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*Attorneys for Defendants Garmin International, Inc.
and Garmin Ltd.*

**IN THE UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA**

PHILIPS NORTH AMERICA LLC,)
)
Plaintiff,)
)
v.)
)
GARMIN INTERNATIONAL, INC. AND)
GARMIN LTD.,)
)
Defendants.)
)
)

Case No. 2:19-cv-06301-AB-KS

GARMIN'S P.R. 3-3 DISCLOSURES

1 Pursuant to the Court’s Case Scheduling Order in the above captioned case, and Patent Local
2 Rule 3-3 of the Northern District of California, Defendants Garmin International, Inc. and Garmin
3 Ltd. (collectively “Garmin”) hereby serve their Invalidity Contentions (“Invalidity Contentions”).
4 Garmin offers these Invalidity Contentions in response to Plaintiff’s P.R. 3-1 Disclosures
5 (“Infringement Contentions”) served on March 2, 2020 as supplemented March 27, 2020 addressing
6 how claims 7 and 21-29 of U.S. Patent No. 6,013,007 (the ’007 Patent), claims 1, 7-10, 13-16, 22,
7 and 24-26 of U.S. Patent No. 7,088,233 (the ’233 Patent), claims 1, 4-6, 9 and 12 of U.S. Patent No.
8 8,277,377 (the ’377 Patent), claims 15-17 of U.S. Patent No. 6,976,958 (the ’958 Patent), claims 1,
9 3, 5, and 20 of U.S. Patent No. 9,314,192, and claims 13 and 15 of U.S. Patent No. 9,801,542
10 (the ’542 Patent) (collectively referred to herein as the “Asserted Patents” or “Asserted Claims”), are
11 invalid.
12

13 Pursuant to P.R. 3-3, and based on Defendants’ investigation and knowledge developed to
14 date, Garmin hereby (a) identifies each currently known item of prior art that anticipates and/or
15 renders obvious the Asserted Claims; (b) specify whether each such items of prior art (alone or in
16 combination) anticipates the Asserted Claims or renders them obvious, including an explanation of
17 why the prior art renders the asserted claims obvious, including an identification of any combinations
18 of prior art showing obviousness; (c) provide claim charts identifying where specifically in each item
19 of prior art ach element of the Asserted Claims is found, including for each limitation governed by
20 35 U.S.C. 112(6), the identity of the structure(s), act(s) or material(s) in each item of prior art that
21 performs the claimed function; and (d) any grounds of invalidity based on 35 U.S.C. 101,
22 indefiniteness under 35 U.S.C. 112(2) or enablement or written description under 35 U.S.C. 112(1)
23 of any of the asserted claims. Garmin takes no opinion with respect to any claims that are not asserted
24 against Garmin and reserves its right to supplement these Invalidity Contentions should the Court
25 permit Plaintiff Philips North America (“Philips” or “Plaintiff”) to assert new claims against Garmin.
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1 **I. RESERVATIONS**

2 **A. General Reservations**

3 Garmin incorporates by reference any and all other bases for invalidity identified during
4 prosecution or any other proceeding before the United States Patent and Trademark Office
5 (“USPTO”) regarding the Asserted Patents, or any other patents in the same family as any Asserted
6 Patent. Garmin additionally incorporates by reference any and all other invalidity contentions and
7 expert reports, including any references or arguments set forth therein, that have been or will be
8 served in this case or any other case brought by or against Philips and/or involving the Asserted
9 Patents. This includes without limitation the invalidity contentions and expert reports served in at
10 least *Philips North America LLC v. FitBit, Inc.*, No. 1:19-cv-11586-IT (D. Mass.).

