

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WISCONSIN
EASTERN DIVISION

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;
CANARM, LTD.; TEST RITE PRODUCTS
CORPORATION

Third-Party Defendants

Civil Action No. 3:22-cv-00706

District Judge James D. Peterson

Magistrate Judge: Stephen L. Crocker

**DEFENDANT’S FIRST AMENDED ANSWER TO PLAINTIFF’S COMPLAINT AND
DEMAND FOR JURY TRIAL**

Defendant Menard, Inc. (“Menard”) hereby submits its Answer to Plaintiff Signify North America Corporation’s and Signify Holding B.V.’s (collectively “Signify”) Complaint and Demand for Jury Trial, EFC No. 1.

NATURE OF THE ACTION

1. Menard admits Signify has filed an action for alleged patent infringement, asserting the patents listed in the complaint. Otherwise denied.

THE PARTIES

2. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 2 of the Complaint and on that basis denies the same.

3. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 3 of the Complaint and on that basis denies the same.

4. Admitted.

JURISDICTION AND VENUE

5. Admitted.

6. Menard admits that venue is proper in this judicial district under 28 U.S.C. §§ 1391(b) and (c) and 1400(b). Otherwise denied.

7. Menard admits that venue is proper in this judicial district under 28 U.S.C. §§ 1391(b) and (c) and 1400(b). Otherwise denied.

8. Menard admits this Court has personal jurisdiction over Menard. Otherwise denied.

9. Menard admits it maintains a commercial website accessible to residents of the State of Ohio. Otherwise denied.

10. Menard admits it previously filed a suit in the Northern District of Ohio.
Otherwise denied.

SIGNIFY AND THE PATENT-IN-SUIT

11. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 11 of the Complaint and on that basis denies the same.

12. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 12 of the Complaint and on that basis denies the same.

13. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 13 of the Complaint and on that basis denies the same.

14. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 14 of the Complaint and on that basis denies the same.

15. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 15 of the Complaint and on that basis denies the same.

16. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 16 of the Complaint and on that basis denies the same.

17. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 17 of the Complaint and on that basis denies the same.

18. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 18 of the Complaint and on that basis denies the same.

19. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 19 of the Complaint and on that basis denies the same.

20. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 20 of the Complaint and on that basis denies the same.

DEFENDANT AND ITS (ALLEGEDLY) INFRINGING LED LIGHTING PRODUCTS

21. Admitted that Menard has more than 300 stores and that such stores offer for sale lighting products, among many other products. Otherwise denied.

22. Admitted.

23. Menard admits that it owns one or more Federal Registered trademarks for MASTERFORCE and that Reg. No. 5616305 includes classes generally related to lighting. Otherwise denied.

24. Menard admits it owns one or more Federal Registered trademarks for SMART ELECTRICIAN that Reg. Nos. 3997476, 5081316 and 6302884 include classes generally related to lighting. Otherwise denied.

25. Admitted that Menard controls the "Patriot Lighting," "MasterForce," and "Smart Electrician" trademarks. Otherwise denied.

26. Denied.

27. Admitted that these are products sold by Menard at least at one time. Otherwise denied.

28. Admitted.

29. Admitted.

30. Admitted.

31. Admitted.

32. Admitted.

33. Admitted.

34. Admitted.

35. Admitted.

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43. Admitted.

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47. Admitted.

48. Admitted.

49. Admitted.

50. Admitted.

51. Admitted.

52. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 52 of the Complaint and on that basis denies the same.

53. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 53 of the Complaint and on that basis denies the same.

54. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 54 of the Complaint and on that basis denies the same.

PRE-SUIT NOTICE AND COMMUNICATIONS

55. Denied.

56. Denied.

57. The document speaks for itself. Otherwise denied.

58. The document speaks for itself. Otherwise denied.

59. The document speaks for itself. Otherwise denied.

60. The document speaks for itself. Otherwise denied.

61. The document speaks for itself. Otherwise denied.

62. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 62 of the Complaint and on that basis denies the same.

63. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 63 of the Complaint and on that basis denies the same.

