

EXHIBIT 1

From: [Adam Steinmetz](#)
To: [Custer, John W.](#); [David Shaw](#)
Cc: [Fitbit Philips DC Appeal](#); [BOST - F - Philips - Fitbit](#)
Subject: RE: Philips v. Fitbit - No. 1:19-cv-11586-FDS - Proposed Joint Motion
Date: Friday, September 15, 2023 4:07:00 PM

John,

Thanks for our meeting this afternoon.

As a follow-up, I can confirm that Fitbit will oppose the motions Philips intends to file in the district court, so you can file those as opposed.

Additionally, you confirmed during the call that Philips will not move in the Federal Circuit to dismiss the appeal. You also confirmed that Philips will oppose a motion by Fitbit in the Federal Circuit to dismiss the appeal.

As for the other issues we discussed, we are working on the appendix materials, and we will get back to you on that next week. And you noted that you may seek an extension of the deadline for the brief, but you will follow up on any extension request you intend to make.

Please let me know if I owe you a response on anything else.

Regards,
Adam

From: Custer, John W. <jcuster@foley.com>
Sent: Thursday, September 14, 2023 9:17 PM
To: Adam Steinmetz <asteinmetz@desmaraisllp.com>; David Shaw <DShaw@desmaraisllp.com>
Cc: Fitbit Philips DC Appeal <FitbitPhilipsDCAppeal@desmaraisllp.com>; BOST - F - Philips - Fitbit <BOSTFPhilipsFitbit@foley.com>
Subject: [Ext] Re: Philips v. Fitbit - No. 1:19-cv-11586-FDS - Proposed Joint Motion

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Hey Adam,
I can confirm that tomorrow at 1:30pm will work. I will circulate an invite tomorrow morning.
Best,
John

From: Adam Steinmetz <asteinmetz@desmaraisllp.com>
Sent: Thursday, September 14, 2023 7:59:35 PM
To: Custer, John W. <jcuster@foley.com>; David Shaw <DShaw@desmaraisllp.com>
Cc: Fitbit Philips DC Appeal <FitbitPhilipsDCAppeal@desmaraisllp.com>; BOST - F - Philips -

Fitbit <BOSTFPhilipsFitbit@foley.com>

Subject: Re: Philips v. Fitbit - No. 1:19-cv-11586-FDS - Proposed Joint Motion

**** EXTERNAL EMAIL MESSAGE ****

Thanks John. Let us know. Otherwise, Monday should work too. Thanks.

From: Custer, John W. <jcuster@foley.com>

Sent: Thursday, September 14, 2023 6:50:54 PM

To: Adam Steinmetz <asteinmetz@desmaraisllp.com>; David Shaw <DShaw@desmaraisllp.com>

Cc: Fitbit Philips DC Appeal <FitbitPhilipsDCAppeal@desmaraisllp.com>; BOST - F - Philips - Fitbit <BOSTFPhilipsFitbit@foley.com>

Subject: [Ext] Re: Philips v. Fitbit - No. 1:19-cv-11586-FDS - Proposed Joint Motion

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Hey Adam, I will need to check with the rest of my team regarding availability for a call. But let's tentatively plan to have one tomorrow at 1:30 pm.

Best,

John

From: Adam Steinmetz <asteinmetz@desmaraisllp.com>

Sent: Thursday, September 14, 2023 6:17:27 PM

To: Custer, John W. <jcuster@foley.com>; David Shaw <DShaw@desmaraisllp.com>

Cc: Fitbit Philips DC Appeal <FitbitPhilipsDCAppeal@desmaraisllp.com>; BOST - F - Philips - Fitbit <BOSTFPhilipsFitbit@foley.com>

