

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

KONINKLIJKE PHILIPS N.V.,
Patent Owner

IPR2020-00754
U.S. Patent No. 7,845,228

**PETITIONERS' REQUEST FOR REHEARING
UNDER 37 C.F.R. § 42.71(D)**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioners Garmin International, Inc., Garmin USA, Inc., Garmin Ltd., and Fitbit, Inc. (collectively, “Petitioners”) respectfully request rehearing of the Decision Denying Institution of *Inter Partes* Review (Paper 11, “Decision” or “Dec.”). Invoking *NHK Spring Co. v. Intri-Plex Technologies, Inc.*, IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018), and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020), the Decision denied institution under 35 U.S.C. § 314(a) based largely on the allegedly advanced stage of the parallel proceeding before the U.S. International Trade Commission (“ITC”) that—as of the time of the Decision—involved only one of the eleven claims challenged in this IPR. The Decision did so even though it credited Petitioners for filing their IPR petition quickly after the commencement of the ITC investigation, Dec. at 14, and acknowledged that “the merits of Petitioner’s asserted ground are strong,” *id.* at 16.

The Board should grant reconsideration and set this case for rehearing before the Precedential Opinion Panel (“POP”). The POP should reject the Decision’s extension of *NHK Spring* and *Fintiv* (which allow for discretionary denial for a parallel *judicial* proceeding) to parallel ITC proceedings. This holding contravenes the IPR statutory scheme and congressional intent, ignores different statutory mandates of the Patent Office and the ITC, and significantly curtails the availability of IPRs as a mechanism for challenging patent validity. As the Decision

acknowledged, the ITC lacks authority to invalidate a patent, and its rulings on invalidity are not binding either on the Patent Office or on the district court. Dec. at 10. No efficiency would be lost by having the Board institute review and proceed to determine conclusively the challenged claims' patentability.

In any event, the Decision misapplied *Fintiv*'s factors for determining when discretionary denial of institution is warranted. The Decision ignored critical differences between the district court and ITC proceedings in mechanically applying *Fintiv*'s first and third factors to an ITC investigation, which proceeds in accordance with a rapid and strict statutory timeline. In applying *Fintiv*'s second factor—which considers the proximity of the court's trial date to projected deadline for the Board's final written decision—the Decision failed to focus solely on the ITC's final determination, which is the actual agency decision. The Decision compounded its error by refusing to factor into the projected timeline the 60-day presidential review period, even though such review is an integral statutory component of the ITC's decisional process. The Decision also ignored the limited overlap between claims at issue in the IPR and in the ITC investigation (which, by the time of the Board's decision, was a single claim) under *Fintiv*'s fourth factor, partly due to Patent Owner's failure to inform the Board that it had dropped two asserted claims in the ITC. Finally, the Decision gave insufficient weight to the merits of Petitioners' invalidity contentions under *Fintiv*'s sixth factor.

II. LEGAL STANDARD

“A party dissatisfied with a decision may file a single request for rehearing,” “identify[ing] all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d). Institution decisions are reviewed on rehearing for an abuse of discretion. *Id.* § 42.71(c). An abuse of discretion occurs when a “decision [i]s based on an erroneous conclusion of law or clearly erroneous factual findings, or ... a clear error of judgment.” *Apple Inc. v. DSS Tech. Mgmt., Inc.*, IPR2015-00369, Paper 14 at 3 (Aug. 12, 2015) (citation omitted).

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

The Board, applying *NHK Spring* and *Fintiv*, denied review under 35 U.S.C. § 314(a) because it concluded that the ITC will complete its parallel investigation into unfair trade practices before the Board issues its final written decision. The Board denied institution even though it acknowledged that two of *Fintiv*'s factors weighed in favor of instituting review (Dec. at 16, 18), and that any ITC invalidity ruling will not be binding on the challenged claims' patentability (Dec. 10).

The Decision was incorrect to extend *NHK Spring*, which applied to parallel *judicial* proceedings, to proceedings before another *agency*, especially one with a

different mission (prevention of unfair trade acts).¹ Unlike a court ruling, an ITC decision on invalidity does not conclusively resolve the question of patentability, and has no preclusive effect on the Patent Office or the district court. Given the strict and rapid statutory timeline for an ITC investigation, extending *NHK Spring* to those proceedings would severely curtail IPRs as a mechanism for challenging patents of questionable validity, in contravention of congressional intent. Denying institution in this context is also inconsistent with *Fintiv*, which favors institution when the district court stays its action (as the court must do in the case of a parallel ITC investigation).

