

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MASSACHUSETTS

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PHILIPS NORTH AMERICA LLC,

Plaintiff,

v.

FITBIT, INC.,

Defendant.

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

**REDACTED**

**PLAINTIFF'S PRESENTATION FOR MOTIONS TO STRIKE  
AND PRECLUDE EXPERT TESTIMONY**

# Philips v. Fitbit

Case No. 1:19-cv-11586 (D. Mass)

Hon. Chief Judge Saylor

Plaintiff's Motions to Strike and Preclude Expert Testimony

March 14, 2022

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# Overview

# Overview – Philips’s Motions

1. Mot. to Strike Portions of Paradiso’s Opening Rpt. on Undisclosed Prior Art (Dkt. 259,260)
  - Opinions purportedly offered under 35 U.S.C. § 101 discuss prior art never previously identified as grounds for invalidity (in reality, a backdoor .§ 103 analysis)
  - Fitbit never sought to amend contentions.
2. Motion to Strike Portions of Fitbit Experts’ (Paradiso & Kindler) Rebuttal Reports Concerning Non-Infringing Alternatives (Dkt. 300, 301)
  - Fitbit’s Failure to Designate 30(b)(6) Designee re Non-Infringing Alternatives
  - Fitbit’s Failure to meet burden in opening expert reports
3. Motion to Preclude Paradiso Testimony Concerning iFIT Prior Art (Dkt 305, 306)
  - By Dr. Paradiso’s own admission the prior art does not disclose a critical element resulting in a flawed and unreliable option with regard to iFIT
  - **Related:** MSJ of No Invalidity re iFIT (Dkt. 335,340.)
4. Mot. to Strike Portions of Paradiso’s Opening Rpt. on Indefiniteness (Dkt. 259, 260)
  - Never disclosed in contentions and Fitbit never sought to amend contentions.
5. Motion to Strike Portions of Paradiso Rebuttal Rpt. concerning purported lack of provisional support (Dkt 300, 301)
  - Never previously contended. Rather, Fitbit previously admitted that ’377 Patent was entitled to the priority date of the provisional.



1. Motion to Strike Portions of  
Paradiso's Opening Expert  
Report Concerning  
Undisclosed Prior Art  
(Dkt. 259, 260)

# Undisclosed Prior Art

- Fitbit's Position on 11 Undisclosed Prior Art References:
  - 9 references disclosed against **other asserted patents** but not the '377 Patent
  - 1 reference (Vaisanen) allegedly disclosed in non-instituted IPR filed **after** service of contentions
  - 1 references (DARPA) admittedly not disclosed in any fashion
- Despite having disclosed **39** separate pieces of prior art against the '377 Patent and **thousands** of potential obviousness combinations. (Dkt. 261-1, 11-3, 72-91 and Dkt. 261-2 at 12-14, 74-97)
- No Amendment Sought in violation of the Local Rules and the Court's Scheduling Order
- "If the parties were not required to amend their contentions promptly after discovering new information, the contentions requirement would be virtually meaningless as a mechanism for shaping the conduct of discovery and trial preparation." *Philips v. Fitbit*, Dkt. 254 (quoting *02 Micro Int'l. Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1366 n.12 (Fed. Cir. 2006)).

# Dr. Paradiso’s Use of Undisclosed Art

- Under the guise of § 101, Dr. Paradiso summarizes the elements of the claim:

[T]he asserted claims of the '377 patent generally recite the following components and concepts, which relate to collecting, analyzing, and displaying exercise-related information:

- interactive exercise monitoring;
- web-enabled wireless phones;
- downloading an application from a remote server over the internet;
- rendering user interfaces on web-enabled wireless devices;
- gathering exercise and physiologic status data while a subject is exercising;
- coupling web-enabled wireless devices to data gathering devices and/or transferring data between devices using either wired connections or short-range wireless communications including infrared and radio frequency (“RF”) communication protocols;
- sending data over the internet to back-end servers for further processing; and
- receiving and displaying calculated responses.

- The proceeds to disclose what Fitbit now characterizes as “background art” that would meet the limitations.
- Indeed ¶¶ 196-307 consist mostly of copy-and-pasted disclosures, including many undisclosed references that were selected to line up with Dr. Paradiso’s “paraphrasing” of the claim limitations.





# Dr. Paradiso's Use of Undisclosed Art

- For example, with regard to the paraphrased element “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” Dr. Paradiso opines that this was “well known” in the art by pointing to specific disclosures of undisclosed references:

302. As another example, “Duffin” (U.S. Patent No. 5,752,976) describes the prior art’s

widespread use of short-range wireless communications in the context of arrhythmia control

devices:

Over time, various patient worn, ambulatory ECG and device monitors have been developed for providing ECG data for remote analysis of cardiac arrhythmias. Also, the remotely programmable modes of operation of implanted medical devices increased, and programming methods improved.

\*\*\*

The pacemaker operating modes and the algorithm for calculation of the appropriate pacing rate are programmed or reprogrammed into internal memory by accessing the implanted pacemaker’s telemetry transmitter with an external programmer.

\*\*\*

Such implanted devices can also process the patient’s electrogram and any measured physiological conditions employed in the diagnosis and store the data, for subsequent telemetry out on interrogation by the external programmer. The telemetered out data is analyzed and may be employed to establish or refine the operating modes and parameters by a doctor to adjust the therapies the device can deliver. In general, the manner of communicating between the transmitters of the external programmer and the implanted device during programming and interrogating is referred to as telemetry.

Initially, when programming techniques were first devised, the paramount concern addressed related to patient safety. Safeguards addressed the concern that the patient could be put at risk of inadvertent misprogramming of the implanted device, e.g. by stray electromagnetic fields. For this reason, and in order to avoid high current consumption that would shorten the implanted device battery life, telemetry operating range was extremely limited. In systems continuing to the present time, telemetry has required application of a magnetic field at the patient’s skin over the implanted device to close a reed switch while RF programming or interrogating commands are generated to be received by the implanted device transmitter. The programming or interrogating commands are decoded and stored in memory or used to trigger telemetry out of stored data and operating modes and parameters by the implanted device transmitter.

\*\*\*

One of the external devices disclosed in the ‘869 patent is a wrist worn, personal communicator alarm for responding to a telemetered out signal and emitting a warning to the patient when the implanted AECG monitor has detected an arrhythmia. The patient is thereby advised to take medications or contact the physician or to initiate external cardioversion. The personal communicator alarm also includes a transmitter and may also be used to control certain functions of the implanted AECG monitor. A further, belt worn “full disclosure recorder” is disclosed with high capacity memory for receiving and storing data telemetered out of the implanted AECG monitor when its memory capacity is exhausted.

