

UNITED STATES DISTRICT COURT  
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*

**Civil Action No. 3:22-cv-00706**

District Judge James D. Peterson

Magistrate Judge: Stephen L. Crocker

**DEFENDANT’S RESPONSE IN OPPOSITION TO PLAINTIFFS’ MOTION FOR  
LEAVE TO SERVE SECOND AMENDED INFRINGEMENT CONTENTIONS**

Defendant Menard, Inc. (“Menard<sup>1</sup>”) files this response in opposition to Plaintiffs’ Signify North America Corporation’s and Signify Holding B.V.’s (hereafter collectively, “Signify”) Motion For Leave To Serve Second Amended Infringement Contentions.

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<sup>1</sup> Menard and the various third-party defendants are collectively referred to herein as “the Defendants.”

## I. INTRODUCTION

Pursuant to the Court's Scheduling Order (Dkt. 193), any amendments to the parties' substantive contentions require leave of the Court if made after the date for amendments to the pleadings, or October 19, 2023. The Court warned the parties that it "will be increasingly reluctant to allow amendments as the deadline for expert disclosures approaches." Dkt. 193, pg. 2. On October 19, 2023, Signify amended its infringement contentions to add additional accused products, all based upon publicly available information. Now, six (6) months later and on the eve of expert disclosures, Signify is attempting to add even more accused products - *the fifth time* it has done so since this dispute began - again based only on publicly available information. Signify is also attempting to add new infringement arguments, primarily to remedy deficiencies in the representative product arguments included in its First Amended Infringement Contentions.

Signify wrongfully blames Menard for its delay in this latest attempt to expand the case, despite having all of the information necessary for the proposed amendments for at least a year. And while Signify attempts to gloss over the source of information upon which these amendments are based, the truth remains: These latest amendments *are not* based on any newly discovered or recently produced information. Rather, all of the publicly available information that Signify relies on for its current, out-of-time proposed second amendment was available to Signify well before its previous amendment of October 19, 2023. Signify had—or in the exercise of minimal diligence should have had—ample access to this information to amend its infringement contentions far earlier.

Allowing Signify to amend its infringement contentions at this late stage, adding new accused products and additional infringement arguments, will severely prejudice the Defendants. Signify has taken a piecemeal approach to identifying the accused products in this case, with this

latest attempt to add new products being the fifth time they have sought to do so since this dispute first began. Signify continues to move the goalposts as to which products it is accusing, forcing the Defendants to constantly play catch up as they attempt to marshal their defenses. At this late stage in the proceedings, after the parties have already proposed claim constructions and on the eve of opening expert technical reports, the Defendants would be unduly prejudiced by having to yet again review a new set of accused products and expend the resources necessary to defend themselves against such allegations.<sup>2</sup>

## II. RELEVANT BACKGROUND

This case is at an advanced stage. The parties have already exchanged proposed claim terms for construction. Opening technical expert disclosures are due in less than two weeks. And this is not a simple case. Signify has sought to continuously add additional accused products since this dispute first began in 2021. At that time, Signify identified only 12 products to Menard. In the three years since, Signify has introduced more than 140 accused products into the case, including the addition of numerous products in its First Amended Infringement Contentions served on October 19, 2023 pursuant to the Court's Scheduling Order (Dkt. 193). Signify now seeks to raise the number of accused products to more than 170. At such an advanced stage of the proceedings, the parties should be seeking to narrow the dispute; not expand it.

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<sup>2</sup> Initial technical expert disclosures were scheduled for exchange on March 29, 2024. At Signify's request, the Defendants agreed to a one month extension for all technical expert disclosure deadlines, which the Court granted on March 18, 2024. (Dkt. 254.) Signify did not provide its proposed second amendments to their infringement contentions until the following day, March 19, 2024—just 10 days prior to the original deadline for opening technical expert disclosures. Without this extension, which Defendants agreed to at Signify's insistence, it is difficult to imagine how Signify would have sought to justify the inclusion of the newly added products to its opening technical expert disclosures on infringement.

