## UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MASSACHUSETTS

PHILIPS NORTH AMERICA LLC,	
Plaintiff,	)
	) Civil Action No. 1:19-cv-11586-I
V.	[]
FITBIT, INC.,	) JURY TRIAL DEMANDED
Defendant.	: )
	; )

## RESPONSE TO FITBIT'S MOTION FOR LEAVE TO SUBMIT SUPPLEMENTAL AUTHORITY RELATING TO CLAIM CONSTRUCTION (DKT. 98)

While Philips North America, LLC ("Philips") does not object to submission of the interlocutory order from the Central District of California, Philips does not agree that the interlocutory order is supplemental "authority" in view of the fact that the order has no preclusive effect, it is a non-final and not appealable, subject to intervening change as the parties further brief the issues. *See RF Del., Inc. v. Pacific Keystone Techs.*, 326 F.3d 1255, 1260-62 (Fed. Cir. 2003) (affirming that district court properly conducted independent claim construction, without giving collateral estoppel effect to interlocutory orders of other court); *Vardon Golf Co. v. Karsten Mfg. Corp.*, 294 F.3d 1330, 1334-1335 (Fed. Cir. 2002) (finding error to give interlocutory non-appealable orders preclusive effect). This is particularly true in view of the preliminary nature of the order and its repeated reservation that the comments are being made "at this time" subject to the court's further understanding of the merits of the dispute. The court's determination on various claim terms was based on the briefs and record before it, and the



Case 1:19-cv-11586-IT Document 102 Filed 09/02/20 Page 2 of 4

arguments and issues raised by Garmin in the Central District of California, which in many

respects differ from the issues presented to this Court.

For example, with respect to the '233 Patent, the Central District of California noted that

it was not addressing the merits of Garmin's non-infringement argument that its devices do not

constitute "medical devices" because they were not FDA approved. (See Dkt. 98-1 at 18, n. 5.)

The order also includes some aspects that will need to be reconsidered so as to avoid reversible

error, including the Court's improper disregard for expert testimony as to the '007 patent. Amtel

Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 1382 (Fed. Cir. 1999) (reversing

grant of summary judgment of indefiniteness of means-plus-function claim for failing to consider

unrebutted expert testimony with regard to the appropriate structure).

Accordingly, the Court is not, and should not be, bound by the decision and should

continue to assess the issues on the record before it.

Dated: September 2, 2020

Respectfully Submitted,

/s/ Eley O. Thompson

Lucas I. Silva (BBO 673,935)

Ruben J. Rodrigues (BBO 676,573)

John Custer (BBO 705,258)

FOLEY & LARDNER LLP

111 Huntington Avenue

Suite 2500

Boston, MA 02199-7610

Phone: (617) 342-4000

Fax: (617) 342-4001

lsilva@foley.com

rrodrigues@foley.com

jcuster@foley.com

Eley O. Thompson (pro hac vice)

FOLEY & LARDNER LLP

321 N. Clark Street

**Suite 2800** 



## Case 1:19-cv-11586-IT Document 102 Filed 09/02/20 Page 3 of 4

Chicago, IL 60654-5313 Phone: (312) 832-4359 Fax: (312) 832-4700 ethompson@foley.com

Counsel for Plaintiff Philips North America LLC



## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the above document was served on September 2, 2020 on counsel for Defendant via electronic mail.

By: <u>/s/Ruben J. Rodrigues</u> Ruben J. Rodrigues

