

**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; CANARM, LTD.;
TEST RITE PRODUCTS CORPORATION,

Third-Party Defendants.

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

District Judge: James D. Peterson

Magistrate Judge: Stephen L. Crocker

**PLAINTIFFS' FIRST SET OF REQUESTS FOR PRODUCTION
TO THIRD-PARTY DEFENDANT
LUMINEX INTERNATIONAL COMPANY, LTD. (NOS. 1-24)**

Pursuant to Rules 26 and 34 of the Federal Rules of Civil Procedure, Plaintiffs Signify North America Corporation and Signify Holding B.V. (collectively, "Plaintiffs" or "Signify") hereby request that Third-Party Defendant Luminex International Company, Ltd. ("Luminex") produce for inspection and copying the Documents and Things identified below, in accordance with those rules and the Definitions and Instructions provided herein, within thirty (30) days of

the service at the offices of Venable LLP, 600 Massachusetts Avenue, NW, Washington, DC 20001, or at such other location and time as the Parties may agree. The Requests herein are to be read, interpreted, and responded to with reference to each of the instructions and definitions set forth below.

DEFINITIONS

1. The terms “Luminex International Company, Ltd.,” “Luminex,” “Third-Party Defendant,” “You,” and “Your” mean Luminex International Company, Ltd., its predecessors and successors, parents, subsidiaries, divisions, and affiliated companies, and all past and present directors, officers, employees, agents, representatives, consultants and attorneys of the foregoing.

2. The terms “Menard, Inc.,” “Menard,” “Menards,” and “Defendant” mean Defendant Menard, Inc., its predecessors and successors, parents, subsidiaries, divisions, and affiliated companies, and all past and present directors, officers, employees, agents, representatives, consultants and attorneys of the foregoing.

3. The terms “Signify” and “Plaintiffs” mean Plaintiffs Signify North America Corporation and Signify Holding B.V., collectively, including their predecessors and successors, parents, subsidiaries, divisions and affiliated companies, and all past and present directors, officers, employees, agents, representatives, consultants and attorneys of the foregoing.

4. The term “this Action” means the above-captioned case, Case No. 3:22-cv-00706-jdp (W.D. Wisc.) (formerly Case No. 1:22-cv-01447-JPC (N.D. Ohio)).

5. The term “Infringement Contentions” means Signify’s Initial Infringement Contentions served in this Action on October 31, 2022, and any and all amendments and supplementations thereto, including without limitation Signify’s First Amended Infringement Contentions served on October 19, 2023.

6. The term “’399 Patent” means U.S. Patent No. 7,038,399.
7. The term “’554 Patent” means U.S. Patent No. 7,256,554.
8. The term “’643 Patent” means U.S. Patent No. 7,737,643.
9. The term “’604 Patent” means U.S. Patent No. 7,348,604.
10. The term “’506 Patent” means U.S. Patent No. 7,658,506.
11. The term “’336 Patent” means U.S. Patent No. 10,299,336.
12. The terms “Asserted Patents” and “Patents-in-Suit” mean the ’399 Patent, ’554 Patent, ’643 Patent, ’604 Patent, ’506 Patent, and ’336 Patent, collectively.
13. The term “Asserted Claim” means any claim of the Asserted Patents that Signify alleges has been or is currently being infringed by any Menards Accused Product (as defined below), including any such claims identified in Signify’s Complaint, Signify’s Infringement Contentions, and any amendments and/or supplementations thereto.
14. The term “relevant timeframe” as used herein means the timeframe beginning on the date six years prior to the filing of the original Complaint in this Action to the present—i.e., August 12, 2016.
15. The term “Menards Accused Products” means any and all products that Signify has identified and accused of infringing one or more Asserted Patents in this Action—including any such products identified in Signify’s Complaint, Signify’s Infringement Contentions, and any amendments and/or supplementations thereto—and any and all such products that have been or will be marketed, offered for sale and/or sold in the United States under a SKU, model number and/or product name different from the SKU, model number and/or product name identified in Signify’s Infringement Contentions.