Even under *NHK Spring* or *Fintiv*, the Board erred in denying institution. The Decision misapplied *Fintiv*'s second factor by focusing on a hearing before the ITC's Administrative Law Judge ("ALJ"), instead of the final determination by the full ITC, and by ignoring the subsequent 60-day presidential review period. The Decision also erred by reflexively applying *Fintiv*'s first and third factors (designed for district court proceedings) to an ITC investigation, which is subject to strict statutory timelines and requires rapid investment of resources. Finally, the Decision

¹ Petitioners respectfully submit that § 314(a) does not authorize discretionary institution denials in the first place, but the Board need not resolve that issue here.

gave insufficient weight to *Fintiv*'s fourth and sixth factors, which look to the overlap between the issues and the strength of Petitioners' challenges.²

A. The Board Should Reconsider Extending *NHK Spring* to Deny Institution Based on a Parallel ITC Investigation

The Board should reconsider the Decision's extension of *NHK Spring* and *Fintiv* to parallel ITC proceedings. Such extension undermines the IPR statutory regime and contravenes the efficiency objectives of *NHK Spring* and *Fintiv*.

In promulgating IPRs, Congress chose a precise statutory scheme. *See, e.g.*, 35 U.S.C. § 311(b) (limiting the grounds of patentability challenges); *id.* § 314(a) (requiring a determination of a reasonable likelihood of prevailing). While Congress was well aware of the possibility of parallel ITC investigations where patent validity would be at issue, *see* 19 U.S.C. § 1337(a)(1)(B), it did not authorize denial of IPR institution simply because of developments in those investigations. Congress only authorized the Board to stay or terminate a pending IPR in view of other proceedings *before the Patent Office*. *See* 35 U.S.C. § 315(d).

Moreover, Congress provided for estoppel in the ITC investigations based on the grounds raised in the IPR, *id.* § 315(e)(2), but did not provide for a similar

² The Decision was also incorrect that the ALJ found infringement of the '228 patent, Dec. at 4; the ALJ actually denied the parties' respective requests for summary determination of infringement and of non-infringement for that patent.

estoppel based on the grounds raised in the ITC investigations. That deliberate choice further indicates that Congress did not authorize the Board to decline its statutory responsibility of conducting IPRs because of parallel ITC proceedings.

The ITC lacks authority to invalidate a patent, and its rulings on invalidity are not binding either on the Patent Office or on the district court, *Texas Instr. Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1569 (Fed. Cir. 1996), as the Decision itself acknowledged, Dec. at 10. *See also* Reply at 1-2. While Congress authorized the ITC to consider “all legal and equitable defenses, including patent invalidity and unenforceability,” it cautioned that “[t]he Commission’s findings neither purport to be, nor can they be, regarded as binding interpretations of the U.S. patent laws in particular factual contexts.” *Texas Instr.*, 90 F.3d at 1568-69 (citation omitted); *see also Nichia Corp. v. Lighting Sci. Group Corp.*, IPR2019-01259, Paper 21 at 27 (P.T.A.B. Jan. 15, 2020) (because “the ITC does not have the authority to invalidate a patent,” “ITC decisions *do not preempt* issues addressed in an *inter partes* review proceeding”) (citations omitted); *3Shape A/S v. Align Tech., Inc.*, IPR2020-00223, Paper 12, 33-34 (P.T.A.B. May 26, 2020) (same). Unlike a court ruling, an ITC decision will not conclusively resolve the question of a patent’s validity, and (absent a Board decision) the same validity issues will need to be litigated in district court in order to obtain patent cancellation. *See Nichia*, Paper 21 at 27-28. Thus, denying institution because of a parallel ITC proceeding will not further the “efficiency and

integrity of the system,” *Fintiv*, Paper 11 at 6. *See Samsung Elecs. Co. v. BitMicro, LLC*, IPR2018-01410, Paper 14, at 18 (P.T.A.B. Jan. 23, 2019) (ITC investigations “do not render [an IPR] proceeding duplicative or amount to a waste of the Board’s resources”); *Wirtgen Am., Inc. v. Caterpillar Paving Prods.*, IPR2018-01202, Paper 10, at 10 (P.T.A.B. Jan. 8, 2019) (same).

