

JONES DAY

110 N. WACKER • SUITE 4800 • CHICAGO, ILLINOIS 60606
TELEPHONE: +1.312.782.3939 • FACSIMILE: +1.312.782.8585

DIRECT NUMBER: (312) 269-4240
WDEVITT@JONESDAY.COM

April 18, 2024

VIA EMAIL

Robert C. Tapparo
VENABLE LLP
600 Massachusetts Ave., NW
Washington, DC 20001
RCTapparo@Venable.com

Re: Signify North America Corporation et al. v. Menard, Inc. et al., No. 3:22-cv-00706-jdp

Dear Robert:

On behalf of Menard's and the Third-Party Defendants' (collectively "Defendants"), we write regarding a number of outstanding discovery issues, including: (1) Signify's March 28 Letter; (2) deficiencies in Signify's document production; and (3) Defendants' Responses to Signify's Common Interrogatory Nos. 1 and 2. We address each of these issues in detail below.

I. SIGNIFY'S MARCH 28 LETTER

We are in receipt of your March 28 Letter responding to our March 22 Letter detailing the numerous deficiencies in Signify's responses and objections to Defendants' First Set of Common RFPs and First Set of Common Interrogatories.

We maintain our positions set forth in our March 22 Letter. Signify's repeated refusal to comply with its discovery obligations is materially prejudicing Defendants. While we are prepared to discuss Signify's discovery deficiencies in detail on a meet and confer, we provide additional responses to certain positions Signify raised in its March 28 letter below in the hopes of furthering such future discussions.

A. RFP NO. 14

Defendants' RFP No. 14 seeks documents, communications, and things that relate to communications between Signify (or its attorneys) and any third parties regarding the asserted patents. Your position that such a request is "overly broad and unreasonable" is unfounded.

CONFIDENTIAL – ATTORNEY WORK PRODUCT

Luminex v. Signify
IPR2024-00101
Exhibit 2019

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Signify has repeatedly emphasized the robust licensing campaign that it maintains for its patent portfolio, which includes the Asserted Patents in this case. Defendants are entitled to non-privileged documents and communications between Signify and third parties, whether licensees of the asserted patents or not, that involve the asserted patents. By way of a nonlimiting example, Signify could be seeking to license the Asserted Patents to third parties on different terms than it seeks in this case, or Signify could be taking infringement positions inconsistent with those positions it has taken in this litigation. Such documents and communications would be plainly relevant to the issues in this case. Signify cannot simply stand on its “overly broad” objection to avoid producing relevant documents in response to this request.

B. RFP NO. 15

By Signify’s insistence that it “has no formal licensing policy documents in its possession, custody or control that is not already represented in its published website or in the licenses themselves,” Defendants understand that the only materials and information Signify will rely on for purposes of establishing any possible damages in this case will be those publicly available documents that Signify has already produced and the forthcoming licenses that it will be producing in response to Defendants’ other requests. To the extent Signify attempts to introduce any further evidence related to its licensing program, Defendants will seek to exclude such materials and other evidence as not timely produced and reserve all rights to pursue any other appropriate remedies based upon Signify’s misrepresentation as to the existence of such documents.

C. RFP NOS. 23–25, 31–32

Signify again plays games in an attempt to avoid producing any relevant documents in response to Requests 23-25 and 31-32. Defendants have clearly stated since discovery began that they are not seeking the production of any privileged documents. To the extent Signify intends to stand on privilege as a means for avoiding the production of documents, that is fine. But Signify must state so, and identify the privileged documents which it intends to withhold pursuant to FRCP 26. As Signify has not yet identified any privileged documents that it is withholding from production in this case, Defendants understand that Signify is instead simply refusing to produce such documents.

Signify cannot legitimately claim that documents related to other proceedings (judicial or otherwise) involving the asserted patents and/or their foreign equivalents are not relevant to this litigation.

D. RFP NO. 38

Signify continues to try to obfuscate Request No. 38, which is in fact a relatively straight forward Request. Using the current situation as the most obvious example, Signify is asserting

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patent infringement against Menard, a distributor who does not manufacture the Accused Products. Defendants simply want all licenses between Signify and other distributors (like Menard) that sell products supplied by the Third-Party Defendants. Defendants never changed the scope of this request. Rather, Defendants attempted to simplify the issue based on Signify's manufactured confusion. If Signify is still confused by the scope of this request, we look forward to discussing such apparent confusion during the meet and confer.

