

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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KINGSTON TECHNOLOGY COMPANY, INC.,

Petitioner

v.

POLARIS INNOVATIONS LTD.,

Patent Owner

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Case IPR2016-01623

Patent 7,315,454

DEPOSITION OF PROF. JOSEPH B. BERNSTEIN

JUNE 29, 2017

LOS ANGELES, CALIFORNIA

Reported by:

Paula A. Pyburn

Job no. 19114

TransPerfect Legal Solutions

1 DEPOSITION OF PROF. JOSEPH B. BERNSTEIN, taken  
2 at 1880 Century Park East, Suite 815, Los Angeles,  
3 California, on Thursday, June 29, 2017, at 9:04 a.m.,  
4 before Paula A. Pyburn, RPR, CLR, Certified Shorthand  
5 Reporter, in and for the State of California.  
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THURSDAY, JUNE 29, 2017, 9:04 A.M.  
LOS ANGELES, CALIFORNIA

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PROF. JOSEPH B. BERNSTEIN,  
having been first duly affirmed, testifies as follows:

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EXAMINATION

BY MR. HOFFMAN:

Q Good morning, again, sir.

A Good morning.

Q So I need you to state your name for the record.

A Joseph Bernstein. I'm from --

Q Your address?

A And address, yes.

-- from Arveinahal 4, which is  
A-r-v-e-i-n-a-h-a-l, No. 4, in town of Hashmonaim,  
H-a-s-h-m-o-n-a-i-m in Israel.

Q This morning is there any reason you feel you can't give complete and accurate testimony?

A No, sir.

Q All right. You understand I'm going to ask you a series of questions and you need to provide answers?

A I understand.

Q Unless your counsel tells you not to.

Q Okay, great.

Just so you know, the structure today is going to be a little bit different. We've broken this up between the two of us. And roughly the way we've done this, just so there's no secrets, it's done by section of your declaration.

So the sections that Mr. Hoover is going to ask you about, I am going to avoid. And we'll certainly endeavor not to ask anything we feel would be overlapping between the sections. I can't promise you there won't be a little bit of overlap, but we have endeavored to break it up.

And you'll probably only get an hour or so from me. So I know you're disappointed. But I will be starting. Could be a little longer than an hour. Never know.

Just to confirm, like yesterday, you understand you've been retained, at least indirectly, by Polaris in this matter?

A I understand that.

Q Okay. And just to keep things quick, could you describe your methodology, your way of preparing your declaration in this matter?

A Okay. Well, I used the same basic procedure that I've done on other declarations, including the one

A Yes.

Q You understand you're under oath?

A I understand.

Q Okay. My questions are not meant to be tricky. I'm going to believe you understood them unless you tell me otherwise.

A Uh-huh.

Q Is that fair?

A That's fair.

Q So if you think you don't understand a question, you'll let me know; right?

A Yes.

Q Okay. As we talked about yesterday, the court reporter is writing everything down; so it's important that you answer audibly and not nodding or shrugging.

You can do that?

A I understand.

Q Okay. You can take a break any time you want, roughly probably about an hour between breaks, but if you want a break, will you let me know?

A Okay.

Q And if for any reason anything changes, you get a pounding headache in the middle of the deposition, will you let me know?

A Okay.

we discussed yesterday, which is I would basically go over the material, review the material, taking what I would say -- notes, which I would then work into sort of a draft, which I would then send to the lawyers.

And the lawyers would then take my draft and put it into a format that's comfortable for them, and take my CV and -- take parts of my CV and put it together into the introductory part, where they will say -- put in all the words about how counsel has informed me -- that's pretty much a sign that it was verbiage that was not of my own.

Then they would send back to me, the larger draft, which included all the preliminary and my notes organized in a proper way, and then I would go through the whole thing, the whole document, and see what I agreed with, didn't agree with, made sure it was all understood and proper.

I tried to take out all the dangling participles and the split infinitives; I don't know if I got them all. I at least like good grammar.

And then I would send it back, and then they would make whatever modification to make sure it was correct.

Of course, they would send it to me to make sure I agreed with the whole thing before they asked for

1 my signature.

2 Q So just to summarize, you would prepare some

3 notes on your thoughts; you'd send those to your

4 counsel; they would put those into a draft, adding the

5 legal sections.

