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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

WESTERN DIVISION

Philips North America LLC,

Plaintiff,

vs.

Garmin International, Inc. and Garmin Ltd.,

Defendants.

Case No. 2:19-cv-06301-AB-KS

PHILIPS NORTH AMERICA LLC's AGREED RESPONSE TO DEFENDANTS' REQUEST TO SUPPLEMENT CLAIM CONSTRUCTION (DKT. 97)

Hon. André Birotte Jr.

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1 Plaintiff Philips North America, LLC ("Philips") agreed to not oppose Defendants'
2 Request for Leave to File Supplemental Claim Construction Evidence (Dkt. 97) on the
3 condition that Philips be allowed a short response, which Defendants agreed to.
4 Defendants' submission consists of excerpts of the deposition transcript of Frank van
5 Hoorn, one of two inventors (along with Gary Root) of Philips's U.S. Patent No. 6,013,007
6 (Dkt. 45-1, "'007 Patent"). Defendants contend that Mr. van Hoorn's testimony supports
7 their position that the language "means for presenting the athletic performance feedback
8 data" in '007 Patent Claims 1 and 21 mandates audio presentation of the feedback data in
9 all circumstances, and can never consist of visual means alone. (Dkt. 97, p. 2.)
10 Defendants' arguments should be disregarded because (1) Mr. van Hoorn' testimony
11 amounts to his merely saying that non-audio feedback is "not the best option" (Tr. 47:20-
12 21), not that it fell outside the scope of the patent, and (2) the law is clear that the testimony
13 of a lay inventor – un-versed in patent claim drafting – cannot be used to change the legal
14 scope of a patent claim.

15 **A. <u>Mr. van Hoorn's Testimony Amounts To Saying Non-Audio Feedback</u>**
16 **<u>Is Not A Preferred Embodiment, Which Should Not Affect Claim Scope</u>**

17 Mr. van Hoorn was pressed repeatedly in his deposition to state that the claimed
18 invention requires audio feedback in all circumstances, and was given this suggestion
19 enough times that his answers may not always have been clear if considered in isolation.
20 However, over the course of his deposition, the point Mr. van Hoorn conveyed was that
21 non-audio feedback was simply not a preferred embodiment, which does not mean it is
22 outside the scope of the claim, but rather just that the inventor deemed it to be a less favored
23 manifestation of the inventive concept. *See, e.g., Gillette Co. v. Energizer Holdings, Inc.*,
24 405 F.3d 1367, 1371 (Fed. Cir. 2005) ("It may be that a four-bladed safety razor is a less
25 preferred embodiment. A four-bladed razor costs more to build, requires more parts, and
26 adds more frictional drag compared to the three-bladed version. Nevertheless, a patentee
27 typically claims broadly enough to cover less preferred embodiments as well as more
28 preferred embodiments, precisely to block competitors from marketing less than optimal

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1 versions of the claimed invention.”).

2 For example, at the portion of the testimony cited at pages 2-3 of Defendants’ brief,
3 Mr. van Hoorn merely states that a visual-only embodiment was “not the best option” (Tr.
4 47:20-21) – not that it was not an option at all. Elsewhere, Mr. van Hoorn also stated that
5 a visual-only embodiment was within the contemplation of the patent:

6 Q. Okay. The means for presenting here, is all I'm asking you, if you
7 read this claim – not what you built -- if you read this claim, what is the
8 means for presenting the athletic performance feedback data to the
9 athlete claimed in your patent?

10 A. It’s either on the screen or the audio feedback.

11 Q. Either the screen or the audio feedback could satisfy that
12 limitation?…

13 THE WITNESS: I believe it does, yes.

14 (Tr. 19:18-20:4.)

15 While Mr. van Hoorn may have deemed non-audio embodiments to be less safe –
16 the way a four-bladed razor was a less preferred embodiment than a three-bladed razor in
17 *Gillette* – that does not mean that a skilled patent attorney would not have included them
18 within the scope of the invention in drafting the patent claims.

19 **B. <u>As A Matter Of Law, Inventor Testimony Is Given Little If Any Weight</u>**
20 **<u>In Claim Construction</u>**

21 The cases that Defendants cite at pages 1-2 of their brief stand merely for the
22 proposition that inventors, being technically skilled in the relevant field of technology, are
23 useful witnesses to explain that technology. For example, an inventor can testify to what
24 a particular technical term might usually be understood to mean by other experts. Here,
25 Mr. van Hoorn was retained by Philips as an expert for his knowledge of the technology
26 underlying the ’007 Patent – not his interpretation of the claims that were drafted by a
27 patent attorney. Indeed, while inventors may have knowledge from the field or academia,
28 the patent attorneys (and agents) who draft patent claims employ a language and legal

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reasoning of their own that is often foreign to inventors. Patent drafters may even do things as a matter of course that inventors would not think to do … such as draft a patent claim to cover a less preferred embodiment in order to secure broader claim scope.

Here, the patent attorney who drafted the Claims of the ’007 Patent clearly differentiated between audio-only embodiments (*e.g.*, Dependent Claims 2-5), and a broader case (Independent Claim 1) that did not mandate audio feedback. (’007 Patent, Dkt. 45-1.) *Curtiss-Wright Flow Control Corp. v. Velan, Inc*., 438 F.3d 1374, 1380 (Fed. Cir. 2006) (“In the most specific sense, claim differentiation refers to the presumption that an independent claim should not be construed as requiring a limitation added by a dependent claim.”).

Because lay inventors lack requisite patent drafting expertise – and for other prudent reasons – the law is clear that the use of inventor testimony is strictly limited in the context of claim construction:

> The testimony of an inventor cannot be relied on to change the meaning of the claims. [] In particular, we have explained that the subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of a claim. [] We hold that inventor testimony as to the inventor’s subjective intent is irrelevant to the issue of claim construction.

Howmedica Osteonics Corp. v. Wright Med. Tech., Inc., 540 F.3d 1337, 1346-47 (Fed. Cir. 2008); *see also POWERbahn, LLC v. Zwift, Inc.*, No. 2:17-cv-01393-H (MRWx), 2018 U.S. Dist. LEXIS 99375, at *23-24 (C.D. Cal. June 8, 2018) (same.)

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DATED: August 27, 2020

Respectfully submitted,

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