Signify's statements that it lacked notice of the Defendants' position regarding the allegedly representative products charted in Signify's infringement contentions require correction. Signify states that it "had no way of knowing what ... representativeness positions Menard and the third-party defendants would choose to advance." (Dkt. 255 at 17.) This is false. The Defendants put Signify on notice of their opposition to Signify's charting of allegedly representative products for only certain third-party suppliers' products on numerous occasions, beginning *more than one year ago*. (Dkt. 128 at 22.) In fact, Signify acknowledged the Defendants' position on representativeness in the parties' joint Rule 26(f) report filed with the Court on March 3, 2023. And one of the third-party defendants, Luminex, independently identified the representativeness issue in its Crossclaims against Signify on April 10, 2023, and then referenced back to these statements in its November 2023 interrogatory responses. Signify's assertion that it was unaware of the Defendants' representativeness position is simply not true.

### **III. LEGAL STANDARD**

Litigants must commit to their substantive contentions early on in a case so as to avoid prejudicing the other party. Dkt. 193, pg. 2; *see Douglas Dynamics, LLC v. Meyer Prods. LLC*, 2017 U.S. Dist. LEXIS 82166, \*7 (W.D. Wis. 2017). Once the deadline for amending pleadings has passed, as it has here, then the Scheduling Order dictates that any further amendments to the parties' contentions require leave of the Court pursuant to FRCP 15. (Dkt. 193 at 2.) And "district courts have broad discretion to deny leave to amend" such as where there is "undue delay" or "undue prejudice to the defendants." *Arreola v. Godinez*, 546 F.3d 788, 796 (7th Cir. 2008); *see also Fin. Fiduciaries, LLC v. Gannett Co.*, 46 F.4th 654, 667-68 (7th Cir. 2022). This Court has previously denied a plaintiff's motion to amend infringement contentions under similar

circumstances. In *Ascion, LLC v. Ashley Furniture Indus., Inc.*, the plaintiff sought to amend its infringement contentions to add additional accused products and infringement theories. No. 19-cv-856-jdp, Dkt. 66 at 1 (W.D. Wis. Oct. 23, 2020) (Judge Peterson). Plaintiff sought to make such amendments despite having come into possession of the new products it sought to add more than six (6) months previously, prior to expert disclosures. *Id.* This Court noted that in “patent infringement cases, the court grows increasingly reluctant to allow amendments to infringement contentions as other case deadlines approach.” *Id.*; *see also Douglas Dynamics, LLC v. Meyer Prods. LLC*, 2017 U.S. Dist. LEXIS 82166, \*8 (W.D. Wis. 2017) (Judge Peterson) (“The reason for this warning is that as the case progresses, changes to core substantive contentions are increasingly prejudicial to the other side.”). The plaintiff’s delay in seeking to amend its infringement contentions resulted in “inevitable” prejudice to the defendant. *Ascion*, Dkt. 66 at 2. As this Court found, “[i]f the new infringement contentions were allowed, [the defendant] would be entitled to update its prior art investigations, invalidity contentions, and claim construction positions. And that would require updated expert reports.” *Id.*

#### IV. ARGUMENT

##### A. Signify Fails To Identify Any New Information Produced By The Defendants Necessitating The Addition Of New Products

Signify spends a significant portion of its brief accusing Menard of delay and citing this Court’s Order directing Menard to produce information on additional “Relevant Products” (Dkt. 252); however, *that Order is immaterial to the motion at hand - Signify’s present motion is not based on that discovery.*<sup>3</sup> Signify’s newly accused products are all based on publicly available

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<sup>3</sup> Contrary to Signify’s characterizations, the Defendants do not concede that discovery on Menard Relevant Products would justify future revisions adding additional products to this case. Signify’s interpretation that Menard “suggested” it would not oppose a motion based on the information produced in response to the Court’s Order (Dkt. 252) is simply incorrect. Dkt. 257-3

information that has been available to Signify for years. Signify readily admits that the new products and theories it seeks to introduce into the case are not based on any information recently provided by the Defendants pursuant to the Court's Order, but rather information that Signify identified "through its own ... means." (Dkt. 255 at 8.) This information has been publicly available to Signify for over a year, and in most instances, since as early as 2021.

