims of the Asserted Patents, the amount of damages to which Signify is entitled;
7. If Defendant Menard is found to have infringed any asserted claims of the Asserted Patents, whether the Court should issue a permanent injunction barring any further infringement by Menard of any such asserted claims;
8. Whether this case is exceptional entitling Signify or Menard to attorney fees; and
9. Whether any Third-Party Defendants must indemnify and defend Menard in this lawsuit.⁴

The parties reserve the right to raise additional issues that may arise through the course of this action.

D. Description of Any Pleading Amendments That a Party Intends to Make

1. Signify's Statement

Signify does not intend to make any pleading amendments at this time, subject to resolution of its pending Motion to compel (Dkt. 166).

Signify filed its Complaint against Menard on August 12, 2022 (Dkt. 1), and Menard filed its Answer on October 14, 2022 (Dkt. 17). Menard thereafter filed its Third-Party Complaint on

⁴ The Court has ordered that these issues will be handled following resolution of Signify's claims of patent infringement.

October 17, 2022 (Dkt. 20). While the case was venued in Ohio, and pursuant to the Northern District of Ohio local patent rules, Signify served its Infringement Contentions on October 31, 2022. It has now been almost a year since Signify served those contentions, and Menard has not sought leave to amend its pleading. Signify believes that any further amendments to the pleadings at this stage should be by leave of Court. This includes any further efforts by Menard to amend its Third-Party Complaint to introduce even more Third-Party Defendants into this case.

Signify does not presently anticipate a need to amend its Complaint. However, Menard has thus far refused to provide discovery⁵ on all the accused products/SKUs delineated in Signify's Infringement Contentions. Menard insists that Signify must first amend its Complaint to separately list by individual SKU number all Menard SKUs delineated in Signify's Infringement Contentions before those products can become part of the case and before Signify is entitled to any discovery on them. Signify disputes this and believes that all the products delineated in its previously served Infringement Contentions are already part of the case, and properly subject to discovery. No purpose, other than further delay, would be served by requiring Signify to amend its Complaint to delineate SKU numbers that Menard has been on notice of since October 2022. This dispute has been fully briefed in connection with Signify's Motion to compel certain discovery from Menard, which is currently pending before the Court. Dkt. 166.

⁵ Menard also erroneously alleges below that during the March 17, 2023, scheduling conference, "the Court indicated to the parties that they should essentially treat the rescheduling of the preliminary pretrial conference as a stay in the case." In fact, the Court recognized that Menard was going to be a party to the case regardless of how the motions to sever and dismiss were resolved. The Court did not "advi[se]" Menard to refrain from developing Invalidity Contentions or from voluntarily proceeding with discovery between itself and Signify in the period between March and August 2023. Rather, the Court instructed Signify and Menard to confer on how discovery should proceed as between Signify and Menard. See Dkt. 182 (transcript) at 13-14. Following the meet and confer, Menard agreed to respond to Signify's previously served discovery requests, but declined to move forward on any other discovery between Signify and itself. Menard itself made that decision, not the Court.

Further, since the time Signify served its Infringement Contentions last October, additional infringing Menard-branded products/SKUs have appeared on Menard's website. Upon information and belief, those additional products were launched after Signify served its Infringement Contentions in October 2022. Signify plans to add those additional products to the case and to its Infringement Contentions as well. Signify notified Menard on July 13, 2023, of its intention to do so after the Court rules on Signify's pending Motion to compel, and resolves the dispute between the parties as to whether all accused SKUs must be separately and individually delineated in the Complaint (as opposed to the Infringement Contentions).

If the Court rules that Signify must formally amend its Complaint to individually delineate all accused products by individual SKU number, Signify will, of course, seek leave of Court to do so. Menard has been on notice of all the SKUs listed in Signify's Infringement Contentions since October 2022. And Menard has been on notice since July 13, 2023, of the additional infringing SKUs added to its website after Signify served its Infringement Contentions in October 2022. There would be no prejudice to Menard from any amendment to formally add any of those SKU numbers to Signify's Complaint or Infringement Contentions.

