

EXHIBIT A

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571-272-7822

Paper 13
Date: November 3, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITBIT, INC.,
Petitioner,

v.

PHILIPS NORTH AMERICA LLC,
Patent Owner.

IPR2020-00828
Patent 8,277,377 B2

Before PATRICK R. SCANLON, FRANCES L. IPPOLITO and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

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I. INTRODUCTION

Fitbit, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1, 4–6, 9, and 12 of U.S. Patent No. 8,277,377 B2 (Ex. 1001, “the ’377 patent”). Philips North America LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). With our authorization, Petitioner filed a Reply (Paper 7, “Reply”), and Patent Owner filed a Sur-reply (Paper 9, “Sur-reply”).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2019). To institute an *inter partes* review, we must determine that the information presented in the Petition shows “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons set forth below, we exercise our discretion under 35 U.S.C. § 314(a) to deny institution.

II. BACKGROUND

A. Related Matters

The parties identify *Philips North America LLC v. Fitbit, Inc.*, No. 1:19-cv-11586-IT (D. Mass., July 22, 2019) (“the Fitbit case”) as involving the ’377 patent, as well as U.S. Patent 6,976,958 (“the ’958 patent”), U.S. Patent No. 7,088,233 (“the ’233 patent”), and U.S. Patent No. 6,013,007 (“the ’007 patent”). Pet. 1; Paper 3, 1. Patent Owner adds that the ’377, ’958, ’233, and ’007 patents, as well as U.S. Patent Nos. 9,314,192 and 9,801,542, are at issue in *Philips North America LLC v. Garmin International, Inc. et al.*, Case No. 2:19-cv-06301-AB-KS (C.D. Cal., June 8, 2020) (“the Garmin case”). Paper 3, 1.

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Petitioner has filed a petition for *inter partes* review challenging the '958 patent (IPR2020-00782). Pet. 1; Paper 3, 1–2. Petitioner has also filed a petition for *inter partes* review challenging the '233 patent (IPR2020-00783). Pet. 1; Paper 3, 1–2.

B. Real Parties-in-Interest

Petitioner identifies itself as the real party-in-interest. Pet. 1. Patent Owner identifies itself as the real party-in-interest. Paper 3, 1.

C. The '377 patent

The '377 patent, titled “Method and Apparatus for Monitoring Exercise with Wireless Internet Connectivity,” issued October 2, 2012, with claims 1–19. Ex. 1001, code (54), code (45), 13:23–16:5. Figure 1 is reproduced below.

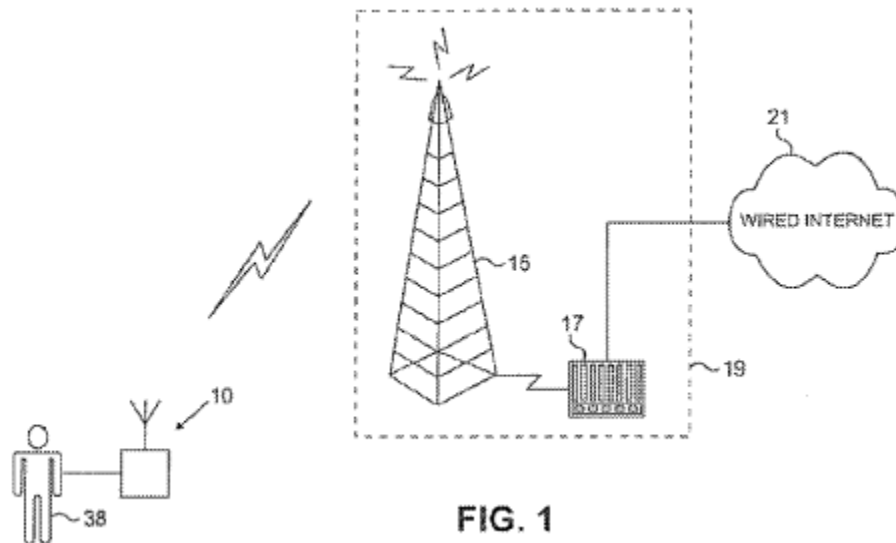


Figure 1 depicts a general embodiment of a wireless health-monitoring system. *Id.* at 5:24–25. More specifically, the '377 patent discloses wireless health-monitoring system (“WHMA”) 10 for monitoring health data from a patient or subject 38. *Id.* at 6:36–37. WHMA 10 is wirelessly linked to wireless connection point of presence (“POP”) 19. *Id.* at 6:39–41. POP 19

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includes base station antenna 15 that is coupled to server 17, which in turn is connected to Internet 21. *Id.* at 6:41–44.

In addition, WHMA 10 includes health monitoring device (“HMD”) 11 and wireless web device (“WWD”) 12. *Id.* at 6:45–48, Fig. 2. HMD 11 may include physiologic sensor 24 or manual system 36 for input of physiologic data via a connection 34. *Id.* at 6:52–54, Fig. 2. WWD 12, which can be a web-enabled cellular phone, connects wirelessly to base station 15 to provide a user interface. *Id.* at 3:58–59, 6:48–50.

Figure 4 is reproduced below.

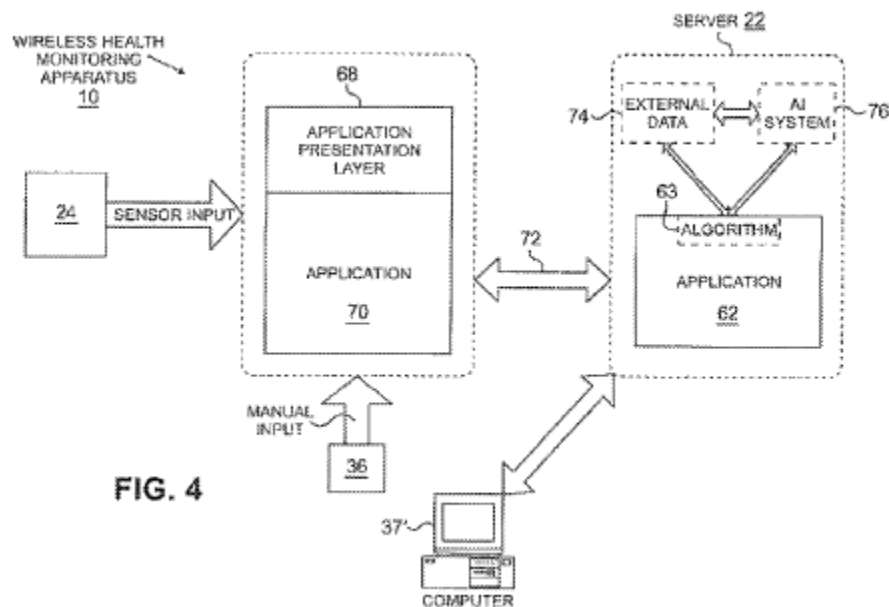


Figure 4 is a data flow diagram of the invention. *Id.* at 5:32–33. WHMA 10 is shown in signal communication with server 22. *Id.* at 7:66–67. WHMA 10 includes an application having two components: base wireless or device application 70 and application presentation interface 68. *Id.* at 8:3–5. These applications may accept input from sensor 24. *Id.* at 8:10–12. In addition, application 70 can send health data to server application 62. *Id.* at 8:61–63.

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