

Filed on behalf of: Signify Holdings B.V.

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

Case IPR2024-00101
U.S. Patent No. 10,299,336

PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY¹

¹ This Motion was authorized by the Board in an email dated November 6, 2024.
Ex. 3005.

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<i>Mylan Pharma. Inc. v. Qualicaps Co.</i> , IPR2017-00203, Paper 35 (Aug. 23, 2017)	7

EXHIBIT LIST

Exhibit No.	Description
2001	Menard's Third-Party Complaint (10/27/2022)
2002	Luminex's Answer to the Third-Party Complaint and Crossclaim (2/27/2023)
2003	Signify's Complaint for Patent Infringement (8/12/2022)
2004	Proof of Service for Signify's Complaint
2005	Order Granting Motion to Transfer (12/9/2022)
2006	Signify's Infringement Contentions (8/31/2022)
2007	Luminex's Opposition to Motion to Transfer (5/15/2023)
2008	Order on Motion to Sever (8/31/2023)
2009	District Court Scheduling Order (10/2/2023)
2010	Black's Law Dictionary
2011	Joint Invalidity Contentions (Appendix F) (11/22/2023)
2012	U.S. District Court Caseload Statistics
2013	Amended Luminex's Answer to the Third-Party Complaint and Crossclaim (11/16/2023)
2014	Canarm's Answer and Affirmative Defenses to the Third-Party Complaint (1/25/2024)
2015	Signify's letter to Menard (2/8/2021)
2016	Luminex's letter to Signify (3/15/2021)
2017	Luminex's letter to Signify (4/26/2021)
2018	Menard's letter to Signify (2/24/2021)
2019	Luminex's letter to Signify (4/18/2024)

Exhibit No.	Description
2020	Luminex's letter to Signify (5/10/2024)
2021	Luminex's email to Signify (10/29/2024)
2022	R Mark Halligan's (Luminex counsel) email to Signify (4/1/2021)
2023	Menard's email to Signify (11/8/2024)
2024	Opening expert report of Dr. J. Gary Eden
2025	Rebuttal expert report of Dr. J. Gary Eden
2026	Protective Order in parallel district court litigation
2027	Menard's Amended Answer to Signify's Complaint (10/19/2023)

On just the limited, public record Signify presented in its preliminary response (“POPR”, Paper 6), this Board panel initially agreed with Signify that Menard was a real party in interest (“RPI”). *See* Paper 10. The Director determined that this pre-institution record did not support an RPI relationship (Paper 12), but has not yet provided her rationale. Given the significance of the RPI question, a full record of the relationship and interactions between Menard and Luminex is necessary. For example, relevant documents were produced under the protective order in the parallel litigation, yet Luminex has refused to make the same production available here. Other documents are known to exist because they were identified by Menard in a litigation-produced privilege log where Menard claimed a purported common interest privilege with Luminex, while in this proceeding Luminex has claimed *not* to share the same interests as Menard. Accordingly, Signify respectfully submits that the information requested in the accompanying Requests for Production (“RFPs”) should be produced in the interest of justice.

I. Factual Background

The known record confirms that highly relevant documents exist and should be produced. For example, on February 8, 2021, long before filing its patent infringement complaint, Signify sent a letter to Menard identifying certain patents, including the ’336 Patent, that Signify believed were being used by Menard-branded products sold by Menard. Ex. 2015. Signify sent its February 8

letter only to Menard, but received a response from *Luminex's* counsel, R Mark Halligan, confirming *Luminex's* receipt of Signify's February 8 letter. Ex. 2016. On April 26, 2021, Mr. Halligan asserted that "Luminex is much better equipped to evaluate Signify's assertions" set forth in Signify's February 8 letter to Menard concerning Menard-branded products. Ex. 2017 at 1; Ex. 2022. Separately, Menard's counsel, Elizabeth Weber, also confirmed that Menard had forwarded Signify's correspondence and requested any further interactions be held with Menard's suppliers rather than Menard itself. Ex. 2018.