A remote, external programmer and analyzer as well as a remote telephonic communicator are also described that may be used in addition to or alternately to the personal communicator alarm and/or the full disclosure recorder. The programmer and analyzer may operate at a distance to the implanted AECG monitor to perform programming and interrogation functions. Apparently, the implanted AECG may automatically transmit a beacon signal to the programmer and analyzer to initiate an interrogation function to transmit data to the programmer and analyzer on detection of an arrhythmia or a malfunction of the implanted AECG monitor detected in a self-diagnostic test. Or by setting a timer in the personal communicator alarm, the implanted AECG monitor may be automatically interrogated at preset times of day to telemeter out accumulated data to the telephonic communicator or the full disclosure recorder. The remote telephonic communicator may be part of the external programmer and analyzer and is automatically triggered by the alarm or data transmission from the implanted AECG monitor to establish a telephonic communication link and transmit the accumulated data or alarm and associated data to a previously designated clinic or physician’s office through a modem.

Safeguards addressed the concern that the patient could be put at risk of inadvertent misprogramming of the implanted device, e.g. by stray electromagnetic fields. For this reason, and in order to avoid high current consumption that would shorten the implanted device battery life, telemetry operating range was extremely limited.

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## “Background Art” Does Not Circumvent L.R.s

- Courts routinely strike reliance on prior art not disclosed in contentions when purportedly offered merely as “background” or to show the “state of the art” (See Dkt. 260 at 8):
  - *Life Techs Corp. v. Biosearch Techs., Inc.*, No. C 12-00852, 2012 WL 4097740, \*2 (N.D. Cal. Sept. 17, 2012) (striking portions of expert report that discussed alleged “background prior art” that had not been adequately disclosed)
  - *Emcore Corp. v. Optium Corp.*, No. 7-326, 2009 WL 3381800 (W.D. Penn. Oct. 16, 2009) (holding that “state of the art” is a subset of prior art and thus must be disclosed under the local patent rules).
  - *Pactiv Corp. v. Mutisorb Techx., Inc.*, 2013 WL 2384249, \*2 (N.D. Ill., May 29, 2013) (“parties should not be able to circumvent the disclosure requirements of our Local Patent Rules by offering such materials as background”)



## 2. Motion to Strike Portions of Fitbit Experts' (Paradiso & Kindler) Rebuttal Reports Concerning Non-Infringing Alternatives (Dkt. 300, 301)



# Undisclosed Non-Infringing Alternatives

- Fitbit refused to designate a witness re Non-Infringing Alternatives:

## DEPOSITION TOPIC NO. 52:

Any alleged non-infringing alternatives to the Asserted Patents, including the identity of each alternative, the time period during which each alternative was available, the time and cost to develop, design, and manufacture each alternative, and any differences between each alternative and the Accused Products.

## RESPONSE TO TOPIC NO. 52:

[...]

Subject to and without waiving the foregoing general and specific objections, Fitbit will

not designate a witness to testify on this Topic at this time.

Dkt. 302-2

- Instead, purported to offer a witness on **design arounds** limited to non-infringing alternatives who testified that Fitbit had none.
- Failed to meet its burden on non-infringing alternatives in opening expert reports:
  - *Smart Skins LLC v. Microsoft Corp.*, No. 15-544-MJP, 2016 WL 4148091 (W.D. Wash. July 1, 2016) (for reasonable royalty, Defendant bears burden re non-infringing alternatives)
  - Fitbit: relies on **inapplicable lost profits cases** to suggest burden on Philips
  - Not proper rebuttal to Dr. Martin’s Opening Report on Infringement.
  - Philips prejudiced without opportunity to rebut and depose fact witnesses. **PHILIPS**

# 3. Motion to Preclude Paradiso Testimony Concerning iFIT Prior Art (Dkt 305, 306)

## iFIT Does Not Disclose Element 1(h):

- Element 1(h) of the '377 Patent requires: “[h] receiving a calculated response from the server, the response associated with a calculation performed by the server based on the exercise-related information.”
- Dr. Paradiso’s opinions with respect to iFIT are unsupported and unreliable because they fail to point to any evidence that element 1(h) is met.
- **First**, Paradiso point to user manuals that purportedly disclose a “calculated response” in the form of a website, iFIT.com, “adjust[ing] the speed and/or incline of the tread ... As needed to keep [the user’s] heart rate near the current target heart rate setting.”  
However:
  - Admitted that manuals **do not disclose** such functionality.
  - Admitted that manuals only describe a product capable of **one-way** communication (via audio), and not two-way communication as would be required to receive a calculated response from a server.
- **Second**, Paradiso cites the uncorroborated testimony of iFIT witness Colleen Logan  
However:
  - Ms. Logan’s testimony is not specific to receiving any “calculated response”
  - She disclaimed any technical knowledge about how the systems worked.

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REDACTED



## Dr. Paradiso's Admissions:

- At deposition, Dr. Paradiso repeatedly confirmed that the iFIT documents disclosed only one-way communication (via audio) and
- Eventually agreeing that none of the documents he looked at supported his original opinion concerning iFIT.com controlling a treadmill based on heart rate information sent from the treadmill to iFIT.com:

16 Q. But none of the product manuals  
17 that you looked at described to a  
18 communication with a treadmill as of  
19 December 17, 1999 that would allow the  
20 treadmill to send information to iFit.com,  
21 is that correct?  
22 A. No, they do not.

Dkt. 308-2 at 177



4. Mot. to Strike Portions of Paradiso's Opening Rpt. on Indefiniteness  
(Dkt. 259, 260)
5. Motion to Strike Portions of Paradiso Rebuttal Rpt. Concerning Purported Lack of Priority to Provisional App.  
(Dkt 300, 301)

## Fitbit Failure to Disclose

- No disclosure of Indefiniteness in L.R. 16.6 disclosures (despite identifying grounds for indefiniteness for many other terms) and never any attempt to amend.
- Until rebuttal reports, Fitbit **agreed** that there was no issue with priority claim to provisional of the '377 Patent
- Fitbit justifies lack of disclosure and change of positions **exclusively** on what it characterizes as a “vague” or “unclear” infringement contention with regard to “server” aspects of the claim, however:
  - Philip’s position has always been that the relevant “application” is downloaded from Apple or Google, as reflected in the Complaint, L.R. 16.6 disclosures, and the understanding of anyone who has used an “app store” to download an application to their phone
  - That Fitbit included undisclosed indefiniteness argument in its **opening** expert report demonstrates that it did not genuinely believe there to be confusion as to Philips’s contention—and no basis to challenge the claim of priority for the first time in rebuttal.



# Philips v. Fitbit

Case No. 1:19-cv-11586 (D. Mass)

Hon. Chief Judge Saylor

Opposition to Defendant's Motions to Strike and Preclude Expert Testimony  
Hearing March 14, 2022

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# Motion to Strike Dr. Martin's Expert Report and Testimony



# Fitbit's Arguments

Fitbit asserts that Philips violated LR 16.6(d) and failed to fully respond to Fitbit Int. No. 9.

