

# EXHIBIT 5

March 6, 2020

Ruben Rodrigues  
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111 Huntington Avenue  
Boston, MA 02199

Re: Philips v. Fitbit, Case No. 1:19-cv-11586 (D.Mass)  
Follow up to March 4, 2020 Meet and Confer Conference Call

Dear Ruben,

Thank you for meeting and conferring with us on March 4, 2020 to discuss the deficiencies that Fitbit has raised in connection with Philips' discovery responses and Infringement Contentions. We have made progress on some issues, while we have established an impasse on others. I trust that our continued efforts to meet and confer, and your agreement to provide supplemental responses will further narrow our disputes.

On the issue of modifications to the protective order, and an ESI/Discovery order, we proposed the parties implement the scope and terms of the ITC protective and discovery orders, to ensure consistency in productions and format for electronic materials etc. You agreed in principle to this request.

**Interrogatory 1** calls for identification of conception and reduction to practice for each asserted claim. This interrogatory also relates to Local Rule 16.6(d)(1)(B) which requires Philips produce documents concerning conception and reduction to practice. You confirmed that while Foley represents both Philips and the individual inventors, you did not seek any evidence of conception or reduction to practice from the inventors. Your position is that Philips does not have custody or control of any of this information and, despite representing all participants in this litigation, you have no obligation to request or obtain the information from the inventors. Fitbit disagrees. You confirmed that you are authorized to accept service of a subpoena on behalf of all inventors. You also confirmed that, to the extent you intend to rely on anything in the file history to establish an earlier conception date than that of the filing date of the application, you will identify by bates number exactly what you contend establishes an earlier conception and reduction to practice. We are at an impasse and continue to insist that Philips comply with its discovery obligations and that the required information be obtained from the inventors whom you also represent.

**Interrogatory 5** calls for the written description support for each asserted claim in the provisionals and CIPs relied upon to establish an early claim to priority. Fitbit pointed out to you that with multiple provisionals and CIPs, the difference between the earliest claim to priority and the filing date of the patent application is sometimes over 4 years. This makes the search for prior art unnecessarily costly, as Fitbit does not know what Philips contends provides written description support for its reliance on the earliest priority date. You confirmed Philips' position that it is entitled to claim the benefit of the earliest date in the priority chain, but have conducted

no analysis to determine if there is written description support for any of the claims in those earliest provisional applications. You asserted that Philips has no obligation to provide support for their reliance on the provisional and continuation-in-part applications absent identification of § 102(e) prior art. Please provide authority supporting this position, as promised during the call, or information responsive to Interrogatory 5.

**Interrogatory 8** calls for all evidence of secondary considerations of non-obviousness that Philips may rely upon. Fitbit explained that these objective indicia of non-obviousness exist, if at all, independent of the particular prior art that Fitbit may rely upon to establish obviousness. You responded that you disagreed because the prior art might include text that suggests no motive to combine the prior art in an obviousness combination. I responded that you have confused motivation to combine, with the entirely separate inquiry of whether there is objective indicia of non-obviousness. You stated that Philips does not have any information responsive to this request and that you would not tell us if you had asked the inventors, who you represent, if they had any information responsive to the request. We are at an impasse. Fitbit will seek to exclude all materials that you may later present that could have been provided in response to this interrogatory had you conducted a good faith effort to investigate and prepare a response.

Regarding your infringement contentions, we discussed the deficiencies in your disclosures under Local Rule 16.6(d), which had previously been raised in our February 21, 2020 letter.

**Means-Plus-Function Disclosures** Local Rule 16.6(d)(iv) requires disclosure of means-plus-function terms and identification of structures in the accused products that perform the claimed function. Despite numerous means-plus-function claims, Philips' infringement contentions did not meet this requirement. You agreed to revise your means-plus-function disclosures and supplement to expressly explain those claims to comply with Local Rule 16.6(d)(1)(A)(iv).

Philips maintains that "means for computing athletic performance data" is a processor and "athletic performance data" is distance, cardio fitness score, and pace. You also agreed to make this, and other mean-plus-function terms, clear in your revised contentions. Philips confirmed they are not relying on anything other than what is already in their infringement charts, and will just revise to make it clearer. You agreed to supplement no later than March 17<sup>th</sup>.

**Doctrine of Equivalents Disclosures** Local Rule 16.6(d)(1)(A)(v) requires a disclosure whether each claim limitation is asserted literally or under the doctrine of equivalents. Philips' disclosures included only boilerplate assertions that every claim limitation is present either literally or by equivalents, and failed to provide the details required under the Local Rules that would give Fitbit adequate notice of Philips' infringement theory for the asserted claims. You agreed that all claims of infringement are literal, and at present you have no claims for infringement based on equivalents.

**Third-Party/Indirect/Joint Infringer Disclosures** Local Rule 16.6(d)(1)(A)(vi) requires that where any alleged infringement is based on the acts of multiple parties, disclosure must identify those parties and their role in the alleged infringement. Philips provided only boilerplate contentions that every single asserted claim is infringed directly and indirectly by unknown third

parties. Philips agreed to provide further details in contentions regarding joint, contributory and induced infringement including identifying the direct infringer to respond to Interrogatories 6, 7, and 9 and to comply with Local Rule 16.6 (d)(1)(A)(vi). You agreed to supplement no later than March 17<sup>th</sup>.

**Limitation-by-Limitation Descriptions of Infringement** Local Rule 16.6(d)(1)(A)(iii) requires Philips to provide a limitation-by-limitation description of where and how each asserted claim is found in each accused product or how Fitbit practices each method claim. We discussed, and you agreed, that some of Philips' disclosures reference an extensive range of page numbers or series of images rather than specific references. This is insufficient to give Fitbit adequate notice of Philips' infringement theory for the asserted claims. You agreed to supplement in the form of a written response.

**Request 32** We asked for further information concerning your Request 32, and whether you were aware of any products actually produced by any of the named entities so we can better determine if we have any documents responsive to the Request. You agreed to look into this issue.

**Request 39** Regarding your Request 39, we informed you that premium subscription service was not available until fall 2019, long after the '007 patent had expired. We informed you that we believe this is a further indication of a faulty pre-filing Rule 11 analysis, as Philips is asserting expired patents in this case, but appears to repeatedly rely on information generated post-expiration to support its infringement contentions. As we explained, had a proper pre-filing inquiry taken place Philips would have realized that many of its infringement contentions rely on information that was not available during the time period that the patents were in force.

**Requests 19, 25, 29, 68** Regarding your RFPs 19, 25, 29, and 68, we are not producing materials from other disputes as the material is not relevant and not proportional to the needs of the case given the importance of the issues at stake, the amount in controversy, the parties' relative access to information, the parties' resources and the importance of the discovery (or lack thereof). Fitbit further expresses concern as to the admissibility of such evidence and questions the relevance when the asserted patents and issues in the present suit (particularly due to the age of the patents-in-suit) may be significantly different from those in past cases.

We agreed to provide written responses to your meet and confer letter, explaining the basis of our objections, on the remaining issues. We agreed to meet and confer further thereafter, as necessary.

Thank you for your prompt attention to these issues. We look forward to your supplemental responses expected by March 17, 2020.