In nevertheless denying review here, the Decision relied on *Fintiv*’s observation that, “as a practical matter, it is difficult to maintain a district court proceeding on patent claims determined to be invalid at the ITC.” *Fintiv*, Paper 11 at 8-9, *quoted in* Dec. at 10. But the Board may not abdicate its statutory duty to consider validity challenges where § 314(a)’s institution criteria are otherwise met (as they are here, *see* Dec. at 16) merely because, *if* the ITC finds these claims to be invalid, the patent owner *may* have difficulty persuading a district court to reach a different conclusion.³ Doing so ignores Congress’ deliberate choice to make the ITC’s validity rulings non-binding. Moreover, the ITC proceeding involves only

³ In fact, district court proceedings often continue long after the ITC issues its decision on patent validity (a decision that itself is subject to appeal and modification by the Federal Circuit). *See, e.g., Hyosung TNS, Inc. v. Diebold Nixdorf, Inc.*, 2019 WL 6684138, at *1-2 (N.D. Tex. Dec. 5, 2019).

claim 2 of the '228 patent, *see infra* at § III.B.3, and Patent Owner can assert additional claims in the district court (which the ITC's decision would not address).

Even if the Board could deny institution to respect an Article III court's prerogative to conclusively adjudicate patent validity, there is no basis to defer to another agency—one whose validity decisions lack any preclusive power. On the contrary, *the ITC* has a stated policy of deferring to the Board's decisions on patentability, and suspending its remedial orders when the Board issues its final written decision or when the Board's proceedings are sufficiently advanced. *See Certain Unmanned Aerial Vehicles*, Inv. No. 337-TA-1133, Comm'n Op., 2020 WL 5407477, at *20-21 (U.S.I.T.C. Sep. 8, 2020). Petitioners brought the ITC's decision in *Certain Unmanned Aerial Vehicles* to the Board's attention as supplemental authority on September 23, 2020, but the panel did not address it.

The reason Congress made the ITC's rulings on patent issues non-binding is because "the Commission's primary responsibility is to administer the trade laws, not the patent laws." *Tandon Corp. v. ITC*, 831 F.2d 1017, 1019 (Fed.Cir.1987). The task of issuing patents and ensuring patent quality is the charge of the Patent Office, not of the ITC. Congress designed the IPR regime as an expeditious forum to improve patent quality and to enable the Patent Office "to weed out bad patent claims efficiently." *Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367, 1374 (2020) (citations omitted). It would contravene congressional design for the Board

to defer to an agency that had no role in the original issuance of the challenged patents, and whose focus is on protecting domestic industry from unfair trade acts.

Denying institution because of a pending ITC investigation risks curtailing IPRs as a forum for challenging questionable patents. Given the ITC's tight statutory deadlines, it may be practically impossible for a petitioner to file its IPR petition early enough to forestall denial of institution in light of an ITC proceeding. This case is a telling example. The Board "credit[ed]" Petitioners with filing their IPR petition "within a short time (less than three months) after the ITC proceeding was instituted," Dec. at 14, but nevertheless concluded that the investment of resources in the ITC investigation weighed against institution, *id.* at 12-14. There is no indication, however, that, in enacting the IPR scheme, Congress intended for the Board to take a back seat to the ITC. On the contrary, whereas Congress expressly required district courts to stay their proceedings for pending ITC proceedings, 28 U.S.C. § 1659, it imposed no such requirement on the Board.

Denying an IPR petition because of a parallel ITC action also undercuts § 315(b)'s one-year safe-harbor provision. That period was carefully chosen to provide a petitioner with "a reasonable opportunity to identify and understand the patent claims that are relevant to the [district court] litigation," given the challenge of determining "in the first few months of the litigation which claims will be relevant and how those claims are alleged to read on the defendant's products." Cong. Rec.

at S5429 (statement of Sen. Kyl). This statutory safe harbor becomes meaningless if the Board can deny timely-filed petitions on non-statutory grounds that are outside of a petitioner's control—such as the pace of an ITC investigation.