16. The term “Luminex Relevant Products” means any and all products, devices, and/or components thereof that Luminex manufactures for, sells to, delivers to, supplies to, or otherwise provides to Menard that constitute, comprise, or otherwise relate to (in whole or in part) any Menards Accused Products. “Luminex Relevant Products” include, without limitation, any and all products, devices, and/or components identified by Menard as “Luminex Infringing Products” in its Third Party Complaint (D.I. 20), and any amendments and/or supplementations thereto, including SKU#s 348-2182, 349-0502, 349-0503, 349-0514, 349-0517, 349-0519, 349-0526, 349-1199, 349-1202, 349-1342, 349-1343, 349-1348, 349-1349, 349-1352, 349-1362, 349-2134, 349-2135, 351-0008, 351-4739, 351-8792, 352-5810, 352-5811, 352-5812, 352-5813, 352-5814, 352-5815, 352-5838, 352-5839, 352-5840, 352-5841, 356-9422, 356-9423, and 356-9450, and any and all other products, devices, and/or components that Menard identifies as “Luminex Infringing Products” (including any Menards Accused Products supplied to Menard, in whole or in part, by Luminex) in this lawsuit.

17. The term “Third Party Vendor” as used herein shall mean all entities involved in the design, development, manufacture and/or supply of any Luminex Relevant Products (or components thereof).

18. The term “supplied” shall include delivered, tendered, transferred, provided or otherwise made available for possession, custody or control.

19. The terms “any” and “all” shall include “each and every.”

20. The terms “Relate to,” “related to” or “relating to” mean embodying, pertaining, concerning, involving, constituting, commenting upon, comprising, reflecting, discussing, evidencing, mentioning, referring to, consisting of, responding to, or having any logical or factual connection whatsoever with the subject matter in question.

21. The term “Identify” when used with reference to a Person means his/her full name and present and last known business address or residence address, his/her present and last known employment position, including a description of his/her duties and responsibilities.

22. The term “Identify” when used with reference to a date means specify the month, day, and year.

23. The term “Identify” when used with reference to a Document means specify the month, day, and year the Document was created, the author(s) and recipient(s) of the Document, the production number(s), and the location of all copies of the Documents.

24. The term “Person” means any natural person or any business, legal, or governmental entity or association, including, but not limited to, any individual, company, corporation, division, joint venture, partnership, unincorporated association, or other entity.

25. The term “Document” means all documents, written communications or electronically stored information (whether “originals” or “duplicates”), whether a draft, or a copy, however reproduced – including writings, drawings, graphs, charts, photographs, sound recordings, images, communications, studies, data, declarations, notes and memoranda, minutes, summaries, negotiations, financial records and other data or data compilations stored in any medium from which information can be obtained, and is defined to be synonymous in meaning and equal in scope to the usage of this term in Federal Rule of Civil Procedure 34, including but not limited to the examples set forth in Federal Rules of Evidence 1001. Any document with any marks such as initials, comments, or notations of any kind is not deemed to be identical to one without such marks and is to be identified and/or produced as a separate document.

26. The term “Thing” has the meaning prescribed in Federal Rule of Civil Procedure 34, and includes every kind of physical specimen or tangible item, other than a document, in the possession, custody or control of Plaintiff.

27. The term “Communication” means every manner of disclosure, transfer, or exchange of information whether orally or by document or whether face-to-face, by telephone, mail, e-mail, telegram, telex, or telefax, personal delivery or otherwise.

28. The term “Concerning” means relating to, referring to, describing, evidencing or constituting.

29. The term “Product” means a machine, apparatus, device, instrument, mechanism, appliance, assembly, algorithm, software, system, program, component, part, or assemblage of components/parts (either individually or collectively) which are designed to function together electrically, mechanically, electronically (including the method of use or operation of such product or equipment) or otherwise, to achieve a particular function or purpose.