E. RFP NOS. 5, 11, 16, 36, 39–44

Defendants are not seeking expert discovery through these requests. Defendants are simply seeking damages-related, factual information that Signify may rely on in building its damages case. The fact that Signify's damages expert may rely on such information in the future does not somehow protect this information from fact discovery. Indeed, quite the opposite. Defendants are entitled to the underlying factual information upon which Signify will build its damages case. Signify has no legitimate basis to withhold this relevant information and must produce it immediately.

II. SIGNIFY'S DEFICIENT DOCUMENT PRODUCTION

We also write to address deficiencies in Signify's document production. To date, despite having received multiple sets of Requests for Production from Defendants, Signify has produced only the Asserted Patent file histories, a handful of invention disclosure documents, details of assignment of the Asserted Patents, Menard website listings of the Accused Products, other documentation of Signify's analysis of the Accused Products, a handful of documents from prior cases involving certain Asserted Patents, and minimal licensing documents. These materials fail to sufficiently address the wide range of Defendants' Requests for Production. Noticeably absent from Signify's production are materials related to: (A) the claimed inventions; (B) products purportedly embodying the patented inventions; and (C) Signify's contentions for its claims of willfulness, irreparable harm, and attorneys' fees. These Requests are reasonable, and such information is fundamental to Defendants being able to properly defend themselves from Signify's assertions.

A. DOCUMENTS CONCERNING THE CLAIMED INVENTIONS (RFP NOS. 6–12, 18, 22, 26–27, 34, AND 36)

Defendants requested documents related to the Asserted Patents in RFP Nos. 6-12, 18, 22, 26, 27, 34, and 36 as discussed below. Signify agreed to search for and produce responsive documents related to each of these RFPs. Yet, to date, Signify has produced few—if any—responsive documents to these requests.

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- RFP Nos. 6–8, 18: RFP Nos. 6–8 and 18 request documents, communications, and things related to the research, diligence, conception, and actual reduction to practice of each Asserted Patent. Defendants requested, and Signify agreed to search for and produce, a much larger potential scope of material, including, for example, “engineering notebooks, laboratory notebooks, log books, record books, memoranda, design reviews, progress reports, technical reports, drawings, schematics, specifications, diagrams, computer records, diaries, calendars, test results,” or any other documents or things that corroborate conception, research, diligence, or reduction to practice. These documents are necessary to aid Defendants in determining both the scope and validity of the Asserted Patents and claimed inventions.
- RFP Nos. 9 and 10: RFP Nos. 9 and 10 request documents, communications, and things related to first prototypes and manufactures, uses, offers for sale, disclosures, or publications of the claimed inventions. Defendants are not aware of any responsive documents produced by Signify to date that are responsive to Request Nos. 9 and 10.
- RFP No. 11: RFP No. 11 requests documents, communications, and things related to Signify’s valuation of the Asserted Patents. Defendants are not aware of any documents produced by Signify to date that are responsive to Request No. 11. Signify cannot withhold documents related to its claim for damages.
- RFP Nos. 12 and 22: RFP Nos. 12 and 22 request documents, communications, and things related to invention contributions and statements regarding the Asserted Patents. Aside from the Asserted Patents’ file histories, limited invention disclosure statements, and a handful of documents related to assignments and prior litigation, Signify has provided little, if any, responsive material. These documents are crucial to permitting Defendants to evaluate the scope and validity of the Asserted Patents, as well as any claim for an earlier priority date for any asserted claim.
- RFP Nos. 26, 27, and 34: RFP Nos. 26, 27, and 34 request documents, communications, and things related to the validity of the Asserted Patents, including secondary considerations of nonobviousness and prior art. Signify has only produced the Asserted Patents’ file histories, limited invention disclosure statements, and a handful of documents from previous litigation involving certain Asserted Patents. This is hardly substantive or responsive. These Requests are crucial to evaluating the validity of the Asserted Patents and Signify’s claims.
- RFP No. 36: RFP No. 36 requests documents, communications, and things related to statements made in the Asserted Patents that provide enablement and written description support for the Asserted Claims as well as documents, communications, and things related

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to Signify's claims of infringement, claim construction, validity, and damages positions. Defendants are aware of no responsive material regarding Signify's damages positions—beyond a handful of license documents, despite its agreement to search for and produce responsive documents. This Request is crucial to Defendants ability to sufficiently evaluate and respond to the central issues in this case, including alleged infringement, damages, and validity.

