

UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS

PHILIPS NORTH AMERICA LLC,	)	
	)	
Plaintiff,	)	
v.	)	CIVIL ACTION
	)	NO. 19-11586-FDS
FITBIT LLC,	)	
	)	
Defendant.	)	

**MEMORANDUM OF DECISION AND ORDER  
ON DEFENDANT FITBIT, INC.’S MOTION TO COMPEL  
CERTAIN OF MR. ARIE TOL’S EMAIL COMMUNICATIONS**

January 27, 2022

DEIN, U.S.M.J.

**I. INTRODUCTION**

The plaintiff, Philips North America LLC (“Philips”), researches and develops numerous technologies, including connected-health and related products such as wearable fitness trackers that monitor and analyze personal health and fitness information. It maintains a patent portfolio that consists of more than 60,000 patents, including patents pertaining to connected health technologies. On July 22, 2019, Philips brought this action against Fitbit LLC (“Fitbit”),<sup>1</sup> a company that develops, manufactures, markets and sells connected health products. By its Second Amended Complaint, Philips claims that Fitbit has infringed and continues to infringe upon three of its U.S. patents. Fitbit denies liability and has asserted counterclaims against Philips for declaratory judgment of non-infringement and invalidity.

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<sup>1</sup> Fitbit recently changed its name from Fitbit, Inc. to Fitbit LLC. (See Docket Nos. 226 & 227).

The matter is presently before the court on “Defendant Fitbit, Inc.’s Motion to Compel the Production of Certain of Mr. Arie Tol’s Email Communications” (Docket No. 198), by which Fitbit is seeking an order compelling Philips to produce email communications that were sent or received by one of the plaintiff’s employees, Mr. Arie Tol (“Mr. Tol”), and have been withheld on the basis of attorney-client privilege and/or the work product doctrine. Mr. Tol is a Dutch Patent Attorney and the Principal Licensing Counsel for the intellectual licensing division of Philips’ parent company in the Netherlands where he works. However, he is not admitted to the Dutch bar and is not a licensed attorney-at-law. At issue is whether, under these circumstances, Philips is entitled to rely on the attorney-client privilege to withhold communications reflecting legal advice provided and received by Mr. Tol. Also at issue is whether Philips improperly relied on the attorney-client privilege to withhold communications containing business rather than legal advice, and whether Philips has met its burden of showing that documents withheld under the work product doctrine were prepared in anticipation of litigation or for trial.

After consideration of the parties’ written submissions and oral arguments, and for all the reasons detailed below, Fitbit’s motion to compel the production of Mr. Tol’s emails is ALLOWED IN PART and DENIED IN PART. Specifically, Phillips cannot assert the attorney-client privilege over Mr. Tol’s communications so Fitbit’s motion to compel is ALLOWED to the extent Philips claims that the communications are privileged. However, Philips has appropriately claimed work product protection with respect to Mr. Tol’s emails so Fitbit’s motion to compel is DENIED with respect to the communications over which Philips has asserted work product claims.

## **II. FACTUAL AND PROCEDURAL BACKGROUND**<sup>2</sup>

### **Mr. Tol's Employment at Philips**

The present dispute concerns email communications that were sent or received by Mr. Tol between June 2, 2015 and December 17, 2019. (See Def. Ex. M; Tol Decl. ¶ 2).<sup>3</sup> Mr. Tol is the Principal Licensing Counsel for the Intellectual Property & Standards (“IP&S”) organization of Philips’ parent company in the Netherlands, Koninklijke Philips N.V., where he has been employed since 1995. (Id. ¶ 1). He has been registered as a Dutch Patent Attorney since 2000 and has been registered as a European Patent Attorney since 2003. (Id.). However, it is undisputed that Mr. Tol is not an attorney-at-law and is not admitted to the bar for Dutch attorneys-at-law. (See Def. Mem. (Docket No. 199) at 3; Hoyng Decl. ¶ 42 & n. 20-21). It is this differing role between foreign patent attorneys and attorneys-at-law that raises the issue whether the attorney-client privilege should apply.

