IN THE 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

DEFENDANT FITBIT INC.'S MEMORANDUM OF LAW IN SUPPORT OF ITS MOTION TO COMPEL THE PRODUCTION OF CERTAIN OF MR. ARIE TOL'S EMAIL COMMUNICATIONS

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INTRODUCTION

Defendant Fitbit, Inc. ("Fitbit") moves to compel Plaintiff Philips North America LLC ("Philips") to produce email communications Philips improperly withheld for privilege. Specifically, Fitbit seeks to compel production of emails of Mr. Arie Tol, a Dutch patent agent employed by Philips's parent, Koninklijke Philips N.V., in its intellectual property licensing division, Philips Intellectual Property and Standards ("Philips IP&S"). Mr. Tol has first-hand knowledge regarding Philips's licensing practices and policies, both generally and as they relate to the litigation against Fitbit—matters relevant to Fitbit's defenses. Nonetheless, both during Mr. Tol's deposition and in response to Fitbit's subsequent requests for Mr. Tol's relevant emails, Philips prevented Fitbit from obtaining this relevant discovery by improperly invoking attorney-client privilege and work product protection. Accordingly, Fitbit moves to compel certain entries on Mr. Tol's email privilege log (attached as Exhibit A (April 16 Privilege Log)) for three reasons.

First, Philips's invocation of attorney-client privilege for communications exclusively between Dutch patent agents and other non-attorney employees who were not acting at the direction and control of a licensed attorney, and related to matters other than representation before a patent office, has no basis in U.S. or Dutch law. Patent agent privilege extends only to matters before a patent office, such as patent prosecution. As such, Philips's claims of attorney-client privilege over communications between patent agents related to the post-issuance assertion of patents it acquired from third-parties and did not prosecute, is improper under U.S. law. Additionally, to the extent Dutch law applies—and Fitbit contends that it does not—these communications are not privileged because, like the U.S., the Netherlands does not recognize a patent agent privilege for matters other than proceedings before the Netherlands Patent Office.

Second, regardless of the communicants, Philips improperly invokes attorney-client privilege for communications that appear to deal primarily with business—rather than legal—

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