

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MASSACHUSETTS

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PHILIPS NORTH AMERICA LLC,

Plaintiff,

v.

FITBIT, INC.,

Defendant.

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

**PLAINTIFF'S OPPOSITION TO FITBIT, INC.'S MOTION TO COMPEL THE  
PRODUCTION OF CERTAIN OF MR. ARIE TOL'S EMAIL COMMUNICATIONS**

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## I. INTRODUCTION

Mr. Arie Tol has been a registered Dutch Patent Attorney since the year 2000, and in his current role serves as a Principal Licensing Counsel for Philips, where he has worked since 1995. (*See* Ex. 1, Tol. Decl. ¶ 1.) Mr. Tol is also the patent attorney at Philips principally responsible for overseeing not only the present litigation pending in the District Massachusetts, but also the litigation matters pending against Fitbit before the U.S. International Trade Commission, and earlier matters relating to European Patents involving Fitbit or Garmin in Germany and the United Kingdom.<sup>1</sup> This is not a case where Philips has refused—wholesale—to produce Mr. Tol’s correspondence on some blanket assertion of privilege over his communications. To the contrary, and in accordance with the parties’ agreement to run search terms on Mr. Tol’s e-mail, Philips produced 685 documents from Mr. Tol’s e-mail that related to business issues as opposed to legal advice or pre-suit investigations—a production totaling 4,279 pages.<sup>2</sup>

Of course, given Mr. Tol’s role as a Dutch Patent Attorney,<sup>3</sup> who not only advises on the prosecution of patent applications, but also manages patent infringement disputes—including the

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<sup>1</sup> Fitbit accuses Philips of “omitting” Mr. Tol from its initial disclosures. To be clear, Fed. R. Civ. P. 26(a)(1)(A)(i) requires an identification of witnesses that a disclosing party “may use to support its claims or defenses.” Until Fitbit sought to depose Mr. Tol in this action, Philips had no intent on relying on his testimony at trial, and had no obligation to disclose him.

<sup>2</sup> Fitbit notes that Mr. Tol’s documents were produced on “March 23, 2021—the last day of fact discovery,” however Fitbit’s **first** request that Philips run search terms on Mr. Tol’s e-mails was made on January 15, 2021. The parties then negotiated the scope of terms to be searched, reaching an agreement on March 4<sup>th</sup>, 2021.

<sup>3</sup> Fitbit refers to Mr. Tol and other Dutch Patent Attorneys as “Patent Agents” in an effort to equate the scope of Mr. Tol’s authorized scope of work under Dutch law as limited to the equivalent of a U.S. Patent Agent. However, as explained in more detail throughout this opposition, and in the accompanying expert declaration of Dutch Law Professor Willem Hoyng (*see* Ex. 2, Hoyng Decl.), the authorized scope of work for a Dutch Patent Attorney is not so limited. While Mr. Tol, those at Philips, and others in the Dutch larger legal community appear to use the term “attorney” rather than “agent” to describe the role of “Dutch Patent Attorney”—whether one uses the term “agent” or “attorney” should not matter, what matters is the scope of the role as authorized under Dutch law—which is broader than merely advising on the

present and related cases—it should not be surprising that many of communications that happened to hit on Fitbit’s search terms are privileged and were, accordingly logged. As explained below, the documents would be protected from discovery under both U.S. and Dutch law, and there is no basis on which to compel their discovery.

While Philips’s initial privilege log included a number of errors attributable to the number of documents to be reviewed and mistakes initially made by some of the individuals reviewing those materials, Philips has repeatedly engaged in a good faith effort to correct those errors and provide additional detail on any privilege log entry for which Fitbit has sought additional information. Indeed, since the initial privilege log Philips has produced many documents that were originally logged but, upon further inspection, were not protected from discovery.

## **II. PHILIPS’S APPROACH TO PATENT ENFORCEMENT AND LICENSING AGAINST FITBIT BEGAN WITH DEVELOPING AN INFRINGEMENT CASE AGAINST FITBIT**

As described in Mr. Tol’s accompanying declaration, Philips’s approach to licensing almost always starts with identifying infringers against whom Philips could bring a legal claim for patent infringement (whether in the U.S., Europe, Asia, or elsewhere), and this was indeed the approach taken by Philips in preparing to put Fitbit on notice of its infringement and then filing suit against Fitbit (first in the Europe, later in the United States). (*See* Ex. 1, Tol. Decl. ¶ 3.) As explained by Mr. Tol, Philips began evaluating whether certain Fitbit and Garmin products infringed Philips patents in 2015, and Dutch Patent Attorney Erik Pastink was primarily responsible for this work. (*Id.* ¶ 4-5). Because of the similarities in the infringing Fitbit and Garmin technologies, and the overlap in patents to be asserted against each entity, the effort

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