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<sup>2</sup> The facts are derived from the following materials submitted by the parties in connection with Fitbit’s motion to compel: (1) the exhibits attached to the Declaration of David J. Shaw in Support of Fitbit, Inc.’s Motion to Compel the Production of Certain of Mr. Arie Tol’s Email Communications (Docket No. 200) (“Def. Ex. \_\_\_”); (2) the Declaration of Arie Tol (“Tol Decl.”), which is attached as Exhibit 1 to the Plaintiff’s Opposition to Fitbit, Inc.’s Motion to Compel (Docket No. 210); (3) the Declaration of Willem A. Hoyng (“Hoyng Decl.”), which is attached as Exhibit 2 to the Plaintiff’s Opposition to Fitbit’s Motion to Compel (Docket No. 210); (4) the exhibits attached to the Declaration of David J. Shaw in Support of Fitbit, Inc.’s Reply in Support of its Motion to Compel the Production of Certain of Mr. Arie Tol’s Email Communications (Docket No. 214) (“Def. Supp. Ex. \_\_\_”), including the Declaration of Mr. Frits W. Gerritzen (“Gerritzen Decl.”), which is attached as Exhibit 1 thereto; (5) the Declaration of Willem A. Hoyng (“Supp. Hoyng Decl.”), which is attached as Exhibit 1 to the Plaintiff’s Sur-Reply in Opposition to Fitbit, Inc.’s Motion to Compel the Production of Certain of Mr. Arie Tol’s Email Communications (Docket No. 220); and (6) the documents attached as Exhibit A (“Def. Supp. Ex. A”) to Fitbit’s Status Report Regarding Fitbit’s Motion to Compel Certain Emails of Mr. Arie Tol (Docket No. 233).

<sup>3</sup> In his Declaration, Mr. Tol stated that Fitbit is seeking discovery of communications that Mr. Tol sent or received “between June 2, 2014 and December 17, 2019[.]” (Tol Decl. ¶ 2). The record demonstrates that the 2014 date is a typographical error and that the communications in dispute date from June 2, 2015 through December 17, 2019. (See, e.g., id. ¶ 4; Def. Ex. M).

In connection with his employment at Philips, Mr. Tol is primarily responsible for selling and licensing patents. (Def. Ex. E at 12-14). He also provides advice on matters concerning intellectual property, including advice on early-stage business activities and opportunities for the company. (Id. at 14-18). Additionally, since 2015, Mr. Tol has been involved in evaluating whether Fitbit and Garmin products infringe certain of Philips' patents relating to activity trackers or "fitness trackers." (Tol Decl. ¶ 4). He currently serves as the primary Patent Attorney at Philips with responsibility for managing the company's enforcement of patents in that field against both Fitbit and Garmin. (Id.).

#### Philips' Notices of Infringement to Fitbit and Garmin

According to Mr. Tol, Philips' approach to licensing its patents "almost always starts with identifying infringers of Philips's patent rights in anticipation of having to enforce those patent[s] in court." (Id. ¶ 3). As Mr. Tol describes the process:

the beginning of such licensing activities ... first involves identifying products that infringe Philips's patents, and working up a case against the accused infringer. Next, Philips puts the infringer on notice of their infringement in view of pursuing enforcement actions for damages and/or an injunction against the infringers. Depending on the patent rights at issue, this may include an enforcement action in one or more of the United States, Europe, or Asia (or anywhere in which Philips's patent rights may be enforced). While Philips is of course willing to enter into licensing discussion upon providing notice of infringement in order to settle disputes with accused infringers, the focus throughout is to develop and enforce Philips's patent rights through legal action as necessary.

(Id.).

Mr. Tol claims that this was the approach that Philips followed with respect to Fitbit and Garmin.<sup>4</sup> (Id.). Thus, in 2015, Philips began evaluating whether certain Fitbit and Garmin products infringed on some of Philips' patents relating to activity trackers. (Id. ¶ 4). The work initially focused on reviewing and analyzing Philips' patent rights to determine which patents might be infringed by Fitbit and Garmin. (Id. ¶ 5). Mr. Tol and other Dutch Patent Attorneys, as well as American Patent Attorneys working for Philips, participated in this effort under the direction of Erik Pastink. (Id. ¶¶ 4-5). Mr. Pastink is a Dutch and European Patent Attorney who currently serves as Senior IP Counsel for Philips in the Netherlands and whose name appears on many of the communications that the plaintiff has withheld from production. (Id. ¶ 5 & Ex. 1.A thereto; Def. Exs. A, K, M). Mr. Tol contends that a significant number of those communications concern the pre-suit analysis and enforcement activities that Philips' Attorneys conducted with respect to Fitbit and Garmin. (See Tol Decl. ¶¶ 16-22, 24-26, 29-33, 39).

On February 17, 2016, Mr. Pastink sent a letter to Garmin on behalf of Philips IP&S. (Tol Decl., Ex. 1.A). Therein, Mr. Pastink formally notified Garmin that certain of its products and services in the field of activity trackers infringed upon one or more of Philips' U.S. patents and their foreign counterparts. (Id.). He also informed Garmin that Philips would be willing to discuss the terms and conditions of a non-exclusive, world-wide license under its patents, and that Philips wished to schedule a meeting with Garmin to discuss this matter "within two months" from the date of his letter. (Id.). Finally, Mr. Pastink stated that "[f]or good order's

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<sup>4</sup> According to Mr. Tol, Philips focused on Fitbit and Garmin at the same time due to the similarities in their allegedly infringing products and an overlap in the patents that Philips is attempting to enforce against those entities. (Tol Decl. ¶ 4).

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