In the Joint Preliminary Pretrial Conference Report filed March 3, 2023, Menard suggested that it may seek to add additional suppliers (Canarm LTD, Max Energy LLC, Quoizel, and Test Rite Products Corp.) as third-party defendants to the case, because they purportedly supply Menard with certain accused products that Signify delineated by SKU number for the first time in its October 31, 2022, infringement contentions. Dkt. 128 at 13. Given that Menard has been on notice of these accused products for nearly a year, and has taken no steps to add these additional suppliers to the case, Menard should not be permitted to add these suppliers at this time and potentially further disrupt the proposed case schedule. While Menard alleges that it would be

“patently unfair [to these additional suppliers] to not allow them to participate in the case,” Menard has offered no indication that these additional suppliers actually wish to participate in the case. Indeed, if these additional suppliers wanted to be involved, they have had the opportunity for almost a year now to seek to intervene, yet none have.

2. Menard and Third-Party Defendants’ Statement

Menard asserts that now that the Court has resolved the pending motions to dismiss and sever, the parties should be given the opportunity to amend the pleadings without requesting leave from the Court.

Menard maintains that Signify should amend its complaint if they want to pursue claims against all the products accused of infringement in Signify’s infringement contentions. The Complaint is what defines the products at issue. Signify essentially doubled the number of accused products in their infringement contentions, and indicated that it intends to add even more products in a letter it sent Menard on July 13, 2023. If Signify moves to amend their Complaint or the Court rules in favor of Signify on their pending motion to compel, Menard should have the opportunity to amend its pleadings as well.

During the call in March of 2023, the Court indicated to the parties that they should essentially treat the rescheduling of the preliminary pretrial conference as a stay in the case.⁶ While various procedural matters and settlement discussions have taken place, Menard abided by the Court’s advice. Menard has not unreasonably delayed adding these parties as no real substantive technical matters have proceeded in this case. The delay was caused by Signify’s various motions to sever and dismiss.

⁶ With the exception of pending discovery requests filed by Signify at the time of the call.

Further, it did not make sense for Menard to add any additional parties to the case for a variety of additional reasons. First, Signify's motion to sever was pending until recently, so there was uncertainty whether the Third-Party Defendants would remain in the case. It would not have made sense to bring in additional Third-Party Defendants just for them to be dismissed if the Court had ruled in Signify's favor. Second, the parties disagree on whether Signify needs to add any additional products they allege infringe their asserted patents to their Complaint. If yes, Menard will need to be able to amend its pleadings to match Signify's amendment. If no, there was still uncertainty, and after guidance being provided by the Court, Menard will need to bring in the additional manufacturers to defend their products. Further, as noted in the Court's order, any additional parties implicated by the products added to the case after the filing of the original Complaint would have just a strong of an interest in the result of this case. If Menard is found liable, the additional manufacturers' accused products are also liable. These parties would have the technical knowledge and evidence necessary to defend their products. It would be patently unfair to not allow them to participate in the case.

Menard intends to move to amend its Answer to more explicitly plead the defenses of invalidity of the Asserted Patents and non-infringement of the Asserted Patents.

E. The Identity of Any New Parties to Be Added, Including an Explanation as to Why These Parties Must Be Added

1. Signify's Statement

Signify does not intend to add any new parties at this time. For the reasons set forth *supra* in Section III.D.1, Signify does not believe Menard has cause to add any new parties to this case either.

2. Menard and Third-Party Defendants' Statement

Signify's infringement contentions and their July 13, 2023 letter implicate products supplied to Menard by Canarm LTD, Max Energy LLC, Quoizel and Test Rite Products Corporation. These products were not listed in Signify's initial Complaint. If Signify amends their Complaint to add those products to the case or the Court rules in favor of Signify for their Motion to Compel, Menard may need to add these parties so they may defend their products against accusations of infringement.

F. Estimated Trial Length

1. Signify's Statement

Signify estimates that trial of the patent-related claims can be completed in 10 full court days, provided Menard and the Third-Party Defendants coordinate and present a united front.

2. Menard and Third-Party Defendants' Statement

Due to the sheer number and differences between the products accused of infringement by Signify and the number of parties implicated, including the issues unique to each of the parties, Menard estimates that at least 15 full court days will be required to sort through the 120+ products accused of infringement. As of July 13, 2023, Signify has indicated to Menard that they may potentially increase the number of accused products beyond the 120+ listed in their infringement contentions. Signify has indicated to Menard that they may potentially increase the number of accused products during discovery. If Signify chooses to do so, additional days may be needed.

