

EXHIBIT D

From: [Rodrigues, Ruben J.](#)
To: [Peterman, Chad](#)
Cc: [BOST - F - Philips - Fitbit; Philips - Fitbit](#)
Subject: RE: Philips v. Fitbit (D. Mass) - Contentions
Date: Tuesday, February 2, 2021 3:30:49 PM

Hi Chad,

Thanks, for providing a counterproposal. Here our current thoughts, let us know if we might have an agreement on some or all of this:

1.) We won't agree to not to include the Charge 4 product in the amendment, which was released just after Philips finalized its original contentions. The Charge 4 products infringes for the same reasons as all the other accused products and there is no prejudice to Fitbit in adding it to the contentions. That said, if we can reach agreement that Fitbit would not object on the basis of diligence with respect to Charge 4, we would not object to the proposed amendments concerning Gaukel.

2.) We are open to narrowing the asserted claims as part of an overall agreement to limit prior art. We think, however, that this limiting exercise should occur prior to the service of expert reports. If we agree to an overall extension of the schedule as proposed in my earlier e-mail, perhaps sit makes sense to include some deadlines for narrowing prior art and asserted claims prior to the service of expert reports? Is this something we should discuss?

Regards,

-Ruben

From: Peterman, Chad <chadpeterman@paulhastings.com>
Sent: Friday, January 15, 2021 1:15 PM
To: Rodrigues, Ruben J. <RRodrigues@foley.com>
Cc: BOST - F - Philips - Fitbit <BOSTFPhilipsFitbit@foley.com>; Philips - Fitbit <Philips-Fitbit@paulhastings.com>
Subject: RE: Philips v. Fitbit (D. Mass) - Contentions

**** EXTERNAL EMAIL MESSAGE ****

Ruben –

Thanks for your email. We offer the following in response:

- 1) We would agree that neither party shall object to any amendment on the basis of timeliness/diligence, except for Philips' attempt to add the Charge 4 product. The Charge 4 launched in April 2020 and Philips has not provided any justifiable reason for delay. If Philips agrees to the foregoing, we would also agree to withdraw the proposed amendment with respect to Gaukel.

- 2) We do not agree to your proposal for limiting the prior art. At a minimum, it is premature. Notably, there are pending motions and claim constructions that may impact the scope of the case and the parties' positions. These motions must be resolved before we could consider potential narrowing. Further, we could not possibly consider narrowing prior art positions without Philips narrowing the number of asserted claims in each patent.

Please let us know your positions in response.

Regards,
Chad

From: RRodrigues@foley.com <RRodrigues@foley.com>
Sent: Monday, January 11, 2021 10:47 AM
To: Peterman, Chad <chadpeterman@paulhastings.com>
Cc: BOSTFPhilipsFitbit@foley.com; Philips - Fitbit <Philips-Fitbit@paulhastings.com>
Subject: [EXT] Philips v. Fitbit (D. Mass) - Contentions

Hi Chad,

In order to move the ball forward with respect to both Philips's and Fitbit's proposed amendments to the contentions, Philips proposes that both parties agree that neither party shall object to any amendment on the basis of timeliness/diligence. After all, the materials Fitbit seeks to add to the invalidity contentions at this stage are all publicly available materials that it could have been identified earlier.

If agreement can be reached on that front, and assuming Fitbit agrees to additionally withdraw the proposed amendment with respect to Gaukel, a reference Fitbit had when it served its original contentions, Philips would further agree not to oppose the proposed amendments with respect to the Icon Health and Fitness charts.

That would leave the issue of Fitbit's proposed amendment with regards to the Teller, Maeda, Henderson, and "SmartClothing" references. Assuming agreement on the above, Philips would only oppose Fitbit's proposed amendments with respect to these references on the grounds that Fitbit has already served an unreasonable number of invalidity contentions, and now would be a good time to simplify the case and not further complicate the case. Specifically, with respect to the patents still at issue in this matter, and including the proposed amendment, Fitbit will have identified more than 109 total prior art references and will have served 53 claim charts. Fitbit can't genuinely intend to pursue all these prior art references in this case, nor would it be reasonable to do so. Accordingly, we could agree to Fitbit's proposed amendment if Fitbit would agree to limit its contentions at this stage to five (5) prior art references against each patent still at issue (for a total of fifteen). Let us know if this might be agreeable.

We understand that even if we are able to agree with respect to the above, this would mean that

Fitbit would continue to oppose Philips's amendment to its infringement contentions on the basis of Fitbit's theory that the '377 Patent is expired. As we've explained, we believe Fitbit's position to be without merit in view of the fact that no provisional application was converted to a non-provisional in under 37 C.F.R. 1.53, and the cited cases relied on by Fitbit are inapposite. We intend to file a motion to amend Philips's contentions as previously shared with Fitbit and believe our meet and confer requirements have been met. Please advise if you disagree or if Fitbit has changed its position.

Regards,

-Ruben

Ruben J. Rodrigues
Foley & Lardner LLP
111 Huntington Ave, Suite 2600
Boston, MA 02199

rrodrigues@foley.com
617-502-3228 (office)
617-763-5089 (mobile)

The information contained in this message, including but not limited to any attachments, may be confidential or protected by the attorney-client or work-product privileges. It is not intended for transmission to, or receipt by, any unauthorized persons. If you have received this message in error, please (i) do not read it, (ii) reply to the sender that you received the message in error, and (iii) erase or destroy the message and any attachments or copies. Any disclosure, copying, distribution or reliance on the contents of this message or its attachments is strictly prohibited, and may be unlawful. Unintended transmission does not constitute waiver of the attorney-client privilege or any other privilege. Legal advice contained in the preceding message is solely for the benefit of the Foley & Lardner LLP client(s) represented by the Firm in the particular matter that is the subject of this message, and may not be relied upon by any other party. Unless expressly stated otherwise, nothing contained in this message should be construed as a digital or electronic signature, nor is it intended to reflect an intention to make an agreement by electronic means.