11
12 In addition, Garmin incorporates herein all statements made by the patentee(s) during
13 prosecution of the Asserted Patents and any other patents in the same family characterizing the state
14 of the art or characterizing the prior art. Garmin also incorporates relevant statements about the state
15 of the art and prior art made by the USPTO during prosecution. To the extent that Plaintiff takes
16 positions in this litigation (for example, in its Infringement Contentions or Claim Construction
17 proceedings) that differ from positions taken by the patentee during prosecution of the Asserted
18 Patents or related patents, Garmin reserves the right to amend these Invalidity Contentions to include
19 the patentee’s positions previously taken during prosecution.
20

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22 **B. Asserted Claims**

23 These Invalidity Contentions address only those claims that Plaintiff has asserted in its
24 Infringement Contentions against Garmin. Garmin reserves the right to supplement these Invalidity
25 Contentions if Plaintiff attempts to assert any claims not addressed in its Infringement Contentions
26 or attempts to modify or revise the Infringement Contentions served in March 2020 in any way.
27

28 **C. Ongoing Discovery**

1 Garmin discloses these Invalidity Contentions based on its current knowledge and
2 understanding of the prior art as of the date of these Invalidity Contentions. Discovery is ongoing,
3 and Garmin's prior art investigation is not yet complete. Furthermore, Garmin's investigation from
4 potentially relevant third parties is not yet complete. Additional discovery and investigation,
5 including but not limited to Plaintiff's or third-party production of relevant additional materials, may
6 lead to additions to, changes in, or modifications of these Invalidity Contentions. Garmin expects
7 that further discovery will reveal additional prior art, including related disclosures and corresponding
8 evidence for many of the prior art references identified below. Additionally, it is likely that Garmin
9 will identify additional prior art or contentions that will add meaning to and/or increase the relevance
10 of already known prior art or contentions or possibly lead to additions or changes to these invalidity
11 contentions. In particular, for example, Garmin may serve subpoenas on, and/or take depositions of,
12 Plaintiff and third parties, and expects to rely on such information to support its invalidity positions.
13 To the extent Garmin obtains additional information, and without obligating itself to do so, Garmin
14 reserves the right to amend, modify, or supplement these Invalidity Contentions.
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17 Plaintiff has not produced all prior art materials and/or information relevant to invalidity
18 issues that is in its possession, custody and/or control. Plaintiff's production of those materials and/or
19 information may lead to additions to, changes in, or modifications of these Invalidity Contentions.
20 Nor has Garmin had the opportunity to depose Plaintiff or the patent applicants regarding the notes,
21 records, reports or similar materials prepared in conjunction with the supposed inventions'
22 conception and reduction to practice. As such, Garmin reserves the right to revise, amend, and/or
23 supplement the information provided herein, including identifying, charting, and relying on
24 additional references or combinations of references.
25

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27 These Invalidity Contentions, therefore, are provided without prejudice to Garmin's right to
28 revise, amend, correct, supplement, modify, or clarify their Invalidity Contentions. Defendants also

1 reserve the right to complete its investigation and discovery of the facts, to produce subsequently
2 discovered information, and to introduce such subsequently discovered information at the time of
3 any hearing or trial in this action.
4

5 **D. Claim Interpretation**

6 Unless otherwise stated herein, Garmin takes no position on any matter of claim
7 interpretation, including any application or interpretation of claim construction orders in related
8 cases, in these Invalidity Contentions. Garmin notes that no claim construction order has been issued
9 in this case. Garmin reserves the right to propose any claim interpretation it considers correct and to
10 contest any claim interpretation it considers inappropriate. Without conceding any express or implied
11 claim interpretation apparently posited by Plaintiff, Garmin has attempted to apply the Asserted
12 Claims to the prior art in view of Plaintiffs Infringement Contentions, as well as other allegations,
13 admissions, and/or positions taken so far in this litigation.
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16 In addition, the identification of exemplary disclosures in the prior art that anticipate or render
17 obvious a particular claim element should in no way be construed as an admission that the claim
18 element satisfies the requirements of 35 U.S.C. §112. In those instances where Defendants assert that
19 the Asserted Claims are invalid under 35 U.S.C. §112 (e.g., for failure to particularly point out and
20 distinctly claim the invention and for failure to provide written description support in the
21 specification and/or lack of enablement), Garmin has applied the prior art in part in accordance with
22 its assumption that Plaintiff contends the Asserted Claims are definite, find written description
23 support in, and are enabled by the relevant Patents-in-Suit. However, Garmin's prior art Invalidity
24 Contentions do not represent Garmin's agreement as to the meaning, definiteness, written description
25 support for, or enablement of any claim contained therein. Garmin therefore reserves the right to
26 argue that certain claim terms, phrases, and elements are indefinite, lack written description, are not
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