

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

PHILIPS NORTH AMERICA LLC,

Plaintiff,

v.

FITBIT, INC.,

Defendant.

Civil Action No. 1:19-cv-11586-FDS

**FITBIT'S OPPOSED MOTION FOR LEAVE TO SUBMIT SUPPLEMENTAL
AUTHORITY ON CLAIM CONSTRUCTION**

Fitbit, Inc. ("Fitbit") submits this motion for leave to submit supplemental authority on claim construction (*see* Dkt. Nos. 72, 73, 77, 78, 83, 84, 87, 98, 102, 111). Philips North America LLC ("Philips") opposes.

On March 2, 2021, the Federal Circuit issued a precedential opinion in *Rain Computing, Inc. v. Samsung Elecs. Am., Inc.*, No. 2020-1646, -- F.3d --, 2021 WL 786361 (Fed. Cir. Mar. 2, 2021), reversing a judgment of no indefiniteness by the U.S. District Court for the District of Massachusetts. This opinion is attached as Exhibit A.

Relevant to at least the parties' *Markman* disputes with respect to the "means for computing" limitation recited by U.S. Patent No. 6,013,007, the Federal Circuit determined claims reciting a means-plus-function limitation that invoked 35 U.S.C. § 112 ¶ 6 to be invalid as indefinite because the structure corresponding to the claimed function was a general purpose processor and the specification did not disclose an algorithm to perform the claimed function.

Excerpts of the relevant portion of the Federal Circuit opinion follow:

The district court found that the structural examples linked to the function of the “user identification module” are all “computer-readable media or storage device[s].” *Rain Computing*, 2020 WL 708125, at *5 The district court erred, however, in concluding that the disclosure of computer-readable media or storage devices provided sufficient structure for the “control access” function. *Id.* These computer-readable media or storage devices amount to nothing more than a general-purpose computer. . . . Rather, some special programming, *i.e.*, an algorithm, would be required to control access to the software application packages. Rain even agrees that the “user identification module” should include software algorithms. *See, e.g.*, Appellant’s Resp. & Reply Br. at 22, (“the module would . . . be configured to . . . respond to requests for information (using common software algorithms)”), *id.* at 27 n.17 (“the user identification module should include software implementations”). And the inventor agreed that “there are certain algorithms out there” such as “open source software that can implement” the user identification module. J.A. 297–99. Under these circumstances, where a general purposes computer is the corresponding structure and it is not capable of performing the controlling access function absent specialized software, an algorithm is required.

Nothing in the claim language or the written description provides an algorithm to achieve the “control access” function of the “user identification module.” When asked at oral argument to identify an algorithm in the written description, Rain could not do so. Oral argument at 32:54–34:40, *available at* http://oralarguments.cafc.uscourts.gov/default.aspx?fl=20-1646_02022021.mp3. Without an algorithm to achieve the “control access” function, we hold the term “user identification module” lacks sufficient structure and renders the claims indefinite.

Rain Computing, 2021 WL 786361, at *4.

Dated: March 4, 2021

FITBIT, INC.

By Its Attorneys,

/s/ Yar R. Chaikovsky

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LOCAL RULE 7.1 CERTIFICATION

I, Chad Peterman, counsel for Defendant Fitbit, Inc., hereby certify that Fitbit has conferred with counsel for Philips North America, LLC and could not reach agreement on this motion.

Dated: March 4, 2021

By: /s/ Chad Peterman
Chad Peterman

CERTIFICATE OF SERVICE

I certify that a true copy of the above document was served on the attorney of record for each party via the Court's CM/ECF system, which will send notification of this filing (NEF) to all registered participants, and paper copies will be sent to those indicated as nonregistered participants.

Dated: March 4, 2021

By: /s/ Yar Chaikovsky
Yar Chaikovsky