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LAMKIN IP DEFENSE
RDL@LamkinIPDefense.com
Rachael D. Lamkin (246066)
One Harbor Drive, Suite 300
Sausalito, CA 94965
(916) 747-6091 Telephone

Michelle L. Marriott (*pro hac vice*)
michelle.marriott@eriseip.com
Erise IP, P.A.
7015 College Blvd.
Suite 700
Overland Park, KS 66211
(913) 777-5600 Telephone
(913) 777-5601 Facsimile

Attorneys for Defendants
Garmin International, Inc. and Garmin Ltd.

**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

**NOTICE OF MOTION and OPPOSED
MOTION TO MODIFY THE
SCHEDULING ORDER UNTIL
AFTER THE PTAB’S FINAL
DECISION ON THE ’233 PATENT**

**Hearing: February 26, 2021
10:00 am**

Hon. André Birotte Jr.

1 **TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:**

2 PLEASE TAKE NOTICE that on February 26, 2021 at 10:00 AM, or as soon thereafter
3 as the matter may be heard before Honorable André Birotte Jr., in Courtroom 7B of the
4 United States District Court, Central District of California, located at 350 West First
5 Street, Los Angeles, CA 90012, Defendant Garmin will, and hereby does, respectfully
6 move pursuant to extend the trial dates until after final decision on the IPR of the asserted
7 '233 Patent.
8

9 The grounds for the Motion are set forth in the Motion below. This Motion is
10 based on this Notice of Motion, the accompanying Memorandum of Points and
11 Authorities, the pleadings and papers on file in this action, and on such other and
12 further evidence as may properly be before this Court at the hearing on the Motion.

13 This Motion is made following the requested conference of counsel on January 14,
14 2021, and again on January 18, 2021, and again on January 20, 2021, and on the
15 telephonic discussion on January 21, 2021. The undersigned acknowledges that this
16 Motion was filed less than seven days after the telephonic conference of counsel but was
17 necessitated by Philips' delay in participating in said conference and the trial schedule,
18 which currently calls for summary judgment motions prior to this motion for an extension
19 in the trial schedule.

20 **LAMKIN IP DEFENSE**

21 */s/ Rachael D. Lamkin*
22 Rachael D. Lamkin (246066)
23 LAMKIN IP DEFENSE
24 One Harbor Drive, Suite 304
25 Sausalito, CA 94965
26 RDL@LamkinIPDefense.com
27 916.747.6091
28 *Attorney for Defendant
Garmin USA, Inc.*

I. INTRODUCTION

Philips asserted six patents against Garmin. (Dkt. No. 45, ¶48.) Only three remain. The '007 Patent was invalidated at claim construction (Dkt. No. 102), and Philips has voluntarily withdrawn its infringement allegations as to the '192 Patent. (Dkt. No. 113-1, ¶6.) Only the '233 Patent (expired), the '377 Patent (expired), and the '542 Patent remain at-issue. As noted by this Court in two separate orders, “each of the asserted patents generally relate to monitoring a subject’s activity or health condition. The patents are all utilized across the same allegedly infringing products and involve electronic monitoring of athletes—facts that Plaintiffs also recognize as true.” Order on Philips’ Rule 54 Motion, Dkt. No. 118, at 3 (*citing* Markman Order, Dkt. No. 102, at 2).

On October 27, 2020, the Patent Trial and Appeal Board (“PTAB”) instituted an IPR challenge against all of the asserted claims of the '233 Patent, finding a “reasonable likelihood that Petitioner would prevail” in its invalidity challenge. (Dkt. No. 113-1, ¶7.) The PTAB’s final decision must issue on or before a year from institution, or October 27, 2021. *See* 35 U.S.C. § 316(a). Further, in 2020, in 79% of the cases, at least some claims of the instituted patents were invalidated by the PTAB. In 52% of the cases, all claims of the asserted patents were invalidated. (Lamkin Decl., Exh. A) There is thus a near 80% probability that at least some of the asserted claims of the '233 patent will be invalidated and a 52% chance that all asserted claims of the '233 Patent will be invalidated on or before October 27, 2021.

