

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Luminex International Company, Ltd.

Petitioner,

v.

Signify Holdings B.V.

Patent Owner

IPR2024-00101

Patent 10,299,336

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION FOR
ADDITIONAL DISCOVERY**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE REQUESTED DISCOVERY IS NOT IN THE INTERESTS OF JUSTICE	2
A.	Factor 1: More Than a Possibility and Mere Allegation	2
B.	Factor 2: Litigation Positions and Underlying Basis	5
C.	Factor 3: Ability to Generate Equivalent Information by Other Means	6
D.	Factors 4 and 5: Easily Understandable Instructions and Requests Not Overly Burdensome to Answer	9
III.	CONCLUSION	10

I. INTRODUCTION

Signify, desperate to avoid addressing the substance of this IPR, continues to waste the parties' and the Board's resources with unmeritorious arguments. The Director, upon reviewing the most relevant evidence, has already rejected Signify's RPI theory. Paper 20 (Director Review Supplemental Opinion) at 8-20. Yet Signify now seeks sweeping discovery, spanning six pages of requests for production ("RFPs"), hoping to find something new to support its RPI theory.

But Signify fails to show beyond speculation that its expansive requests will uncover anything useful on the RPI issue, particularly in view of Luminex's and Menard's independent certifications that Menard had no involvement in this IPR. Paper 8 (Reply to POPR) at 3-4 (Luminex "filed this IPR through its own counsel, at its own cost, to assert its own interests"); Ex. 2023. Luminex filed this IPR to protect its owner's patent portfolio and the licensees of those patents.¹

Rather than propounding targeted requests based on documents already in its possession, Signify demands wide swaths of information (*e.g.*, "**All** documents and **all** Communications") dating back to February 2021, when it first wrote to Menard regarding alleged infringement of 19 different patents. The broad scope of

¹ Mr. Chen, Luminex's sole owner, has a strong patent portfolio, with over 70 CCT-related patents, that is licensed to other LED-related companies.

Signify’s RFPs, which inevitably implicate Luminex’s litigation positions and privileged communications, confirms that this is a classic fishing expedition.

Further, Signify concedes that it already has access to many of the documents it seeks, or could have accessed them, via district court discovery, which ran for about a year from the filing of this IPR. “Whether the documents may be cited in this IPR (under a protective order, for example) is a different matter,” and certainly does not support granting Signify’s motion. *Cellco v. General Access*, IPR2023-00978, Paper 14 at 11-12 (September 15, 2023). Signify also provides no answer for its failure to seek the requested information over this year-long period.

The Board should deny Signify’s motion for additional discovery.²

II. THE REQUESTED DISCOVERY IS NOT IN THE INTERESTS OF JUSTICE

The party requesting additional discovery must show that its request is in the “interests of justice” per the *Garmin* factors. 37 C.F.R. § 42.51(b)(2); *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6-7 (March 5, 2013) (precedential). As explained below, *Garmin* mandates denial of Signify’s motion.

A. Factor 1: More Than a Possibility and Mere Allegation

“The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.”

² Luminex reserves the right to seek costs for opposing this motion.

Garmin at 6. Useful “does not mean merely ‘relevant’ and/or ‘admissible’”—rather, it means “favorable in substantive value to a contention of the party moving for discovery.” *Id.* And here, useful information is that tending to show beyond speculation that Menard had a role in the filing of this IPR, or that Menard is funding or controlling this IPR. *See Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018, 1027-28 (Fed. Cir. 2021) (Relevant considerations to RPI determination include “whether a party exercises or could exercise control over a petitioner’s participation in a proceeding, or whether a party is funding the proceeding or directing the proceeding.”). Signify fails to meet this burden for each of its RFPs because it presents no evidence suggesting that Menard had any involvement in this IPR.

Regarding RFPs 1-2, Signify’s citation to pre-suit communications does not rise above speculation. Paper 18 at 4. These pre-suit communications show that Signify first emailed Menard almost three years before this IPR was filed, asserting 19 different patents against 12 products. Ex. 2015. Because Luminex had supplied some of these accused products, Menard relayed Signify’s allegations to Luminex, reminding Luminex of its indemnification obligation, and Luminex responded to Signify, seeking to understand the allegations. *See* Exs. 2016, 2017, 2018. Contrary to Signify’s assertion, these communications do not show Menard’s involvement in this IPR; they show routine customer-supplier communications in response to infringement allegations. These communications do not specifically discuss the

'336 Patent or plans to file an IPR against this Patent, and Signify does not provide any rationale as to how these communications, dating back almost three years before the filing of this IPR and discussing 19 different patents, bear on the RPI issue.