Furthermore, both Menard and Luminex have confirmed the existence of a pre-existing agreement between Menard and Luminex that requires Luminex to "indemnify or defend [Menard] as a matter of first defense and payment, not as a matter of reimbursement." Exs. 3003 and 2013, ¶29 (emphasis added), *see also* Exs. 3003 and 2013, ¶¶24-28.

Signify filed its infringement complaint against Menard on August 12, 2022. Ex. 2003. On October 27, 2022, Menard filed a third-party complaint against Luminex and other third-parties. Ex. 2001. Months before Luminex filed the Petition, the district court addressed Signify's concern over having to litigate against multiple third-parties—despite having filed its complaint against only Menard for selling its Menard-branded products in Menard stores—by ordering Menard and the third-parties, including Luminex, to coordinate strategy and act as

a united front. Ex. 2008 at 5. Menard and Luminex have confirmed that they complied with the court's order. Ex. 1020 at 20. Indeed, Luminex's counsel (William Devitt, who also serves as Luminex's IPR counsel) has sent various correspondence "*on behalf of Menard[]* and the Third-Party Defendants[]." Ex. 2019 at 1 (emphasis added), Ex. 2020 at 1.

On Oct. 19, 2023, just six days before Luminex filed its IPR petition, Menard added invalidity as a defense for the first time, having failed to include invalidity as a defense in its original answer to Signify's complaint. *Compare* Ex. 3002 at 15-16, Ex. 2027 at 16-17 (¶¶1-2). The Director's Order refers to Menard's original answer lacking this defense, without referencing Menard's amended answer adding this defense. Paper 12 at 3.

II. Summary of Requested Discovery

The proposed RFPs concern Menard's relationship with Luminex and its involvement in the development of the grounds set forth in the IPR petition, including their retention of Dr. Eden concerning the validity of the '336 patent.

III. Legal Standard

In determining whether to grant additional discovery, the Board applies the five-factor test from *Garmin Int'l v. Cuozzo Speed Techs LLC*, IPR2012-00001, Paper 26 at 6-7 (Mar. 5, 2013) (precedential).

IV. *Garmin* Factor 1 – There is More Than a Possibility and Mere Allegation that Something Useful Will be Discovered

Signify is “already ... in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered” from these RFPs. *Garmin* at 7. The requests pertain to communications and related documents between Luminex and Menard, as well as cost and/or expert sharing that goes beyond mere indemnification. Such evidence is useful to provide a complete picture of the relationship between Luminex and Menard, beyond the limited record considered by the Director. This factor favors granting discovery.

Regarding RFPs 1-2, Luminex’s statements to Signify confirm the existence of pre-suit correspondence between Luminex and Menard concerning Signify’s allegations. Exs. 2016, 2018. RFP 1 even identifies, by litigation Bates ranges, exemplary responsive documents that Luminex has refused to make available for the IPR. Exs. 2021, 2026. Signify knows of other pre-suit communications between Menard and Luminex, based on a privilege log served by Menard in which Menard asserted an alleged common interest privilege. Menard has refused to allow Signify to submit a copy of that privilege log with this Motion. Ex. 2023.

These pre-suit communications are not subject to a common interest privilege, despite Luminex suggesting otherwise (Ex. 3004 at 2). **First**, for a privilege to exist, there must have been an actual agreement, whether written or oral. *See Hunton & Williams v. U.S. Dept. of Justice*, 590 F.3d 272, 285 (4th Cir.

