UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITBIT, INC.,

Petitioner

v.

PHILIPS NORTH AMERICA LLC, Patent Owner

Case Nos. IPR2020-00783

U.S. Patent No. 7,088,233

PATENT OWNER PRELIMINARY RESPONSE UNDER 35 U.S.C. § 313 AND 37 C.F.R. § 42.107



TABLE OF CONTENTS

I.	INTI	RODU	CTION	1	
II.	BACKGROUND				
	A.	The '233 Patent			
		1.	Specification	3	
		2.	Challenged Claims	4	
	B.	The 1	Parties' Related District Court Litigations	5	
III.	CLAIM CONSTRUCTION				
	A.	Petitioners' Claim Constructions			
		1.	"wireless communication"	10	
		2.	"governing information transmitted between the first personal device and the second device"	11	
IV.	THE BOARD SHOULD DENY INSTITUTION PURSANT TO 35 U.S.C. § 314(a)				
	A.	The Fintiv Factors Weigh Against Institution			
		1.	Neither Petitioner Has Sought to Stay Either District Court Litigation	16	
		2.	The Progression of the Fitbit and Garmin Litigations Weigh Heavily in Favor of Denial	16	
		3.	The District Courts and the Parties Have Invested a Significant Amount of Resources in the District Court Litigations	17	
		4.	The Issues Raised in the Petitions Will Be Resolved by the District Court Litigations	18	
		5.	Petitioners Are Also Parties in the District Court Litigations	19	



		6.	The Weakness of the Petitions Also Weighs in Favor of Denying Institution	19	
V.	THE PETITIONS SHOULD BE DENIED BECAUSE THEY FAIL TO DEMONSTRATE A REASONABLE LIKELIHOOD OF SUCCESS				
	A.	Level	of Ordinary Skill in the Art	20	
	B.	Because Jacobsen Does Not Disclose All of the Limitations of Claim 1, Ground 1 Fails			
		1.	Jacobsen	20	
		2.	Jacobsen Does Not Disclose the Claimed "wireless communication module[s]"	24	
		3.	Jacobsen Also Does Not Disclose the Claimed "security mechanism governing information transmitted between the first personal device and the second device"	25	
	C.		use Say Does Not Disclose All of the Limitations of Claim ound 2 Fails	26	
		1.	Say	26	
		2.	Say Does Not Disclose the Claimed "security mechanism governing information transmitted between the first personal device and the second device"	29	
	D.		use the Combination of Jacobsen and Say Does Not ose All of the Limitations of Claim 1, Ground 3 Fails	30	
		1.	Jacobsen in View of Say	30	
		2.	Because Jacobsen Does Not Disclose the Claimed "wireless communication module[s]," the Petitions Fail to Show How the Jacobsen-Say Combination Discloses All of the Limitations of Claim 1	30	
		3.	Because Say Does Not Disclose the Claimed "security mechanism," the Petitions Fail to Show the Jacobsen-Say Combination Meets All of the Limitations of Claim 1	31	



	E.	The Other Grounds Fail For Much the Same Reasons as Discussed Above		
		1.	Because Neither Jacobsen nor Say Disclose All of the Claim Limitations, Grounds 4-7 Fail	32
		2.	Ground 4 Does Not Overcome the Failings of the Jacobsen-Say Combination	32
		3.	Ground 5 Also Fails to Overcome the Issues Associated With Jacobsen and Say	34
		4.	Ground 6 Also Fails to Overcome the Deficiencies of Jacobsen and Say	35
		5.	Ground 7 Fails to Overcome the Deficiencies of Say	36
VI	CON	JCI IIS	SION	40



TABLE OF AUTHORITIES

Page(s) Cases Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (Fintiv I)passim General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha, IPR2016-01357, Paper 19, 15-19 (PTAB, Sept. 6, 2017)......14 Harmonic Inc. v. Avid Tech., Inc., NHK Spring Co., Ltd. v. Intri-Plex Techs. Inc., IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018)......14, 15, 17 Philips N. Am. LLC v. Fitbit, Inc., Philips N. Am. LLC v. Garmin Int'l, Inc., et al., WesternGeco LLC v. ION Geophysical Corp., ZTE (USA) Inc. v. Fractus, S.A., IPR2018-01451, Paper No. 12 (PTAB Feb. 19, 2019)......17 **Statutes** 35 U.S.C. § 101......5 35 U.S.C. § 313....... Other Authorities 37 C.F.R. § 42.107......1



DOCKET

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