Regarding RFP 3, the indemnification agreement between Luminex and Menard does not show beyond speculation that anything useful pertaining to the RPI issue will be uncovered. Paper 18 at 6. The Director, upon reviewing the exact indemnification obligation from this agreement, has already determined that Menard is not an RPI. Paper 20 at 11-13; Paper 6 (POPR) at 2 (citing the indemnification obligation verbatim); Ex. 3003 at 4-5 (citing the indemnification obligation verbatim). The indemnification agreement is a standard, boilerplate agreement, identical to the ones that Menard has with the 14 other suppliers involved in the litigation, that neither contemplates an IPR, nor gives Menard the ability to control, direct, or fund any IPR. *Wavemarket v. Locationet*, IPR2014-00199, Paper 34 at 5-6 (August 11, 2014) (denying request for additional discovery based on “the admitted existence of indemnification obligations” because it “does not demonstrate beyond speculation that something useful will be uncovered regarding [the alleged RPIs’] funding, direction, control, or ability to exercise control of [the IPR]”).

With respect to RFPs 4-8, Signify does not even attempt to provide any supporting evidence, or explain how the requested information allegedly would be “useful” on the RPI issue. Regarding RFP 4, Signify’s bare assertion that

“communications between Menard and Luminex regarding the Petition are highly relevant” (Paper 18 at 6) ignores that Luminex has already certified, under its duty of candor, that Menard had no role in filing this IPR, and is not controlling or funding this IPR. Paper 8 at 3-4. Menard has made the same certification. Ex. 2023.

With respect to RFPs 5 and 8, although Signify asserts that the district court ordered Luminex and Menard “to coordinate a litigation strategy whenever possible” (Paper 18 at 7), Signify does not explain how the order, which was limited to the district court and did not extend to this IPR, shows beyond speculation that information regarding Menard’s role in this IPR will be found.

RFPs 6 and 7 fail for similar reasons. In addition to not providing any supporting evidence, Signify also ignores that both Luminex and Menard have already certified that Menard did not fund this IPR in any way, which includes payments to Dr. Eden for work on this IPR. Paper 8 at 4; Ex. 2023.

Garmin factor 1 supports denying Signify’s motion.

B. Factor 2: Litigation Positions and Underlying Basis

Signify’s discovery requests are drafted so broadly that they encompass Luminex’s litigation positions and their underlying bases. RFP 1 seeks “*All* Communications,” spanning from Signify’s first infringement notice to the filing of Menard’s third-party complaint, that relate to Signify’s infringement allegations. Given that Luminex is defending Menard in the district court litigation as part of the

joint defense group, any communications during this period about Signify's infringement allegations would touch on Luminex's litigation positions and bases.

Similarly, RFP 5 seeks "*All* documents and Communications," spanning from Signify's first infringement notice to the filing of this IPR, that relate to the prior art applied in this IPR. This request directly implicates Luminex's litigation strategy because the prior art applied in this Petition has also been applied in the district court invalidity contentions. Therefore, any documents and communications about this prior art would inevitably include Luminex's litigation strategy.

Contrary to Signify's contention, the fact that the invalidity expert reports have already been filed in the district court litigation does not eliminate the threat of Signify prying into Luminex's litigation positions. The requested communications would encompass Luminex's litigation positions that are not already memorialized in its expert reports, such as discussions on the relative strength of the prior art references, which references are to be used at trial, and the relationship of the invalidity arguments to non-infringement arguments. Therefore, these communications would prematurely disclose Luminex's positions.

Garmin factor 2 supports denying Signify's motion.

C. Factor 3: Ability to Generate Equivalent Information by Other Means

Signify repeatedly acknowledges in its motion that it has access to the requested documents through other means. Indeed, Signify has identified that it

already possesses some of the communications it requests in RFP 1 because they were “produced in the litigation.” Paper 18 at 9; Paper 19 (RFPs) at 4 (identifying documents responsive to RFP 1 by Bates ranges). Signify’s assertion that it needs additional discovery because those communications are not available for citation here is somewhat misleading.³ The fact is none of the documents it already has support its arguments, so Signify is simply hoping to find something that might support its claim. Such fishing expeditions are improper under *Garmin*.

Signify also acknowledges that it already has the indemnification agreement between Luminex and Menard (RFP 3) from the district court discovery. Paper 18 at 6. In fact, the exact indemnification provision from this agreement is on the record here (Ex. 3003 at 4-5), which Signify cited verbatim in its POPR. Paper 6 at 2.

Regarding RFPs 4-8, Luminex has already certified under its duty of candor that Menard had no role in this IPR. Paper 20 at 16 (the Director citing Luminex’s certifications and recognizing that “the record does not include evidence showing any control or funding of this IPR by Menard”). The Board has denied discovery in such cases based on representations made under the duty of candor. *See Innolux Corp. v. Semiconductor Energy Lab. Co., Ltd.*, IPR2013-00028, Paper 31 at 4 (May

³ Contrary to its statement (Paper 18 at 9), Signify did not ask for permission to use documents already in its possession. Ex. 1021.

21, 2013) (denying additional discovery based on petitioner's RPI representations made under the duty of candor); *IBG LLC v. Trading Techs. Int'l, Inc.*, CBM2015-00181, Paper 24 at 5 (January 14, 2016) (same); *Argentum Pharms. LLC, v. Research Corp. Techs., Inc.*, IPR2016-00204, Paper 10 at 3 (March 17, 2016) (refusing to compel further routine discovery due to insufficient evidence of patent owner's failure to meet the duty of candor).