30. The term “Inventor” means a named inventor of an Asserted Patent.

31. The term “License” means any license, sublicense, cross-license, release, grant of manufacturing rights, agreement, transfer of rights, contract, or undertaking pursuant to which You have licensed or received any right to one or more patents or related applications. The term “License” includes any covenants not to sue or covenants not to assert.

32. The term “Transfer of Rights” means an assignment, license, sublicense, cross-license, release, covenant not to sue, grant of manufacturing rights, or grant of any other rights in a patent or patent application, domestic or foreign, whether alone or in combination with other consideration.

33. “Infringe” and “infringement” refer to direct infringement, contributory infringement, inducement of infringement, literal infringement, and/or infringement under the doctrine of equivalents or any other infringement actionable under United States law.

34. “Prior Art” is used herein in the same sense that it is used in 35 U.S.C. §§ 102 and 103, and includes any patent, printed publication, product, process, prior knowledge, prior use, prior sale or offer for sale, or other act or event as defined in 35 U.S.C. § 102, taken singly or in combination.

35. The words “and” or “or” shall be construed conjunctively or disjunctively, whichever makes the request more inclusive.

INSTRUCTIONS

1. Unless otherwise specified above, the meanings to be used when interpreting these Requests is the commonly accepted definition of the term in the context of the Request with the understanding that each word, term, or phrase used in these Requests is intended to have the broadest possible meaning under the Federal Rules of Civil Procedure. If You find the meaning of any term in these Requests unclear, then You shall construe the term so as to render responsive any information, document, thing, or communication that might otherwise be rendered non-responsive.

2. If any Request cannot be answered in full, it must be answered to the extent possible, with a specification of the reasons for your inability to answer the remainder.

3. If a document required to be identified has been destroyed, lost, discarded, or is otherwise no longer in Your possession, custody, or control, you shall identify such document as completely as possible, including, without limitation, the following information: (i) date of

disposal; (ii) manner of disposal; (iii) reason for disposal; (iv) person authorizing the disposal; and (v) person disposing of the document.

4. In the event You object to any Request in whole or in part on the ground that the information sought is protected from discovery under the attorney-client privilege, work product immunity, or is otherwise not discoverable, You shall state in detail the basis for the claim that such information is privileged or otherwise not discoverable. In the event You object to the production of any document or thing in response to a Request on the ground that it is protected from discovery under the attorney-client privilege or work product immunity or is otherwise not discoverable, You shall identify each such document or thing and describe the basis of the claim with sufficient specificity to allow Signify to determine whether to seek a privilege log (the form of which to be specified by the Parties pursuant to Fed. R. Civ. P. 26(b)(5)), or further remedies from the Court.

5. These discovery requests are deemed to be continuing in nature so as to require amended and supplemented responses to the extent called for by Rule 26(e) of the Federal Rules of Civil Procedure. If You acquire additional knowledge or information with respect to any of these requests after service of your responses, You shall serve a supplemental and/or amended response to each such discovery as required by Rule 26(e) entered by the court and in no event later than thirty (30) days after acquiring the additional knowledge or information.

6. References to companies, corporations, partnerships, unincorporated associations, or other entities include each director, officer, employee, agent, attorney, representative, instrumentality, parent, subsidiary, division, subdivision, affiliate, joint venture, component, or unit thereof.

7. The singular form of a word should be interpreted in the plural as well. Any

pronoun shall be construed to refer to the masculine, feminine or neuter gender as is most appropriate in each case.

8. These Requests seek all information that is known to You, Your representatives, agents, employees, investigators, consultants, and, unless privileged, their counsel, and any third party with which you have an ability or right (contractual or otherwise) to obtain information from.