6 And then there would be a iterative process

7 back and forth between you and counsel until you arrived

8 at the final draft that was submitted. Is that fair?

9 A That's fair.

10 Q I know yesterday you had made some corrections

11 to your declaration. At least one of them I think would

12 apply again.

13 Do you want to provide some corrections?

14 A Oh, there is the one on the CV.

15 Q If you don't want to, that's fine. I just want

16 to give you the opportunity.

17 A We did over there. It's just -- again, for

18 someone who doesn't like to see improper grammar, if

19 it's -- that says "Professor's Bernstein's expertise

20 lie," should be "areas of expertise" or "expertises."

21 So, again, that's -- we can just leave it the way it is

22 for now, because I think you already have it on that

23 document. Or change it.

24 But I did not go through this document prior to

25 today, like I did over there, to know all the cases. So

1 read):

2 -- the time of the effective filing

3 date of the original foreign

4 application from which the '454 patent

5 issued.

6 That's October 31st, 2005.

7 And (as read):

8 In assessing the level of skill of

9 a person of ordinary skill in the art,

10 I have considered the type of problems

11 encountered in the art, the prior

12 solutions to those problems found in

13 the prior art references, the rapidity

14 at which innovations are made, the

15 sophistication of the technology, the

16 level of education of active workers in

17 the field, and my own experience

18 working with those of skill in the art

19 at the time of the invention.

20 Q Okay. And, again -- we talked about this

21 yesterday, but just to make sure this transcript is

22 clean, when I ask you to read something, you are welcome

23 to read it out loud if you prefer.

24 But unless I expressly ask you to read it out

25 loud, I'm not asking you to read it out loud. So you

1 there are probably several -- I think when I was reading

2 over one to one, I did see a split infinitive, which

3 troubled me, but I didn't make a note to where it was.

4 So I think it will still be legally understood.

5 Q If you see anything during the course of the

6 testimony today that you think is an error, needs to be

7 corrected, you'll let us know?

8 A That's a good idea. I can do that.

9 Q Okay. Thank you.

10 Let's turn to paragraph 25 of your

11 declaration -- actually even 24. And if you want, you

12 can take a look at 24 and 25. I'm going to ask you

13 about those.

14 A (As read):

15 My opinions in this declaration,

16 include [verbatim] opinions on validity

17 and claim construction, are based on

18 the understandings of a person of

19 ordinary skill in the art (which I

20 understand is sometimes referred to as

21 a POSITA or PHOSITA) the time of the

22 effective filing" -- "at" -- I guess

23 that's missing -- I would say "at the

24 time."

25 Is that right? Oh. "At," da, da, da (as

1 can choose to read it to yourself if you prefer.

2 A I'm preferring to read it out loud only because

3 under -- there is a little bit of, you know -- let's say

4 a anxiety-provoking atmosphere, and it's very difficult

5 for me to concentrate properly by reading to myself.

6 Q That's fine. Like I said, if you prefer to

7 read it out loud, I have no problem with that. I just

8 don't want you to think I'm telling you or asking you to

9 do that.

10 A Okay.

11 Q So can you describe for me what process you

12 used to determine the level of ordinary skill in the art

13 of the '454 patent?

14 A I believe we say that, at least in the next

15 paragraph, where I substantially agree with

16 Dr. Subramanian and his position from his doc

17 declaration, that (as read):

18 A person of ordinary skill in the

19 relevant art at the time of the

20 invention would be a person with a

21 B.S. -- that's only a bachelor's

22 degree -- in electrical engineering and

23 approximately two years of industrial

24 [verbatim] experience in the field of

25 semiconductor memory design.