1. Fitbit challenges notice of Philips' allegation that Fitbit directly infringes by joint infringement.
  - a. No challenge to direct infringement performed by Fitbit. Fitbit performs the method for the purposes of "testing its products and services, demonstrating its products and services to others, etc." Dkt. 270-10 at 9.
  - b. No challenge to direct infringement performed by Fitbit Users and Inducement by Fitbit. "[T]he customers directly infringe by using the Fitbit system, App, and services through their account." Dkt. 270-10 at 9.
2. Fitbit challenges notice of Philips' allegation of infringement by Cardio Fitness Score calculated based on exercise information including GPS (Fitbit dubbed "Run Cardio Fitness Score")
  - a. No challenge to Cardio Fitness Scores and Cardio Fitness Level based on exercise information including heart rate and accelerometers.
3. Fitbit challenges notice of Martin's testing evidence (Fitbit dubbed "Representative Product" theory)
  - a. No challenge to underlying notice of infringement of each product and each claim.



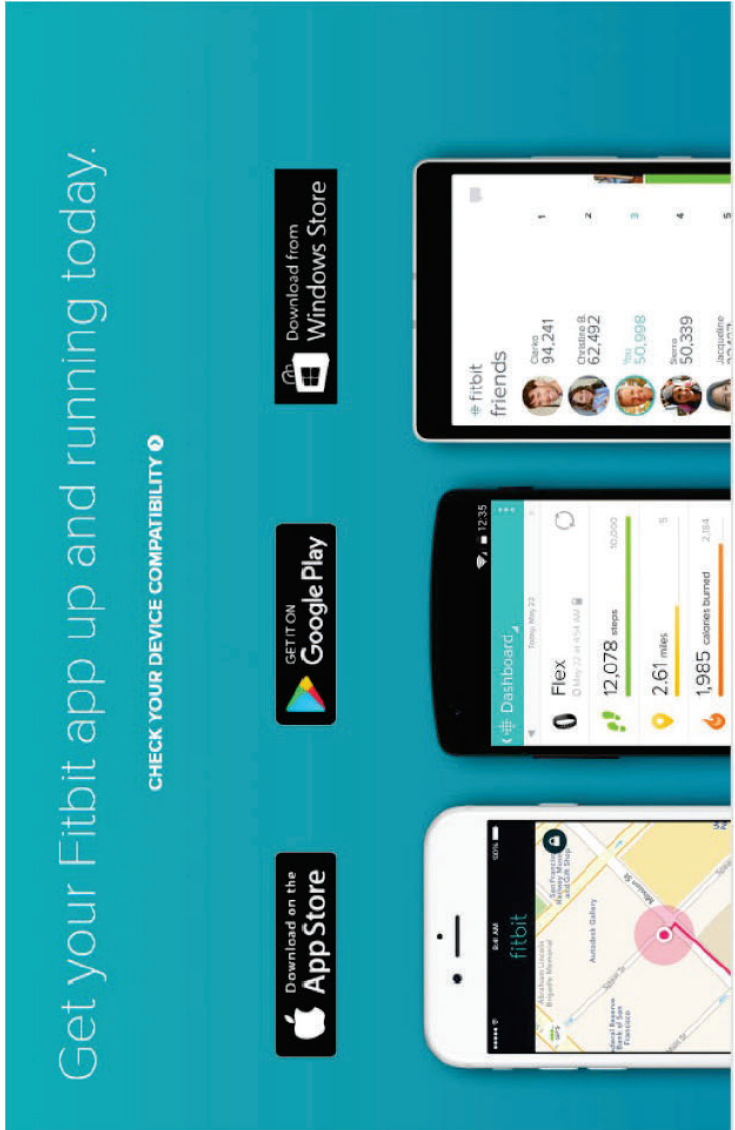
# Philips Put Fitbit on Notice of Joint Infringement

## Philips Provided Extensive Responses

- **January 31, 2020** Disclosures (Dkt. 270-9, Exhibit 9)
  - Included claim charts
  - Incorporated the First Amended Complaint (Dkt. 25) of **November 27, 2019**
- **February 10, 2020** Response to Interrogatory (Dkt. 270-3, Exhibit 3)
- **March 17, 2020** Supplemental Disclosures (Dkt. 270-10, Exhibit 10)
  - Re-explained joint infringement from the complaint
  - Provided additional disclosure on performance of method
    - Fitbit Users perform when they purchase
    - Fitbit performs when it demonstrates, tests, etc.
- **May 15, 2020** Supplemental Disclosures (Dkt. 270-11, Exhibit 11; Dkt. 287-1 to 287-9, Exhibits 1-9)
  - Provided updated claim charts

# Philips Claim Charts

May 15, 2020 claim charts, Dkt. 270-11 at 3 and D.I. 270-12 at 6. **Fitbit and Fitbit users** perform the steps of the method by “us[ing] the Accused Products.” Dkt. 270-11 at 3.

<p>c. rendering a user interface on the web-enabled wireless phone;</p>	<p>The method provided by the Accused Product involves rendering a user interface on the web-enabled wireless phone (via the Fitbit App):</p>  <p>Download on the App Store</p> <p>GET IT ON Google Play</p> <p>Download from Windows Store</p> <p>Get your Fitbit app up and running today.</p> <p>CHECK YOUR DEVICE COMPATIBILITY</p> <p>PNA-FB0000130</p>
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Dkt. 270-12 at 6

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# Philips Claim Charts

May 15, 2020 claim charts, Dkt. 270-11 at 3 and Dkt. 270-12 at 22. Fitbit and Fitbit users perform the steps of the method by “us[ing] the Accused Products.” Dkt. 270-11 at 3.

i. using the application, displaying the response.

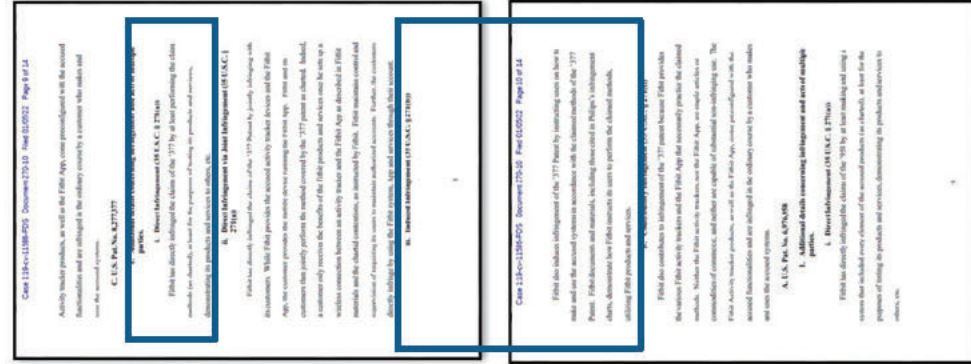
The image displays three screenshots from the Philips Lifeline app, each showing heart rate data and a 'See How Fit You Are' section. The first screenshot shows 'Cardio Fitness' with a score of 41-45. The second screenshot shows 'Minutes in Heart Rate Zones' with a total of 1278 minutes. The third screenshot shows 'Resting Heart Rate, Last 30 Days' with a score of 76. Each screenshot includes a 'See How Fit You Are' section with a 'Learn more' button and a weekly heart rate trend chart.

