

MASSACHUSETTS Lawyers Weekly

Patent infringement claim against Fitbit to proceed

'Inventive concept' is plausibly argued

By Eric Berkman | September 30, 2021

A federal judge has ruled that infringement claims brought against a manufacturer of wearable fitness technology can proceed despite the asserted patents being directed to “abstract ideas.”

Plaintiff Philips North America accused defendant Fitbit of infringing patents for a method of “interactive exercise monitoring,” a wireless communication system, and a means of computing athletic performance feedback data.

Fitbit argued that the asserted patents related to collecting, analyzing and displaying data and securely transforming it between devices, all of which it contended were abstract ideas constituting patent-ineligible subject matter under 35 U.S.C. §101.

Accordingly, the defendant argued, the complaint should be dismissed under the statute.

But U.S. District Court Judge F. Dennis Saylor IV disagreed, applying the so-called “Alice test,” taken from the U.S. Supreme Court’s 2014 *Alice Corp. v. CLS Bank Intern.* decision, under which an infringement claim directed toward abstract ideas can still be valid if it states an “inventive concept.”

“[F]or present purposes, it appears that the complaint plausibly alleges that the elements of the claims of [two of the asserted patents], when considered in combination, contain an inventive concept sufficient to transform the claimed abstract idea into a specific patent-eligible application,” Saylor wrote, denying Fitbit’s motion. “[D]iscovery may well prove otherwise. But at this stage, the Court must accept as true the complaint’s non-conclusory allegations.”

The 22-page decision is Philips North America



LLC v. Fitbit, Inc., Lawyers Weekly No. 02-255-21. The full text of the ruling can be found [here](#).

ILLUSTRATING A TREND

Philips was represented by Lucas I. Silva of Boston and Eley O. Thompson of Chicago. Boston attorney Gregory F. Corbett and David J. Shaw of Washington, D.C., represented the defendant. None of the party counsel responded to requests for comment.

However, Kirk Teska, an IP lawyer in Waltham, said the ruling is indicative of a trend away from patent owners losing their infringement cases on motions to dismiss.

“This is a trend that’s been ramping up for a while,” Teska said. “Attorneys representing patent owners have figured out how to beef up their complaints. It won’t work in every case, but this is another citable decision patent owners can use, another arrow in their quiver to survive a motion to dismiss.”

Patent litigator Craig R. Smith of Boston also noted a trend.

“Courts are less likely to grant a motion to dismiss based on unpatentable subject matter if the complaint contains plausible allegations that the patent claims cover an inventive concept,” he said.

Ultimately, [Susan] Glovsky said, while the ruling may make some defendants think twice about spending money on a motion to dismiss, “a lot more has to happen for the pendulum to swing in that direction because there are still too many advantages to filing the motion.”

“Patent owners have picked up on this trend and are more careful in drafting their complaints.”

However, Smith added, Saylor’s denial of Fitbit’s motion to dismiss does not mean that the patents in question will survive a motion for summary judgment.

“The court applies a different standard to motions for summary judgment,” he said.

Samuel Brenner, an IP litigator in Boston, said the decision provides a useful takeaway for defense counsel in infringement cases, too.

“Even if you lose your motion to dismiss at the second step of the Alice analysis, you can still effectively use the motion to dismiss to address whether claims are directed to an abstract idea and use this sort of motion practice to help focus the issues for discovery, which can then be addressed at summary judgment or at a later stage,” he said.

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In other words, Brenner continued, the decision operates as a “roadmap” for parties in litigating the remainder of a §101 case beyond the motion-to-dismiss stage.

Meanwhile, Susan G.L. Glovsky of Boston, who handles patent infringement cases, downplayed any notions that the ruling would serve as a “broad brush case” against defendants filing motions to dismiss.

Specifically, Glovsky said, when a defendant files a motion to dismiss on §101 grounds, it does not immediately have to answer the complaint. Mean-



Susan G.L.
Glovsky

while, the case sits there until the judge decides the motion.

“The case could sit for a year or two before that happens,” she said. “Damages may be accruing, but a lot of cases probably settle while that motion to dismiss is sitting there.”

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ALLEGED INFRINGEMENT

Philips, a Delaware corporation based in Massachusetts, develops, among other products, connected-health technologies and related products such as wearable fitness trackers that monitor and analyze personal health and fitness information.

It has more than 60,000 patents in its portfolio and licenses its patented technologies to companies in the connected-health field.

Fitbit, also a Massachusetts-based Delaware corporation, develops, manufactures and sells connected-health products.

According to Philips’ 2019 complaint, Fitbit infringed its patents concerning related technology, in-

**PHILIPS NORTH
AMERICA LLC
V. FITBIT, INC.**



THE ISSUE: Could patent infringement claims brought against a manufacturer of wearable fitness technology proceed despite the asserted patents being directed to “abstract ideas” of collecting, analyzing and displaying data and securely transferring it between devices?

DECISION: Yes (U.S. District Court)

LAWYERS: Lucas I. Silva of Foley & Lardner, Boston; Eley O. Thompson of Foley & Lardner, Chicago (plaintiffs) David J. Shaw of Desmarais, Washington, D.C.; Gregory F. Corbett of Wolf, Greenfield & Sacks, Boston (defense)

cluding patents regarding GPS/audio athletic training, security mechanisms for transmitting personal data, wearable-technology products, and handling interrupted connections.

One of the patents, titled “Personal Medical Device Communication System and Method” – referenced as the “’233” patent – relates to a personal communication system suitable for use by children and vulnerable adults, like those in assisted living situations, and medically distressed individuals, as well as those in whom a personal medical device has been deployed for medical testing.

The patent describes a “device and method” to couple with personal medical devices to provide wireless communication and locating functions. According to the patent, health care professionals can access information to perform remote diagnoses and allow for notification of acute conditions that may require immediate assistance, among other things.

Another patent – referenced as the “’377” patent – provides a means for wireless monitoring of exercise or nutrition by connecting a wireless phone to a device that provides such information.

Fitbit moved to dismiss for failure to state a claim, contending that under §101 the patents were ineligible for protection as directed to abstract ideas.

Claims to proceed

Saylor found that the patents in question were, in fact, directed to abstract ideas as Fitbit asserted.

For example, he said, the ’377 patent is directed to the abstract idea of collecting and analyzing exercise-related data and presenting it to a user.

Meanwhile, the Federal Circuit Court of Appeals has held repeatedly that “collecting, analyzing, and displaying data” are abstract concepts.

The same is true of the ’233 patent, Saylor continued, agreeing with the defendant that the claim was directed to the abstract idea of secure data transfer between devices and that, under Federal Circuit precedent, a claim must have sufficient specificity to transform it from one claiming only a result to one claiming a way of achieving that result.

However, he said, that was only the first step of the Alice analysis. At step two, Saylor pointed out, the court looks for an “inventive concept” – in other words, an element or combination of elements sufficient to ensure the patent amounts to more than a patent upon the ineligible concept itself.

With respect to the ’377 patent, Philips contained such a concept, namely the installation of a filtering tool at a specific location with customizable filtering features specific to each end user, the judge noted. That plausibly suggests a technological advancement over prior art, he said.

Similarly, Saylor said, the ’233 patent – as asserted in the complaint – discloses a “distributed personal health communication system” that solved certain problems of prior art, including those related to interoperability between wireless technologies and security of data transfers.

Because Philips’ complaint satisfied the second step of the Alice analysis, Saylor said the defendant’s motion to dismiss must be denied.”