Signify simply rests the necessity of this amendment on "positions taken by Menard and/or the third party defendants in recent discovery responses and claim construction exchanges" without *actually identifying* any of those positions. (Dkt. 255 at 4.) But all positions taken by the Defendants thus far are based on an analysis of those products previously identified by Signify. Signify should not be allowed to amend its infringement contentions to continuously add new products at this late stage, providing it a strategic advantage in crafting such later positions based on the Defendants' already identified positions. This is particularly true where, as here, *all of the information* about these newly added products was publicly available to Signify at least as of the time of its previous amendment to its infringement contentions in October 2023. That was nearly six months ago, precisely the amount of delay that this Court previously found unduly prejudicial to the defendant in *Ascion*. No. 19-cv-856-jdp, Dkt. 66 at 2.

To the extent Signify wanted to add these additional products, it should have done so long ago as it did with its previous amendment to its infringement contentions in October 2023. Indeed, Signify's infringement allegations have been a constantly moving target. While titled as Signify's "Second Amended Infringement Contentions," this is actually Signify's *fifth attempted revision* to the list of accused products. Signify's original demand letter, sent February 8, 2021, accused just 12 products of infringing Signify's patents. (Exhibit A.) In

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at 2,4. The amendments that Signify seeks are not justified now, nor would they be justified at an even later date.

August 2022, the original Complaint filed in this action identified more than 60 products. Dkt. 1. Thereafter, Signify added more than 60 additional products with its initial infringement contentions served in October 2022. (Dkt. 22; Dkt. 144.) Then in October 2023, Signify filed its “First Amended Infringement Contentions,” adding even more products, bringing the total number of accused products to more than 140. (Dkt. 204.)

Like the 140+ previously identified products, the newly proposed 31 products appear to have been identified solely based on Signify’s review of Menards.com or purchases made in Menard’s stores. For example, Menard has been selling the new products identified by SKUs 346-0884, 346-0885 and 346-0886 since at least 2019. (Exhibit B.) All 31 newly added products were sold by Menard prior to October 2023. (Exhibit C, Declaration of Jim Chapman (“Chapman Decl.”) at ¶ 3. More specifically, all 31 products were sold by Menard prior to January 2023, over 13 months ago. *Id.* In fact, 28 of the 31 products were sold by Menard in 2021 or earlier. *Id.* at ¶4. It is Menard’s standard practice to have information on its publicly available website for each of the products offered for sale by Menard during the period of time in which each product is offered for sale. *Id.* at ¶5. Signify should have and could have identified these 31 products based on the publicly available information long ago, as it did for the other 140+ products it has accused. Signify’s argument that its ability to add these products at an earlier date was “hampered due to the ever-changing and limited content available on the Menard website” (Dkt. 255 at 8) is wholly unsupported by the facts. Signify relies on *Oxbo Int’l Corp. v. H&S Mfg. Co.* in support of its proposed late amendment. But *Oxbo* is distinguishable. The plaintiff in *Oxbo* sought to amend its infringement contentions to add only a handful of claims; not to add 31 new products and dozens of new arguments as Signify does here. *Oxbo Int’l Corp.*, 2016 U.S. Dist. LEXIS 45499, at \*1. In particular, in *Oxbo* this Court stated that it was granting the motion to

amend in part due to the fact that the amendment “does not involve new patents, *new products*, or new parties.” *Id.* at 4 (emphasis added). The amendment Signify seeks here is thus the exact type of amendment which this Court indicated it would be unlikely to allow in *Oxbo* (*i.e.*, the addition of new accused products).

**B. Signify’s Assertion That The Defendants’ Responses To Signify’s Common Interrogatories 1 and 2 Necessitated The Amendment Is Incorrect**

In addition to the new products, Signify has introduced entirely new representative product arguments and charts that could have been presented long ago. It again appears these new arguments and analyses are based entirely on previously available information. Signify’s new arguments largely, if not entirely, rely upon: screenshots from Menards.com; links to menards.com; and images of product samples or documents produced by Menard nearly a year ago. Although Signify is purportedly relying on some documents that Menard produced such as its website listings, those documents are merely screen captures of listings and instruction manuals that were publicly on the website at least as early as March 2023. Signify should have and could have cited to these sources of information earlier and has no good cause for delaying this long.

