

EXHIBIT 6

PAUL HASTINGS

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Re: Philips' Discovery Deficiencies and Meet and Confer

Ruben:

We write regarding several of a number of deficiencies in Philips' interrogatory responses. We address Philips' responses to Fitbit's Interrogatory Nos. 1, 6-7, 9, 13, 16, 18-19 in this letter. As discussed below, Philips' responses to these interrogatories are deficient. Fitbit requests that Philips promptly supplement its responses to provide the requested information.

Furthermore, we request a meet and confer at your earliest opportunity to discuss these discovery deficiencies, in addition to those raised in correspondence dated October 30, 2020.

I. INTERROGATORY NO. 1

Interrogatory No. 1 asks:

For each claim of the Patents-in-Suit, describe the facts and circumstances of the conception, reduction to practice, and earliest effective filing date of the claimed invention, including without limitation (a) the identity of the earliest date by which the inventor(s) conceived the claimed invention; (b) the identity of the earliest date by which the inventor(s) reduced to practice the claimed invention; (c) whether the alleged reduction to practice was actual or constructive; (d) the steps constituting diligence from conception to actual or constructive reduction to practice, including any testing of the claimed invention; and (e) the identity of all Documents that Refer or Relate to such conception, diligence, or reduction to practice.

Philips' response alleges that each of the Patents-in-Suit is entitled to claim the benefit of at least the filing date of the earliest application to which priority is claimed. This response is inconsistent with Philips' response to Interrogatory No. 5, which admits that the Patents-in-Suit are not each entitled to claim the benefit of the earliest application in the priority chain. For example, Philips admitted that certain claims of the '233 patent are only entitled to a priority date of March 28, 2001, and that the remaining asserted claims of the '233 patent are only entitled to a priority date of May 25, 1999, not to the earliest-filed application in the priority chain, which was filed on October 23, 1998.

Moreover, Philips has not supplemented its response to identify any conception or reduction to practice prior to the dates listed in response to Interrogatory No. 5, despite Fitbit requesting this information since at least February. See February 14, 2020 Letter from D. Beckwith to R. Rodrigues. In view of Philips' failure to supplement its response to provide this information that it was required to provide under Local Rule 16.6(d)(1)(B), Fitbit understands that Philips will not be contending that the asserted claims were

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conceived and reduced to practice prior to the alleged priority dates provided in response to Interrogatory No. 5. Indeed, Fitbit understands from Philips' response to Interrogatory No. 12 that Philips' priority date contentions are set out in its response to Interrogatory No. 5.

Philips must supplement its response to Interrogatory No. 1 such that it is consistent with its response to Interrogatory No. 5.

II. INTERROGATORY NO. 6

Interrogatory No. 6 asks:

For each asserted claim that You contend Fitbit has induced infringement under 35 U.S.C. § 271(b), state the factual basis for your contention that Defendants have induced infringement, including identification of the underlying direct infringer, identification of the specific act (i.e., (a) makes; (b) uses (c) offers to sell or (d) sells any patent invention, within the United States or (e) imports into the United States any patented invention) You contend the direct infringer performs, identification of the action constituting inducement of infringement, identification of facts supporting your contention that Defendants had knowledge of the Patents-in-Suit prior to the filing of this lawsuit, the identity of the person or entity performing each such action (including any third parties You allege Fitbit is inducing to infringe), and identify documents (by bates number) or things evidencing such alleged infringement.

Induced infringement requires underlying direct infringement. *Limelight Networks, Inc. v. Akamai Techs., Inc.*, 572 U.S. 915, 920–21 (2014). Philips does not identify the specific acts it contends Fitbit's customers perform, nor has it identified any evidence that any customer has actually performed any such infringing act, despite this interrogatory requesting both. Philips' response also vaguely refers to "distributors, partners, resellers," without identifying any specific distributor, partner, or reseller that it believes has directly infringed the claims.

Nor has Philips identified or described any facts supporting its contention that Fitbit has "tak[en] active steps to encourage and facilitate others' direct and joint infringement of the Patents-in-Suit." Philips refers to broad categories of documents ("instructions, user manuals, advertising and/or marketing materials"), but does not point to any specific documents nor any specific statements within those documents showing that Fitbit has specifically encouraged direct infringement of the Patents-in-Suit.

Moreover, Philips' response provides conclusory assertions as to the *mens rea* required to show induced infringement. Induced infringement requires both knowledge of the patent *and* knowledge that the induced acts were infringing. The Supreme Court has made clear in both "inducement and contributory infringement cases," the knowledge that "acts might infringe" is insufficient: "*Global-Tech* requires more. It requires proof the defendant knew the acts were infringing. And the Court's opinion was clear in rejecting any lesser mental state as the standard." *Commil USA, LLC v. Cisco Sys., Inc.*, 575 U.S. 632, 135 S. Ct. 1920, 1928 (2015); see also *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1307 (Fed. Cir. 2006) ("[O]n this record, the jury was well within the law to conclude that ITL did not induce JMS to infringe by purposefully and culpably encouraging JMS's infringement. To the contrary, the record contains evidence that ITL did not believe its Platypus infringed. Therefore, it had no intent to infringe."). Conclusory assertions that Fitbit "knowingly induced and continues to induce infringement," had "knowledge or willful blindness to that infringement," or

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performed certain acts “with knowledge thereof” provides nothing more than legal conclusions. Philips provides no facts supporting its contention that Fitbit had knowledge that the allegedly induced acts were infringing, nor when Fitbit had such knowledge. Nor does Philips state when it contends Fitbit had knowledge of each of the Patents-in-Suit for purposes of induced infringement and the facts supporting such contention.

