

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMERICAN NATIONAL MANUFACTURING INC.,

Petitioner,

vs.

SLEEP NUMBER CORPORATION
f/k/a SELECT COMFORT CORPORATION,

Patent Owner.

-----x
Case No. IPR2019-00497 (Patent 8,769,747 B2)

Case No. IPR2019-00500 (Patent 9,737,154 B2)

DEPOSITION OF JOSHUA W. PHINNEY, Ph.D., P.E.

New York, New York

Thursday, February 20, 2020

Reported by:

Shauna Stoltz-Laurie, CLR

JOB NO. 27004

TransPerfect Legal Solutions

February 20, 2020
1:00 p.m.

Deposition of DR. JOSHUA W.
PHINNEY, Ph.D., P.E., held at the
offices of Fox Rothschild LLP, 101 Park
Avenue, New York, New York, pursuant to
Notice, before Shauna Stoltz-Laurie, a
Certified Realtime Reporter and Notary
Public of the State of New York.

JOSHUA W. PHINNEY ,
called as a witness, having been duly sworn
by a Notary Public, was examined and
testified as follows:

EXAMINATION BY
MR. MOORE:

Q. Good afternoon, Dr. Phinney.

A. Good afternoon.

Q. Nice to see you again.

A. Good to see you.

Q. So do you understand why we're here
today?

A. In part, I think.

Q. And what would that be?

A. We'd be here to discuss my
supplemental or reply report I call it, and
perhaps the -- the report that I -- I wrote
about the Motion to Amend.

Q. Okay. So how many times have you
been deposed before?

A. I mean somewhere about 20.

Q. Okay. How are you feeling today?

A. All right.

Q. Is there any reason that you can't

A P P E A R A N C E S:

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Phinney
offer truthful answers to the questions
today?

A. No.

Q. And you understand that in an IPR,
which is the proceeding we're in, that your
testimony is trial testimony.

A. Yes, I understand.

Q. So there will be times today when I
ask questions that are yes or no questions,
and in those situations, you should provide a
yes or no answer. Do you understand that?

A. Yes.

MR. HARE: Objection, form.

Q. Do you have any devices on you that
allow to you communicate with others?

A. I have a cellphone.

Q. Is that it on the table?

A. No.

Q. Okay. During the deposition
today, if you are going to communicate with
anyone that's outside of the room, would you
please let me know ahead of time.

A. I will.

Q. What did you do to prepare for your

1 Phinney
 2 deposition today?
 3 A. I met with Mr. Hare, and reviewed
 4 my reports and the accompanying petitions or
 5 what the lawyers worked on.
 6 Q. How long did that meeting last?
 7 A. About -- about five hours.
 8 Q. Where was that meeting conducted?
 9 A. At Exponent's offices in New York.
 10 Q. So can you list the materials for
 11 me that you did review during that meeting?
 12 A. The -- my report to -- for the
 13 Motion to Amend, my reply report, the
 14 petition -- I'm not sure what to call it, the
 15 lawyer's work product that corresponded to
 16 the reply report --
 17 Q. Okay.
 18 A. -- and the patents.
 19 Q. Anything else?
 20 A. The Gifft reference, '172.
 21 Q. Anything else?
 22 A. The Ebel reference and the Mittal
 23 reference.
 24 Q. Did you review Pillsbury?
 25 A. Oh. Yes.

1 Phinney
 2 footnote in one of your reports?
 3 A. I believe it was a footnote, yes.
 4 Q. Were there any other errors?
 5 A. Nothing I can think of that
 6 wouldn't be like a typo.
 7 Q. So your education, training and
 8 work history, has that changed since we last
 9 spoke in deposition?
 10 A. I don't think so.
 11 Q. So we've spoken before; have we
 12 not?
 13 A. Yes, we have.
 14 Q. Our last deposition, you submitted
 15 declarations as part of the petitioner's
 16 petition on the '154 and '747 patents; is
 17 that true?
 18 A. I didn't hear the first part of
 19 your question. Sorry.
 20 Q. So our prior deposition, we were
 21 speaking about the declarations that you
 22 submitted to the Patent Trials and Appeals
 23 Board for Petitioner's petitions for
 24 interparties review of the '154 and '747
 25 patents; is that true?

