

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

SCRAMOGE TECHNOLOGY LTD.,

Patent Owner.

Case IPR2022-00118

U.S. Patent No. 10,804,740

REMOTE DEPOSITION OF

JOSHUA PHINNEY, Ph.D., P.E.

Wednesday, July 27, 2022

9:50 a.m. Pacific Time

Stenographically Reported By:

Lorie Rhyne, CSR No. 12905

Job No. 5237

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Page 2

1 DEPOSITION OF: JOSHUA PHINNEY, Ph.D., P.E.
 2 DATE: Wednesday, July 27, 2022
 3 TIME: 9:50 a.m. Pacific Time
 4 LOCATION: Conducted remotely with all
 5 parties appearing via Zoom
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 16 US 2009/0021212 A1 (Hasegawa) 7
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1 Conducted Remotely
 2 9:50 a.m. Pacific Time
 3
 4 JOSHUA W. PHINNEY, Ph.D., P.E.,
 5 having first been duly sworn, was examined and
 6 testified as follows:
 7
 8 EXAMINATION
 9 BY MR. PAPAGEORGIU:
 10 Q. So, Dr. Phinney, please state your name for
 11 the record.
 12 A. My name is Joshua Phinney. Should I spell
 13 it?
 14 Q. No, that's okay.
 15 And you've been retained by the petitioner
 16 in this case, IPR 2022-0118; is that correct?
 17 A. Yes.
 18 Q. And that relates to U.S. Patent
 19 Number 10,804,740.
 20 A. Yes.
 21 Q. Can we refer to it as the "'740 patent"?
 22 A. Agreed.
 23 Q. Thanks. Great.
 24 (Exhibit 1003 was marked for identification.)
 25 //

2 (Pages 2 to 5)

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1 BY MR. PAPAGEORGIU:
 2 Q. The -- so you prepared a declaration marked
 3 Exhibit 1003; is that correct?
 4 A. Yes.
 5 Q. Okay. And this is the document on screen
 6 right now; is that correct?
 7 A. Yes, that looks like it.
 8 Q. Okay, great.
 9 (Exhibit 1001 was marked for identification.)
 10 BY MR. PAPAGEORGIU:
 11 Q. And in addition to Exhibit 1003, there's
 12 also Exhibit 1001.
 13 (Calmann Clements joins proceedings.)
 14 BY MR. PAPAGEORGIU:
 15 Q. Let me get the front page there.
 16 Do you recognize that document?
 17 A. Yes. It's the '740 patent.
 18 Q. Great.
 19 (Exhibit 1002 was marked for identification.)
 20 BY MR. PAPAGEORGIU:
 21 Q. Exhibit -- this is Exhibit 1002 shown on the
 22 screen right now.
 23 Do you recognize that document?
 24 A. Yes, the -- the file history for the
 25 '740 patent.

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1 (Exhibit 1008 was marked for identification.)
 2 BY MR. PAPAGEORGIU:
 3 Q. And, finally, there is Exhibit 1008.
 4 Do you recognize this?
 5 A. Yes. I call that Hiramatsu.
 6 Q. Okay, great.
 7 Did you review your declaration,
 8 Exhibit 1003, in preparation of this deposition?
 9 A. I did.
 10 Q. Did you review any other documents?
 11 A. Just the documents cited in my declaration.
 12 Q. Great.
 13 A. Oh, and I should say I -- I also did see an
 14 institution decision, and I saw patent owner's
 15 preliminary response.
 16 Q. Thank you.
 17 Now, you're currently employed with
 18 Exponent, Inc.; is that correct?
 19 A. Yes.
 20 Q. What is your role with the company?
 21 A. I'm a principal engineer, and my role is
 22 to -- to lead technical investigations I would call,
 23 like, failure analysis, trying to figure out what went
 24 wrong with something. And about half the time, I'm
 25 involved in -- in intellectual property case of some

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1 (Exhibit 1004 was marked for identification.)
 2 BY MR. PAPAGEORGIU:
 3 Q. And Exhibit 1004, that is your CV; is that
 4 correct?
 5 A. Yes.
 6 (Exhibit 1005 was marked for identification.)
 7 BY MR. PAPAGEORGIU:
 8 Q. Do you recognize Exhibit 1005?
 9 A. Yes, this is Hasegawa, which is the --
 10 the -- the reference for the -- the ground in the
 11 petition.
 12 Q. Okay.
 13 (Exhibit 1006 was marked for identification.)
 14 BY MR. PAPAGEORGIU:
 15 Q. And this document shown on the screen right
 16 now is marked Exhibit 1016 [sic].
 17 Do you recognize this?
 18 A. I do. I -- I call it Akiho.
 19 Q. That's fair enough.
 20 (Exhibit 1007 was marked for identification.)
 21 BY MR. PAPAGEORGIU:
 22 Q. And there's a -- also Exhibit 1007 shown on
 23 screen now.
 24 Do you recognize this?
 25 A. Yes. I -- I call this Tabata.