1 Q So I just want to clarify.  
 2 I mean, did you do your own analysis here, or  
 3 did you just accept what Dr. Subramanian said?  
 4 A I accepted that as a standard under the counsel  
 5 of the counsel.  
 6 Q So you didn't perform your own determination on  
 7 what the level of ordinary skill in the art would be?  
 8 A I was just following the instructions of --  
 9 because I'm not a lawyer and I have no understanding of  
 10 a legal meaning of "a person of ordinary skill." I  
 11 mean, I could only -- we can only guess based on  
 12 inappropriate standards.  
 13 So of course I'm depending on people with a  
 14 legal expertise to know what is the legal definition of  
 15 a person of ordinary skill.  
 16 Q So your level of ordinary skill in the art, you  
 17 just accepted that counsel told you that was the proper  
 18 level of ordinary skill in the art?  
 19 MR. LOWENSTEIN: Objection. Form.  
 20 THE WITNESS: Can you ask the question again?  
 21 BY MR. HOFFMAN:  
 22 Q Yeah. I'm just trying to clarify what you  
 23 just -- what you just told me.  
 24 So you were told the level of ordinary skill in  
 25 the art from counsel, and you applied the level that you

1 of experience?  
 2 MR. LOWENSTEIN: Objection. Form. Objection.  
 3 Calls for a legal conclusion.  
 4 THE WITNESS: I only said I agree substantially  
 5 with Subramanian. And I had seen the Subramanian  
 6 document; he came up with a statement; and I said,  
 7 "Okay, I agree." There's not much more to say about  
 8 that.  
 9 BY MR. HOFFMAN:  
 10 Q Again -- and I'm not trying to be tricky here,  
 11 sir. I'm just trying to figure out, there's -- you  
 12 know, there are certain things that you accept as  
 13 something you're being told to apply, the law, for  
 14 example. And there are some things that you determine  
 15 on your own.  
 16 And I'm just trying to figure out the level of  
 17 ordinary skill in the art that you've agreed with here,  
 18 a bachelor's in electrical engineering and approximately  
 19 two years of experience, is that something that you made  
 20 an independent determination of, or is that something  
 21 that you were told to apply in this case?  
 22 MR. LOWENSTEIN: Objection. Form. Asked and  
 23 answered. Calls for a legal conclusion.  
 24 THE WITNESS: I think I answered what you said.  
 25 I didn't -- I don't have a -- this is not a term I

1 were provided --  
 2 MR. LOWENSTEIN: Objection --  
 3 BY MR. HOFFMAN:  
 4 Q -- by counsel?  
 5 MR. LOWENSTEIN: Sorry. Objection. Form.  
 6 THE WITNESS: I didn't ask. I only -- I was  
 7 instructed that I should apply the level of skill in the  
 8 art that they felt was appropriate for this case, and  
 9 this is the level of skill that I considered for myself.  
 10 Because even the term "POSITA" -- you know,  
 11 these are all terms that come up in legal aspects;  
 12 they're not scientific terms. My background is, I would  
 13 say, entirely scientific, and these are not terms --  
 14 even the word "ordinary skill in the art" is not at all  
 15 a scientific term. They have no other meaning to me  
 16 other than what I am instructed that they mean by the  
 17 counsel who hired me to -- indirectly through the  
 18 client, of course -- who hired me to ask me to form an  
 19 opinion based on what they told me to do.  
 20 And I hope, with all modesty, I did my job  
 21 properly.  
 22 BY MR. HOFFMAN:  
 23 Q So you were instructed on the level of ordinary  
 24 skill to apply in this case, namely a electrical  
 25 engineering degree and two to five years -- or two years

1 learned -- there's no textbook that I have ever read --  
 2 this is not a scientific terminology.  
 3 I would have no idea what it means, "a person  
 4 of ordinary skill in the art," if I was not instructed  
 5 what that word -- what that phrase means.  
 6 It means nothing to me outside of what I'm told  
 7 that it means, and I was asked to apply a standard like  
 8 this.  
 9 Can it -- is it possible to completely apply,  
 10 you know, any perfect standard? I mean, we're talking  
 11 about a hypothetical person. Are we talking about one  
 12 hypothetical person? Are we talking about a  
 13 hypothetical team?  
 14 I don't know anything other than what I can do  
 15 based on the instructions that I had.  
 16 BY MR. HOFFMAN:  
 17 Q Okay. The person of ordinary skill in the art  
 18 that you used for your analysis, did you assume that  
 19 that person knew all the prior art?  
 20 MR. LOWENSTEIN: Objection. Form.  
 21 THE WITNESS: I think if you were to take  
 22 someone with a bachelor of science who has no more than  
 23 really two years of practical, let's say, true  
 24 engineering courses and only two or three years of  
 25 industrial experience, it would be really hard to assume

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