



IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

HONEYWELL INTERNATIONAL INC.,)
)
Plaintiff,)
)
v.)
)
RESEARCH PRODUCTS)
CORPORATION,)
)
Defendant.)
)

Case No. 3:17-cv-00723-wmc

**PLAINTIFF HONEYWELL INTERNATIONAL INC.’S MOTION TO COMPEL
DISCOVERY FROM DEFENDANT RESEARCH PRODUCTS CORPORATION**

Plaintiff Honeywell International Inc. (“Honeywell”) hereby moves the Court under Fed. R. Civ. P. 37 for an order compelling relevant and important discovery from Defendant Research Products Corporation (“RPC”). Beginning in the mid-2000s, Honeywell invested significant resources redesigning its HVAC zoning products, including its zone control panels, zone dampers, and bypass dampers. Am. Compl. ¶¶ 14-15. RPC responded by redesigning its products to emulate the features pioneered and patented by Honeywell, launching its redesigns around 2016. *Id.* ¶ 16. Much of the discovery sought herein pertains to RPC’s copying of Honeywell’s patents.

Honeywell has diligently made numerous good faith attempts to resolve these disputes, but RPC has repeatedly refused the discovery or stalled these attempts by ignoring Honeywell’s written correspondence, withholding any rationale for why RPC refuses to provide the discovery, delaying and postponing meet and confers, asking Honeywell repeatedly to explain the discovery requests, and claiming to be busy on other matters. This continued delay prejudices Honeywell, especially in view of imminent expert report deadlines and depositions. Honeywell therefore has no choice but to seek the Court’s relief.



I. BACKGROUND

Honeywell has diligently attempted, for months, to resolve discovery disputes raised in this motion. In June, Honeywell wrote to RPC on multiple occasions, detailing various relevant and pertinent discovery it needed from RPC, including that sought herein. Ex. 1, 6-4-18 Lauer Letter; Ex. 2, 6-12-18 Fjellstedt Letter; Ex. 3, 6-26-18 Lauer Email. After RPC delayed its response for nearly a month, RPC agreed to meet and confer on July 2 (although it could have simply responded to Honeywell's requests). RPC did not come prepared to the meet and confer, however, and instead punted on nearly every subject, claiming that it would investigate the issues (despite plenty of notice and time to prepare). Ex. 4, 7-3-2018 Lauer Letter. RPC's follow-up did not resolve any of the issues. *See, e.g.*, Ex. 5, 7-12-18 Lauer Email.

Honeywell nevertheless made a final attempt to resolve the accumulated issues, Ex. 6, 7-23-18 Lauer Email, but RPC claimed it could not confer because it was "a very busy week," and therefore delayed the discussion yet another week. Ex. 7, 7-26-18 Nickels Email. Honeywell was forced to accommodate, but in so doing notified RPC that:

"If we must wait another week to discuss [these issues] (again), we will do so, but only on the condition that RPC will be able to affirmatively represent during our meet and confer whether it will provide the requested information or not. We don't want to wait longer for a conversation, just to have RPC punt yet again."

Ex. 7, 7-26-18 Lauer Email. A week later, just eleven minutes before the scheduled meet and confer, RPC cancelled the call, stating that "something has come up last minute" and telling Honeywell it could not reschedule for yet another week, while asking Honeywell to explain, all over again, the numerous discovery issues. Ex. 8, 7-30-18 Nickels Email.

II. LEGAL STANDARD

A party may seek an order to compel discovery if an opposing party fails to respond to discovery requests or has provided incomplete responses. Fed. R. Civ. P. 37(a)(1)-(4). "Parties

[REDACTED]

may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case" Fed. R. Civ. P. 26(b)(1). "When deciding whether to grant a motion to compel discovery, the court must consider whether the requested discovery is relevant, 'proportional to the needs of the case,' and nonprivileged." *Boehm v. Scheels All Sports, Inc.*, No. 15-cv-379-JDP, 2016 WL 6811559, at *2 (W.D. Wis. Nov. 17, 2016).