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1 type that could be trade secrets or patents.
 2 Q. Have you been retained for this particular
 3 petitioner in other matters? I know there's a few IPRs
 4 going on. Are you working on those as well?
 5 A. There should be -- I -- I -- perhaps a
 6 testimony list that you saw, and, yeah, I have been
 7 retained by petitioner in other matters that I've
 8 already testified on.
 9 Q. Okay. The matters related to the same
 10 patent owner? Have there been any other patent
 11 owners -- let me rephrase that.
 12 Have you worked on any matters for Apple
 13 that do not involve this particular patent owner?
 14 A. Yes, I have.
 15 Q. Okay. And those are on your list?
 16 A. Those -- yeah, they should all be on -- on
 17 the -- the list. Those are publications, but my
 18 testimony list should have that.
 19 Q. So you indicated that you've provided
 20 testimony in other patent cases as well. The
 21 approximate number, more than 10, more than 20?
 22 A. Yeah, it's probably more than 20, could be
 23 more than 30.
 24 Q. Do you recall that in any of those cases
 25 whether you've given opinions on anticipation in the

3 (Pages 6 to 9)

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1 35 U.S.C. 102?
 2 A. I -- I have.
 3 Q. How did you become aware of the standard for
 4 anticipation? Did you read any cases, for example?
 5 A. No, I -- I don't read cases. I tend to have
 6 a -- a section of any report I do on a patent matter, a
 7 section I usually just call Legal Understanding and,
 8 you know, it just has a lot of paragraphs that say,
 9 I've been informed by counsel that, and that just
 10 reflects what I -- what I learned in the course of
 11 doing this type of work about anticipation and
 12 obviousness.
 13 Q. So it's fair to say that, basically, you've
 14 learned about obviousness and anticipation based on
 15 what you've been told by counsel?
 16 A. Yeah, I think that's -- that's a fair way to
 17 put it.
 18 Q. Okay. Now, in this particular case here in
 19 your declaration, we're principally concerned with
 20 obviousness; is that correct?
 21 A. Correct.
 22 Q. Now, what -- in terms of obviousness, you
 23 understand that, in essence, that the requirement to
 24 show that the -- the claim is obvious requires that all
 25 of the elements be in the prior art; is that correct?

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1 And, so, yeah, I -- I basically would show
 2 some, you know, reasons from -- from Hasegawa and then
 3 conclude with that type of sentence, that that
 4 element's obvious in view of that.
 5 Q. Okay. Are you -- has the -- the concept of
 6 impermissible hindsight ever been explained to you?
 7 A. It has.
 8 Q. Okay. What is your understanding of that
 9 concept?
 10 A. My -- my understanding is that using the --
 11 using the -- the patent itself as a template for
 12 arranging the prior art would be an example of
 13 impermissible hindsight.
 14 Q. Okay. Now, the -- as we discussed briefly
 15 earlier, the -- you cite a number of patent references
 16 in your declaration. Did you do the search and locate
 17 those references or were they provided to you?
 18 A. So Hasegawa -- I can't recall where Hasegawa
 19 came from. I did search and find Hiramatsu, Akiho and
 20 then Tabata.
 21 Q. Okay. Now, in your declaration, it is your
 22 position that the '740 patent, at least the claims that
 23 are at issue, are obvious in view of Hasegawa,
 24 Exhibit 1005; is that correct?
 25 A. Yeah, I think that's a -- that's a fair

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1 A. That all of the elements would be obvious to
 2 a -- a person of ordinary skill at the time of the
 3 invention.
 4 Q. Right. So it's -- it's a combination of --
 5 of references plus a rational basis for combining those
 6 references to yield the claimed invention; is that
 7 correct?
 8 A. Well, if I could look at my --
 9 Q. Sure.
 10 A. -- Legal Understanding section here.
 11 I'll just -- so I -- I think you asked a
 12 question about obviousness, and then you asked if
 13 your -- your way you said it was -- was correct, I
 14 believe.
 15 Q. Okay. That's fine.
 16 Now, would you agree that it's not enough to
 17 merely show that components are in the prior art to
 18 prove obviousness.
 19 Would you agree?
 20 A. Well, I -- I tried to end the -- end my
 21 analysis in each -- of each claim element with a
 22 concluding sentence that would say -- it would say
 23 something to the effect of, you know, Thus, this
 24 teaching would render -- would render obvious the claim
 25 element.

