

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 REQUESTS FOR PRODUCTION

I. INSTRUCTIONS

1. In producing documents or other information responsive to these Requests for Production (“RFPs”), Petitioner is to comply with the Federal Rules of Civil Procedure 26 and 34, the Board’s Scheduling Order, and any other Board Order in this proceeding, and the instructions in the Patent Trial and Appeal Board Practice Guide.

2. For each Request, identify any responsive document that Petitioner is aware of but cannot produce because it has been lost or destroyed or is no longer in Petitioner’s possession, custody, or control.

3. If Petitioner believes the meaning of any term in any Request is unclear, Petitioner should assume a reasonable meaning, state what the assumed meaning is, and produce documents and things or provide information on the basis of that assumed meaning.

4. For any document responsive to a Request that Petitioner withholds on the basis of privilege, Petitioner shall provide a privilege log identifying the document’s date, author(s), recipient(s), subject matter, and the basis of the asserted privilege.

5. These 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 Petitioner acquires additional knowledge or

information with respect to any of these requests after service of your responses, Petitioner shall serve a supplemental and/or amended response to each such discovery no later than thirty (30) days after acquiring the additional knowledge or information.

II. DEFINITIONS

6. The terms “Petitioner” and “Luminex” 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.

7. The term “Menard” means 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.

8. The terms “Patent Owner” and “Signify” mean 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.

9. The term “IPR Petition” means the petition for *inter partes* review of U.S. Patent No. 10,299,336, filed by Luminex in IPR2024-0010 as Paper 1.

10. The term “336 Patent” means U.S. Patent No. 10,299,336.
11. The term “Asserted Patents” means U.S. Patent Nos. 7,038,399, 7,256,554, 7,737,643, 7,348,604, 7,658,506, and 10,299,336, collectively.
12. The term “Signify Litigation” means Case No. 3:22-cv-00706-jdp (W.D. Wisc.) (formerly Case No. 1:22-cv-01447-JPC (N.D. Ohio)).
13. The terms “any” and “all” shall include “each and every.”
14. 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.
15. The term “document” includes “originals” and “duplicates” and has the same meaning as the term “writings and recordings” and “photographs” as defined in Fed. R. Evid. 1001, whether or not claimed to be privileged or otherwise exempted from discovery, including without limitation correspondence, written agreements, memoranda, summaries, notes, written communications and electronically stored information, whether a draft, or a copy, however reproduced.
16. The term “Communication” means a document referring or relating to any transfer or exchange of information (or requests for information) of any kind,

whether orally or by document, or whether face-to-face, by telephone, letter, e-mail, memoranda, telegram, text, telex, telefax, personal delivery or otherwise.

17. The term “concerning” means relating to, referring to, describing, evidencing or constituting.

III. REQUESTS

Request No. 1: All Communications dated from February 8, 2021 through October 27, 2022 (the date of Menard’s Third-Party Complaint against Luminex) between Luminex and Menard relating to Signify’s patent infringement allegations and/or offers to license pertaining to the Signify EnabLED Portfolio (see, e.g., SIGNIFYMDRD0015968-69), including without limitation (1) the documents produced in the Signify Litigation as MEN008627-30, MEN008675-78, and MEN008684-88 and (2) all such Communications between the law firm of Fisher Broyles (counsel for Luminex), including but not limited to R Mark Halligan of Fisher Broyles, and Menard, including but limited to Elizabeth Weber of Menard.

Request No. 2: All common interest agreements between Luminex and Menard that (1) were entered into from February 8, 2021 through October 27, 2022 and (2) pertain to Signify’s patent infringement allegations and/or offers to license pertaining to the Signify EnabLED Portfolio. To the extent that Luminex asserts that any such an agreement existed but was not in writing, the response to this Request shall describe (i) the date of the agreement, (ii) the individuals that were

involved in the communication and consummation of the agreement, (iii) the specific terms and scope of the agreement, and (iv) Luminex's proof of the agreement's existence, terms, and scope.

Request No. 3: All agreements between Luminex and Menard that concern, reflect and/or define any indemnification or defense obligation owed by Luminex pertaining to the Accused Products, including without limitation relevant purchase order agreements.

Request No. 4: All Communications dated from February 8, 2021 through October 25, 2023 between Luminex and Menard relating to (1) the process of deciding to prepare the IPR Petition, including general discussions about filing IPR petitions against the Asserted Patents, of which the '336 Patent is one, (2) the preparation of the IPR Petition (including without limitation the searching for prior art and preparation of drafts of the IPR Petition), and (3) the filing of the IPR Petition, including without limitation e-mails, calendar invitations, responses thereto, attachments to calendar invitations, and/or minutes for meetings and/or conference calls wherein (i) both counsel for Menard and counsel for Luminex were invited to the meeting and/or conference call and (ii) the calendar invitations, responses thereto, attachments to calendar invitations, and/or minutes include the term "IPR", "inter partes", and/or "petition".

Request No. 5: All documents and all Communications between Luminex and Menard dated from February 8, 2021, through October 25, 2023, and relating to the discovery of and/or reliance on U.S. Patent No. 10,234,091 (“Chaimberg”), U.S. Patent No. 7,178,941 (“Roberge”), U.S. Patent No. 9,801,250 (“Halliwell”), and/or U.S. Patent No. 7,192,160 (“Reiff”) for purposes of asserting that the Asserted Patent is invalid/unpatentable.

Request No. 6: All documents and all Communications relating to any contributions (through monetary payment or other form of compensation, such as withholding or discounting of payments for goods purchased by Menard and supplied by Luminex) by Menard to the costs in preparing and filing the IPR Petition (including without limitation costs associated with identifying prior art and/or compensating Dr. J. Gary Eden for his analysis of the validity of the ’336 Patent).

Request No. 7: All documents and all Communications that state that Dr. J. Gary Eden was being retained by and/or on behalf of Menard for the IPR Petition and/or the Signify Litigation.

Request No. 8: All documents describing, evidencing, or relating to the “steps” referred to by Petitioner in Exhibit 1020 that “Menard and the Third-Party Defendants fully intend to, and have taken various steps to, comply with the

Court's request that Menard and the third-party defendants act as a united front when possible." *See* Ex. 1020 at 3, 20.

Respectfully submitted,

November 14, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies that a complete copy of this Patent Owner's
Requests for Production was served on Petitioner at:

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November 14, 2024

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