64. The document speaks for itself. Otherwise denied.

65. The document speaks for itself. Otherwise denied.

66. The document speaks for itself. Otherwise denied.

67. The document speaks for itself. Otherwise denied.

68. The document speaks for itself. Otherwise denied.

69. The document speaks for itself. Otherwise denied.

70. The document speaks for itself. Otherwise denied.

71. The document speaks for itself. Otherwise denied.

72. The document speaks for itself. Otherwise denied.

73. The document speaks for itself. Otherwise denied.

74. The document speaks for itself. Otherwise denied.

75. The document speaks for itself. Otherwise denied.

76. The document speaks for itself. Otherwise denied.

77. The document speaks for itself. Otherwise denied.

78. The document speaks for itself. Otherwise denied.

79. The document speaks for itself. Otherwise denied.

80. The document speaks for itself. Otherwise denied.

81. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 81 of the Complaint and on that basis denies the same.

82. The document speaks for itself. Otherwise denied.

83. The document speaks for itself. Otherwise denied.

84. The document speaks for itself. Otherwise denied.

SIGNIFY'S FIRST CLAIM FOR RELIEF

Alleged Infringement of the '399 Patent

85. Menard incorporates by reference its answers to the allegations in Paragraphs 1-84 of the Complaint.

86. Denied.

87. The document speaks for itself. Otherwise denied.

88. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 88 of the Complaint and on that basis denies the same.

89. Denied.

90. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 90 of the Complaint and on that basis denies the same.

91. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 91 of the Complaint and on that basis denies the same.

92. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 92 of the Complaint and on that basis denies the same.

93. Denied.

94. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 94 of the Complaint and on that basis denies the same.

95. Denied.

96. Denied.

97. Denied.

98. Denied.

SIGNIFY'S SECOND CLAIM FOR RELIEF

Alleged Infringement of the '554 Patent

99. Menard incorporates by reference its answers to the allegations in Paragraphs 1-84 of the Complaint.

100. Denied.

101. The document speaks for itself. Otherwise denied.

102. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 102 of the Complaint and on that basis denies the same.

103. Denied.

104. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 104 of the Complaint and on that basis denies the same.

105. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 105 of the Complaint and on that basis denies the same.

106. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 106 of the Complaint and on that basis denies the same.

107. Denied.

108. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 108 of the Complaint and on that basis denies the same.

109. Denied.

110. Denied.

111. Denied.

112. Denied.

113. Denied.

SIGNIFY'S THIRD CLAIM FOR RELIEF

Alleged Infringement of the '643 Patent

114. Menard incorporates by reference its answers to the allegations in Paragraphs 1-84 of the Complaint.

115. Denied.

116. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 116 of the Complaint and on that basis denies the same.

117. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 117 of the Complaint and on that basis denies the same.

118. Denied.

119. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 119 of the Complaint and on that basis denies the same.

120. Denied.

121. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 121 of the Complaint and on that basis denies the same.

122. Denied.

123. Denied.

124. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 124 of the Complaint and on that basis denies the same.

125. Denied.

126. Denied.

127. Denied.

128. Denied.

129. Denied.

SIGNIFY'S FOURTH CLAIM FOR RELIEF

Alleged Infringement of the '605 Patent

130. Menard incorporates by reference its answers to the allegations in Paragraphs 1-84 of the Complaint.

131. Denied.

132. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 132 of the Complaint and on that basis denies the same.

133. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 133 of the Complaint and on that basis denies the same.

134. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 134 of the Complaint and on that basis denies the same.

135. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 135 of the Complaint and on that basis denies the same.

136. Denied.

137. Denied.

138. Denied.

139. Denied.

140. Denied.

SIGNIFY'S FIFTH CLAIM FOR RELIEF

Alleged Infringement of the '506 Patent

141. Menard incorporates by reference its answers to the allegations in Paragraphs 1-84 of the Complaint.

142. Denied.

143. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 143 of the Complaint and on that basis denies the same.

144. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 144 of the Complaint and on that basis denies the same.

145. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 145 of the Complaint and on that basis denies the same.

146. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 146 of the Complaint and on that basis denies the same.

147. Denied.

148. Denied.

149. Denied.

150. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 150 of the Complaint and on that basis denies the same.

