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

Leave to file granted during status conference held April 21, 2021

PLAINTIFF'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR LEAVE TO AMEND L.R. 16.6(d)(1) INFRINGEMENT CONTENTIONS

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I. INTRODUCTION

Fitbit's Opposition brief fails to identify any genuine prejudice to Fitbit from allowing the proposed amendment—there is none. Indeed, Fitbit does not dispute that (at least for the Charge 4 product) the proposed amendments accuse the **very same features** previously accused of infringement with respect to other products. It also remains true that it is these **very same features** that are accused in the proposed amended contentions for the Inspire 2, Sense, and Versa 3, though Philips apologizes to both the Court and Fitbit for inadvertently failing to include copies of the proposed amended contentions for these products with its opening brief. The proposed amended contentions for these additional products are now attached hereto as Exhibits R, S, and T.[1] The infringement theories for the Inspire 2 (Ex. R) are the same as previously disclose for the Inspire HR (Ex. U) while the infringement theories for the Sense (Ex. S) and Versa 3 (Ex. T) are the same as for the Versa 2 (Ex. V).

Meanwhile, Fitbit's Opposition brief tacitly acknowledges, as it must, that the '191 Patent was **not actually a conversion** of the '486 Provisional. Instead, Fitbit's argument is essentially that the '191 Patent should be **treated as** a conversion simply because of the colloquial language used in claiming priority to the '486 Provisional. Yet Fitbit cites not a single case where any Court has ever taken such an extreme approach, and this Court should decline Fitbit's invitation to be the first. Fitbit's purports to rely on inapposite cases involving the failure of applicants to actually include a specific reference to an application to which priority is claimed, but that is not an issue here.

[1] Fitbit points out that Philips's draft contentions served back in December of 2020, when the parties began negotiating amendments to both sides' contentions, included allegations of infringement against an additional "Active Zone Minutes" feature that was previously not accused of infringement—however Philips is not presently seeking to amend

II. GOOD CAUSE EXISTS TO ALLOW THE AMENDMENT

As set forth in its opening memorandum, Philips was diligent in seeking to amend its infringement contentions. This is particularly so in light of Philips's desire to avoid piecemeal amendments as Fitbit rolled out new products through 2020 and the fact that Philips is not seeking to add **any new infringement theories** to the case—only features also previously available in older products are accused of infringement.

Fitbit repeatedly hammers the notion that Philips waited "a year" with respect to the Charge 4 and "six months" for the other three products. However, this fails to acknowledge that Philips sought to amend its contentions **in December of 2020** and that the parties subsequently entered into negotiations, concerning the scope of **both sides'** contentions, that Philips presumed were proceeding in good faith. That Fitbit retained new counsel and appears to have abandoned its desire to amend its own contentions should not be used to somehow demonstrate lack of diligence on Philips's part. Indeed, it is tantamount to arguing that Philips should not have engaged in negotiations in an effort to narrow the dispute and should have instead run to the Court despite Fitbit's then-willingness to engage in a discussion of potential narrowing.

Fitbit's attempt to compare Philips's purported "delay" here to situations where amended contentions were not allowed also fails. In neither *Acer, Inc. v. Tech. Properties Ltd.*, 5:08-CV-00877 JF/HRL, 2010 WL 3618687 (N.D. Cal. Sept. 10, 2010), nor *Synopsys, Inc. v. Atoptech, Inc.*, 13CV02965MMCDMR, 2016 WL 4945489 (N.D. Cal. Sept. 16, 2016) did the patent owner seek to amend infringement contentions to include the accused infringer's new products launched after initial contentions were served. Rather, in *Acer*, the amended contentions introduced new infringement theories, including adding existing products and asserting new patent claims. *Acer,* 2010 WL 3618687 at *1- 2. The case had been stayed pending results of a reexamination, and only after the stay was lifted, the patent owner "re-investigated evidence" regarding the accused

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