

From: [Trials](#)
To: [Oliver, Justin J.](#); [Trials](#); [Devitt, William E.](#); [Khatri, Vishal V.](#); [Nightingale, Joshua R.](#); [Messing, Jeffrey S.](#); [Dorsky, Jason M.](#); [Yam, Stephen K.](#); [Carlin, John D.](#)
Subject: RE: IPR2024-00101 - Luminex v. Signify - Authorization for a Motion for Discovery
Date: Wednesday, November 6, 2024 2:59:16 PM

Counsel,

In response to Patent Owner's November 5, 2024, renewed request for authorization, the Board authorizes Patent Owner to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) for the documents identified in the October 30, 2024, email to the Board, i.e., as items (i) and (ii). The motion must not exceed ten pages and must be filed within five business days of the date of this email. The Board also authorizes Petitioner to file an opposition to the motion. The opposition must not exceed ten pages and must be filed within ten business days of the date of this email. The Board does not at this time authorize a reply to the opposition.

Best regards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Oliver, Justin J. <JOliver@Venable.com>
Sent: Tuesday, November 5, 2024 11:55 AM
To: Trials <Trials@USPTO.GOV>; Devitt, William E. <wdevitt@jonesday.com>; Khatri, Vishal V. <vkhatr@jonesday.com>; Nightingale, Joshua R. <jrnightingale@jonesday.com>; Messing, Jeffrey S. <jmessing@jonesday.com>; Dorsky, Jason M. <JMDorsky@Venable.com>; Yam, Stephen K. <SYam@Venable.com>; Carlin, John D. <JCarlin@Venable.com>
Subject: RE: IPR2024-00101 - Luminex v. Signify - Authorization for a Motion for Discovery

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To the Board,

Signify respectfully renews its request for a conference call to discuss a motion for discovery and the prejudice caused by delay. Signify believes that (i) the Director's decision was based on an incomplete record (which Signify nevertheless believed established Menard was a RPI) and facts currently not known to the Director or Board should be brought to light, in the interests of justice, and (ii) Signify's ability to develop and preserve its RPI-based arguments for its POR (and for potential appellate review) is being prejudiced the closer the Director's forthcoming opinion gets to Signify's POR deadline, such that further delay could result in a de facto denial.

IPR2024-00101
Ex. 3005

Regards,
Justin Oliver
Counsel for Patent Owner

Justin J. Oliver, Esq. | Venable LLP
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600 Massachusetts Avenue, NW, Washington, DC 20001

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From: Trials <Trials@USPTO.GOV>

Sent: Thursday, October 31, 2024 3:45 PM

To: Oliver, Justin J. <JOliver@Venable.com>; Devitt, William E. <wdevitt@jonesday.com>; Khatri, Vishal V. <vkhatr@jonesday.com>; Nightingale, Joshua R. <jnightingale@jonesday.com>; Messing, Jeffrey S. <[jmessaging@jonesday.com](mailto:jmessing@jonesday.com)>; Dorsky, Jason M. <JMDorsky@Venable.com>; Yam, Stephen K. <SYam@Venable.com>; Carlin, John D. <JCarlin@Venable.com>

Cc: Trials <Trials@USPTO.GOV>

Subject: RE: IPR2024-00101 - Luminex v. Signify - Authorization for a Motion for Discovery

Caution: External Email

Counsel,

In granting Director review, the Director disagreed that “the facts of record establish that Menard is a real party in interest to this proceeding.” Paper 12, 5. Additionally, the Director stated that “I will issue a subsequent opinion in due course that details my reasoning” regarding the real-party-in-interest issue. Id. at 6.

A conference call to discuss authorization to file a motion for additional discovery on the real-party-in-interest issue is premature before the Director’s opinion on the question issues.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Oliver, Justin J. <JOliver@Venable.com>

Sent: Wednesday, October 30, 2024 11:36 AM

To: Trials <Trials@USPTO.GOV>

Cc: Devitt, William E. <wdevitt@jonesday.com>; Khatri, Vishal V. <vkhatr@jonesday.com>; Nightingale, Joshua R. <jnightingale@jonesday.com>; Messing, Jeffrey S. <jmessing@jonesday.com>; Dorsky, Jason M. <JMDorsky@Venable.com>; Yam, Stephen K. <SYam@Venable.com>; Carlin, John D. <JCarlin@Venable.com>

Subject: IPR2024-00101 - Luminex v. Signify - Authorization for a Motion for Discovery

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To the Board,

Signify requests authorization to file a motion for additional discovery pertaining to whether Menard qualifies as an RPI in this IPR. The proposed motion would seek discovery of, in particular, (i) relevant documents already known to exist (due to discovery in the related litigation), which were not available for citation in the POPR, and (ii) relevant documents believed to exist based on statements made in the litigation and this IPR. Signify has identified to Luminex the specific requests most likely to be presented in the motion, in an attempt to reach agreement. In response, Luminex stated that it “opposes Signify’s request for additional discovery.”

Luminex’s position: “The discovery sought by Signify is not in the ‘interests of justice,’ and is improperly directed to Luminex’s and Menard’s defense and other litigation positions in the district court case, which is currently stayed. Such discovery also seeks communications that are privileged under the common interest privilege. Signify already has the agreement between Menard and Luminex relating to the indemnification obligations, and there is no dispute that Luminex, along with the other suppliers, is working with Menard on the defense of the litigation. The RPI issue is whether Menard had any role in the IPR Petition, and that has been addressed several times already by Luminex. Luminex’s counsel is under a duty of candor and has already advised Signify that Menard had no role in the filing of the IPR Petition, and Menard is not controlling or funding the IPR. For at least these reasons, Signify’s requested discovery is not in the interests of justice under the *Garmin* factors, and should be denied.”

(Regarding Luminex’s above-stated position, the undersigned has reminded Luminex’s IPR counsel that the agreement, and other documents, produced in the litigation is subject to a protective order that precludes it from being submitted in this IPR.)

The parties are available for a conference call with the Board on this matter during the following periods: November 1 from 10:00am to 5:00pm; November 4 from 10:00am to 3:00pm; and November 5 from 10:00am to 12:00pm.

Regards,

Justin Oliver
Counsel for Patent Owner

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