2010). Neither Menard nor Luminex has shown that any agreement existed prior to any (post-litigation filing) joint defense agreement. *Id.* (“Documents exchanged before a common interest agreement is established are not protected”). RFP 2 seeks to confirm that no such pre-suit agreement existed or, if it does exist, its terms (the burden for which rests with Luminex). *Id.* at 284. **Second**, the common interest must be ***the same interest***. *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1172 (D.S.C. 1974) (4th Circuit’s position) (“The key consideration is that the nature of the interest be identical, not similar, and be legal, not solely commercial.”); *In re Dealer Management Sys. Antitrust Lit.*, 335 F.R.D. 510, 514-15 (N.D. Ill. 2020) (7th Circuit’s position) (quoting same); *In re Regents of the Univ. of California*, 101 F.3d 1386, 1389-90 (Fed. Cir. 1996) (applying 7th Circuit law and referencing *Duplan*’s above-quoted language); *see also Leader Techs., Inc. v. Facebook, Inc.*, 719 F.Supp.2d 373, 376 (D. Del. 2010) (confirming Judge Stark’s finding that common interest requires identical interests); *Minebea Co., Ltd. v. Papst*, 228 F.R.D. 13, 16 (D.D.C. 2005)); *Mondis Tech, Ltd. v. LG Elecs., Inc.*, No. 2:07-CV-565-TWJ-CE, 2011 U.S. Dist LEXIS 47807 at *19-20 (E.D. Tex. May 4, 2011) (communications concerning “rights and relationships” between the parties do not qualify).

Here, Luminex has predicated its RPI argument on the assertion that its interests are ***not*** the same as Menard’s. Paper 8 at 4 (“***Luminex’s interest*** in selling

its products to other customers *is not shared by Menard.*” (emphasis added)); Paper 11 (Director review request) at 8 (“Luminex ... filed the petition ... to assert *its own interests*” (emphasis added)), 9-10 (Luminex purportedly filing the IPR “to protect their patent portfolio and defend their status as the true innovator in CCT technology ... Menard does not share these interests of Luminex.”). The Director relied upon Luminex’s assertions. Paper 12 at 2-3. Luminex cannot have it both ways by withholding the requested pre-suit documents under a common interest privilege but also claiming not to share the same interest with Menard and to have an “arms-length customer-manufacturer relationship with Menard.” Paper 11 at 10.

Regarding RFP 3, the pre-existing indemnification agreement exists and was produced in the litigation subject to a protective order. Ex. 3004 at 2; Exs. 2001 and 2002 at ¶¶24-29, 35; Paper 11 at 2 (“Luminex acknowledged that it entered into such an agreement”). Luminex refuses to make the same production here.

Regarding RFP 4, Luminex has never denied that it communicated with Menard regarding the IPR Petition before it was filed. Instead, Luminex represented that it “never communicated with Menard regarding the *substance* of the IPR petition and never told Menard *why* the IPR petition would be filed.” Paper 8 (POPR) at 3-4 (emphasis added). But this carefully crafted language does not negate the fact that communications between Menard and Luminex regarding the Petition are highly relevant in ascertaining whether Menard is an RPI.

Regarding RFPs 5 and 8, Menard and Luminex cannot dispute that they worked together on invalidity in the litigation, given the Court ordered them to do so. Ex. 2008 at 5 (the Court ordering “Menard and the third-party defendants [including Luminex] to coordinate a litigation strategy, acting as a united front whenever possible”); Ex. 2019 at 1 and Ex. 2020 at 1 (Luminex’s litigation and IPR counsel corresponding with Signify “on behalf of Menard[]”). Luminex cannot reasonably dispute that responsive documents and communications exist.

Regarding RFPs 6 and 7, the same expert (Dr. Eden) was used in the IPR and the litigation. The record reflects that Dr. Eden was retained by, at least, Menard. Ex. 2024 at ¶1 (“at the *request of counsel for Defendant Menard, Inc. (‘Menard’), and the Third-Party Defendants (Luminex ...)*” (emphasis added)); Ex. 2025 at ¶2 (same language). The source of the payments to Dr. Eden and the nature of his arrangement with Menard and Luminex are important in determining whether Menard was involved in aspects tied to the IPR.

