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16 *Philips North America LLC*

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

20 Philips North America LLC,

21 *Plaintiff,*

22 vs.

23  
24 Garmin International, Inc. and  
Garmin Ltd.,

25 *Defendants.*  
26  
27  
28

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

**PHILIPS NORTH AMERICA LLC's  
OPPOSITION TO DEFENDANTS'  
MOTION TO AMEND; MOTION TO  
DISMISS IN THE ALTERNATIVE**

Date: August 28, 2020

Time: 10:00 A.M.

Courtroom: 7B

Hon. André Birotte Jr.

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1       **I. INTRODUCTION**

2           Plaintiff Philips North America, LLC (“Philips”) hereby respectfully opposes  
3 Defendants Garmin International, Inc.’s and Garmin Ltd.’s (collectively “Garmin”) Motion  
4 to Amend their Counterclaims to add allegations of inequitable conduct with respect to  
5 U.S. Patent No. 9,314,192 (“’192 Patent”) on the grounds that such amendment would be  
6 futile, and that Garmin is improperly seeking to derail and multiply these proceedings.  
7 Significantly, although not acknowledged by Garmin, the International Trade Commission  
8 just recently granted Philips’s Motion to Strike very similar inequitable conduct allegations  
9 in a co-pending proceeding between the parties. (*See* Ruling at **Exhibit 1** to the  
10 accompanying Declaration of Jean-Paul Ciardullo.)

11           Garmin’s proposed counterclaim rests on the premise that the Philips attorneys  
12 prosecuting the ’192 Patent application in the US were aware of purportedly material prior  
13 art – the Yamamoto reference – that had been cited in a European patent application  
14 claiming similar priority. However, as is apparent on the face of the US and EU application  
15 file histories that Garmin’s pleadings rely upon, none of the same attorneys handling the  
16 US case were ever involved in the EU case, and indeed they are from different continents.  
17 The only linkage Garmin draws between the separate US and EU patent prosecutors is the  
18 fact that they all work for Philips, and they use the same automated docket numbering  
19 format (even though the record establishes that there were separate file names and separate  
20 files in the US and EU). As is proved up by the proposed pleadings themselves, the Philips  
21 Intellectual Property & Standards (IP&S) group has hundreds of professionals working in  
22 dozens of offices prosecuting more than a thousand patent applications per year, such that  
23 imputing specific knowledge across the organization is not plausible on its face.  
24 Furthermore, the Yamamoto reference was cited in the EU a full *six years after* the ’192  
25 Patent application had already been filed and was nearing the end of prosecution.

26           The law is clear that “[t]he mere fact that an applicant disclosed a reference during  
27 prosecution of one application, but did not disclose it during prosecution of a related  
28 application, is insufficient to meet the threshold level of deceptive intent required to

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