G. Other Matters Affecting the Just, Speedy and Inexpensive Disposition of this Case

1. Signify's Statement

As noted above and in the original Pretrial Conference Report, Signify believes that the

primary issue affecting the just, speedy and inexpensive disposition of this case is the extent to which Menard and the Third-Party Defendants coordinate and present a united front, as required by the Court's August 31, 2023 Order. Toward that end, and as per the Court's suggestion, Signify has proposed a number of discovery limitations and additional "special rules" that it respectfully request the Court adopt in this case. *See infra* Sections IV.B.1, VI.A.

2. Menard and Third-Party Defendants' Statement

Menard is not currently aware of any additional matters affecting the just, speedy and inexpensive disposition of this case.

IV. PROPOSED DISCOVERY PLAN PURSUANT TO FED. R. CIV. P. 26

A. Signify's Proposed Schedule

This case was filed in August 2022, and Signify believes the Court should enter a schedule that ensures a trial in Q1 2025. When the current January 27, 2025, trial date was set, the Court and the parties anticipated that a scheduling conference would be held on August 24, 2023, to set a full schedule of interim dates. The scheduling conference has been deferred until September 28, 2023. But that should not result in any significant postponement of the trial date, and certainly not beyond Q1 2025.

Based on a review of the Court's on-line calendar, it appears that in addition to the current January 27, 2025, trial date, Judge Peterson's calendar might also permit trial to start on March 10 or March 17, 2025. A March trial date would be preferable to both sides. It would give the parties and the Court some additional time to ready the case for trial and adjust for the fact that the scheduling conference is being held about a month later than expected when the Court originally set the January 27, 2025, trial date. If, however, it is not possible for the Court to conduct a trial in March 2025, then Signify believes the current trial date should be kept.

Accordingly, Signify proposes two alternative scheduling options below, both of which

would lead to a trial in Q1 2025. Option 1 contemplates that trial would commence on either March 10 or March 17, 2025. Option 2 maintains the currently-scheduled January 27, 2025 trial date. Signify prefers Option 1, and this option more closely aligns with Menard and the Third-Party Defendants' proposed schedule. However, if the Court is unavailable to hold a trial in March of 2025, Signify proposes the Court adopt Option 2 and maintain the currently-scheduled January 27, 2025 trial date. As this case has already been pending for over a year, Signify is opposed to delaying trial beyond Q1 2025.

Menard and the Third-Party Defendants' proposed schedule is also presented as a column in Option 1 for comparison.

Option 1

	Signify's Proposed Dates	Menard and Third- Party Defendants' Proposed Dates
Scheduling conference	9/28/2023	
Amendments to the Pleadings	By leave of court	10/19/2023
Establish standing to assert patent	10/19/2023	
Infringement Contentions	previously served 10/31/2022 ⁷	
Invalidity/Unenforceability Contentions	10/12/2023	11/23/2023
Exchange of Terms and Proposed Constructions:		
Opening Exchange	1/12/2024	
Responses	2/9/2024	
Disclosure of Reliance on Advice of Counsel	2/9/2024	
Disclosure of Liability Experts:		

⁷ Once the Court rules on Signify's pending Motion to compel (Dkt. 166), Signify intends to update its previously served Infringement Contentions to formally add certain additional infringing Menard-branded products/SKUs which Signify brought to Menard's attention in a letter dated July 13, 2023. Upon information and belief, those additional accused Menard-branded products/SKUs were launched after Signify served its Initial Infringement Contentions in October 2022, as discussed above in Section III.D.1.

