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

LEAVE TO FILE GRANTED ON January 14, 2022 (Dkt. 282)

REPLY BRIEF 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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Fitbit's Opposition to Philips's Motion to Strike Portions of the November 16, 2021 Expert Report of Joseph A. Paradiso fails to provide any justification for Fitbit's failure to disclose in its initial invalidity contentions eleven[1] different prior art references that Dr. Paradiso relied upon in his report. Nor does Fitbit explain its failure to move to amend those invalidity contentions.[2] It would be highly prejudicial to effectively allow Fitbit to amend its invalidity contentions at this late stage without even an attempt at showing good cause for the amendment. This is particularly so since Fitbit successfully opposed Philips's motion to amend its own infringement contentions principally on the basis of delay. *See* Dkt. 173, 254. Further, Fitbit's repeated attempts to argue that Philips suffered no prejudice because Philips allegedly "had notice" of the prior art in question rings hollow, especially in light of this Court's ruling that even though Philips did notify Fitbit of Philips's intention to amend its infringement contentions early on, such notification was "without legal effect". *See* Dkt. 254 at 8-9.

I. Fitbit Fails to Explain How Incorporating by Reference Unspecified Prior Art From An IPR Petition Not Yet Filed Meets the Disclosure Requirements of Local Rule 16.6(d)

Fitbit fails to cite to any case law that suggests an accused infringer can skirt local rule patent disclosure requirements by incorporating by reference **future** petitions for *inter partes* review. Fitbit's citation to *Fresenius* is inapposite not only because the incorporation by reference was to a **previously filed** request for reexamination, but also because the accused infringer identified the reference at issue in their invalidity contentions as being relevant prior art **and also provided a claim chart** in response to an interrogatory request. *Fresenius Med. Care Holdings*

[1] Fitbit apparently does not dispute that three of the fourteen references identified in Philips's motion should be stricken from Dr. Paradiso's report. Specifically, Fitbit decided to "withdraw[] its reliance on . . . 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 Opposition at 1.

[2] As of January 18, 2022, Fitbit has still not moved to amend its invalidity contentions and Philips is unaware of any intention by Fitbit to do so.

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