III. ARGUMENT

A. RPC Should Be Ordered to Produce Relevant Documents and Things Responsive to Honeywell's Discovery Requests

1. Documents and Things Related to Development and Marketing of the Accused Products

a. *RPC's Prototypes for Accused Products*

RPC refuses to produce any prototypes of its accused products, despite their relevance to Honeywell's claims of infringement (including inducement and willful infringement) as well as objective indicia of nonobviousness related to RPC's copying of Honeywell's patents. Honeywell propounded requests seeking prototypes as early as December 15, 2017. *See e.g.*, Ex. 9 at 10, Honeywell's First Set of Requests for Production, No. 15 (requesting "prototypes"). RPC never produced any prototypes, but one of its witnesses, Mr. Rimrodt, testified at his deposition in June [REDACTED]. Ex. 10, 6-27-18 M. Rimrodt Dep. Tr. at 107:6-10. Honeywell followed up after the deposition, Ex. 11, 7-5-18 Lauer Letter, and RPC confirmed that [REDACTED], Ex. 5, 7-12-18 Lauer Email. RPC has neither [REDACTED] nor said it would. RPC should be ordered to produce to Honeywell [REDACTED].

b. *Installation Videos for Accused Products*

Honeywell also learned during Mr. Rimrodt's deposition that [REDACTED]. Ex. 12, 6-28-18 M. Rimrodt Dep. Tr.

[REDACTED]

at 414:6-10. RPC never produced these videos to Honeywell, however, and they do not appear to be publicly available. These videos are responsive to at least Honeywell's RFP No. 14 (requesting "all documents and things related to the installation . . . of any Accused Product") and relevant to at least Honeywell's claim that RPC has actively induced others to infringe the claims of the asserted patents. Ex. 9 at 10, Honeywell's First Set of Requests for Production. Accordingly, RPC should be ordered to produce these videos.

c. *Information from RPC's Customer Communication Database*

RPC uses an internal database called [REDACTED] that records interactions with RPC's customers, and it contains highly relevant feedback from customers. For example, RPC's customers [REDACTED] Ex. 13, RPC-0645506 at 892, and frequently stated that [REDACTED] *id.* at 991. The excerpts from [REDACTED] produced by RPC do not, unfortunately, have contextual information such as the name of the person who submitted a particular note or comment. This blunts Honeywell's ability to use the material or seek further discovery related to it. But RPC's Product Manager for zoning products, Mr. Rimrodt, admitted that [REDACTED] [REDACTED]. Ex. 12, 6-28-18 M. Rimrodt Dep. Tr. at 458:15-20; Ex. 11, 7-5-18 Lauer Letter. Such contextual and identifying information is responsive to at least Honeywell's RFP No. 19 (requesting "communications with Defendant's customers") and is relevant to at least induced infringement, damages, and RPC's copying of Honeywell's products and other objective indicia. Ex. 9 at 11, Honeywell's First Set of Requests for Production. This information is also relevant to Honeywell's claim that RPC has infringed the asserted design patents because an ordinary observer would be confused by the similarities between Honeywell's patented design and the design of RPC's zone panels. RPC should be ordered to identify and produce this and any other pertinent information from the [REDACTED] database.

[REDACTED]

2. Documents and Things Related to Honeywell's Damages Claims

a. RPC's Inventory of Accused Zone Panels

RPC launched modifications of the accused products this spring in a purported attempt to design around the asserted patents. It was revealed for the first time during the deposition of RPC's corporate witness John Bloemer that [REDACTED]

[REDACTED]. Ex. 14, 6-20-18 J. Bloemer Dep. Tr. at 141:6-19. That means RPC's modified zone boards infringe upon importation just the same as unmodified zone boards infringe when sold to customers. 35 U.S.C. § 271(a). Since this revelation, Honeywell has sought information about RPC's domestic inventory of zone boards that have been imported and are being modified, but RPC has so far refused. *See* Ex. 4, 7-3-18 Lauer Letter (citing *Wisconsin Alumni Research Found. v. Apple, Inc.*, 135 F. Supp. 3d 865, 868-69 (W.D. Wis. 2015)); *see also* Ex. 15, D.I. 642, Special Verdict Form, *Wisconsin Alumni Research Found. v. Apple, Inc.*, Case No. 14-cv-062-wmc (W.D. Wis.). This information is responsive to Honeywell's RFP No. 13 requesting "[d]ocuments and things sufficient to identify all of the Accused Products that were made, used, sold, or offered for sale within the United States or imported into the United States." Ex. 9 at 10, Honeywell's First Set of Requests for Production. RPC's inventory information is relevant to Honeywell's calculation of the amount of damages it has suffered due to RPC's infringement. RPC should be ordered to produce it.

b. RPC's [REDACTED]

RPC witnesses have revealed that [REDACTED]

[REDACTED] While RPC agreed that it would search for and produce documents relating to [REDACTED], Ex. 4, 7-3-18 Lauer Letter, that was over a month ago. RPC has yet to produce these documents and should be ordered to produce them. This information is responsive

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