Dkt. 270-12 at 22

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# Philips Supplemental Disclosures

March 17, 2020 Supplemental Disclosures, Dkt. 270-10.



**1. Additional details concerning infringement and acts of multiple parties.**

**i. Direct Infringement (35 U.S.C. § 271(a))**

Fitbit has directly infringed the claims of the '377 by at least performing the claim methods (as charted), at least for the purposes of testing its products and services, demonstrating its products and services to others, etc.

Dkt. 270-10 at 9

**iii. Induced Infringement (35 U.S.C. § 271(b))**

Fitbit also induces infringement of the '377 Patent by instructing users on how to make and use the accused systems in accordance with the claimed methods of the '377 Patent. Fitbit documents and materials, including those cited in Philips's infringement charts, demonstrate how Fitbit instructs its users to perform the claimed methods, utilizing Fitbit products and services.

Dkt. 270-10 at 9-10





# Fitbit Misinterprets Akamai (en banc)

**HN1**[↑] Direct infringement under [§ 271\(a\)](#) occurs where all steps of a claimed method are performed by or attributable to a single entity. See [BMC Res.](#), at 1022

responsible [\*\*\*1346] for the infringement. We will hold an entity responsible for others' performance of method steps in two sets of circumstances: (1) where that entity directs or controls others' performance, and (2) where the actors form a joint enterprise.<sup>1</sup> at 1022

**HN2**[↑] To determine if a single entity directs or controls the acts of another, we continue to consider general principles of vicarious liability.<sup>2</sup> at 1022

*Limelight Networks, Inc. v. Akamai Techs., Inc.*, 797 F.3d 1020 (Fed. Cir. 2015)(en banc)





# Fitbit Misinterprets Akamai (en banc)

method. See BMC, 498 F.3d at 1380-81. We conclude, on the facts of this case, that liability under § 271(a) can [\*\*5] also be found when an alleged infringer conditions participation in an activity or receipt of a benefit upon performance of a step or steps of a patented method and establishes the manner or timing of that performance. Cf.

at 1023

We reverse and reinstate the jury verdict. The jury heard substantial evidence from which it could find [\*\*9] that Limelight directs or controls its customers' performance of each remaining method step, such that all steps of the method are attributable to Limelight. Specifically, Akamai presented substantial evidence demonstrating that Limelight conditions its customers' use of its content delivery network upon its customers' performance of the tagging and serving steps, and that Limelight establishes the manner or timing of its customers' performance. We review the

at 1024



# Philips Supplemental Disclosures

March 17, 2020 Supplemental Disclosures, Dkt. 270-10 at 9.

ii. **Direct Infringement via Joint Infringement (35 U.S.C. § 271(a))**

Fitbit has directly infringed the claims of the '377 Patent by jointly infringing with its customers. While Fitbit provides the accused activity tracker devices and the Fitbit App, the customer provides the mobile device running the Fitbit App. Fitbit and its customers then jointly perform the method covered by the '377 patent as charted. Indeed, a customer only receives the benefits of the Fitbit products and services once he sets up a wireless connection between an activity tracker and the Fitbit App as described in Fitbit materials and the charted contentions, as instructed by Fitbit. Fitbit maintains control and supervision of requiring its users to maintain authorized accounts. Further, the customers directly infringe by using the Fitbit system, App and services through their account.

Dkt. 270-10 at 9

# Philips Original Disclosure and First Amended Complaint (FAC)

January 31, 2020 Disclosures, Dkt. 270-9 at 3 incorporated First Amended Complaint Dkt. 25 November 27, 2019.

100. The Accused Products including access to the Fitbit account and operational apps and related programs are provided under the direction and control of Fitbit. Fitbit establishes the procedures and timing to operate the Accused Products with the Fitbit account including receipt of the benefits of the Accused Products. Access to the Fitbit servers is limited to customers and subscribers that download and activate the required software and apps on to a smartphone or other wireless device.

First Amended Complaint Dkt. 25 at ¶100





# Philips First Amended Complaint (con't)

January 31, 2020 Disclosures, Dkt. 270-9 at 3 incorporated First Amended Complaint Dkt. 25 November 27, 2019.

¶101

scheme in the band of 2400-2480 MHz. The Accused Products include wearable fitness tracking devices that, when used with the accompanying Fitbit application, server and other software, practice the claimed invention, without limitation, by receiving exercise related information to the user's smartphone from the Accused Products while the user is exercising that includes data

First Amended Complaint Dkt. 25 at ¶101

## HOW DOES FITBIT MEASURE MY CARDIO FITNESS SCORE?

Your cardio fitness score is determined by your resting heart rate, age, sex, weight, and other personal information. For best results, make sure your weight is correct in your Fitbit profile. Also, wear your tracker or watch to sleep for a better resting heart rate estimate. Your cardio fitness score will be shown as a range unless you use GPS for runs.

Source: [https://help.fitbit.com/articles/en\\_US/Help\\_article/209671-en\\_US&fs=Search&pn=1](https://help.fitbit.com/articles/en_US/Help_article/209671-en_US&fs=Search&pn=1).

Under the direction and control of Fitbit, the use of the Fitbit app combined with a user's smartphone, an accompanying Fitbit activity tracker, including other software and Fitbit servers, practices the steps of downloading an application to a web-enabled wireless phone directly from

# Philips Disclosures Were Sufficient

February 10, 2020 - Response to Interrogatory, Dkt. 270-3 at 4.

In addition to directly infringing through its development and use of the Accused Products, and/or by prototyping and testing functionality of the Accused Products that infringe one or more claims of the Patents-in-Suit, Fitbit jointly infringes with its customers and subscribers with the establishment and operation of solutions covered by the Patents-in-Suit. For example, Fitbit's customers use their Fitbit devices, Fitbit account, and the Fitbit App jointly with Fitbit by downloading and activating the required software to a mobile device and additionally utilize software on Fitbit's servers, which enable functionality that may be relevant to infringement of the Asserted Patents. Fitbit customers receive a clear benefit from their use of the software and services made available by Fitbit, and those benefits are conditioned upon downloading, installing, and using Fitbit software and services.

Philips also refers Fitbit to its disclosures under L.R. 16.6(d)(1).

Philips Response, Dkt. 270-3 at 4





# Martins Report is Consistent With Disclosures

more detail below with respect to achieving the specific functionalities accused of infringement

by Philips. It is also apparent to me that Fitbit has conditioned the receipt of significant benefits

provided by the accused products on requiring that its customers practice the '377 Asserted Claims.