Opening Reports (by party bearing burden of proof)	3/18/2024	3/29/2024
Rebuttal Reports	4/22/2024	5/3/2024
Reply Reports	5/6/2024	NONE
Dispositive Motions & Claim Construction:		
Opening	6/7/2024	
Responsive	7/12/2024	
Reply	8/2/2024	
Disclosure of Damages Experts:		
Opening reports (by party bearing burden of proof)	9/27/2024	10/4/2024
Rebuttal Reports	10/25/2024	11/1/2024
Reply Reports	11/8/2024	NONE
Settlement Letters	11/29/2024	
Discovery Cutoff	12/20/2024	
Rule 26(a)(3) Disclosures; MILs	1/3/2025	
Objections	1/31/2025	
Final Pretrial Conference #1	2/18/2025	3/7/2025
Final Pretrial Conference #2	2/26/2025	NONE
Trial	3/10/2025 or 3/17/2025	March or April 2025

Option 2

	Signify's Proposed Dates
Scheduling conference	9/28/2023
Amendments to the Pleadings	By leave of court
Establish standing to assert patent	10/12/2023
Infringement Contentions	previously served 10/31/2022
Invalidity/Unenforceability Contentions	10/12/2023
Exchange of Terms and Proposed Constructions:	
Opening Exchange	12/11/2023
Responses	1/8/2024
Disclosure of Reliance on Advice of Counsel	1/12/2024
Disclosure of Liability Experts:	

Opening Reports (by party bearing burden of proof)	2/2/2024
Rebuttal Reports	3/8/2024
Reply Reports	3/22/2024
Dispositive Motions & Claim Construction:	
Opening	4/25/2024
Responsive	5/30/2024
Reply	6/21/2024
Disclosure of Damages Experts:	
Opening reports (by party bearing burden of proof)	8/26/2024
Rebuttal Reports	9/20/2024
Reply Reports	10/4/2024
Settlement Letters	10/11/2024
Discovery Cutoff	11/15/2024
Rule 26(a)(3) Disclosures; MILs	11/22/2024
Objections	12/20/2024
Final Pretrial Conference #1	1/8/2025
Final Pretrial Conference #2	1/16/2025
Trial	1/27/2025

B. Defendant Menard's Statement:

Menard proposed one schedule. Menard does not believe an Option 2 schedule is necessary. On the September 7, 2023 call, the Court indicated that it was open to later dates. While Menard generally agrees with the March 2025 trial date, as indicated by the proposed schedule below, if a later date is necessary, Menard is amendable to the later date. Menard disagrees that a January 2025 Court date is plausible and requests that the Court choose a date in April 2025 or later if the Court is unavailable in March 2025.

C. Signify's Statement on Proposed Schedule:

1. Coordination Between Menard and Third-Party Defendants

Both of Signify's alternative proposed case schedules assume that Menard and the Third-Party Defendants will cooperate and present a united front wherever possible, and that any areas of disagreement or separate participation among Menard and the Third-Party Defendants will be minimal. Signify reserves the right to seek relief from the Court should Menard and/or the Third-Party Defendants fail to follow the letter or the spirit of the Court's directive on coordination.

In its August 31, 2023, decision, the Court invited the parties to propose additional rules to ensure that Menard and the Third-Party Defendants coordinate and present a united front wherever possible. Dkt. 183 at 6. Signify proposes the following additional rules:

- (1) Menard and the Third-Party Defendants will collectively serve a single consolidated set of invalidity and unenforceability contentions.
- (2) On common issues, Menard and the Third-Party Defendants will submit a consolidated report from a joint expert.
- (3) Menard and the Third-Party Defendants will collectively propose one consolidated list of claim terms for construction and a joint, unified position on the construction of any particular claim term to be construed.

2. Amendments to the Pleadings

As explained *supra* in Section III.D.1, Signify does not intend to make any pleading amendments at this time, subject to resolution of its pending Motion to compel (Dkt. 166).

3. Menard's Intention to Add Additional Third-Party Defendants

For the reasons explained *supra* in Section III.D.1, Signify is opposed to any effort by Menard to add additional suppliers as third-party defendants at this time. If, however, Menard is

permitted to add any additional suppliers, the Court should take steps to ensure that will not impact the schedule or the trial of this matter.