B. DOCUMENTS CONCERNING EMBODYING PRODUCTS (RFP NOS. 16, 28–30, 39–41)

Defendants have also requested documents related to Embodying Products in RFP Nos. 16, 28-30, and 39-41. Despite Signify's agreement to provide relevant responsive documents, Defendants are aware of little, if any, documents produced regarding any of Signify's Embodying Products and subsequent sales, prices, or consumer demand.

- RFP Nos. 28-30 and 39-40: RFP Nos. 28–30 and 39–40 request documents, communications, and things related to Signify's products that embody the Asserted Patents, including sales information and pricing of the alleged Embodying Products. Defendants are not aware of any relevant material related to any alleged Embodying Product that Signify has produced. Such material is crucial to Defendants evaluating the scope of the Asserted Patents.
- RFP No. 41: RFP No. 41 requests documents, communications, and things related to consumer demand for Embodying Products, Competing Products, and the Accused Products. Defendants are not aware of any material produced by Signify concerning Signify's alleged Embodying Products or Signify's Competing Products, let alone consumer demand regarding these products. This material is necessary for Defendants to assess the potential breadth of alleged damages in this case amongst other issues.
- RFP No. 16: RFP No. 16 requests documents, communications, and things related to any licenses that would assist in determining a reasonable royalty rate for the Asserted Patents. However, Signify has produced only a limited number of prior license agreements. Licensing material regarding the Asserted Patents is relevant to the *Georgia Pacific* factors considered in a claim for patent damages.

C. DOCUMENTS CONCERNING SIGNIFY'S CONTENTIONS OF WILLFULNESS, IRREPARABLE HARM, AND ATTORNEYS' FEES (RFP NOS. 42–44)

Defendants also requested documents, communications, and things related to Signify's various contentions related to willfulness (RFP No. 42), irreparable harm (RFP No. 43), and

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attorneys' fees (RFP No. 44). Signify agreed to produce responsive documents; yet, Defendants are aware of little, if any, documents produced that are responsive to these Requests. These Requests are directed towards accusations specifically made by Signify and Defendants are entitled to the basis for Signify's contention that: Defendants' conduct has been willful; Signify will continue to suffer irreparable harm; and how this case is exceptional under 35 U.S.C. § 285. To the extent Signify continues to maintain such claims, please confirm that Signify will produce material responsive to these Requests.

III. DEFENDANTS' RESPONSES TO SIGNIFY'S COMMON INTERROGATORY NOS. 1 AND 2

Your April 9 letter regarding alleged deficiencies in the Defendants' Responses to Signify's Common Interrogatories 1 and 2 is premature and contains numerous misstatements and inaccuracies requiring correction. We address each of these issues in more detail below.

A. THE COURT HAS NOT YET GRANTED SIGNIFY LEAVE TO AMEND ITS INFRINGEMENT CONTENTIONS

Signify's April 9 letter addresses Signify's Second Amended Infringement Contentions, as if Signify has already been granted leave by the Court to make such amendments. But as Signify well knows, it is not free to unilaterally amend its infringement contentions at this late stage. Indeed, the Court was clear in its scheduling order regarding amendments to the parties' contentions. Pursuant to the Scheduling Order, the parties were free to amend their respective contentions until the date provided for amending pleadings. That date was October 19, 2023. (D.I. 193 at 2.) And Signify already amended its infringement contentions once prior to that date. Any further amendments to a parties' contentions require leave of the Court, and the Court indicated it would be "increasingly reluctant to allow amendments as the deadline for expert disclosures approaches." (D.I. 193 at 2-3.)

Signify knows it must have the Court's approval in order to amend its infringement contentions at this late stage, and accordingly filed its motion for leave to do so on April 1. (See D.I. 255.) Defendants filed their Opposition to the Motion to Amend on April 16. (D.I. 258.) The Court has not yet ruled on Signify's motion to Amend. Any attempts by Signify to press discovery issues, which are grounded in Signify's not-yet-admitted Second Amended Infringement Contentions, are premature.