## 11. Fitbit Conditions Benefits on Practicing the '377 Patent

259. Fitbit conditions the benefit of using the Cardio Fitness feature of the '377 Products

on the user downloading of the Fitbit App onto a smartphone, pairing a '377 Device to said

smartphone, syncing exercise-related data to the smartphone using the Fitbit App, and opening the

Cardio Fitness Score page on the Fitbit App.

Martin Report, Dkt. 270-2 at ¶¶46, 259



## LR 16.6(d)

LR 16.6(d)(1): “Patentee’s **Preliminary Patent Related Disclosures**”

Subsections (A)-(D): The disclosures are “Infringement Claim Charts”, “Prosecution History”, “Ownership Evidence” and “Real Parties In Interest.”

LR 16.6(d)(2): “Conference Concerning Preliminary Patent Disclosures” to address among other things “the sufficiency of the patentee’s disclosures”

LR 16.6(d)(4): “Accused Infringer’s Preliminary Production of Technical Documents, Source Code, and Samples of Accused Products”

Subsections (A)-(H): The disclosures are “Technical Documents”, “Samples”, “Source Code”, “Noninfringement Claim Charts”, “Invalidity Claim Charts – Anticipation or Obviousness”, “Other Grounds for Invalidity”, “Supporting Evidence for Invalidity Defense”, and “Identity of Real Parties in Interest”

## Fitbit Misinterprets the Rules

LR 16.6(d)(1)(A): “if any alleged infringement is based on the acts of multiple parties, the role of each party in the infringement.”

- **The roles of Fitbit and Fitbit Users were extensively explained.**

Expert discovery is part of Rule 26(a) “Required Disclosures”

- Rule 26(a)(1) “Initial Disclosure”
- Rule 26(a)(2) “Disclosure of Expert Testimony”

Rule 37(c) includes precondition to any preclusion: “If a party fails to provide information or identify a witness as required by Rule 26(a) or (e)...”

- **Rule 26(a)(2) expert disclosures are part of the Rule 26 disclosures.**

## Fitbit Misinterprets Its Cited Decisions

*Inline Plastics Corp. v. Lacerta Group., Inc.*, Case No. 4:18-cv-11631-TSH \*4-6 (D. Mass. Feb. 23, 2021)(Judge Hillman) – supports denying Fitbit’s motion.

- “Inline’s Infringement Contentions were **purely based on a literal infringement theory**” and “Inline concedes that it **did not disclose or even reserve the right to add equivalent infringement theories.**” As a result, the court did not permit the addition of equivalent infringements after close of fact discovery.
- The court distinguished situations where “**some measure of notice**” had been provided like “plaintiff reserved the right to pursue an equivalency infringement theory but did not provide detailed contentions” noting that an “expert report [could] provide[] more detail”). The court noted that 5 decisions denied motions to strike in such situations.
- The court specifically distinguished the situation where “an expert report [] ‘more fully explain[ed]’ the plaintiff’s DOE infringement theories that had already been raised, albeit with inadequate facts and allegations, in its infringement contentions.” The court cited *Finjan, Inc. v. Blue Coat Sys. Inc.*, No. 13-03999, 2015 WL 3640694 (N.D. Cal. Jun. 11, 2015).

## Fitbit Cited Decisions are inapposite

The other cases relied upon by Fitbit in its opening brief at 3 (Dkt. 269) are inapposite:

*Woods v. DeAngelo Marine Exhaust, Inc.*, 692 F.3d 1272, 1279 (Fed. Cir. 2012)

- Supplementation at the close of discovery, after expert discovery.
- Identification of prior art drawings alone at close of discovery, with no explanation, “did not provide notice of the party's theory of liability”, i.e., that “the drawings ... rendered MES's patents obvious on a claim-by-claim basis”

*B-K Lighting, Inc. v. Vision3 Lighting*, 930 F. Supp. 2d 1102, 1137 (C.D. Cal. 2013)

- “The second post/opening pair ... is not the allegedly infringing opening and post identified in B-K's preliminary contentions.”
- There was also an assertion that the plaintiff “failed to assert literal infringement of this element.” Preliminary contention that “each of the limitations of each asserted claim is claimed to be literally present” was sufficient specificity. Motion to Strike denied.

*Hochstein v. Microsoft Corp.*, No. 04-73071, 2009 WL 2498481, at \*5 (E.D. Mich. Aug. 17, 2009)

- “Plaintiffs were aware ... that the Xbox360 had wireless controllers”
- “Plaintiffs did not notify Microsoft that they intended to accuse the wireless controllers until March 27, 2009, long after discovery was closed and just a few months before trial was scheduled to begin.”



## Philips Properly Put Fitbit On Notice

- “Proper infringement contentions provide a defendant with notice of a plaintiff’s infringement theories.” *Fenner Investments, Ltd. v. Hewlett-Packard Co.*, No. 6:08-cv-273, 2010 WL 786606, at \*2 (E.D. Tex. Feb. 26, 2020)
  - “The scope of infringement contentions and expert reports are not, however, coextensive. Infringement contentions need not disclose specific evidence nor do they require a plaintiff to prove its infringement case.”

# Philips Put Fitbit on Notice of Infringement by Cardio Fitness Score Calculated from Exercise Information

## Philips Provided Extensive Responses

- **January 31, 2020** Disclosures (Dkt. 270-9, Exhibit 9)
  - Included claim charts
  - Incorporated the First Amended Complaint (Dkt. 25) of **November 27, 2019**
- **February 10, 2020** Response to Interrogatory (Dkt. 270-3, Exhibit 3)
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  - Provided updated claim charts

# Philips Claim Charts

May 15, 2020 claim charts, Dkt. 270-11 at 3 and Dkt. 270-12 at 22. Fitbit and Fitbit users perform the steps of the method by “us[ing] the Accused Products.” Dkt. 270-11 at 3.

i. using the application, displaying the response.

The image displays three screenshots of the Philips Heart Rate app interface, arranged vertically. Each screenshot shows a different metric related to heart rate and fitness. The first screenshot (top) is titled 'Cardio Fitness' and shows a score of 41-45, labeled 'FAIR to AVERAGE'. It includes a 'See How Fit You Are' section with a 'Learn more' button. The second screenshot (middle) is titled 'Minutes in Heart Rate Zones' and shows a bar chart with three categories: Fat Burn, Cardio, and Peak. It also includes a 'See How Fit You Are' section with a 'Learn more' button. The third screenshot (bottom) is titled 'Resting Heart Rate, Last 30 Days' and shows a line graph with data points for 82, 79, and 76. It includes a 'See How Fit You Are' section with a 'Learn more' button. A red box highlights the first screenshot. Below the screenshots is a text string: PNA-FB0000257-259.

Dkt. 270-12 at 22

**PHILIPS**

# Philips Claim Charts

**May 15, 2020** claim charts, Dkt. 270-11 at 3 and Dkt. 270-12 at 20. **Fitbit and Fitbit users** perform the steps of the method by “**us[ing] the Accused Products.**” Dkt. 270-11 at 3.