4. Invalidity Contentions

Menard (the only party accused of patent infringement in this lawsuit) has had Signify's infringement contentions for nearly a year (*i.e.*, since October 22, 2022), and has had Signify's Complaint (including the detailed claim charts appended to the Complaint) for over a year (*i.e.*, since August 26, 2022). Moreover, Signify sent Menard detailed claim charts outlining Menard's infringement as early as August 2021, prior to bringing this action. *See* Dkt. 1 at 19. Thus, if Menard intends to challenge the validity of any of the asserted patents, Menard has already had more than sufficient time to prepare invalidity contentions.⁸ Likewise, the Third-Party Defendants have possessed Signify's infringement contentions since at least February of this year. *See, e.g.*, Dkts. 105-2 through 105-4. Accordingly, Signify believes that Menard and the Third-Party Defendants should be required to coordinate and serve a joint set of any invalidity/unenforceability contentions promptly after the Scheduling Conference on September 28, 2023. Signify proposes October 12, 2023, as the deadline for doing so. Neither Menard nor the Third-Party Defendants should be heard to complain that October 12 is too early. Menard has had Signify's contentions for nearly a year, and has on multiple occasions represented to this Court and the Northern District of Ohio that it was prepared to served contentions long before now. In fact, ***after*** Signify served its infringement contentions and before this case was transferred to this District, Menard itself proposed to the Ohio court that its deadline for serving invalidity contentions should be reset to

⁸ Menard erroneously asserts below that during the March 17, 2023, scheduling conference, "the Court indicated to the parties that they should treat the rescheduling of the preliminary pretrial conference as a stay in the case." As noted above, the Court specifically did not take any stance on whether discovery between Signify and Menard should proceed, let alone any stay regarding invalidity contentions. *See supra* n.5.

April 19, 2023. *See* Dkt. 25 (“Menard additionally moves for a ninety (90) day extension of time through **April 19, 2023** in which to submit the initial invalidity contentions required in this case pursuant to Local Patent Rules 3.5-3.6.”) (emphasis added); Dkt. 25-1 (same). And, in the March 3, 2023 Preliminary Pretrial Conference Report, Menard proposed July 28, 2023 as the deadline for serving any invalidity/unenforceability contentions. Dkt. 128 at 15. Given Menard’s prior representations to this Court and to the Ohio court, any further delay in serving invalidity/unenforceability contentions is unwarranted. None of the reasons given by Menard support a later deadline for serving invalidity contentions.

First, Menard asserts that its proposed deadline is consistent with the typical gap between the Preliminary Pre-trial Conference and Invalidity Contentions in this Court. But this ignores the unique circumstances of this case. In a typical case in this Court, the Preliminary Pre-trial Conference is held **before** Infringement Contentions are served, and Invalidity Contentions are typically due within 1-2 months after Infringement Contentions are served. Here, Menard has been sitting on Signify’s Infringement Contentions for nearly a year. Signify is unaware of any case where a defendant was afforded that much time to prepare and serve Invalidity Contentions.

Second, Menard asserts that it needs additional time because of “the additional products Signify intends to add” to the case. This assertion has no merit. Signify’s Infringement Contentions were served last October. Menard has had nearly a year to consider those contentions and formulate Invalidity Contentions for any asserted claims. And, while Signify did advise Menard on July 13, 2023, that it had recently identified 15 Menard SKUs in addition to those delineated in its October 2022 Infringement Contentions (all of which are believed to have been launched by Menard after Signify served its Infringement Contentions), none of those additional SKUs warrant any further delay in serving invalidity contentions. In fact, no new patents or

patent claims are implicated by those additional SKUs that Signify seeks to accuse.

Finally, while Menard alleges below that “none of the other deadlines are affected by Menard’s proposed November 23, 2023 deadline,” this is incorrect as Menard’s proposed Invalidity/Unenforceability Contentions deadline prejudices Signify by reducing the time between the Invalidity/Unenforceability Contentions deadline and opening claim term exchange to only 1.5 months over the winter holiday season, during which Signify must analyze the Invalidity/Unenforceability Contentions before strategizing what claim terms need construction. Conversely, Menard and the Third-Party Defendants will have had over a year since receiving Signify’s Infringement Contentions in which to formulate their claim construction strategies.