1 Phinney
 2 Q. Anything else?
 3 A. I don't think so.
 4 Q. While you were reviewing those --
 5 Please go ahead.
 6 A. I'm sorry. I also saw the written
 7 transcript for Dr. Messner.
 8 Q. While you were reviewing those
 9 documents did you notice any errors in any of
 10 your declarations?
 11 A. Not while I was reviewing those
 12 documents.
 13 Q. At any other documents have you
 14 noticed errors in your written product?
 15 A. Yes.
 16 Q. And what were those?
 17 A. There was an error in the voltage
 18 divider equation that I wrote in my opening
 19 report.
 20 Q. Is that error the subject matter of
 21 footnote 2 on page 45 of your Declaration in
 22 Support of the Patent Office Motion to Amend?
 23 A. I -- I -- I wouldn't know one way
 24 or the other. It could be.
 25 Q. Did you document that error in a

1 Phinney
 2 A. Yes.
 3 Q. And you understand that the Board
 4 instituted those petitions.
 5 A. Yes.
 6 Q. Since that point in time American
 7 National has filed a number of briefs that
 8 you have provided declarations for; have they
 9 not?
 10 MR. HARE: Objection to form.
 11 A. Yeah. I'm not sure if they're
 12 called briefs, but yeah. Yes.
 13 Q. So in our deposition last time we
 14 met, you had opined on your understanding of
 15 the law in your prior declarations; did you
 16 not?
 17 A. Yes.
 18 Q. Has that understanding changed in
 19 any material way between those declarations
 20 and the declarations we are here to talk
 21 about today?
 22 A. Not that I can think of.
 23 Q. And you applied the same
 24 understanding of the legal principles that
 25 you had in the previous briefs, in the

1 Phinney
2 previous declarations; you applied that same
3 analysis and your understanding in this set
4 of briefs; is that true?

5 MR. HARE: Objection to form.

6 A. And so what do you mean by "this
7 set of briefs" in the last part of that
8 question?

9 Q. I go back to the first, one of the
10 first questions I asked, do you know what
11 we're here to talk about today, and your
12 response was a couple of declarations that
13 you've submitted. Is that true?

14 A. Yes.

15 Q. Okay. So when I say these briefs,
16 I mean the ones that we're here to talk about
17 today. Did you apply the same analysis and
18 legal standards to these briefs that you did
19 to the opening declarations?

20 MR. HARE: Objection, form.

21 A. Yes.

22 Q. Thank you.

23 So has your understanding of the
24 law of anticipation changed since the prior
25 analysis?

1 Phinney

2 A. (Perusing document) Yes.

3 Q. What is this document?

4 A. This is what I was referring to
5 previously as my reply report.

6 Q. And the front page of this
7 document, it's entitled "Declaration of
8 Dr. Joshua Phinney, Ph.D., P.E. in Support of
9 Petitioner's Reply to Patent Owner's
10 Response"; is it not?

11 A. Yes.

12 Q. And this is a declaration that you
13 submitted in support of Petitioner's Reply to
14 the Patent Owner's Response to the
15 Petitioner's Petition.

16 A. Yes.

17 Q. How many paragraphs is this
18 declaration?

19 A. It has 24 paragraphs.

20 Q. And you submitted this in both the
21 00497 proceeding and the 00500 proceeding;
22 did you not?

23 A. Yes.

24 I believe it's identical in both
25 proceedings.

1 Phinney

2 A. No.

3 Q. Has your understanding of the law
4 of obviousness changed since your prior
5 declarations?

6 A. Not in any material way.

7 Q. In any way at all?

8 A. I have had the opportunity to look
9 at like summaries of the law of obviousness
10 in the last -- in the last months.

11 Q. Did that change your analysis that
12 you applied in your -- in the declarations
13 we're here to speak about today?

14 A. No.

15 MR. HARE: Objection to form.

16 Q. (Handing).

17 A. Thank you.

18 Q. Dr. Phinney, I'm handing you what
19 we'll mark as [Phinney] Exhibit 1 (sic).

20 ([Phinney] Exhibit 1 mistakenly
21 marked for identification.)

22 MR. MOORE: And it bears
23 "EXHIBIT 1061" from IPR 2019-00497.

24 Q. (Continuing) Dr. Phinney, have you
25 seen this document before?

1 Phinney

2 Q. What did you review in preparation
3 of this document?

4 A. I saw Dr. Messner's report and
5 Respondent's Reply to Petitioner's Petition.

6 Q. You don't reference anything in
7 this document that you consulted, did you?

8 A. I believe that's correct.

9 Q. So the documents that you just
10 stated were Dr. Messner's report and the
11 respondent's reply, but you don't detail how
12 you used those in the preparation of this
13 document, do you?

