

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMERICAN NATIONAL MANUFACTURING INC.,

Petitioner,

v.

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

Patent Owner.

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Cases

IPR2019-00497 (Patent 8,769,747 B2)

IPR2019-00500 (Patent 9,737,154 B2)

CONTINUED DEPOSITION of DR. JOSHUA PHINNEY

VOLUME II

September 25, 2019

New York, New York

Reported by:

Joseph Danyo V

Job no: 26066

TransPerfect Legal Solutions

1 CONTINUED DEPOSITION of DR. JOSHUA PHINNEY,
 2 held at the offices of Fox Rothschild, LLP, 101
 3 Park Avenue, 17th Floor, New York, New York, on
 4 September 25, 2019, at 9:00 a.m., before Joseph
 5 Danyo V, a Shorthand Reporter and Notary Public
 6 for the State of New York.
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1 J. PHINNEY
 2 DR. JOSHUA PHINNEY,
 3 the Witness herein, having first been
 4 duly sworn by the Notary Public, was
 5 examined and testified as follows:
 6 EXAMINATION
 7 BY MR. MOORE:
 8 Q. Dr. Phinney, good morning. A couple
 9 of questions for you before we start into the
 10 specific claim limitations.
 11 Yesterday we talked about your
 12 understanding of obviousness; did we not?
 13 A. Yes.
 14 Q. You mentioned that your investigation
 15 of obviousness starts with the claims; does it
 16 not?
 17 A. Yes.
 18 Q. What do you do next?
 19 A. Well, you know, the first step is
 20 sort of just reading the patent and the claims,
 21 and reading the claims in light of the
 22 specification and moreover in light of the
 23 disclosure.
 24 So one of the first things I got was
 25 the -- that file history, so I understand that

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 * * *

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 2 the disclosure includes that as well, so, you
 3 know, go look at that as well.
 4 Q. What do you do after that?
 5 A. Well, you know, practically speaking,
 6 at this point I have a-- you know, in this case I
 7 formed an opinion based on my understanding of a
 8 -- the claims subject matter, and I had an
 9 expectation to find references that would render,
 10 you know, anticipate the asserted claims or
 11 render that obvious.
 12 Q. What do you do next?
 13 A. I guess I maybe should have said that
 14 if there was any specific meaning given to
 15 specific words, that would have been something I
 16 would have tried to resolve by that time, but in
 17 a practical manner, what I do is look at
 18 different patents, you know, just see if I can
 19 find references that express what I expected to
 20 find; namely, references that were compensating
 21 for the impedance of pneumatic systems in this
 22 instance.
 23 Q. After you look at those references
 24 what do you do?
 25 A. Well, I -- you know, one thing is to,

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2 you know, make a listing of the claims of
3 different elements and try to figure out, are we
4 dealing with a good disclosure in one of these
5 references.

6 You know, would one of these support
7 anticipation by either explicitly or inherently
8 providing all of the elements or are we really
9 faced with obviousness and for a combination
10 where we need to, you know, combine a reference
11 with a level of ordinary skill and/or other
12 references.

13 Q. Is that the end of the process or do
14 you do something else?

15 A. Those I think are like a lot of the
16 really important parts of it, to get an opinion
17 in my mind about what combination of references
18 could be invalidated.

19 There could be other steps, but then
20 I --

21 Q. What would those other steps be?

22 A. I'm trying to think of them.

23 Well, when considering different
24 pieces of prior art, you know, one thing is just
25 to, you know, read them in their entirety, just

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2 and then I searched and found others, and then I
3 also received others from counsel at a different
4 time.

5 So there was some that I found as
6 being both within the same sort of cluster, and I
7 found them on my own and also received them from
8 counsel. I'm not sure about the timing from all
9 that.

10 Q. How about Ebel?

11 A. I think Ebel falls in the same class
12 as Pillsbury. You know, I was doing keyword
13 searches and looking for citations and then
14 following strings of citations among patents, and
15 so I think it was -- I really can't recall if
16 that's one -- you know, it was either one that I
17 found and was provided by counsel. I think
18 that's the best answer.

19 Q. What were the keywords did you use to
20 search?

21 A. Keywords?

22 MR. TUTTLE: Objection, form.

23 A. I used different things like
24 "pressure," "hose," "conduit." I used things
25 like a two-word type of search like "sensor

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2 try to make sure I'm understanding what that's
3 saying in -- but that's a -- those I think are
4 the important steps that I took.