Subject: RE: Philips v. Fitbit - No. 1:19-cv-11586-FDS - Proposed Joint Motion

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John,

The Federal Circuit applies Rule 4(a)(2) when an appellant is under the mistaken impression that the notice of appeal was timely because all issues were resolved. *See Meade Instruments Corp. v. Reddwarf Starware, LLC*, 250 F.3d 759 (Fed. Cir. 2000) (unpublished) (attached). That is not the situation here because, by your concession, claims remain pending in the district court that currently preclude the entry of judgment. *See, e.g., id.* (“[I]mportantly, Reddwarf’s motion for Rule 54(b) certification belies any notion that it was under the mistaken impression that the district court’s order was final and appealable.”). Furthermore, as indicated by my prior email, Fitbit is not willing to join Philips’ proposed filings in the district court while the appeal remains pending; the appeal must first be dismissed, after which time the district court can take the actions you propose.

Perhaps it would be best to talk this through on a call. We can be available tomorrow between

11 am and 3 pm EST, or we can talk on Monday. Please let us know your availability.

Regards,
Adam Steinmetz

Adam Steinmetz

DESMARAIIS LLP

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Washington, D.C. 20006

T: (202) 451-4936

asteinmetz@desmaraisllp.com

From: Custer, John W. <jcuster@foley.com>

Sent: Wednesday, September 13, 2023 11:49 AM

To: Adam Steinmetz <asteinmetz@desmaraisllp.com>; David Shaw <DShaw@desmaraisllp.com>

Cc: Fitbit Philips DC Appeal <FitbitPhilipsDCAppeal@desmaraisllp.com>; BOST - F - Philips - Fitbit <BOSTFPhilipsFitbit@foley.com>

Subject: [Ext] RE: Philips v. Fitbit - No. 1:19-cv-11586-FDS - Proposed Joint Motion

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Hey Adam,

Philips considers the Notice of Appeal to have been timely filed and thus disputes Fitbit's contention that the Federal Circuit lacks jurisdiction. However, even if the Notice of Appeal was premature (as Fitbit contends), it would ripen into a proper Notice of Appeal following an entry of final judgment by the Court pursuant to Federal Rule of Appellate Procedure 4(a)(2). Thus, Philips does not intend to dismiss its present appeal. As Fitbit appears unwilling to join our motion to the District Court, please let us know by the end of the week whether Fitbit plans to oppose such a motion by Philips. Best,

John Custer

Foley & Lardner LLP

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Boston, MA 02199-4001

P 617.226.3148

Pronouns: He/Him/His



From: Adam Steinmetz <asteinmetz@desmaraisllp.com>
Sent: Monday, September 11, 2023 4:38 PM
To: Custer, John W. <jcuster@foley.com>; David Shaw <DShaw@desmaraisllp.com>
Cc: Fitbit Philips DC Appeal <FitbitPhilipsDCAppeal@desmaraisllp.com>; BOST - F - Philips - Fitbit <BOSTFPhilipsFitbit@foley.com>
Subject: RE: Philips v. Fitbit - No. 1:19-cv-11586-FDS - Proposed Joint Motion

**** EXTERNAL EMAIL MESSAGE ****

John,

Based on your email, it appears that Philips does not dispute that the Notice of Appeal was filed prematurely, and that under the current procedural posture the Federal Circuit lacks jurisdiction. Accordingly, we do not agree that the jurisdictional problem would be “mooted” by your proposed course of action, which would involve filings exclusively in the district court. Rather, the appeal must be dismissed without prejudice until such time as the district court issues final judgment resolving all claims and defenses.

Accordingly, we propose that Philips first file an unopposed motion in the Federal Circuit to dismiss the present appeal without prejudice. Once that motion has been granted, Fitbit is willing to join a motion requesting that the district court (1) lift the stay with respect to the '233 patent, (2) dismiss Philips' claims relating to the '233 patent with prejudice, and (3) enter final judgment with respect to the '007 and '377 patents.

Please let us know if you agree to this proposal.

Regards,

Adam Steinmetz

DESMARAIS LLP

1899 Pennsylvania Ave, N.W.

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