Additionally, Signify has already propounded similar requests in the district court, where "relevant documents were produced." Paper 18 at 1. For example, in its RFPs dated October 25, 2023, Signify sought: All Documents and Things referring or relating to Luminex's obligations and/or agreements to supply Luminex Relevant Products to Menard (RFP 3); All Documents and Things concerning any communications or agreements between Menard and [Luminex] regarding Signify, [the litigation], any Asserted Patents, any Menards Accused Product and/or any Luminex Relevant Product (RFP 1); and All Documents and Things relating to any Licenses, Transfer of Rights, license offers and/or agreements that pertain to LED lighting technology (RFPs 1, 2). Ex. 1026 at 10, 12, 14.

Having already obtained these documents, Signify cannot seek additional discovery to obtain the same. Moreover, the discovery period in the district court, which ran from October 2023 (Ex. 1019), when this IPR was filed, until October 2024 (Ex. 1025), when the case was stayed, gave Signify ample opportunity to seek

discovery. *See, e.g. Streck v. Ravgen*, IPR2021-01577, Paper 14 at 6-8 (February 11, 2022) (denying additional discovery as to information that “Patent Owner had ample opportunity to, and did, take discovery ... as part of the district court proceedings”).

Additionally, Signify fails to explain why “efforts to obtain additional information [regarding the RPI issue] could not have been undertaken months earlier given the foreseeable nature of this issue.” *See College Products, Inc., v. Intirion Corp.*, PGR2024-00003, Paper 26 at 8-9 (September 4, 2024) (denying additional discovery sought three months after the POPR on an issue “Petitioner should have been aware of ... as early as the filing date of the Petition ... and was expressly on notice ... by [the filing date of the POPR]”). Signify raised the RPI issue in its POPR on February 22, 2024, yet delayed seeking discovery for over eight months without “satisfactorily explain[ing] why it waited until this late in the proceeding.” *Id.*

Garmin factor 3 supports denying Signify’s motion.

D. Factors 4 and 5: Easily Understandable Instructions and Requests Not Overly Burdensome to Answer

Signify’s RFPs are overly burdensome. Instead of seeking specific documents tailored to the RPI issue, Signify has propounded six pages of litigation-style RFPs seeking “*All* Communications,” “*All* documents,” and “*All* agreements,” relating not only to this IPR, but also to infringement allegations made by Signify for 19 different patents, and agreements predating Luminex’s participation in the district court. The Board has recognized the impropriety of such broad requests. *See Google v. Cywee*,

IPR2018-01257, Paper 30 at 5, 9 (June 20, 2019) (denying additional discovery of “any ... joint interest, and indemnification agreements,” and “any communications” for being “litigation-style requests for broad categories of documents”); *New World Medical v. Microsurgical Tech.*, IPR2020-01573, Paper 13 at 12 (December 10, 2020) (denying open-ended requests for “all agreements,” “all communications,” and “all documents” as overly burdensome for RPI determination).

Moreover, Signify fails to explain how this expansive range of documents, some predating this IPR by almost three years, could uncover information “useful” to the RPI issue. These documents very likely encompass communications subject to common interest and/or joint defense privileges that would require an extensive privilege review, placing a burden not only on Luminex’s finances and human resources, but also on the time schedule of this IPR.⁴ *See Garmin* at 6-7.

Garmin factors 4 and 5 support denying Signify’s motion.

III. CONCLUSION

Luminex respectfully requests that the Board deny Signify’s motion.

⁴ Signify’s argument that pre-suit communications between Luminex and Menard are not subject to a common interest privilege is beyond the scope of its motion. Paper 18 at 4-5. If Signify’s motion is granted, Luminex will produce a privilege log with information sufficient to establish the basis of the claimed privilege.

Dated: November 21, 2024

Respectfully submitted,

By: /s/ Joshua R. Nightingale /

Joshua R. Nightingale (Reg. No. 67,865)

jrnightingale@jonesday.com

William E. Devitt (*pro hac vice* to be filed)

wdevitt@jonesday.com

Vishal V. Khatri (Reg. No. 51,873)

vkhatr@jonesday.com

Jeffrey S. Messing (Reg. No. 81,690)

jmessing@jonesday.com

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Petitioner's Opposition to Patent Owner's Motion for Additional Discovery of U.S. Patent No. 10,299,336 was served on November 21, 2024 via electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

Justin J. Oliver (Reg No. 44,986)
JOliver@Venable.com

John D. Carlin (Reg No. 37,292)
JCarlin@Venable.com

Jason Dorsky (Reg No. 64,710)
JMDorsky@Venable.com

Stephen K. Yam (Reg No. 64,927)
SYam@Venable.com

Signify-IPRs@Venable.com

Counsel for Patent Owner

Date: November 21, 2024

By: /s/ Joshua R. Nightingale /
Joshua R. Nightingale
Reg. No. 67,865
JONES DAY
500 Grant Street, Suite 4500
Pittsburgh, PA 15219
jrnightingale@jonesday.com