5 Q. Thank you. So you identified Giff
6 as a primary reference; is that correct?

7 A. Yes.

8 Q. But you admit that Giff doesn't
9 disclose each of the claimed elements of the '154
10 and '747 patents?

11 A. That is correct.

12 Q. How did you go about finding prior
13 art that disclosed dissertations?

14 A. Well, one thing that I did was to
15 search on Google Patents. You know, I'm looking
16 for keywords. I'm looking at patents that cite
17 to some of the patents in suit. In addition, I
18 was provided references as well by counsel.

19 Q. Okay. Did you find Mittal or was it
20 provided by counsel?

21 A. That one was provided by counsel.

22 Q. How about Pillsbury?

23 A. Pillsbury, I think, was also provided
24 by counsel. It's one that also I also located,
25 because I recall I got initially two references,

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2 pressure."

3 You know, words that were trying to
4 get at, you know, different pressure readings on
5 either side of a hose; so there could be others.

6 Q. Did you combine Mittal with Giff
7 because you believed it disclosed the missing
8 elements?

9 A. Yes. I think that's a fair
10 statement.

11 Q. Was there something about Mittal that
12 was better in your opinion than Pillsbury?

13 MR. TUTTLE: Objection, form.

14 A. Well, maybe the best way to put this,
15 I think that -- you know, I tried to look at this
16 from the standpoint of a person of ordinary skill
17 having Giff in hand, and I was thinking about
18 the -- you know, the motivation that that person
19 would have to seek out other references.

20 So, you know, once I had come to the
21 conclusion that a person of ordinary skill would
22 be cognizant of the fact that pressure on either
23 side of a hose during filling and venting would
24 be different, that let me define different art.

25 And so with that in place, I think

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2 that body of art are things that a person of
3 ordinary skill could consult to see how others in
4 other disciplines had handled the problem of a
5 different pressure sensor reading when that
6 sensor is remote from the volume being filled.

7 So I don't know that I'd say in that
8 process that one is better than the other,
9 because I think a person of ordinary skill would
10 be motivated to look at different references to
11 see how people had solved that problem in other
12 applications.

13 Q. So you found the trucking industry
14 more compelling than the blood pressure cuff
15 industry?

16 MR. TUTTLE: Objection, form.

17 A. Well, what I'm trying to express is
18 that I think that, you know, the standpoint, the
19 shoes I'm trying to put myself in are a person of
20 ordinary skill having Giffit in hand, and then
21 they would be aware of a difference between
22 pressure in a chamber and then this sensor
23 pressure that is sensed at a point remotely.

24 Q. I'm sorry, Dr. Phinney. This kind of
25 needs to be a yes or no answer, if you would

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2 And so I think that problem of
3 compensating for this intervening pneumatic
4 impedance was just-- was well known for many
5 applications, and I think a person of ordinary
6 skill would be motivated to find that body and
7 collection of references.

8 Q. Your analysis ignored the reference
9 in the inflatable bed industry and preferred a
10 trucking reference; is that right?

11 MR. TUTTLE: Objection to form.

12 A. I don't -- I wouldn't say that I -- I
13 didn't include it in an affirmative combination,
14 if that's what you mean.

15 Q. Thank you.

16 A. I didn't include Bhai I mean in an
17 affirmative combination.

18 Q. In your motivation to combine, I
19 didn't see where you gave an explicit reason that
20 a person of ordinary skill would look beyond the
21 combination of Giffit and Mittal to find
22 Pillsbury.

23 Can you point me to that, the
24 explicit motivation, to include Pillsbury in the
25 prior combination?

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2 please.

3 Mittal is in the trucking industry of
4 inflation of tires, and Pillsbury is in the blood
5 pressure cuff industry.

6 My question was, did you find the
7 trucking industry a closer match or more
8 compelling than the blood pressure cuff industry?

9 MR. TUTTLE: Objection to form.

10 A. I wouldn't say that. That's not --

11 Q. Thank you. Bhai is in the same field
12 as Giffit; is it not?

13 MR. TUTTLE: Objection to form.

14 A. Well, Bhai does deal with a bed
15 application.

16 Q. Does Bhai disclose offsets?

17 A. I would say, yes, it does.

18 Q. What about Bhai made you believe that
19 a person of ordinary skill would ignore that
20 reference in favor of a trucking reference?

21 MR. TUTTLE: Objection, form.

22 A. I don't think they would. What I'm
23 trying to explain is that there is many
24 references in many fields that use pressure
25 offsets, including Bhai.

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2 A. So you're asking for something in my
3 report itself?