Signify alleges that the new representative product arguments are made in response to objections in the Defendants’ interrogatory responses that the representative product charts did not adequately disclose Signify’s infringement contentions. Dkt. 255 at 12. Signify’s assertion that the Defendants first raised the representative product issue in their interrogatory responses on November 20, 2023 and that Signify “had no way of knowing what ... representativeness positions Menard and the third-party defendants would choose to advance” before they received the interrogatory responses (*Id.* at 17) is simply false.



Indeed, Signify acknowledged this defense over a year ago in the parties' joint Rule 26(f) report. *See* Dkt. 128, at 19:

Despite having been served with Signify's infringement contentions in October 2022, Menard asserts for the first time below that Signify cannot use representative claim charting for products provided to Menards by different manufacturers. This is incorrect, and unsupported by any legal authority. It is well established that in patent cases involving numerous accused products, infringement issues can be efficiently addressed through analysis of representative products.

Signify was responding to Defendants' position that:

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."

*Id.* at 22. This report was filed with the Court on March 3, 2023. Signify was thus placed on notice of such arguments by the Defendants *more than seven months* prior to the deadline for amending their infringement contentions as a matter of right pursuant to the scheduling order.

Further, Signify cites Luminex's interrogatory responses (amongst the other Defendants') as alleged evidence that it first learned of Luminex's representative product defense on November 20, 2023. But, Luminex also independently identified the representative product issue in its Crossclaims on April 10, 2023. *See, e.g.*, Dkt. 159 (Luminex's Amended Answer and Crossclaims), at 108:

Moreover, Signify has accused seven of the Luminex Accused Products of infringing the asserted claims of the '554 Patent, however, Signify has not charted any Luminex Accused Products with respect to the asserted claims of the '554 Patent. Signify has not met its burden because it has not identified how any of the Luminex Accused Products infringe any asserted claims of the '554 Patent.

*see also, id.*, at 112-113, & 120 (similar). In fact, Luminex repeatedly referred to its Crossclaims nearly a dozen separate times in the very interrogatory responses that Signify cites in its motion.

*See e.g.*, Dkt. 257-9 (Luminex's Objections and Responses to Signify's First Set of Common

Interrogatories), at 23 (“This is particularly true where, as here, the lone product that Signify has charted as representative of the accused products (SKUs 349-2135 and 351-8792) is not even manufactured by Luminex. Luminex identified this deficiency in its Answer and Cross-Claims, yet Signify has still failed to actually analyze or chart any Luminex Accused Products as representative of the following product SKUs: 349-2135 and 351-8792.”); *see also, Id.*, at 9, 12-13, 17-18, 20-21, 25-28.

Signify has been aware of the deficiencies in its infringement contentions raised by the Defendants for over a year. Signify fails to articulate a *bona fide* reason for its delay in providing these revisions in response to Defendants’ objections.

Finally, Signify broadly asserts that the amendments are necessitated by new non-infringement theories in response to Signify’s Common Interrogatories 1 and 2.<sup>4</sup> Yet again, Signify fails to provide or explain even a single factual example to support its position.

### **C. The Proposed Amendments Will Prejudice Menard And The Third-Party Defendants**

Signify’s assertion that Menard is trying to artificially limit the number of products in the case is incorrect. Menard and, by extension, the Third-Party Defendants, are grappling to get a firm grasp on the products accused in this case so that appropriate litigation strategy and positions may be developed. However, this has been nearly impossible due to Signify continually moving the target of accused products.

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<sup>4</sup> On April 9, more than a week after filing its motion, Signify sent a letter to the Defendants alleging deficiencies in Defendants’ responses to interrogatories 1 and 2 - the very same interrogatory responses on which Signify bases its arguments in its motion. And while the Court has not yet ruled on Signify’s motion, Signify is already treating its Second Amended Infringement Contentions as if they have been admitted, attempting to pressure the Defendants into amending their interrogatory responses so as to address the additional products Signify seeks to introduce into the case *via this very motion*. And even more recently, on April 11, Signify informed the Defendants of its intention to amend its previously proposed claim constructions.