<p>h. receiving a calculated response from the server, the response associated with a calculation performed by the server based on the exercise-related information; and</p>	<p>The method of the Accused Product involves receiving a variety of different calculated responses from the server (such as cardio fitness score, heart rate zones, and resting heart rate), the responses associated with a calculation performed by the server based on the exercise-related information:</p> <p><b>When You Sync Your Device</b></p> <p>When you sync your device, data about your activity is transferred from your device to our servers. This data is stored and used to provide the Fitbit Service. Each time a sync occurs, we also log data about the transmission. Some examples of the log data are the sync time and date, device battery level, and the IP address used when syncing.</p> <p>PNA-FB00001113</p>
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Dkt. 270-12 at 20





# Philips Claim Charts

May 15, 2020 claim charts, Dkt. 270-11 at 3 and Dkt. 270-12 at 17. **Fitbit and Fitbit users** perform the steps of the method by “**us[ing] the Accused Products.**” Dkt. 270-11 at 3.

<p>g. sending the exercise-related information to an internet server via a wireless network;</p>	<p>The method of the Accused Product involves sending the exercise related information to an internet server via a wireless network, as demonstrated by the fact that this data can then be accessed through the fitbit.com dashboard website:</p> <p><b>DEVICE INFORMATION</b></p> <p>Your device collects data to estimate a variety of metrics like the number of steps you take, your distance traveled, calories burned, weight, heart rate, sleep stages, active minutes, and location. The data collected varies depending on which device you use. Learn more about the features of our various devices and how you can use <b>MobileTrack</b>. When your device syncs with our applications or software, data recorded on your device is transferred from your device to our servers.</p> <p>PNA-FB0000065</p> <p><b>When You Sync Your Device</b></p> <p>When you sync your device, data about your activity is transferred from your device to our servers. This data is stored and used to provide the Fitbit Service. Each time a sync occurs, we also log data about the transmission. Some examples of the log data are the sync time and date, device battery level, and the IP address used when syncing.</p> <p>PNA-FB0000113</p>
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Dkt. 270-12 at 17



# Philips Claim Charts

May 15, 2020 claim charts, Dkt. 270-11 at 3 and Dkt. 270-12 at 11. **Fitbit and Fitbit users** perform the steps of the method by “**us[ing] the Accused Products.**” Dkt. 270-11 at 3.

e. using the application, receiving data indicating an amount of exercise performed by the subject;

The method provided by the Accused Product involves receiving data indicating an amount of exercise performed by the subject (such as number of steps, active minutes, and distance) using the application (the Fitbit App):

## Automatic Tracking

Ionic continuously tracks a variety of stats whenever you wear it, including hourly activity and heart rate. Ionic also tracks your exercise and sleep automatically. The information is transferred to your dashboard every time you sync your watch.

### DEVICE INFORMATION

Your device collects data to estimate a variety of metrics like the number of steps you take, your distance traveled, calories burned, weight, heart rate, sleep stages, active minutes, and location. The data collected varies depending on which device you use. Learn more about the features of our various devices and how you can use **MobileTrack**. When your device syncs with our applications or software, data recorded on your device is transferred from your device to our servers.  
PNA-FB0000065

Dkt. 270-12 at 11



# Philips Claim Charts

May 15, 2020 claim charts, Dkt. 270-11 at 3 and Dkt. 270-12 at 14. **Fitbit and Fitbit users** perform the steps of the method by “**us[ing] the Accused Products.**” Dkt. 270-11 at 3.

	<p>9:25 AM</p> <p>← Active Minutes</p> <p>S S M T W T F</p> <p>36 30 18 0</p> <p>Today</p> <p>⚙️</p> <p>🔍</p> <p>⚡</p> <p>What are Active Minutes? They're periods of moderate activity done for 10 minutes or more. <a href="#">Learn more...</a></p> <p>This Week</p> <p>Today 6 active minutes</p> <p>PNA-FB0000254-255</p>	<p>9:25 AM</p> <p>← Distance</p> <p>S S M T W T F</p> <p>6 5 3 0</p> <p>Today</p> <p>⚙️</p> <p>🔍</p> <p>📍</p> <p>How does Fitbit calculate distance? Fitbit trackers calculate distance using your stride length or GPS. <a href="#">Learn more...</a></p> <p>Jan 12 - Jan 18</p> <p>Today 0.69 miles</p> <p>1 mile</p>
	<p>Dkt. 270-12 at 14</p>	



# Philips Incorporated First Amended Complaint

Fitbit's First Amended Complaint (Dkt. 25) also details Fitbit's infringement and is incorporated herein by reference.

Dkt. 270-11 at 3

associated with a calculation performed by the server based on the exercise-related information (e.g., the Fitbit server performs calculations such as cardio fitness score based on the exercise-related information and sends it to the Accused Products including the Fitbit app on a smartphone), using the application, displaying the response (e.g., the response may be viewed on

First Amended Complaint Dkt. 25 at ¶101





# Philips Incorporated First Amended Complaint

Source: [https://help.fitbit.com/articles/en\\_US/Help\\_article/1935](https://help.fitbit.com/articles/en_US/Help_article/1935). Fitbit generally explains the

calculation of a cardio fitness score:

## HOW DOES FITBIT MEASURE MY CARDIO FITNESS SCORE?

Your cardio fitness score is determined by your resting heart rate, age, sex, weight, and other personal information. For best results, make sure your weight is correct in your Fitbit profile. Also, wear your tracker or watch to sleep for a better resting heart rate estimate. Your cardio fitness score will be shown as a range, unless you use GPS for runs.

Source: [https://help.fitbit.com/articles/en\\_US/Help\\_article/209671=en\\_US&fs=Search&pn=1](https://help.fitbit.com/articles/en_US/Help_article/209671=en_US&fs=Search&pn=1).

First Amended Complaint Dkt. 25 at ¶101

# Philips Incorporated First Amended Complaint

## What is my cardio fitness score?

Track your overall cardiovascular fitness with your Fitbit device.

Fitbit admits that the “distinctions are described” in this document. Dkt. 269 at 14 and Dkt. 270-13.

How do I track my cardio fitness?

What is VO2 Max?

How does Fitbit measure my cardio fitness score?

Your *cardio fitness score* is determined by your resting heart rate, age, gender, weight, and other personal information. For best results, make sure your weight is correct in your Fitbit profile. Also, wear your tracker or watch to sleep for a better resting heart rate estimate. Your cardio fitness score will be shown as a range unless you use GPS for runs.

How do I get a more precise estimate of my score?

If your Fitbit device connects to GPS, we can provide a more precise estimate of your score using the relationship between pace and heart rate during your runs. This is because individuals with higher VO2 Max have a lower heart rate while running at the same pace compared to individuals with lower VO2 Max. If you're able to run at a comfortable pace for at least 10 minutes, track a run with GPS. We recommend running on flat terrain as much as possible since only the flat sections of your run count toward your score estimate. You may need to go on several runs that are at least 10 minutes in length to affect your score.

