

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GARMIN INTERNATIONAL, INC., GARMIN USA, INC.,  
AND GARMIN LTD.,

Petitioner,

v.

PHILIPS NORTH AMERICA LLC,

Patent Owner.

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Case IPR2020-00910  
Patent 7,088,233 B2

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**Patent Owner's Updated Mandatory Notices  
Under 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8, Philips North America LLC (“Philips”) provides this Mandatory Notice within 21 days of service of the Petition (Paper 1) on May 15, 2020.

I. Real Party-in-Interest Pursuant to 37 C.F.R. § 42.8 (b)(1):

Philips North America LLC is the sole assignee of U.S. Patent No. 7,088,233 (the “’233 patent”).

II. Related Matters Pursuant to 37 C.F.R. § 42.8 (b)(2):

Philips North America LLC is aware of the following matters involving the ’233 patent.

The ’233 patent is at issue in *Fitbit, Inc. v. Philips North America LLC* (IPR2020-0783). The ’233 patent is also at issue in the following cases: *Philips North America LLC v. Fitbit, Inc.*, No. 1:19-cv-11586-IT (D. Mass.); and *Philips North America LLC v. Garmin International, Inc. et al.*, Case No. 2:19-cv-06301-AB-KS (C.D. Cal.). The Massachusetts district court action also involves U.S. Patent Nos. 8,277,377 (“the ’377 patent”), 6,976,958 (“the ’958 patent”) and 6,013,007 (“the ’007 patent”). The California district court action also involves the ’377 patent, the ’958 patent, and the ’007 patent, as well as U.S. Patent Nos. 9,314,192, and 9,801,542.

On April 8, 2020, Fitbit, Inc. filed a petition for *inter partes* review

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challenging the '958 patent (IPR2020-00782). On April 15, 2020, Fitbit also filed an IPR against U.S Patent No. 8,277,377 (IPR2020-00828).

On May 15, 2020, Petitioner filed a petition for *inter partes* review challenging the '958 patent (IPR2020-00909).

**III. Lead and Back-Up Counsel Pursuant to 37 C.F.R. § 42.8(b)(3):**

Philips North America LLC designates the following Lead and Back-up Counsel:

<b>Lead Counsel</b>	<b>Back-up Counsel</b>
George C. Beck Foley & Lardner LLP 3000 K Street, N.W., Suite 600 Washington, DC 20007 Direct Line: 202-945-6014 Email: GBeck@foley.com Fax: 202-672-5399 USPTO Reg. No. 38,072	Eley O. Thompson Foley & Lardner LLP 321 N. Clark Street, Suite 2800 Chicago, IL 60654-5313 Direct Line: (312) 832-4359 Email: EThompson@foley.com Fax: (312) 832-4700 USPTO Reg. No. 36,035
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IV. Service Information Pursuant to 37 C.F.R. §§ 42.8(b)(4):

Please address all correspondence to the lead counsel at the address shown above. Patent Owner consents to electronic service by e-mail at:

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Any questions concerning this paper may be directed to lead counsel.

Dated: December 17, 2020

Respectfully submitted,

/George C. Beck/

George C. Beck

Registration No. 38,072

Counsel for Patent Owner

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing **Philips North America LLC's Updated Mandatory Notices Under 37 C.F.R. § 42.8** was served on December 17, 2020, by email directed to the attorneys of record for the Petitioners at the following address:

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Dated: December 17, 2020

By: /George C. Beck/  
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