IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

PHILIPS NORTH AMERICA LLC, Plaintiff, v. FITBIT, LLC, Defendant.	Civil Action No. 1:19-cv-11586-FDS

DEFENDANT FITBIT LLC'S MEMORANDUM IN OPPOSITION TO PHILIPS' MOTION TO STRIKE PORTIONS OF THE NOVEMBER 16, 2021 EXPERT REPORT OF JOSEPH A. PARADISO (DKT. 259)

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I. INTRODUCTION

Defendant Fitbit LLC ("Fitbit") respectfully requests that this Court deny, in-part, the 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") filed by Plaintiff Philips North America LLC ("Philips"). (Dkt. 259 ("Motion"); *see also* Dkt. 260 ("Memorandum").) Philips disputes Dr. Paradiso's reliance on fourteen prior art references and an indefiniteness opinion. In an effort to narrow the disputes, Fitbit hereby withdraws its reliance on the following three prior art references subject to Philips' Motion: U.S. Patent No. 5,689,825 ("Averbuch"), U.S. Patent No. 6,311,058 ("Wecker"), and U.S. Patent No. 6,493,758 ("McLain"). Fitbit respectfully requests that the Court deny the remainder of Philips' Motion.

First, Philips' issue with Fitbit's incorporation by reference of an *inter partes* review petition that relied on U.S. Patent No. 6,560,443 ("Vaisanen") as a secondary obviousness reference should be ignored given that Philips was undisputedly on notice of Fitbit's invalidity contention with respect to Vaisanen, which was raised in Fitbit's petition for *inter partes* review of the same claims of '377 patent asserted here and incorporated by reference into Fitbit's contentions, and Philips already addressed that argument in its Patent Owner Preliminary Response filed in response to Fitbit's IPR petition.

Second, Dr. Paradiso's reliance on the remaining disputed prior art references to illustrate the state of the art, rather than as anticipating references or part of an obviousness combination, comports with this District's local patent rules and the majority rule under case law collected from various other districts.

Third, Dr. Paradiso's indefiniteness opinion regarding the claim term "server" was necessitated by Philips' own vague infringement contentions and Philips' failure to respond to Fitbit's clear non-infringement contentions. Indeed, it was not until Philips' opening expert report

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