For instructions on how to start in the Exercise app, see [How do I track my workouts with my Fitbit device?](#)

How does Fitbit calculate my cardio fitness level?

We use your cardio fitness score in combination with your gender and age to calculate your cardio fitness level. By helping you understand how you compare to other people who share your gender and age range, cardio fitness level is a holistic way to track your cardiovascular fitness over time.

First Amended Complaint Dkt. 25 at ¶101



# Martin's Personal Testing (Fitbit Dubbed Representative Infringement)

## Expert Testing By Martin Is Proper

	Accused Product – claim chart	Personal Testing – Martin (Philips)	Personal Testing – Paradiso (Fitbit)*
1	Ionic – Dkt. 287-1	Personally tested	
2	Versa – Dkt. 287-2		
3	Versa 2 – Dkt. 287-3	Personally tested	Personally tested (tracking during exercise)
4	Versa Lite Edition – Dkt. 287-4		
5	Charge 2 – Dkt. 287-5	Personally tested	
6	Charge 3 – Dkt. 287-6		Personally tested (tracking during exercise)
7	Inspire HR – Dkt. 287-7	Personally tested	
8	Alta HR – Dkt. 287-8		
9	Blaze – Dkt. 287-9		

\*Philips contests that Paradiso personally did testing.



# Expert Testing By Martin Is Proper

Fitbit does not contest that Philips provided claim charts for each Accused Product during fact discovery. Fitbit does not contest that Expert Martin does the same thing, element-by-element, product-by-product.

Fitbit objects to Martin personally testing some but not all of the products, which he refers to as “representative ‘377 Devices’”. Martin ¶147 (Ionic, Versa 2, Inspire HR, and Charge 2)

- ¶155: “I have personally followed the instructions...”
- ¶161: “I have personally followed the instructions as set out by Fitbit to pair each of the Representative ‘377 Devices...”
- ¶168: “Additionally, I have personally tested the Ionic ...”
- ¶170: “I have personally tested the Charge 2 and Inspire HR devices...”
- ¶181: “I have personally tested the Representative ‘377 Devices...”
- ¶185: “As noted above, I have personally tested the Representative ‘377 Devices...”

I provide the technical documentation that shows the functionality that I have personally tested in the Representative ‘377 Devices is shared by the rest of the ‘377 Devices, and I note when there are relevant differences among the different ‘377 Devices.

Dkt. 270-2 at ¶147 (Technical Documents cited at e.g., ¶¶ 51, 58, 67)





# Fitbit Asserts Expert Testing Is Proper

Paradiso (Fitbit):

24 Q. And you tested five of them. Is  
25 that right?

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1 J. PARADISO - CONFIDENTIAL

2 A. Yes.

3 Q. Are the screenshots and pictures  
4 in this exhibit from the tests performed by  
5 counsel or from you or some combination?

6 A. These were performed -- these  
7 came from counsel. These are not my  
8 screenshots.

11 Q. Okay.  
12 But I just wanted to verify, when  
13 you say this test confirmed that the  
14 accused Fitbit wearables still track and  
15 record a user's data during an exercise  
16 session, this test you're talking about is  
17 just the test of the Versa 2 and the Charge  
18 3, right?

19 A. Yes. This test refers to that.

20 Q. You didn't test the other 7  
21 devices?

22 A. Outside of range? If I did it  
23 would be in the report, the tests that were  
24 run.

25 Q. Okay.

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1 J. PARADISO - CONFIDENTIAL

2 A. But yeah.

3 Q. But you think it's reasonable to  
4 conclude that by testing two of them in  
5 that way, that that would show that all of  
6 them worked in that way, is that right?

7 A. All of the Fitbit devices --  
8 MR. SHAW: Object to form.

9 A. Sorry, all of the Fitbit devices  
10 I've used and owned worked in that way and  
11 it makes sense to me that's what they  
12 would do.

Paradiso Deposition, Dkt. 316-1



# Daubert Motion to Exclude Dr. Akemann's Testimony

# License to the '191 is Comparable to the '377

**United States Patent**  
 Qty  
 (12) Patent No.: **US 8,277,377 B2**  
 (45) Date of Patent: **OCT. 2, 2012**

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
 WASHINGTON, DC 20530

(12) Inventor: Roger J. Qoy, AEB/Vady, CA (US)  
 (23) Assignee: Qoy Systems LLC, Wilmington, DE (US)  
 (\*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b)(1)-(2) days.

(21) Appl. No. 12/211,033  
 (22) Filed: Sep. 15, 2008

**Related U.S. Application Data**  
 (63) Continuation of application No. 11/649,703, filed on Jan. 3, 2007, now abandoned, which is a continuation of application No. 11/184,274, filed on Jul. 18, 2005, now Pat. No. 7,156,808, which is a continuation of application No. 10/418,845, filed on Apr. 18, 2003, now Pat. No. 6,936,007, which is a continuation of application No. 09/738,270, filed on Dec. 15, 2000, now Pat. No. 6,602,191.

(60) Provisional application No. 60/172,486, filed on Dec. 17, 1999.

(51) Int. Cl.  
 H04L 69/00 (2006.01)  
 H04L 29/08 (2006.01)

(52) Field of Classification  
 H04L 69/00 (2006.01)  
 H04L 29/08 (2006.01)

**10 Claims, 8 Drawing Sheets**

(10) Patent No.: **US 8,277,377 B2**  
 (45) Date of Patent: **OCT. 2, 2012**

**Related U.S. Application Data**

(63) Continuation of application No. 11/649,703, filed on Jan. 3, 2007, now abandoned, which is a continuation of application No. 11/184,274, filed on Jul. 18, 2005, now Pat. No. 7,156,808, which is a continuation of application No. 10/418,845, filed on Apr. 18, 2003, now Pat. No. 6,936,007, which is a continuation of application No. 09/738,270, filed on Dec. 15, 2000, now Pat. No. 6,602,191.

(60) Provisional application No. 60/172,486, filed on Dec. 17, 1999.

Fitbit incorrectly suggests that only prior licenses to the same patent are comparable.



## License to the '191 is Comparable to the '377

Fitbit incorrectly suggests that only prior licenses to the same patent are comparable. Comparable licenses by definition cannot be for the same patent.