B. SIGNIFY CANNOT OBFUSCATE ITS BURDEN ON INFRINGEMENT

Signify is also seemingly attempting to use its Second Amended Infringement Contentions as a means of shifting its burden of establishing infringement. There can be no dispute as to who bears the burden on the issue of infringement: that is Signify's burden as the patent owner seeking

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to enforce its patents. *Roche Palo Alto LLC v. Apotex, Inc.*, 531 F.3d 1372, 1377 (Fed. Cir. 2008) (“[T]he patentee bears the burden of proving infringement.”). Yet Signify insists that it must receive further supplements to Defendants’ responses to Common Interrogatories 1 and 2 “seasonably in advance of the April 29 due date for opening technical expert reports.” (April 9 Letter at 2.)

Signify seems to want to flip the infringement analysis on its head, seeking to limit Defendants’ non-infringement positions before Signify has even provided its expert report on infringement—an issue for which it bears the burden of proof. Defendants have already provided Signify with responses to Interrogatories 1 and 2, including identifying particular patent claim limitations for each of the Asserted Patents that are not present in the accused products. Accordingly, Defendants maintain that no further supplementations to their responses to Common Interrogatories 1 and 2 are necessary at this time, and maintain that such responses are complete based upon the information provided by Signify to date.

The same is true for those supplementations that Signify seeks regarding Signify’s failure to chart certain products from the various Third-Party Defendants in Signify’s First Amended Infringement Contentions. Signify bears the burden to establish infringement for every Accused Product—it is not Defendants’ burden to establish that certain charted products are representative of others. If Signify fails to carry such a burden, then Defendants are well within their rights to rely on such a failure as a defense, as Defendants timely disclosed such a defense in their responses to the relevant Common Interrogatories.

Moreover, none of the cases Signify relies upon support its position that Defendants’ Responses to Common Interrogatories 1 and 2 are deficient. For example, *Mirror World Techs.*, an Eastern District of Texas case, which is not binding precedent in this district, cites to a Northern District of California case, which is similarly non-binding, is directed to whether the plaintiff provided an adequate level of disclosure under the circumstances in its response to the defendants’ invalidity contentions. Similarly, *Nouis Techs., Inc. v. Polaris Indus. Inc.*, which Signify cites for its proposition that it has “no notice of the factual bases for Menard’s noninfringement contentions,” (April 9 Letter at 3.), is in the context of the adequacy of the pleadings, and the case states only that plaintiffs are “entitled to know [defendants] noninfringement theories.” *Nouis Techs., Inc. v. Polaris Indus. Inc.*, 2015 WL 3407862, at *3 (W.D. Wis. 2015). And there can be no reasonable dispute that Defendants have provided Signify with proper notice of its infringement defenses. Finally, the *Baltimore Therapeutic Equip. Co. v. Loredan Biomedical, Inc.* case speaks only to the use of contention interrogatories for narrowing issues for trial and gathering evidence **to rebut** an issue on which a party does not bear the burden. *Baltimore Therapeutic Equipment Co. v. Loredan Biomedical, Inc.*, No. S 89–1085–GEB, 1993 WL 129781 (E.D. Cal. 1993), *aff’d*, 26 F.3d 138 (Fed. Cir. 1994). Defendants’ responses to Common Interrogatories 1 and 2 are the Defendants’ position rebutting Signify’s infringement allegations; not the other way around.

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Signify retains the burden of establishing infringement, and it must do so for each Accused Product. Signify cannot shift the burden to the Defendants to prove non-infringement of the Accused Products, nor can it shift the burden to Defendants to establish why one Third-Party Defendant's product is not representative of another Third-Party Defendants' product. And Signify certainly cannot rely on its not-yet-admitted Second Amended Infringement Contentions as authority to do so.

* * * * * * * * * * * *

Please let us know if you are available to meet and confer regarding these issues on Wednesday, April 24, 2024.

Best regards,

A handwritten signature in black ink, appearing to read "William E. Dewett". The signature is fluid and cursive, with a large, stylized "W" and "D".

*Counsel for Third-Party Defendant Luminex
International Company, Ltd.*