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15 *Attorneys for Plaintiff*
16 *Philips North America LLC*

17 **UNITED STATES DISTRICT COURT**
18 **CENTRAL DISTRICT OF CALIFORNIA**
19 **WESTERN DIVISION**

21 Philips North America LLC,

22 *Plaintiff,*

23 vs.

24 Garmin International, Inc.
25 Garmin USA, Inc. and Garmin Ltd.,

26 *Defendants.*

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

**PHILIPS NORTH AMERICA LLC'S
NOTICE OF MOTION AND
UNOPPOSED MOTION FOR LEAVE
TO FILE SECOND AMENDED
COMPLAINT TO WITHDRAW
COUNTS IV AND V**

Date: February 26, 2021

Time: 10:00AM PT

Crtrm: 7B (350 West First Street)

1 TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

2 PLEASE TAKE NOTICE that on February 26, 2021 at 10:00AM PT, or as soon
3 thereafter as the matter may be heard before Honorable André Birotte Jr., in Courtroom 7B of
4 the United States District Court, Central District of California, located at 350 West First Street,
5 Los Angeles, CA 90012, Plaintiff Philips North America LLC (“Philips”) will, and hereby does,
6 respectfully move unopposed under Fed. R. Civ. P 15(a)(2) and 16(b)(4) for leave to amend its
7 First Amended Complaint to withdraw all allegations of infringement of U.S. Patent Nos.
8 6,976,958 (“the ’958 patent”) and 9,314,192 (“the ’192 Patent”). Attached as **Exhibit A** is a
9 copy of Philips’s Proposed Second Amended Complaint.

10 This Motion is based on this Notice of Motion, the accompanying Memorandum of
11 Points and 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 several conferences with defense counsel, and the Motion
14 is unopposed by Defendants.

15 DATED: January 27, 2021

FOLEY & LARDNER LLP

17 /s/ Jean-Paul Ciardullo

18 Jean-Paul Ciardullo

19 Eley O. Thompson

20 Ruben J. Rodrigues

21 Lucas I. Silva

22 John W. Custer

23 *Attorneys for Philips North America, LLC*

1 **MEMORANDUM**

2 Plaintiff Philips North American LLC (“Philips”) respectfully moves the Court under
3 Fed. R. Civ. P 15(a)(2) and 16(b)(4) for leave to amend its First Amended Complaint to
4 withdraw all allegations of infringement of U.S. Patent Nos. 6,976,958 (“the ’958 patent”) and
5 9,314,192 (“the ’192 Patent”). Attached as **Exhibit A** is a copy of Philips’s Proposed Second
6 Amended Complaint. The only change between Philips’s Second Amended Complaint and
7 Philips’s Proposed Second Amended Complaint is that all references to the ’958 Patent and ’192
8 Patent have been removed.

9 With regards to the ’958 Patent, on August 10, 2020 Philips filed a disclaimer of all the
10 asserted claims of the ’958 patent with the U.S. Patent and Trademark Office. (See **Exhibit B**.)
11 As a result of this disclaimer, those claims can therefore no longer be asserted against Fitbit or
12 any other parties. Accordingly, good cause exists to allow the requested amendment.

13 With regards to the ’192 Patent, the parties have reached an agreement to narrow the
14 scope of this dispute and remove claims related to the ’192 Patent from dispute. As part of that
15 agreement, **Philips, on behalf of itself and any successors-in-interest, agrees to hereby**
16 **unconditionally and irrevocably covenant not to sue, or otherwise assert claims, of the ’192**
17 **Patent against any Garmin products for past, present, and future infringement as those**
18 **products existed on December 1, 2020.**

19 Counsel for Philips has conferred with counsel for Garmin with respect to the relief
20 requested in this Motion and counsel for Garmin has confirmed that they do not oppose the relief
21 requested in this Motion.
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1 DATED: January 27, 2021

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