Georgia Pacific Factor 1 (prior licensing of the patent):

“The royalties received by the patentee for the **licensing of the patent** in suit, proving or tending to prove an established royalty”

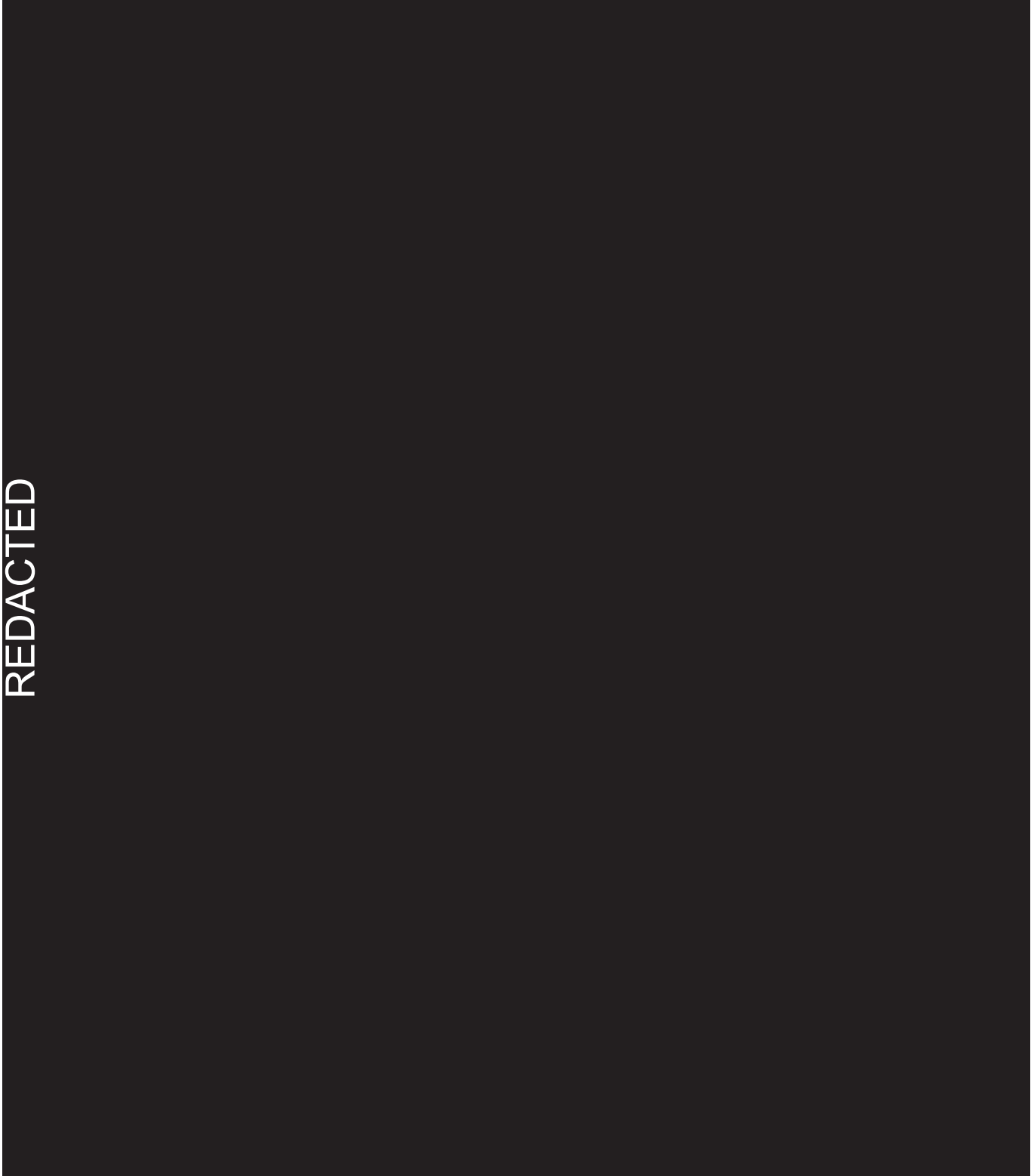
Georgia Pacific Factor 2 (prior licensing of comparable patents):

“The rates paid by the licensee for the **use of other patents comparable** to the patent in suit”

Georgia Pacific Factor 15 (hypothetical license):

“The amount that a licensor (such as a patentee) and the licensee (such as the infringer) would have agreed upon...”

REDACTED



PHILIPS



REDACTED



PHILIPS

REDACTED

**PHILIPS**

REDACTED

REDACTED

**PHILIPS**



REDACTED

PHILIPS

REDACTED

PHILIPS

## Fitbit Misinterprets the Case Law

*Omega Pats., LLC v. CalAmp Corp.*, 13 F.4th 1361, 1376-77 (Fed. Cir. 2021)

- “We have, however, explained that ‘when a sufficiently comparable license is used as the basis for determining the appropriate royalty, further apportionment may not necessarily be required.’”
- “That is because a damages theory that is dependent on a comparable license (or a comparable negotiation) may in some cases have ‘built-in apportionment.’”
- “Built-in apportionment effectively assumes that the negotiators of a comparable license settled on a royalty rate and royalty base combination embodying the value of the asserted patent.”

*LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51, 69-70 (Fed. Cir. 2012)

- “Actual licenses to the patented technology are highly probative.”
- Issue only arises from “alleging a loose or vague comparability” such as to “various licenses in the same general computer field without proving a relationship to the patented technology.”

*Masimo Corp. v. Philips Elecs. N. Am. Corp.*, 2013 WL 2178047 (D. Del. May 20, 2013)

- Prior license involved “technologies other than the patent in suit”
- “Further, nothing in the Agreement suggests Respironics or Nonin intended to include such technology.”

## Cases Support Admissibility

- VirnetX, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308 (Fed. Cir. 2014)

  - “[W]e have never required identity of circumstances; on the contrary, we have long acknowledged that ‘any reasonable royalty analysis’ necessarily involves an element of approximation and uncertainty.” Permitted Expert where there were “undoubtedly differences between the licenses at issue and the circumstances.”
  - “[T]he ‘degree of comparability’ of the license agreements was ‘[a] factual issue[] best addressed by cross examination and not by exclusion.’”

*Bio-Rad Lab’s, Inc. v. 10X Genomics Inc.*, 967 F.3d 1353 (Fed. Cir. 2020)

  - “[T]he issue of comparability is often one of sufficiency of the evidence, not admissibility.”
  - “[I]n ActiveVideo, the damages expert relied on two agreements, one of which did not involve the patents or technologies in the case. We concluded that the district court did not abuse its discretion by failing to exclude the testimony of the damages expert because the ‘degree of comparability’ of the license agreements is a ‘factual issue[] best addressed by cross examination and not by exclusion.’”
  - “The ‘degree of comparability’ was appropriately left for the jury to decide.”

*Skyhook Wireless, Inc. v. Google, Inc.*, CV 10-11571-RWZ, 2015 WL 13620764 (D. Mass. Feb. 18, 2015)

  - “To the extent that [defendant] disagrees with the conclusions of [plaintiff’s expert’s] apportionment methods, its recourse lies in cross-examination, not exclusion.”





**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing document was filed with the Court through the ECF system and that a copy will be electronically served on registered participants as identified on the Notice of Electronic Filing.

Dated: March 15, 2022

/s/ John W. Custer  
John W. Custer