14 MR. HARE: Objection to form.

15 A. (Reading) Yes, that is correct.

16 Q. Is this intended to be a rebuttal
17 to Dr. Messner?

18 MR. HARE: Objection to form.

19 A. No.

20 Q. Is it intended to be a rebuttal to
21 Dr. Edwards?

22 MR. HARE: Objection, form.

23 A. No.

24 Q. Or to any other witness in this
25 proceeding?

1 Phinney
 2 MR. HARE: Objection to form.
 3 A. I think I'd have the same answer:
 4 No.
 5 Q. So this document was submitted with
 6 a document from the petitioner; was it not?
 7 A. Yes. That's my understanding.
 8 Q. And did you review that document?
 9 MR. HARE: Objection to form and
 10 foundation.
 11 A. I don't believe in its final form.
 12 Q. Are you aware if the contents of
 13 your declaration support arguments made in
 14 that document?
 15 A. Yes. That's my understanding.
 16 Q. And do you agree with those
 17 arguments?
 18 MR. HARE: Objection to form.
 19 Objection to foundation.
 20 A. I don't know if I can answer that
 21 yes or no.
 22 Q. Anything that you disagree with?
 23 MR. HARE: Objection to form.
 24 Objection to foundation.
 25 A. I -- I'm not aware of something

1 Phinney
 2 of a number of claim terms; do you not?
 3 MR. HARE: Objection, form.
 4 A. (Perusing document) I don't know
 5 that I'd put it that way. So --
 6 Q. In what way would you put it?
 7 A. You know, I'm just merely offering
 8 my opinion about some claim language versus
 9 others vis-à-vis the support that I found in
 10 the -- in the patent specifications.
 11 Q. So one of the differences that we
 12 noticed between your prior declarations and
 13 this one is "desired pressure setpoint"
 14 versus in the earlier declaration it was
 15 "pressure setpoint." Do those two phrases
 16 have any different meaning to you?
 17 MR. HARE: Objection, form and
 18 foundation.
 19 A. I'm sorry. Can you repeat that?
 20 Q. In your first declaration, you
 21 opined about the meaning of "pressure
 22 setpoint." In this declaration, you opined
 23 about the meaning of "desired pressure
 24 setpoint." Is there a difference between
 25 those two meanings?

1 Phinney
 2 that I disagree with. I --
 3 Q. Are you aware that portions of that
 4 document bear substantial similarities to
 5 portions of the declaration that's in front
 6 of us?
 7 MR. HARE: Objection to form.
 8 Objection to foundation and relevance.
 9 A. No, I'm not aware of that, because
 10 I don't believe I've seen the petitioner's
 11 reply in its final form.
 12 Q. Did you prepare the report?
 13 A. Yes.
 14 Q. Did you have help from attorneys in
 15 the preparation of Exhibit 1?
 16 A. They --
 17 MR. HARE: Objection, relevance.
 18 A. -- provided edits to citations, but
 19 the text of the paragraphs was -- was what I
 20 drafted.
 21 Q. So in Exhibit 1, you seek
 22 construction of a number of claim terms; do
 23 you not?
 24 A. I'm sorry. I didn't hear it.
 25 Q. In Exhibit 1, you seek construction

1 Phinney
 2 MR. HARE: Same objections.
 3 A. One has the word "desired."
 4 Q. Do you import any meaning into
 5 that?
 6 MR. HARE: Same objections.
 7 A. (Reading) I'm not sure I can give
 8 you a yes or no answer, but I could explain
 9 if you permit.
 10 Q. So in paragraph seven here, you
 11 state "a setpoint that is commensurate with a
 12 pressure reading" -- do you not? -- in the
 13 second sentence of paragraph 7.
 14 A. Yes.
 15 Q. What do you mean by "commensurate"?
 16 A. Well, commensurate quantities, for
 17 instance, can be compared to one another, and
 18 they're on the same scale.
 19 Q. Do you know if that terminology is
 20 found in either of the patents in the case?
 21 MR. HARE: Objection, relevance.
 22 A. I -- I don't believe it is.
 23 Q. So the last sentence of that
 24 paragraph states that "The desired pressure
 25 setpoint must also be with pressure, namely a

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