5. Reply Expert Reports

Signify proposes that the expert report schedule include reply reports that are limited in scope to rebuttal of issues or information disclosed in rebuttal reports. Under the schedule proposed above, expert disclosures will be exchanged while fact discovery remains open, and therefore it is possible that arguments or theories may be disclosed for the first time in rebuttal expert reports, leaving an opposing party without an opportunity in the schedule to respond to such previously undisclosed arguments or theories. This issue impacts all parties, as new theories and arguments disclosed in rebuttal reports may relate to noninfringement, validity (including secondary considerations) and damages (including royalty rates and noninfringing alternatives). Signify’s proposal would not allow parties to use reply reports to reargue or “have the last word,” and would instead limit reply reports to only rebuttal of issues and information disclosed in rebuttal reports.

D. Menard and Third-Party Defendants' Statement on Proposed Schedule:

1. Coordination Between Menard and Third-Party Defendants

Menard and the Third-Party Defendants fully intend to, and have taken various steps to, comply with the Court's request that Menard and the third-party defendants act as a united front when possible. Signify accused approximately 120 products supplied to Menards by the Third-Party Defendants. While there is certainly overlap in the issues in this case, each Third-Party Defendant will face unique issues, for example whether their different products infringe the patents asserted by Signify. Naturally, this will require additional discovery, motions, etc. unique to each Third-Party Defendant and their products. Menard does not have any additional rules to propose and is generally amendable to Signify's proposed rules. However, as the Court acknowledged in its order, if there is reasonable disagreement, a party may need to file a separate section to the invalidity and enforceability contentions, to an expert report, or propose a separate claim construction.

2. Amendments to the Pleadings

This case is yet to proceed substantively. The Court just recently ruled on the motions to sever and dismiss. A deadline will provide each party the chance to amend their pleadings in view of this order. Additionally, Signify and Menard may need to amend based on further information, such as Plaintiff's contentions which accuse additional products of infringement. After the deadline, leave of Court should be required.

3. Menard's Intention to Add Additional Third-Party Defendants

During the call in March of 2023, the Court indicated to the parties that they should treat the rescheduling of the preliminary pretrial conference as a stay in the case. Menard abided by the Court's advice. Menard has not unreasonably delayed adding these parties as no real substantive

technical matters have proceeded in this case. The delay was caused by Signify's various motions to sever and dismiss.

Again, it did not make sense for Menard to add any additional parties to the case for a variety of additional reasons. First, Signify's motion to sever was pending until recently so there was uncertainty whether the Third-Party Defendants would remain in the case. It would not have made sense to bring in additional Third-Party Defendants just for them to be dismissed if the Court had ruled in Signify's favor. Second, the parties disagree on whether Signify needs to add any additional products they allege infringe their asserted patents to their Complaint. If yes, Menard will need to be able to amend its pleadings to match Signify's amendment. If no, there was still uncertainty, and after guidance being provided by the Court, Menard will need to bring in the additional manufacturers to defend their products. Further, as noted in the Court's order, any additional parties implicated by the products added to the case after the filing of the original Complaint would have just a strong of an interest in the result of this case. If Menard is found liable, the additional manufacturers' accused products are also liable. These parties would have the technical knowledge and evidence necessary to defend their products. It would be patently unfair to not allow them to participate in the case.

4. Infringement / Invalidity Contentions

Menard proposes the November 23, 2023, deadline for Invalidity/Unenforceability Contentions as is consistent with this Court's typical timeline. It is Menard's understanding based on looking at previous schedules in this Court that Invalidity/Unenforceability Contentions deadline is often set four months from the preliminary pretrial conference, but the November deadline is only 2 months from the preliminary pretrial conference. Under either of Signify's proposed scenarios, none of the other deadlines are affected by Menard's proposed November 23, 2023 deadline, there is no reason to require Signify's earlier deadline.

Signify has alleged infringement of over 120 products sold by Menards, yet has provided only representative claim charts for significantly less than 120 products. Signify cannot assert that a claim chart for one Manufacturer's product is representative for products provided to Menards by another Manufacturer.

Additionally, the Court asked the parties to treat the time between March and September as a stay to preserve party resources. The manufacturers will need sufficient time to evaluate the six asserted patents and each of the accused products, including the additional products Signify intends to add.

5. Reply Expert Reports

Menard proposes no reply reports as is the norm in this District.