9. Use of the past tense includes the present tense unless otherwise explicitly delimited.

10. Unless otherwise indicated in a particular request, the request is not date or time limited.

11. Definitions or usages or words or phrases in these Requests are not intended to be, and shall not be, construed as admissions as to the meaning or words or phrases at issue in the action, and shall have no binding effect on any defendant in this or any other proceeding.

PLAINTIFFS' FIRST SET OF REQUESTS FOR PRODUCTION

REQUEST FOR PRODUCTION NO. 1:

Documents sufficient to identify each designation for each Luminex Relevant Product, including, e.g., each Menard SKU, Luminex SKU, model number, product name, catalog number, code name, and internal project name, used or associated with each Luminex Relevant Product during the relevant timeframe.

REQUEST FOR PRODUCTION NO. 2:

Documents sufficient to identify the date on which each Luminex Relevant Product was first supplied to Menard.

REQUEST FOR PRODUCTION NO. 3:

Documents sufficient to identify all Third Party Vendors (including designers, developers, manufacturers, suppliers, distributors, retailers, or resellers) that are or were involved in the design, development, manufacture and/or supply to Luminex or Menard of any Luminex Relevant Products.

REQUEST FOR PRODUCTION NO. 4:

All Documents and Things referring or relating to Luminex's obligations and/or agreements to supply Luminex Relevant Products to Menard, including without limitation all contracts and agreements between Menard and Luminex, all Documents describing the terms of any manufacture and/or supply agreements between Menard and Luminex (and any supplementations, amendments and/or modifications thereto), all Documents setting forth the identity, number of units and price of any Luminex Relevant Products that Luminex has supplied to Menard, and any correspondence relating thereto.

REQUEST FOR PRODUCTION NO. 5:

All Documents and Things considered, referred to or relied upon in preparing Your Answer to Menard's Third Party Complaint and/or Your Affirmative Defenses and Cross-Claims Against Plaintiffs (ECF No. 159), or any amendments or supplementations thereto, or other pleading later filed by You, including but not limited to, all documents and things on which You base Your allegations, contentions, and any Affirmative Defenses and Cross-Claims against Signify, and any documents which tend to support or undermine any of the Affirmative Defenses and Cross-Claims against Signify identified in Your Answer.

REQUEST FOR PRODUCTION NO. 6:

All Documents and Things that you contend evince, demonstrate or otherwise support any and all of Your Affirmative Defenses and Cross-Claims Against Plaintiffs set forth in Your Answer (ECF No. 159) and any amendments or supplementations thereto, including without limitation any and all documents and things that You intend to rely on in support of any of Your Affirmative Defenses and Cross-Claims Against Plaintiffs in this Action.

REQUEST FOR PRODUCTION NO. 7:

All Documents and Things that were reviewed, considered, or relied upon during the preparation of Your responses to any Interrogatories or Requests for Admission served in this Action.

REQUEST FOR PRODUCTION NO. 8:

All Documents and Things sufficient to show the identity of the managers, directors and officers of Your engineering, marketing, research and development, and sales operations who were in any manner involved in the selection, design, procurement, development, engineering,

manufacturing, deployment, marketing, licensing, offer for sale, sale or importation of all or any part of any Luminex Relevant Product.

REQUEST FOR PRODUCTION NO. 9:

All Documents and Things, including without limitation all documents, notes, memoranda or other documents generated by You or any of Your agents, representatives, officers, directors, or employees, relating or referring to Signify or its officers, employees, products, or services.

REQUEST FOR PRODUCTION NO. 10:

All Documents and Things concerning, referring or relating to each of the Asserted Patents.

REQUEST FOR PRODUCTION NO. 11:

All Documents and Things concerning any communications or agreements between Menard and You regarding Signify, this Action, any Asserted Patents, any Menards Accused Product and/or any Luminex Relevant Product.