Finally, denying institution because of a parallel ITC investigation is inconsistent with *Fintiv*'s first factor, which favors institution where the district court stays its proceedings (as the court must do for a parallel ITC investigation, *see* 28 U.S.C. § 1659). As *Fintiv* explained, “[a] district court stay of the litigation pending resolution of the PTAB trial *allays concerns* about inefficiency and duplication of efforts,” and therefore “*strongly weigh[s]* against exercising the authority to deny institution under *NHK*.” *Fintiv*, Paper 11, at 6 (emphasis added). It is illogical to treat the district court's litigation stay—which was imposed in this case, *see* Dec. at 11—as a factor weighing *in favor* of institution, but to treat the same stay as a factor weighing *against* institution when the stay is imposed pending a parallel ITC proceeding. Notably, other Board panels reached the opposite conclusion in analogous circumstances. *See, e.g., Nichia*, Paper 21 at 28 (where “district court actions are stayed pending the conclusion of the ITC action, ... the ITC investigation does not necessarily render our proceeding duplicative or amount to a waste of the Board's resources ... because other courts may still need to address patentability once stays are lifted”) (citation omitted); *Samsung Elecs. Co. v. Dynamics, Inc.*, IPR2020-00502, Paper 34 at 11-12 (P.T.A.B. Aug. 12, 2020) (where the district

court stayed its case for an ITC investigation, “[t]his factor weighs against exercising discretion to deny institution”).

B. Even if the Board May Consider a Parallel ITC Investigation, the Board Erred by Denying Institution in This Case

Even under *NHK Spring* or *Fintiv*, the Board erred in denying institution. The Decision ignored important differences between the district court and the ITC proceedings when considering *Fintiv*’s first and third factors. The Decision misapplied *Fintiv*’s second factor by emphasizing the hearing before the ITC’s ALJ instead of focusing solely on the ITC’s final determination, and by ignoring the subsequent 60-day presidential review period. The Decision also overlooked the limited overlap between claims at issue in the IPR and in the ITC investigation under *Fintiv*’s fourth factor (in part due to Patent Owner’s failure to disclose relevant facts), and minimized the merits of Petitioners’ invalidity contentions (which it acknowledged to be “strong”) under *Fintiv*’s sixth factor.

1. The Decision Ignored Critical Differences Between the Courts and the ITC Under *Fintiv*’s First and Third Factors

As noted, the Decision is inconsistent with *Fintiv*’s first factor, which favors institution where the district court enters a stay (as the court did here). *Supra* § III.A. At a minimum, the Decision should have taken that stay into account as a factor favoring institution. *Samsung Elecs.*, IPR2020-00502, Paper 34 at 11-12.

The Decision also erred in its application of *Fintiv*’s third factor, which

measures the comparative investment of resources in the two parallel proceedings. The ITC's tight statutory deadlines would always require a rapid investment of resources at the outset. *See Reply* at 4. As explained above, this fact would make it practically impossible for a petitioner to file its IPR petition early enough to negate the application of this factor as favoring denial of institution. *Supra* § III.A.

2. The Decision Misapplied *Fintiv*'s Second Factor

In applying *Fintiv*'s second factor, the Decision incorrectly emphasized the date of a hearing before the ALJ and the expected date of the ALJ's initial determination. *See Dec.* at 11-12. The second factor of *Fintiv* focuses on "the court's trial date," Paper 11, at 8, because the trial results in a verdict that, after any potential post-trial motions, *see* F.R.C.P. 50 & 59, conclusively resolves the litigation. By contrast, in an ITC investigation, the hearing before the ALJ is merely the initial step in the ITC's decisional process. *See* 19 C.F.R. § 210.36(a). The ALJ's initial determination (issued only after post-hearing briefing) is subject to a review by the full Commission, *id.* § 210.45-46; only when the Commission issues its final determination is there a final agency decision, *see id.* § 210.45(c).

The Decision acknowledged that the ALJ's decision is subject to a Commission review, but viewed that review as largely ministerial. *See Dec.* at 11, 12. In particular, the Decision overlooked that when the ITC decides to review the ALJ's decision, it would typically solicit additional briefing from the parties, *see* 19

C.F.R. § 210.45(a), and, when warranted, comments from other government agencies and the public, *id.* § 210.50(a)(4), and may extend the final determination’s target date, *id.* § 210.51(a). The Commission’s review is plenary: it may “affirm, reverse, modify, set aside or remand for further proceedings,” and “make any findings or conclusions that in its judgment are proper based on the record in the proceeding.” *Id.* § 210.45(c) Thus, even when the projected date for the ITC’s final determination is “set to pre-date the Board’s final written decision,” Dec. at 12, that projected date is largely notional, and subject to (likely) extensions.