V. ELECTRONIC DISCOVERY

The parties agree that they will discuss and seek agreement on protocols with respect to identification, review, and production of electronically stored information as necessary.

VI. DISCOVERY LIMITATIONS

The parties generally agree to the limitations on discovery set by the Federal Rules of Civil Procedure. However, the parties separately propose the following additional limitations:

A. Signify's Position and Proposals

To assure that discovery proceeds in a reasonable and efficient manner, Signify proposes the following additional discovery limitations. For each limitation below, the Signify plaintiffs, collectively, are one "side," and Menard and all Third-Party Defendants, collectively, are the other "side," for discovery relating to Signify's patent claims against Menard (and any related defenses or claims) and any Third-Party Defendant's crossclaims against Signify (and any related defenses or claims). These proposed limitations would not apply to discovery relating to Menard's third-

party claims for indemnification, as such discovery is stayed until after Signify's claims are adjudicated (Dkt. 183 at 5).

- Each side may serve a maximum of twenty-five (25) interrogatories, collectively, on the other side. Each side may allocate such interrogatories as “common” (for common service on all entities comprising a side) or “individual” (for service on a single entity) as desired. With respect to any interrogatories that Signify had already served on Menard prior to Menard filing its third-party complaint to name the Third-Party Defendants as parties to this case, Signify may re-frame such interrogatories as common interrogatories without such interrogatories being counted as additional interrogatories.
- Each side may serve a maximum of thirty-five (35) requests for admission, collectively, on the other side. Such requests for admission are exclusive of requests directed solely to authentication of documents or other evidence, which are not limited. The parties shall work together in good faith concerning authenticity of documents in an attempt to eliminate the need for formal requests for admission on these topics.
- Each side is limited to no more than seventy (70) hours of deposition testimony of fact witnesses, including Fed. R. Civ. P. 30(b)(6) depositions, but not including third-party witnesses. Former employees of a party are considered party witnesses for purposes of deposition hours. Absent leave of court or consent of all involved parties, depositions shall be limited to one day of seven (7) hours on the record, and the deposition of a given individual shall run consecutively or concurrently, such that a given individual is not deposed more than once. If a witness is duly noticed

as both a Rule 30(b)(6) witness and a Rule 30(b)(1) witness, the deposition of that witness shall count as both a Rule 30(b)(6) deposition and a Rule 30(b)(1) deposition. Menard and the Third-Party Defendants shall designate a single party to take the lead and represent that side for taking or defending a deposition. Menard and the Third-Party Defendants shall not question a witness separately unless it is determined after consultation that Menard and the Third-Party Defendants disagree on a significant issue. Any party seeking to separately question a witness shall notify Signify at least three (3) business days prior to the deposition of its intention in this regard, including the issue of disagreement to which the separate questioning will be directed, and Signify reserves the right to seek Court involvement should it disagree that separate questioning is warranted and/or should the separate questioning deviate from such issue. The separate questioning shall count towards the side's seven (7) hour limit for the witness.

- Any party that serves a subpoena upon a third party will simultaneously serve a copy upon each other party. Any party that receives documents or written correspondence from a third party pursuant to a subpoena will promptly produce those documents and/or written correspondence to each other party. Each party must produce copies of documents it receives from a third party within five (5) business days. Where such reproduction is not possible within five (5) business days, the party who received the documents will provide notice to the other party on or before the fifth (5th) business day and work in good faith to resolve the issue.
- The parties will work together to accommodate reasonable modifications to these limitations should the need arise, including to the extent that the scope of this

lawsuit changes due to new or additional products at issue.

Menard proposes below that “each party should abide by the limits in Federal Rules of Civil Procedure 33, 34, and 36.” These default limits unduly prejudice Signify, who is faced with seeking discovery from not only Menard but also numerous Third-Party Defendants which Signify had no intention of drawing into this case. At the same time, this approach grants Menard and the Third-Party Defendants excessive collective discovery requests to lodge against Signify (*e.g.*, potentially 300 total interrogatories against Signify). Therefore, the limits under the Federal Rules are ill-suited towards the unique circumstances of this case, whereas Signify’s proposed approach of using common interrogatories for each side ensures a balanced and fair approach. If the Court declines to permit common interrogatories, to ensure an equitable balance, Signify should be accorded the same number of discovery requests as Menard and its suppliers collectively, and such quantities should be fewer than that set forth in the Federal Rules (*e.g.*, to avoid potentially 300 interrogatories per side).