REQUEST FOR PRODUCTION NO. 12:

All Documents and Things sufficient to show the design, structure, operation, function, and performance of each Luminex Relevant Product, including without limitation technical documentation (such as, e.g., circuit schematics, integrated circuit datasheets, user manuals, white papers, CAD drawings, blueprints, design specifications, manufacturing specifications, engineering specifications, bills of materials (BOMs), testing protocols, test results, models, and simulations).

REQUEST FOR PRODUCTION NO. 13:

All Documents and Things concerning any effort, attempt, implementation or consideration, by or for You, to design around any claim of any Asserted Patent, including, but

not limited to, the feasibility, cost, customer acceptance and time for any such design-around, and/or any communications with Menard concerning the same.

REQUEST FOR PRODUCTION NO. 14:

All Documents and Things concerning any comparisons between any claim of any Asserted Patent and any Luminex Relevant Product made, used, sold, leased, or offered for sale in the United States, or imported into the United States, by or for You or Menard.

REQUEST FOR PRODUCTION NO. 15:

Documents sufficient to identify all sales, Licenses and Transfers of Rights of any Luminex Relevant Products to Menard, or any person, agent or third party acting on behalf of Menard, during the relevant timeframe, including units sold and, for each product sold or licensed, the quantity, the revenue, the party, and any additional information maintained at the transaction level related to those sales or licenses.

REQUEST FOR PRODUCTION NO. 16:

All Licenses and Transfers of Rights taken by Menards and/or Luminex relating to (i) any Luminex Relevant Products, (ii) the production, manufacture or supply of any Luminex Relevant Products, or (iii) any components, LED-related technology or functionality used or contained within any Luminex Relevant Products.

REQUEST FOR PRODUCTION NO. 17:

All sales forecasts, revenue forecasts, and unit sales forecasts for each of the Luminex Relevant Products.

REQUEST FOR PRODUCTION NO. 18:

All marketing materials, advertisements, promotional materials, product descriptions, price lists, catalogs, brochures, specifications sheets, press releases, website materials, or other

sales/marketing documents that concern, reference, depict, or describe any Luminex Relevant Product.

REQUEST FOR PRODUCTION NO. 19:

All Documents and Things concerning the product features that are or were demanded or desired by Menard, consumers, businesses, customers, advertisers, or advertising agencies related to the Luminex Relevant Products, or that otherwise drive or influence any sales of any Luminex Relevant Products, including any surveys related thereto.

REQUEST FOR PRODUCTION NO. 20:

All Documents and Things relating to any Licenses, Transfer of Rights, license offers and/or agreements that pertain to LED lighting technology.

REQUEST FOR PRODUCTION NO. 21:

All Licenses, Transfer of Rights, license offers and/or agreements that involve patents that are comparable to any of the Asserted Patents or pertain to technology related to the accused LED lighting designs or functionalities.

REQUEST FOR PRODUCTION NO. 22:

All Documents and Things evidencing or otherwise related to any non-infringing alternative to any of the inventions claimed in the Asserted Patents, including, but not limited to, any documents upon which You intend to rely upon to establish the existence and/or availability of a non-infringing alternative to any of the inventions claimed in the Asserted Patents.

REQUEST FOR PRODUCTION NO. 23:

All Documents and Things concerning or reflecting Your initial awareness and/or knowledge of each of the Asserted Patents.

REQUEST FOR PRODUCTION NO. 24:

All Documents and Things concerning Your request for “[a] finding that this case is exceptional under 35 U.S.C. § 285, and an award of attorneys’ fees to Luminex,” as set forth in Luminex’s Prayer for Relief, paragraph E, of Your Answer (ECF No. 159 at 126), including all evidence that you contend supports this request.

Date: October 25, 2023

By: /s/ Jason M. Dorsky

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that this document is being served upon counsel of record for Third-Party Defendant Luminex International Company, Ltd. on October 25, 2023, via electronic service.

By: /s/ Jason M. Dorsky

Jason M. Dorsky