

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

ORAL ARGUMENT REQUESTED

**PHILIPS NORTH AMERICA LLC'S MEMORANDUM IN SUPPORT OF ITS
MOTION FOR RECONSIDERATION OF THE MEMORANDUM AND
ORDER ON CROSS-MOTIONS FOR SUMMARY JUDGMENT (Dkt. 401)**

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I. Introduction

On September 1, 2022 (Dkt. 401, “Opinion”) the Court granted Fitbit’s motion for summary judgment finding the claims of U.S. Patent No. 8,277,377 (the “’377 Patent”) invalid under 35 U.S.C. § 101. In its Opinion, this Court stated that the asserted claims were not directed to an inventive concept because the “two alleged inventive concepts [were] set out in the specification, not the claim.” Opinion at 18. In this regard, the Court appears to have misunderstood the Federal Circuit’s holding in *Berkheimer* by requiring that the claims not only state the inventive concepts (which as discussed in more detail below they clearly do), but also requiring that the claims recite *ipsis verbis* the reason said concepts are inventive. Opinion at 18-19 (citing *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369-70 (Fed. Cir. 2018)). This was a manifest error of law and should be reconsidered as the Federal Circuit has frequently (including in *Berkheimer*) found inventive concepts captured by claims without the claims reciting *ipsis verbis* the reasons said concepts are inventive.¹ After discarding the two alleged inventive concepts, the Court proceeded to analyze each claim element in isolation without determining whether the ordered combination of elements in the claims included an inventive concept, another clear error for which Philips respectfully requests reconsideration.

II. Argument

A. The Standard for Reconsideration

“[A] district court has the inherent power to reconsider its interlocutory orders” and is “encourage[d] to do so where error is apparent.” *Fernández-Vargas v. Pfizer*, 522 F.3d 55, 61 n.2 (1st Cir. 2008). A motion for reconsideration should be granted “upon a showing of (1) a manifest error of law, (2) new evidence, or (3) a misunderstanding or other error not of reasoning but

¹ This motion focuses on one critical aspect of Step 2 in the *Alice/Mayo* analysis that mandates reversal of this

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