B. Menard and Third-Party Defendants’ Position and Proposals

Menard reiterates that Menard and the Third-Party Defendants will cooperate when possible. However, as the Court acknowledged, it is unreasonable to think zero disputes or differences will arise during his litigation. The primary complexity of this case is Plaintiff’s claims against more than 120 products, and Signify plans to add more. Different products and products from different manufacturers may have different issues, that each manufacturer may need to address separately. Menard asserts each party should abide by the limits in Federal Rules of Civil Procedure 33, 34, and 36.

To the extent reasonable, Menard and the Third Party Defendants agree to coordinate to the extent possible in an effort to avoid serving duplicative discovery requests on Signify, and Signify shall produce all its discovery responses and documents to each of Menard and each of

the Third Party Defendants, whether such discovery request was served by Menard or any particular Third Party Defendant.

VII. PRIVILEGE ISSUES

A. Signify's Position and Proposals

As set forth in the proposed Protective Order (Dkt. 161-1), which the Court entered on April 13, 2023 (Dkt. 162), the parties agree that inadvertent production of any document or information without a designation of CONFIDENTIAL or ATTORNEYS EYES ONLY shall be governed by Fed. R. Evid. 502.

Signify proposes that communications and documents generated after the commencement of this action in the Northern District of Ohio, if privileged or protected as work product, do not need to be included on any privilege log provided pursuant to Rule 26(b)(5). Signify also proposes that privileged communications (i) solely between a party and the party's outside counsel of record or (ii) solely between and among a party's in-house counsel do not need to be included on any privilege log provided pursuant to Rule 26(b)(5), except in the event such party takes a position that puts its state of mind at issue (*e.g.*, by asserting lack of knowledge, good faith belief in non-infringement/invalidity, or an advice of counsel defense to a charge of willful infringement). Signify opposes Menard's proposal of avoiding a privilege log entirely as to these communications, as Signify has asserted a willfulness claim against Menard and is entitled to a privilege log to assess any defense Menard presents in this regard. Finally, Signify proposes that the parties agree to make reasonable efforts to serve privilege logs within ten (10) business days after written responses to discovery are served, and to the extent that such is not practicable, the parties will work in good faith to set a reasonable deadline for the privilege log.

B. Menard and Third-Party Defendants' Position and Proposals

Menard disagrees that only documents generated after the commencement of this action in the Northern District of Ohio, if privileged or protected as work product, do not need to be included on any privilege log provided pursuant to Rule 26(b)(5). Signify first wrote Menard in early 2021. Menard proposes that any communication (i) between Menard and the Menard's outside counsel of record or (ii) between and among a Menard's in-house counsel do not need to be included on any privilege log provided. These documents and communications would clearly be made or prepared in anticipation of potential litigation after receiving Signify's initial letter.

Menard also proposes that all communications and documents generated after the commencement of this action in the Northern District of Ohio between counsel for Menard and counsel for Third-Party Defendants or between counsel for the Third-Party Defendants do not need to be included on any privilege log.

VIII. SERVICE BY EMAIL

The parties agree that service by electronic means shall be allowed as set forth in Fed. R. Civ. P. 5(b)(2)(E) and that such service shall be considered personal service under the Federal Rules and complete upon transmission, such that three days are not added to the response deadline under Fed. R. Civ. P. 6(d).

Email service on Signify will be made to at least the following:

- Sarah A. Zylstra (szylstra@boardmanclark.com)
- John D. Carlin (jcarlin@venable.com)
- Jason M. Dorsky (jmdorsky@venable.com)
- Stephen K. Yam (syam@venable.com)
- Signify-Menards@Venable.com

Email service on Menard will be made to at least the following:

- Charlie J. Meyer (cjmeyer@uspatent.com)
- Scott Collins (scollins@uspatent.com)
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Email Service on the Third-Party Defendants will be made to at least the following:

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⁹ The parties were unable to obtain approval from Alert Reel Manufacturing, LLC as of the time of this filing.

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