

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MASSACHUSETTS

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PHILIPS NORTH AMERICA LLC,

Plaintiff,

v.

FITBIT LLC,

Defendant.

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

**MOTION TO DISMISS CLAIMS PERTAINING TO U.S. PAT. NO. 7,088,233 AND TO  
ENTER FINAL JUDGMENT ON U.S. PAT. NOS. 8,277,377 AND 6,013,007**

**Background / Prior Notice of Appeal**

Philips filed a Notice of Appeal (Dkt. 415) in this matter on August 12, 2023 following this Court's denial (Dkt. 414) of Philips's Motion for Reconsideration (Dkt. 403) of this Court's summary judgment order invalidating the asserted claims of U.S. Patent No. 8,277,377 (the "'377 patent"). Prior to that, the Federal Circuit affirmed the Patent Trial and Appeal Board's final written decision finding unpatentable the previously asserted claims of U.S. Patent No. 7,088,233 (the "'233 patent"), and during claim construction, this Court had found all asserted claims of the only other asserted patent, U.S. Patent No. 6,013,007 (the "'007 patent") to be invalid as indefinite under 35 U.S.C. § 112. Thus, at the time of the filing of Philips's Notice of Appeal (Dkt. 415), all claims in the case had been resolved.

Defendant Fitbit LLC ("Fitbit") has filed a docketing statement with the Federal Circuit Court of Appeals suggesting that it will challenge the jurisdiction of the Federal Circuit in light of no formal separate entry of Final Judgment by the District Court. *See* Ex. 1, Docketing Statement for the Appellee Fitbit LLC, ECF No. 7, *Philips N.A., LLC v. Fitbit LLC*, CAFC-23-2286 (Fed. Cir.). There is no dispute by Fitbit, to which Philips is aware, that all claims in the case have been

resolved as explained. In an abundance of caution and in order to moot Fitbit's objections, Philips requests this Court issue an entry of Final Judgment as to the '377 and '007 Patent, and dismiss the claims related to the invalidated '233 Patent. Further, to the extent necessary, Philips intends to file an additional Notice of Appeal following an entry of Final Judgment by this Court "in order to avoid any doubts over [appellate] jurisdiction." *Clausen v. Sea-3, Inc.*, 21 F.3d 1181, 1183-84 (1st Cir. 1994).

Accordingly, Plaintiff Philips North America LLC ("Philips") hereby files this Motion to Dismiss claims pertaining to U.S. Patent No. 7,088,233 and enter judgment with respect to U.S. Patent Nos. 8,277,377 and 6,013,007.

### **The Parties' Claims and Counterclaims**

Philips's Second Amended Complaint, filed September 3, 2020, asserted three patents against Fitbit: U.S. Patent No. 6,013,007 (the "'007 patent"), U.S. Patent No. 7,088,233 (the "'233 patent"), and U.S. Patent No. 8,277,377 (the "'377 patent"). Dkt. 112. Fitbit filed an Amended Answer on October 10, 2021, asserting six counterclaims seeking declaratory judgments of non-infringement and invalidity of each patent. Dkt. 245.

### **The '233 Patent**

On October 4, 2021, the Patent Trial and Appeal Board ("PTAB") issued a final written decision in IPR2020-00783 finding all asserted claims of the '233 patent unpatentable. *See* Ex. 2 (Final Written Decision) at 46. On October 29, 2021, this Court orally granted a joint stipulation of the parties to stay all proceedings related to the '233 patent "pending a resolution of any appeals of the Patent Trial and Appeal Board's Final Written Decision in IPR2020-00783." Dkt. 251; *see also* Dkt. 252 (Transcript of October 29, 2021 Status Conference) at 7:16-19. On June 3, 2022, this Court memorialized the oral order of October 29, 2021 and stayed all proceedings related to

the '233 patent “pending the outcome of any appeal of the PTAB decision concerning that patent or further order of the Court.” Dkt. 386. On April 6, 2023, the Federal Circuit affirmed the PTAB’s finding that all asserted claims of the '233 patent were unpatentable, and a mandate issued on May 15, 2023 as none of the parties filed further appeals. *See* Ex. Nos. 3-4 (Judgment and Mandate). Philips moves this Court to dismiss all claims and counterclaims with regard to the '233 patent with prejudice.

### **The '007 Patent**

On July 22, 2021, this Court issued a Memorandum and Order on Claim Construction finding all asserted claims of the '007 patent to be indefinite under 35 U.S.C. § 112. Dkt. 212 at 12-21.

### **The '377 Patent**

On September 1, 2022, this Court issued a Memorandum and Order on Cross-Motions for Summary Judgment finding all asserted claims of the '377 patent to be invalid for claiming subject matter not patentable under 35 U.S.C. § 101. Dkt. 401. Philips moved for reconsideration (Dkt. 403), and the Court denied this request on July 13, 2023 (Dkt. 414).

### **Request for Judgment**

As the appeal concerning the '233 patent is now fully resolved, and all remaining claims and counterclaims pertaining to the '007 and '377 patents have been fully resolved or mooted by prior orders, Philips moves that: (1) this Court dismiss all claims and counterclaims with regard to U.S. Patent No. 7,088,233 with prejudice, and (2) this Court enter Final Judgment of invalidity as to the asserted claims of U.S. Patent No. 6,013,007 and U.S. Patent No. 8,277,377, and to further dismiss any remaining counterclaims without prejudice.

Respectfully Submitted,

Dated: September 20, 2023

/s/ Ruben J. Rodrigues

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**LOCAL RULE 7.2 CERTIFICATION**

I, John W. Custer, counsel for Philips North America LLC, hereby certify that we have conferred with counsel for Fitbit, Inc. to resolve the issues presented in this motion, but after a good faith attempt to reach agreement, the parties did not do so.

Dated: September 20, 2023

/s/ John W. Custer

John W. Custer

**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.

By: /s/ John W. Custer

John W. Custer