This interrogatory seeks information relevant to Philips’ affirmative claim of induced infringement under 35 U.S.C. § 271(b) for which Philips bears the burden of proof. See *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 571 U.S. 191, 193 (2014) (“A patentee ordinarily bears the burden of proving infringement.”).

Philips must promptly supplement its response to Interrogatory No. 6 to identify the specific alleged direct infringers (including who the “distributors, partners, resellers” are) and their specific acts that directly infringe in addition to all facts that form the basis for the contention. Philips must also promptly supplement its response to identify the *specific* acts and statements supporting Philips’ contention that Fitbit actively induced others to directly infringe the asserted claims, rather than listing broad categories of documents, and all supporting facts to support its affirmative claim. Philips must also promptly supplement its response to identify all facts supporting its contention that Fitbit had knowledge of the patent and that Fitbit had knowledge that the allegedly induced acts were infringing. To the extent that Philips fails to do so, Fitbit reserves the right to move to exclude any undisclosed evidence that Philips may attempt to submit in support of its induced infringement claim.

III. INTERROGATORY NO. 7

Interrogatory No. 7 asks:

For each asserted claim, state whether You contend Fitbit has contributed to infringement under 35 U.S.C. § 271(c), and if so, state the factual basis for your contention, including identifying the direct infringer, identifying the specific act (i.e., (a) makes; (b) uses (c) offers to sell or (d) sells any patent invention, within the United States or (e) imports into the United States any patented invention) You contend the direct infringer performs, identifying each and every “patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process” that includes a “component” that is a “material part of the invention,” identifying each and every “component” that is a “material part of the invention” and included in the identified “patented machine, manufacture, combination or composition,” identifying facts supporting knowledge that the accused products are “especially made or especially adapted for use in an” alleged infringement, identifying facts that support your contention that Defendants had knowledge of the Patents-in-Suit prior to the filing of this lawsuit, identifying facts that support your contention that the accused products are not a staple article or commodity of commerce suitable for substantial non-infringing use, and identifying documents (by bates number) or things evidencing such alleged infringement.

As with induced infringement, contributory infringement requires underlying direct infringement. *Dynacore Holdings Corp. v. U.S. Philips Corp.*, 363 F.3d 1263, 1272 (Fed. Cir. 2004) (“Indirect infringement, whether inducement to infringe or contributory infringement, can only arise in the presence of direct infringement....”). Philips does not identify any third party as an underlying direct infringer or any specific

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act it contends the third party performs that constitutes direct infringement, nor has it identified any evidence of such direct infringement.

For each patent, Philips alleges that Fitbit contributes to infringement through sale of the “Accused Products.” But Philips defined “Accused Products” in its infringement contentions broadly as including “any of the identified activity tracker products offered by Fitbit, as well as any software products related to, associated with, or used in conjunction with said activity tracker products (regardless of whether such software runs on the activity tracker itself, a mobile device, desktop/laptop computer, server, or other computing device).” Philips’ First Supplemental L.R. 16.6(d)(1) Disclosures (May 15, 2020) at 2-3. According to Philips, an “Accused Product” may refer to “an activity tracker alone or to a system utilizing the activity tracker in combination with a device running the Fitbit App” or to “a system that further includes server-based software and related hardware and software.” This broad, sweeping definition of “Accused Products” provides no notice to Fitbit of precisely which components Philips is alleging are a material part of the invention especially adapted for use in infringement, and not a staple article or commodity with no substantial noninfringing use. As a result, for each Patent-in-Suit, it is unclear precisely what component Philips is contending “includes” or “enables” which claimed components or steps.

Furthermore, Philips’ response does not specify the basis for its contention that each accused product “constitutes a material part of the invention, is known by Fitbit to be especially made or adapted for use in infringing [the Patents-in-Suit], and is not a staple article or commodity of commerce that is suitable for substantial noninfringing use.” Fitbit’s interrogatory specifically asks Philips to identify the facts that supports its contention that the accused products are a material part of the invention, especially adapted for use in an alleged infringement, and not a staple article or commodity of commerce suitable for substantial noninfringing use. Philips has failed to do so, its response merely parroting back its contention. Philips’ conclusory language that the accused products may be used in an allegedly infringing manner and its reference to its L.R. 16.6(d)(1) disclosures are insufficient. The inquiry is not whether the accused products have infringing uses, but whether the accused products can be used for purposes *other than* infringement. *In re Bill of Lading Transmission*, 681 F. 3d 1323, 1338 (“These allegations are tailored too narrowly; they say nothing more than ‘if you use this device to perform the patented method, the device will infringe and has no noninfringing uses.’ But that is not the relevant inquiry. For purposes of contributory infringement, the inquiry focuses on whether the accused products can be used for purposes *other than* infringement.” (emphasis in original)).

This interrogatory seeks information relevant to Philips’ affirmative claim of contributory infringement under 35 U.S.C. § 271(c) for which Philips bears the burden of proof. See *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 571 U.S. 191, 193 (2014) (“A patentee ordinarily bears the burden of proving infringement.”).

Philips must promptly supplement its response to Interrogatory No. 7 to identify the specific third parties that Philips alleges are underlying direct infringers and their specific acts that directly infringe in addition to all facts that form the basis for Philips’ contention. Philips must also identify specific components, and for each component it must specify which claim limitations of each claim it alleges that component supplies, along with the factual basis for Philips’ contention that the component is material to the patented invention, especially made or adapted for use in infringing each of the Patents-in-Suit, and is not a staple article or commodity of commerce with no substantial noninfringing use. To the extent that Philips fails to do so, Fitbit reserves the right to move to exclude any undisclosed evidence that Philips may attempt to submit in support of its contributory infringement claim.

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