

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

**MEMORANDUM IN SUPPORT OF PLAINTIFF'S MOTION TO
STRIKE PORTIONS OF NOVEMBER 16, 2021 EXPERT REPORT
OF JOSEPH A. PARADISO AS TO PREVIOUSLY WITHHELD
PRIOR ART AND INDEFINITNESS DEFENSES**

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I. INTRODUCTION

Plaintiff Philips North America LLC (“Philips”) respectfully submits this Memorandum in support of its Motion to Strike portions of the Expert Report of Joseph A. Paradiso, Ph.D. (the “Paradiso Report”) Regarding Invalidity of U.S. Patent No. 8,277,377 (the “’377 Patent”) dated November 16, 2021.

The Paradiso Report introduces for the first time and relies on new prior art references that were never disclosed by Defendant Fitbit, Inc. (“Fitbit”) as prior art to U.S. Patent No. 8,277,377 (the “’377 Patent”) as required by Local Rule 16.6(d)(4). These prior art patents were therefore not subject to fact discovery. Additionally, the Paradiso Report introduces, for the first time, a new indefiniteness theory of invalidity that Fitbit never disclosed as also required by Local Rule 16.6(d)(4). The Court’s scheduling order set a clear deadline for Plaintiffs to serve their Rule 16.6(d)(4) disclosures of invalidity contentions¹ so they could be tested in fact discovery and prior proceedings, and the Local Rules clearly require that all prior art and invalidity theories Fitbit intends to rely on be disclosed in those contentions. While Fitbit amended its Rule 16.6(d)(4) disclosures in earlier proceedings during fact discovery, Fitbit withheld its newly revealed theories and prior art and never sought to amend its invalidity contentions preferring to surprise Philips at this later stage.

This introduction of new prior art and a new indefiniteness argument not only violates the Court’s orders and the Local Rules, but also unfairly prejudices Philips. Philips was not given notice that this prior art would be asserted against the ’377 Patent and thus did not have an opportunity to conduct fact discovery regarding these references. Philips never had the opportunity to test the prior art, address collateral issues in discovery, obtain testimony from the named

¹ See Dkt. 54, Scheduling Order, at 1 (“[T]he parties shall complete all patent-related disclosures contemplated by Local Rule 16.6(d)(1) and (4) by April 15, 2020.”)

applicants, etc. Likewise, Philips did not have notice of Fitbit's new indefiniteness argument. In this regard, Philips was again denied the opportunity for fact discovery including to ask Fitbit's technical people and other third parties including the inventor about Fitbit's ridiculous theory. Fitbit's delay tactic suppressed the argument so it could not be tested. Thus, Philips asks the Court to maintain the present schedule and strike the portions of the Paradiso Report that discuss this previously undisclosed prior art and indefiniteness argument. Fitbit is very concerned about facing a Jury trial on its infringement, especially since there is significant evidence of willfulness to enhance damages. Fitbit's late attempts to derail the proceedings should not be entertained.

II. BACKGROUND

Philips has already waited over two years to bring this case to trial. On July 22, 2019, Philips filed a patent infringement case against Fitbit in the District Court of the District of Massachusetts asserting that Fitbit infringes a number of U.S. Patents, including the '377 patent, which is presently the only patent at issue. *See* Dkt. 1. The '377 Patent is directed to health, wellness, and fitness monitoring technology, and Philips accuses various Fitbit activity trackers and smart watch products of infringement.

On March 13, 2020, Fitbit served its Invalidity and Non-Infringement Contentions in accordance with Local Rule 16.6(d)(4). *See* Ex. 1. On December 21, 2020, Fitbit served Amended Invalidity and Non-Infringement Contentions. *See* Ex. 2. Fitbit's initial and amended contentions total a staggering 9,002 pages, and in addition to the apparent sandbagging, Fitbit identified thirty-nine separate pieces of prior art (along with thousands of obviousness combinations) that Fitbit "intended" to assert against the '377 Patent, and neither the initial nor the amended contentions identified any basis for indefiniteness of the '377 Patent, despite identifying several indefiniteness arguments for one of the other asserted patents. *See* Ex. 1 at 11-13, 72-91; Ex. 2 at 12-14, 74-97. Well after the close of fact discovery and facing an impending jury trial, on November 16, 2021,

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