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1 statement. That's that concluding statement that I
 2 have at the end of every claim element.
 3 Q. Okay. So to confirm, you did not conclude
 4 that the '740 patent is anticipated by Hasegawa or any
 5 of the other references?
 6 A. I -- I really handled this as an obviousness
 7 analysis, a single -- what I would maybe call a single
 8 reference obvious anal- -- obviousness analysis.
 9 Q. Okay. At paragraph 27 of your declaration,
 10 you have an excerpt pulled from the '740 patent, it --
 11 (Stenographer clarification.)
 12 MR. PAPAGEORGIU: Sorry. Give me one
 13 second.
 14 BY MR. PAPAGEORGIU:
 15 Q. Okay. So back to -- to paragraph 27.
 16 Do you see that -- the -- the quote from the
 17 7- --
 18 A. I -- it -- it -- it dropped out on my side.
 19 I -- I think I heard the last sentence -- the last
 20 words, but I'm not sure.
 21 Q. All right. Sorry. Let me repeat. Can you
 22 hear me?
 23 A. Yes.
 24 Q. Okay. Now, I'm referring to paragraph 27 of
 25 your declaration, you have an -- an excerpt from the

4 (Pages 10 to 13)

1 '740 patent.
 2 Do you see that?
 3 A. Yes.
 4 Q. All right. You understand that this
 5 paragraph is not prior art; is that correct?
 6 MR. JARRATT: Objection. Form.
 7 BY MR. PAPAGEORGIU:
 8 Q. Let me rephrase.
 9 So that paragraph that you quote from the
 10 '740 patent, do you understand that that passage is not
 11 prior art?
 12 A. I guess I'm not quite sure how to answer
 13 because I have heard something called Apple can --
 14 admitted prior art where statements that a patent owner
 15 might make talking about the state of the art at the
 16 time, sort of, are -- are taken to reflect in a way
 17 what was the prior art.
 18 So I'm not -- I guess I'm not quite sure how
 19 to answer your question.
 20 Q. Okay. Well, we'll move on to the next
 21 paragraph.
 22 In that paragraph 28, you refer to more
 23 recent devices?
 24 A. Yes.
 25 Q. All right. And that's not prior art either

1 is -- at least your statement is not prior art?
 2 A. I -- I guess in the sense of being a
 3 reference that I'm relying on affirmatively defined
 4 claim elements, I -- I guess I'd agree with you that
 5 way.
 6 Q. Okay. At paragraph 32, you indicate that
 7 the listed elements there are well-known components; is
 8 that correct?
 9 A. Yes, that's what I say there.
 10 Q. Okay. Now, again, in terms of obviousness,
 11 it's not enough that the components themselves are
 12 well-known; is that correct?
 13 A. That makes sense to me, that it's not just
 14 finding certain things in isolation is, in a way, not
 15 enough. The -- the -- so at least in that sense.
 16 Q. Okay. Going a little further down to
 17 paragraph 35, you note that The specification does not
 18 provide additional details with respect to these
 19 spatial relationships between the connecting unit and
 20 the receiving space in the adhesive layer 710.
 21 Do you see that?
 22 A. Yes.
 23 Q. Okay. You -- do you understand that the
 24 specification itself is not the only part of the patent
 25 disclosure?

1 A. Yes. My understanding is that the
 2 disclosure also includes the file history as an
 3 example.
 4 Q. Do you understand that the drawings
 5 themselves are part of the disclosure?
 6 A. Yeah. My understanding is that -- that the
 7 drawings are -- are part of what I call a
 8 specification. Maybe -- maybe I'm wrong if they're
 9 distinct from that. But I'd always thought of things
 10 before the claim as being the specification, including
 11 a written description and the drawings.
 12 Q. Okay, yeah. Generally, they're considered
 13 separately, but as long as your understanding is that,
 14 you know, they do -- the drawings are part of the
 15 disclosure, that's fine.
 16 Now, at paragraph 33, you include Figure 26
 17 from Exhibit 1001. That's the '740 patent; is that
 18 correct?
 19 A. Yeah. Did you say I include Figure 26?
 20 Q. Twenty-six, um-hum.
 21 A. Yes, that's what's shown here in
 22 paragraph 33.
 23 Q. Now, I just want to go through a few of the
 24 components shown there. So 710, that's the adhesive
 25 layer; is that correct?

1 A. Yeah, that's my memory. I can check if we
 2 want to be sure.
 3 Q. Okay. No, that -- that is correct.
 4 And 130 is the receiving space. Do you see
 5 that?
 6 A. That is my -- that is my recollection. I'm
 7 just looking in the patent. Yes, that -- that makes --
 8 that makes sense.
 9 Q. Okay. Now, reference numbers 210 and 220
 10 are the connecting terminals, and they are located at
 11 the ends of the coil 200.
 12 Do you see that? So 210, 220 and those are
 13 the ends of 200.
 14 A. Yes. 210 and 220, I believe, are called the
 15 first connection terminal and the second connection
 16 terminal. Yeah, it may appear to be shown at the ends
 17 of that -- of 200.
 18 Q. Okay. And that's consistent in the other
 19 drawings as well. So I'm -- I'm displaying Figure 1 in
 20 Exhibit 1001 now. That's the same configuration in
 21 Figure 1; is that correct?
 22 A. Yeah. Just looking at that coil, it --
 23 it -- it pretty much looks like we saw in Figure 26.
 24 Q. Okay. And I'll just go a little lower to
 25 Figure 11. And that is a similar configuration as

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