Further, just a few days ago, Philips filed its response to the institution decision.

1 (Lamkin Decl, Exh B.) In that response, Philips took positions that if adopted by the
2 PTAB, should prompt a non-infringement determination in this case.

3
4 Currently, trial is set for July 27, 2021, three months to the day before the final
5 deadline for the PTAB's decision on the validity of the asserted claims of the '233 Patent.
6 On the data, the PTAB is highly likely to invalidate some or all of the asserted claims of
7 the '233 Patent. And in the unlikely event that the PTAB declines to invalidate all of the
8 asserted claims of the '233, the PTAB may side with Philips on key arguments that will
9 in fact demonstrate that the accused products do not infringe the '233 Patent.
10

11
12 It would be a quintessential waste of judicial resources to try Philips infringement
13 case and Garmin's invalidity defense of the '233 on these facts. Moreover, given the
14 substantial overlap between the '233 and the remaining two patents, judicial economy
15 warrants an extension of the case schedule until after the PTAB's final determination on
16 October 27, 2021.
17

18 **II. LEGAL AUTHORITY**

19
20 In deciding whether to grant a stay pending *inter partes* review proceedings (or, as here,
21 a mere extension), courts in this District have considered three factors that were originally used
22 to consider requests for stays pending the U.S. Patent and Trademark Office's reexamination
23 proceedings: (1) whether discovery is complete and whether a trial date has been set; (2) whether
24 a stay will simplify the issues in question and trial of the case; and (3) whether a stay would
25 unduly prejudice or present a clear tactical disadvantage to the nonmoving party. *Dataquill Ltd.*
26
27 *v. Tcl Commun. Tech. Holdings*, No. 2:19-cv-03394-AB-PLAx, 2020 U.S. Dist. LEXIS
28

1 122984, at *3 (C.D. Cal. Apr. 24, 2020) (*citing Allergan Inc. v. Cayman Chem. Co.*, No. SACV
2 07-01316 JVS (RNBx), 2009 WL 8591844, at *2 (C.D. Cal. Apr. 9, 2009). While these three
3 factors are important, ultimately the totality of the circumstances governs. *Id.*

5 **III. THE TRIAL SCHEDULE SHOULD BE EXTENDED UNTIL AFTER THE** 6 **PTAB'S FINAL DETERMINATION**

8 **A. Factor One is Neutral or Slightly Weighs Against an Extension**

9 “A court’s analysis of the stage of litigation focuses on whether discovery is completed,
10 and whether a trial date has been set.” *SCA Hygiene Prods. Aktiebolag v. Tarzana Enters., LLC*,
11 No. CV 17-04395-AB (JPRx), 2017 U.S. Dist. LEXIS 218330, at *7 (C.D. Cal. Sep. 27, 2017)
12 (citations omitted). Here, fact discovery is closed but expert discovery remains open. A trial
13 date has been set but currently all civil trials in this District are stayed during the Covid 19
14 pandemic. As such, a trial date in July seems unlikely. This factor is neutral, or possibly
15 weighing against extending the case schedule.
16

18 **B. Factor Two Weighs in Favor of an Extension**

19 “With regards to IPR, some of the advantages of a stay include the fact that the record of
20 the reexamination may be entered at trial[;] that the PTO’s expertise will govern[,] thus
21 simplifying the case; that evidentiary and other issues will be further narrowed following a
22 reexamination; and that costs will be reduced.” *SCA Hygiene Prods. Aktiebolag v. Tarzana*
23 *Enters., LLC*, No. CV 17-04395-AB (JPRx), 2017 U.S. Dist. LEXIS 218330, at *10 (C.D. Cal.
24 Sep. 27, 2017) (citations omitted). Further, the Court “will benefit from the expert evaluation
25 of the issues by the Patent Office.” *Id.*, at *12.
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