151. Denied.

152. Denied.

153. Denied.

154. Denied.

SIGNIFY'S SIXTH CLAIM FOR RELIEF

Alleged Infringement of the '336 Patent

155. Menard incorporates by reference its answers to the allegations in Paragraphs 1-84 of the Complaint.

156. Denied.

157. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 157 of the Complaint and on that basis denies the same.

158. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 158 of the Complaint and on that basis denies the same.

159. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 159 of the Complaint and on that basis denies the same.

160. Menard lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 160 of the Complaint and on that basis denies the same.

161. Denied.

162. Denied.

163. Denied.

164. Denied.

165. Denied.

166. Denied.

SIGNIFY'S PRAYER FOR RELIEF

A. Denied.

B. Denied.

C. Denied.

D. Denied.

E. Denied.

F. Denied.

G. Denied.

H. Denied.

J. Denied.

K. Denied.

L. Denied.

M. Denied.

MENARD DEFENSES

1. The asserted patents are each invalid for failure to meet the “Conditions for patentability” of 35 U.S.C. §§ 102 and 103 because the alleged inventions thereof are taught by, suggested by, and/or obvious in view of the prior art, and no claim of the Patents-in-Suit can be validly construed to cover any Menard product.

2. The Patents-in-Suit are each invalid for failure to meet one or more requirements under 35 U.S.C. § 112, including not limited to the “Specification” requirements because the specifications thereof do not contain written descriptions of the alleged inventions and of the manner and process of making and using them in the form required by Section 112; do not conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention; and no claim of the asserted patents can be validly construed to cover any Menard product.

4. Signify’s claims for relief are barred, in whole or in part, by the failure of Signify, its predecessor(s)-in-interest, and/or its licensees to comply with the marking and/or notice provisions of 35 U.S.C. § 287.

5. By reason of admissions, arguments, and/or amendments made by or on behalf of the applicants during the proceedings in the U.S. Patent and Trademark Office during prosecution of each of the applications that resulted in the issuance of the asserted patents,

Signify is estopped, in whole or in part, from construing any claim of the Patents-in-Suit to include any Menard product under the doctrine of prosecution history estoppel.

6. Signify's claims for relief and prayer for damages are limited by 35 U.S.C. §§ 286 and 287. Signify's recovery of costs is limited by 35 U.S.C. § 288.

7. Failure to join a party under Rule 19 of the Federal Rules of Civil Procedure.

8. Failure to name a real party in interest.

9. Menard's suppliers will indemnify and defend Menard in this action. The suppliers will be added to this action in due course.

10. Menard reserves all affirmative defenses permitted under the Federal Rules of Civil Procedure, the patent laws of the United States, and/or at law or in equity, that may now exist or in the future be available based on discovery and further investigation in this case.

PRAYER FOR RELIEF

11. Wherefore, Menard respectfully requests that judgment be entered in its favor and against Signify as follows:

A. That Signify take nothing by way of its Complaint;

B. That judgment be entered in favor of Menard and that Signify's Complaint be dismissed with prejudice;

C. That judgment be entered declaring that Menard has not infringed and does not infringe any claim of the Patents-in-Suit, literally or under the doctrine of equivalents, willfully or otherwise;

D. That judgment be entered declaring the Patents-in-Suit are invalid and unenforceable;

E. That judgment be entered declaring Signify is not entitled to damages for any alleged infringement of the Patents-in-Suit;

F. That judgment be entered declaring that Signify is not entitled to injunctive relief against Menard, its owners, officers, directors, managers, members, employees, agents, representatives, successors, affiliates, subsidiaries and assigns for any alleged infringement of the Patents-in-Suit;

G. That this be declared an exceptional case and judgment be entered awarding Menard its reasonable attorneys' fees and costs; and

H. Such other and further relief as the Court may deem appropriate.

DEMAND FOR JURY TRIAL

Pursuant to Federal Rule of Civil Procedure 38, Menard demands a trial by jury on all issues triable of right by a jury.

Respectfully submitted,

s/ Charles J. Meyer

Charles J. Meyer

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(317) 637-7561 - Facsimile

Attorney for Menard, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on October 19, 2023, I electronically filed the foregoing document with the Clerk of Court using the CM/ECF system which will send notification of such filing via electronic mail to all counsel of record.

s/ Charles J. Meyer