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 SUR-REPLY REGARDING PHILIPS' MOTION TO STRIKE PORTIONS OF THE NOVEMBER 16, 2021 EXPERT REPORT OF JOSEPH A. PARADISO (DKT. 259)

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Philips' Reply Brief in Support of Plaintiff's Motion to Strike Portions of November 16, 2021 Expert Report of Joseph A. Paradiso (the "Paradiso Report") (Dkt. 284; "Philips' Reply") does little more than rehash the arguments in Philips' original Memorandum. Indeed, Philips effectively ignores Fitbit's Opposition in many respects. Fitbit requests that the Court deny Philips' Motion.[1]

I. DR. PARADISO'S RELIANCE ON VAISANEN SHOULD NOT BE STRICKEN

With respect to Vaisanen, Philips omits the most important fact—Philips' expert, Dr. Martin, does not dispute that Vaisanen discloses the additional element of dependent claim 6—the only element for which Dr. Paradiso applied Vaisanen. (Ex. 1 (Martin Rebuttal Report) at ¶ 139 ("However, regardless of the outcome of that motion, because Hickman in view of Theimer do not render claim 1 obvious, the combination of Hickman in view of Theimer and Vaisanen does not render dependent [claims] invalid as obvious."); *see generally id.* at §§ VIII.B.6, VIII.D.1, VIII.D.3) Thus, Dr. Paradiso's use of Vaisanen had no effect on Dr. Martin's ability to respond to Dr. Paradiso's opinions—Dr. Martin had every opportunity to address Vaisanen and decided against it. And contrary to Philips' arguments, *Fresenius Med. Care Holdings Inc. v. Baxter Int'l, Inc.* supports Fitbit. *See* No. C 03-1431 SBA, 2006 U.S. Dist. LEXIS 90856, at *21-22 (N.D. Cal. May 15, 2006).

The *Fresenius* court primarily denied the patentee's motion to strike because "the parties [had] already engaged in extensive discovery pertaining to [the] affirmative defense" the patentee sought to strike. *Fresenius*, 2006 U.S. Dist. LEXIS 90856, at *21-22. Consequently, the *Fresenius* court found that the "[Patentee] does not appear to have been prejudiced by [the accused

[1] Philips' arguments in Section III of its Reply regarding Fitbit's disclosures of the disputed prior art do not merit further discussion. Fitbit rests on its Opposition on this issue. (*See* Dkt. 265 at 11-12.)

infringer's] technical failure to comply with the Local Rules." *Id.* Similarly here, Fitbit provided its invalidity theory involving Vaisanen in its IPR petition and Philips provided its rebuttal in its Patent Owner Preliminary Response. (*See, e.g.,* Dkt. 265-5 at 75-82; Dkt. 265-6 at 60). Philips does not even claim prejudice. Given that "district courts are strongly encouraged to decide issues pertaining to invalidity when presented," the Court should deny Philips' Motion with respect to Vaisanen. *See Fresenius**Error! Bookmark not defined.** Med. Care*, 2006 U.S. Dist. LEXIS 90856, at *22.

II. DR. PARADISO'S RELIANCE ON THE OTHER DISPUTED REFERENCES SHOULD NOT BE STRICKEN

With respect to the disputed references other than Vaisanen (the "other disputed references"), Philips' arguments are misleading and incorrect, and its Motion should be denied.

1. Local Rule 16.6 Only Requires Disclosure Of References Asserted As Anticipating Or As Part Of An Obviousness Combination

Philips never addresses Fitbit's argument and supporting case law that a party's contentions need not disclose references that describe the state of the art for § 103 obviousness, which is one way that Dr. Paradiso uses the other disputed references. (*See* Dkt. 265 at 7-8; Dkt. 284.)[2] Instead, Philips argues that Local Rule 16.6 requires disclosure of references used to show that the claim elements were conventional, routine, and well-known—*i.e.*, to show the state of the art for § 101 patent ineligibility, which is the other way Dr. Paradiso uses the other disputed references. (Dkt. 284 at 2-5.) Philips' argument regarding § 101 remains incorrect.

The plain language of Local Rule 16.6(d)(4)(E) and (F) requires disclosure of references used as anticipating references or in an obviousness combination; it does not require disclosure of

[2] Thus, use of the other disputed references to show the state of the art for obviousness should not be stricken.

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