V. *Garmin* Factor 2 – Requests Do Not Seek Litigation Positions

Opening and rebuttal expert reports concerning the same prior art and same validity arguments have already been served and filed on the litigation docket. *See, e.g.*, Exs. 2024, 2025 (Dr. Eden’s reports). Therefore, litigation positions are not being sought herein. *See, e.g., Mylan Pharma. Inc. v. Qualicaps Co.*, IPR2017-00203, Paper 35 at 5 (Aug. 23, 2017) (the Board finding that no litigation positions

were being sought because, *e.g.*, “parties have [already] exchanged expert reports”). Nor do the RFPs seek any Luminex IPR positions.

Moreover, RFPs 1-2 define a date range which pre-dates the infringement suit against Menard and Menard’s subsequent third-party complaint against Luminex. Indeed, the requests seek communications and documents between Menard and Luminex starting more than 19 months prior to Menard suing Luminex to bring it into the related litigation.

RFP 3 only seeks agreements relating to indemnification, which presumably would have been entered into long before Signify even identified its patents to Menard. *See, e.g.*, Paper 11 (Director review request) at 2 (Luminex referring to a “Menards Customer Returns, Defective Goods Policy and Conditions of Order Agreement” as establishing an indemnification obligation).

RFP 4, by its language, is limited to communications involving the IPR and pre-dating the IPR petition, and therefore, is not seeking litigation or IPR positions. To the extent these communications contain any pre-filing IPR positions, such positions would have already been memorialized in the IPR petition. *See Garmin* at 13 (factor 2 intended to prevent premature disclosure of “positions ... before [the producing party] is ready to present them in this review.”).

RFP 5 is limited to the references that Luminex relies on in the IPR. Moreover, how Menard or Luminex discovered the references is not a “litigation

position.” Regardless, any “litigation position” information responsive to this RFP is irrelevant since technical expert reports have already been exchanged and filed in the related litigation.

RFPs 6-7 seek cost distributions and expert retention terms, while RFP 8 seeks the nature of the collaboration between Menard and Luminex. None relate to litigation positions.

VI. *Garmin* Factor 3 – Signify Cannot Otherwise Generate Equivalent Information

Signify has no other means to generate this information as the requested information is in the possession or control of only Luminex and Menard. For those documents sought that were produced in the litigation, such documents contain a confidentiality designation that prevents Signify from using the documents in the IPR without Luminex’s permission (which it has refused). Ex. 2021.

VII. *Garmin* Factor 4 – Instructions Are Easily Understandable

The RFPs include a list of instructions that are easily understandable, and the requests themselves include, *e.g.*, date ranges as applicable and are narrowly tailored. Some requests even identify exemplary responsive documents by Bates ranges, making them even more easily understandable, *e.g.*, as to scope.

VIII. *Garmin* Factor 5 – Requests Are Not Overly Burdensome to Answer

Signify’s requests will not require a significant expenditure of human and financial resources because, at least, many of the documents have already been

gathered in connection with the related litigation. And, in some cases, the request identifies certain specific responsive documents already known to exist.

As to RFPs 1 and 4-5, the requests define specific date ranges, a specific issue, and/or specific parties. RFP 2 defines a date range that largely pre-dates the litigation, limiting any burden of finding responsive documents. The number of responsive agreement documents to RFP 3 is expected to be limited, and copies are expected to be accessible by Luminex—in fact, one responsive agreement has already been produced in the litigation. RFPs 6-7 are directed to focused topics, and relate to payments/costs (RFP 6) or a specific expert also being used by Luminex in the IPR (RFP 7)—it should not be burdensome to search for and identify these documents and communications. RFP 8 relates to recent communications and documents in the litigation following the Court’s August 31, 2023 Order requiring Menard and Luminex to operate as a “united front”—it should not be burdensome for Luminex’s counsel to simply search its existing electronic correspondence files for these communications.

IX. Conclusion

The Board should grant this Motion for additional discovery and order Luminex to produce all documents and communications responsive to RFPs 1-8, including that to the extent any responsive materials are withheld on the basis of privilege, Luminex must produce a privilege log cataloguing all such materials.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a complete copy of this Motion and all Exhibits and other documents filed together with this Motion were served on Petitioner at:

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