The Decision compounded its error by refusing to factor into the projected timeline the 60-day presidential review period for any ITC final determination, opining that it would not “speculate” about the President’s potential actions. Dec. at 12. Presidential review, however, is an integral statutory component of the ITC’s decisional process. Reply at 3. If the Commission finds a violation, it must “transmit” a copy of its final determination and recommended actions (together with the full record) to the President, *see* 19 U.S.C. § 1337(j)(1)(B), and only upon the President’s approval or the expiration of the 60-day review period does the ITC’s final determination become final (and subject to appeal), *see id.* § 1337(j)(4).

3. The Decision Overlooked Critical Evidence Regarding *Fintiv*’s Fourth Factor

The Board acknowledged that only three of the eleven challenged claims

(claims 1-3) were asserted in the ITC investigation, but gave that fact only “slight” weight because it found “significant overlap between the prior art challenges” in the two proceedings. Dec. at 15-16. This decision is mistaken for two reasons. First, the claims at issue in the IPR present unique issues because they include limitations not present in the claim before the ITC. *See* Reply at 5 (discussing claims 4-7, 9-11). The Decision acknowledged that fact (Dec. at 15), but did not accord those differences sufficient weight, in contrast to prior decisions. *See Samsung Elecs.*, IPR2020-00502, Paper 34 at 12; *Comcast Cable Commc’ns, LLC v. Rovi Guides, Inc.*, IPR2019-00231, Paper 14 at 11 (P.T.A.B. May 20, 2019).

Moreover, the Decision overlooked public information that showed prior to the hearing before the ALJ (and before the institution decision), Patent Owner limited the ITC investigation to claim 2 (dropping independent claims 1 and 3). *See* Complainants’ Unopposed Mot. for Partial Termination of this Investigation as to Claims 1 and 3 of U.S. Patent No. 7,845,228, Inv. No. 337-TA-1190 (U.S.I.T.C. Oct. 13, 2020); Order No. 42, Inv. No. 337-TA-1190 (U.S.I.T.C. Oct. 20, 2020) (terminating claims 1 and 3). This fact requires reassessment of the Decision’s reliance on claims 1 and 8 in its analysis of *Fintiv*’s fourth factor. Dec. at 15.⁴

⁴ Despite relying on claims 1 and 3 in the ITC investigation (and the alleged similarity between claims 1 and 8), *see* Prelim. Response at 28-29; Sur-Reply at 5-

4. The Decision Failed to Give Sufficient Weight to the Merits of Petitioners' Claims Under *Fintiv's* Sixth Factor

Finally, the Decision failed to give sufficient weight to the merits of Petitioners' invalidity contentions under *Fintiv's* sixth factor. The Decision acknowledged that "the merits of Petitioner's asserted grounds are strong," Dec. at 16, and so would have met the requisite reasonable likelihood of success under 35 U.S.C. § 314(a). The Decision, however, asserted that "the benefits that may be gained from analyzing Petitioner's grounds in this forum are largely (but not completely) available ... from the ITC's analysis of the cited art." Dec. at 18.

This reasoning misunderstands the respective statutory mandates and institutional competencies of the Patent Office and the ITC, *see supra* § III.A, and impermissibly abdicates the Board's statutory obligation to review patents where petitioner has satisfied § 314(a)'s "reasonable likelihood" showing. The Decision's assessment is in stark contrast with the weight the Board placed on the merits of petitioner's validity challenges in analogous circumstances, where the Board instituted review despite a parallel ITC investigation. *See Samsung Elecs.*, IPR2020-00502, Paper 34 at 13; *Comcast Cable Commc'ns*, Paper 14 at 11.

IV. CONCLUSION

The Board should reconsider its Decision and institute *inter partes* review.

6, Patent Owner did not inform the Board that it decided to drop those claims.

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CERTIFICATE OF SERVICE

I hereby certify that on November 19, 2020, I caused a true and correct copy of the foregoing Petitioners' Request for Rehearing Under 37 C.F.R. § 42.71(d) to be served electronically on the Patent Owner at the following e-mail addresses:

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