First, Signify included 60+ products in its Complaint. Then, Signify added 60+ additional products in its infringement contentions in October 2022. Finally, six months ago, unopposed by the Defendants due to the timing of the amendment, Signify added even more products to the case. To date, including in the currently proposed amendments, Signify has exclusively used publicly available information to identify products that allegedly infringe the patents-in-suit. Signify could have and should have identified these products earlier. If Signify is permitted to continually move the goalposts in this case, it will significantly prejudice the Defendants' ability to prepare its litigation strategy and expert reports.

In *Oxbo* and *Douglas Dynamic*, this Court indicated that attempting to amend infringement contentions at such a late stage in the proceedings, such as after claim construction disclosure deadlines have passed, is prejudicial to a defendant and supports rejecting a motion to amend infringement contentions. *Oxbo Int'l Corp.*, 2016 U.S. Dist. LEXIS 45499, at \*4; *Douglas Dynamics, LLC*, 2017 U.S. Dist. LEXIS 82166, at \*8. In *Douglas Dynamics* in particular, this Court rejected the plaintiff's motion to amend its infringement contentions, reasoning in part that proposed amendments occurring after the exchange of proposed claim constructions and approximately a month from expert disclosures "are unavoidably prejudicial." *Douglas Dynamics, LLC*, 2017 U.S. Dist. LEXIS 82166, at \*8.

The parties exchanged proposed constructions more than three months ago on January 12, 2024. These claim constructions disclosures were made based on those products that the Defendants understood to be accused of infringement at the time the disclosures were due. The Defendants did not have an opportunity to analyze the additional 31 products when preparing their proposed constructions. For all the Defendants know, the new products Signify is now proposing to include in its infringement contentions are made in view of Defendants' proposed

claim constructions, and could have further implications on Defendants' invalidity contentions as well. In fact, Signify just recently informed the Defendants on April 11, 2024 that it will seek to amend its proposed claim constructions. (Exhibit D.) In addition to the parties already exchanging proposed claim constructions, opening expert reports are due in *less than two weeks*. The circumstances present here are thus even more "unavoidably prejudicial" than those present in *Douglas Dynamics*.

Signify also provides zero explanation for how the Defendants' claim construction positions necessitate the amendment. In *Douglas Dynamic*, this Court denied a motion to amend stating, "[Plaintiff] contends that its amendments are necessary to respond to the amended claim constructions proposed by [Defendant]. But [Plaintiff] does not explain how [Defendant]'s constructions necessitate any amendment." *Douglas Dynamics, LLC*, 2017 U.S. Dist. LEXIS 82166, at \*8. Similarly, Signify makes no attempt to explain how Menard and the Third-Party Defendants' claim construction positions necessitate any amendment, beyond stating that Menard and the Third-Party Defendants proposed constructions for various terms. This falls well short of the standard to amend that this Court applies.

Further, the newly-accused products are from multiple manufacturers, and presumably have different structures and different technical details that may differ from the products currently in the case. The new products will likely require significant new analyses, further prejudicing the Defendants who have been diligently preparing their litigation strategy based on the 140+ products already accused. *See Ascion*, No. 19-cv-856-jdp, Dkt. 66 at 2 (denying the plaintiff's attempt to amend infringement contentions where they "involve new applications of the claim elements to different structures," and were not "simply identifying new products that use the previously accused assemblies"). The likelihood that additional analyses will be needed

is further supported by the fact that Signify has included entirely new claim charts. For example, claim charts B-9 through B-11 were not included in Signify's October 2023 iteration of its infringement contentions. Dkt. 204-1 at 29-30; Dkt. 256-1 at 35-36; Dkt. 256-10; Dkt. 256-11; Dkt. 256-12.

## V. CONCLUSION

Due to the unreasonable delay of the proposed amendments and the undue prejudice to the Defendants, Signify's Motion For Leave To Serve Second Amended Infringement Contentions should be denied.

Respectfully submitted,

s/Charles J. Meyer

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## CERTIFICATE OF SERVICE

I hereby certify that on April 16, 2024, the foregoing document was electronically filed 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

Charles J. Meyer