4 Q. That would be great.

5 A. Can I see a copy of my -- I mean the
6 '747 declaration.

7 Q. Here is the '154.

8 A. Okay.

9 Q. I'll get you the '747. Here, it is,
10 the '747.

11 A. So I point you to a couple of places.
12 Number 1, I describe how I believe that a person
13 of ordinary skill would find a body of
14 references, yes.

15 Q. The declaration please.

16 A. Yes, and so, number 1, so I'm just
17 tying this back to what I told you earlier, that
18 a person of ordinary skill would find a body of
19 references, and indeed there is that.

20 There is a pervasive applications
21 offsets, including dynamic offsets in different
22 applications. So part of, I think the motivation
23 is just that sheer pervasiveness that I think
24 supports this idea of obviousness--

25 Q. Dr. Phinney, I'd like to know where

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2 your declaration?

3 A. Yes, and I'm getting to that, so I'm
4 just making sure you're understanding what I'm
5 talking about.

6 So in paragraph 45 of this -- this is
7 Phinney Exhibit 14.

8 First of all, to try to list many of
9 these different applications where this is found,
10 so that's one place.

11 Then a second place would be, for
12 instance, paragraph 100 is where I say -- the
13 last two sentences of paragraph 100, I say:

14 "This form of compensation using
15 offsets was known specifically in the art
16 for air mattress control." There I refer
17 to Bhai. "As well as the general field of
18 pneumatic controllers."

19 And then I go on to say that:

20 "For this reason a person of ordinary
21 skill designing a pneumatic controller for
22 an air bed would look to reference as an
23 analogous, such as tire pressure
24 controllers or blood pressure monitors."

25 And that's where I -- that refers to

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2 -- for instance, to Pillsbury.

3 Q. Dr. Phinney, that doesn't answer the
4 question I've asked. If you have a combination
5 of Mittal and Giffit in hand, where is the
6 motivation to add Pillsbury specifically noted in
7 your declaration?

8 A. Right.

9 Q. These passages don't answer that.

10 A. No, they do. And so I pointed you
11 first to paragraph 45, so this refers to a body
12 of references which show just how common and
13 pervasive the use of offsets, including dynamic
14 offsets was.

15 In paragraph 45, I mention Pillsbury
16 is one of those examples. So a person of
17 ordinary skill would encounter all of these and
18 would have Pillsbury in hand and just understand
19 that there is a collection of things to, you
20 know, solve this problem.

21 A second place where I say this is
22 here in paragraph 100, the sentences I'm
23 describing when I say "such as tire pressure
24 controllers and blood pressure monitors there,"
25 I'm referring to Pillsbury.

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2 Q. Is it sufficient that a person of
3 ordinary skill in the art know of the existence
4 of the reference?

5 A. Well, what I'm talking about is that
6 a person of ordinary skill would have arrived --

7 Q. I need a yes or no answer to that.

8 A. -- would have arrived at that because
9 of the awareness, their awareness of the
10 difference between --

11 Q. Dr. Phinney, I don't mean--

12 MR. ELLIOTT: Objection,
13 argumentative.

14 MR. MOORE: Let's go off the record
15 for a moment.

16 [Discussion held off the record.]

17 MR. MOORE: On the record.

18 Q. Do the references of Giffit or Mittal
19 suggest looking for another reference themselves?

20 MR. TUTTLE: Objection, form.

21 A. I can't answer yes or no.

22 Q. Does Mittal suggest looking for
23 Pillsbury?

24 MR. TUTTLE: Objection, form.

25 A. If I can just ask for a

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2 clarification.

3 Q. Sure.

4 A. Are you saying like "Does it say"?

5 Q. Does it say you need to find another
6 reference such as Pillsbury?

7 A. Okay. That's the way I understood
8 your question. Okay, if that's the question,
9 then, no. It doesn't have -- it doesn't say go
10 look at Pillsbury.

11 Q. Does either Giffit or Mittal suggest
12 in that matter looking for Pillsbury?

13 MR. TUTTLE: Objection to form.

14 A. In that explicit matter, no.

15 Q. Does any passage of Pillsbury suggest
16 combining it with, Giffit and Mittal?

17 A. And again, suggest, you again mean
18 that explicit?

19 Q. Explicit teaching.

20 A. No.

21 Q. What benefit does Pillsbury confer on
22 Giffit and Mittal?

23 MR. TUTTLE: Objection to form.

24 A. I included Pillsbury as sort of an
25 explanatory reference, because I explain how it

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