

EXHIBIT 1

REDACTED

CONFIDENTIAL

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS**

PHILIPS NORTH AMERICA LLC,

Plaintiff,

v.

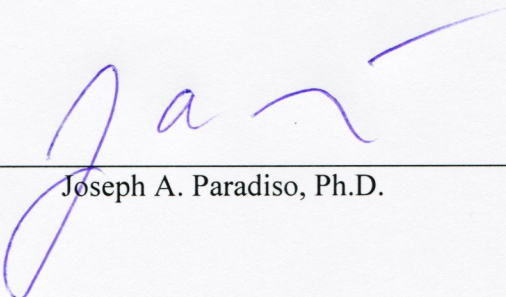
FITBIT, INC.,

Defendant.

Civil Action No. 1:19-cv-11586-FDS

**EXPERT REPORT OF JOSEPH A. PARADISO, PH.D. REGARDING
INVALIDITY OF U.S. PATENT NO. 8,277,377**

Dated: November 16, 2021



Joseph A. Paradiso, Ph.D.

TABLE OF CONTENTS

	<u>Pages</u>
I. INTRODUCTION	1
II. SUMMARY OF CONCLUSIONS.....	1
III. QUALIFICATIONS AND EXPERIENCE	1
IV. UNDERSTANDING OF THE LAW	7
A. Invalidity And Burden Of Proof	7
B. Person Of Ordinary Skill In The Art.....	7
C. Date Of Invention	8
D. Claim Construction	9
E. Patent Eligibility Under 35 U.S.C. § 101.....	9
1. Abstract Idea	9
2. Inventive Concept	10
F. Prior Art Under Pre-AIA 35 U.S.C. § 102.....	11
G. Anticipation Under Pre-AIA 35 U.S.C. § 102	12
H. Obviousness Under Pre-AIA 35 U.S.C. § 103.....	13
1. Secondary Considerations Of Non-Obviousness	14
I. Written Description Under 35 U.S.C. § 112.....	15
J. Enablement Under 35 U.S.C. § 112.....	15
K. Indefiniteness Under 35 U.S.C. § 112	16
V. MATERIALS REVIEWED.....	16
VI. OVERVIEW OF THE '377 PATENT.....	17
A. Priority Date Of The '377 Patent	17
B. Level Of Ordinary Skill In The Art Of The '377 Patent.....	18

TABLE OF CONTENTS (cont'd)

	<u>Pages</u>
C. Summary Of The Specification Of The '377 Patent.....	19
D. Prosecution History Of The '377 Patent.....	25
1. May 4, 2009 Office Action And The Applicant's Response	25
2. December 29, 2009 Office Action And The Applicant's Response	28
3. August 13, 2010 Office Action, The Applicant's Response, And The Applicant's Request For Pre-Appellate Review	31
4. March 18, 2011 Office Action And The Applicant's Response	34
5. August 30, 2011 Office Action, The Applicant's Request For Pre- Appellate Review, And The Applicant's Appeal Brief	38
6. April 4, 2012 Applicant-Initiated Interview and May 18, 2012 Request For Continued Examination	41
7. June 11, 2012 Examiner's Amendments And Notice of Allowance	43
E. Obviousness Finding For The European Counterpart To The '377 Patent	44
F. Claim Construction Of The '377 Patent	46
G. Asserted Claims Of The '377 Patent	46
H. Technology Background Of The '377 Patent And State Of The Art	46
1. Interactive Exercise Monitoring Was Well Known.....	56
2. Web-Enabled Wireless Phones Were Well Known.....	65
3. Downloading An Application From A Remote Server Over The Internet Was Well Known	71
4. Rendering User Interfaces On Web-Enabled Wireless Devices Was Well Known	81
5. Gathering Exercise And Physiologic Status Data While A Subject Is Exercising Was Well Known	86
6. Coupling Web-Enabled Wireless Devices To Data Gathering Devices And Transferring Data Between Devices Using Either Wired Connections Or Short-Range Wireless Communications Including Infrared And RF Communication Protocols Were Well Known.....	93

..

TABLE OF CONTENTS (cont'd)

	<u>Pages</u>
7. Sending Data Over The Internet To Back-End Servers For Further Processing, And Receiving And Displaying Calculated Responses From Such Servers, Were Well Known.....	105
VII. THE '377 PATENT ASSERTED CLAIMS ARE DRAWN TO INELIGIBLE SUBJECT MATTER, OBVIOUS IN LIGHT OF THE PRIOR ART, AND POTENTIALLY INDEFINITE	110
A. Summary Of Invalidity Conclusions For The '377 Patent	110
B. '377 Patent Asserted Claims 1, 4-6, 9, And 12 Are Unpatentable For Claiming Ineligible Subject Matter Under 35 U.S.C. § 101	110
1. The '377 Patent Asserted Claims Are Directed To The Abstract Idea Of Collecting, Analyzing, And Displaying Exercise-Related Information	111
2. The '377 Patent Asserted Claims Do Not Recite An Inventive Concept	129
3. Philips's Arguments To Date Do Not Change My Opinion That The '377 Patent Asserted Claims Are Patent Ineligible	135
C. Asserted Claims 1, 4-6, 9, And 12 Of The '377 Patent Are Invalid As Obvious In Light Of The Prior Art Under 35 U.S.C. § 103	146
1. Prior Art To The '377 Patent	146
2. Browne In View Of Ausems And Hsu Renders Claims 1, 4-6, 9, And 12 Obvious	187
3. Hickman In View Of Theimer, Or Hickman In View Of Theimer And Vaisanen, Renders Claims 1, 4-6, 9 And 12 Obvious.....	224
4. Mault In View of Dean Or Hsu Renders Claims 1, 4-6, 9 And 12 Obvious.....	250
5. iFit In View Of Ausems And Dean, Or iFit In View Of Ausems And Hsu, Renders Claims 1, 4-6, 9, And 12 Obvious	284
6. There Are No Secondary Considerations Of Non-Obviousness For The '377 Patent	333
D. '377 Patent Asserted Claims 1, 4-6, 9, And 12 Are Indefinite Under 35 U.S.C. § 112 If They Are Interpreted To Include More Than One Server	334
VIII. CONCLUSION.....	338

...

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.