

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

SCRAMOGE TECHNOLOGY, LTD.,
Patent Owner

Case IPR2022-00118
U.S. Patent No. 10,804,740

**SUPPLEMENTAL DECLARATION OF JOSHUA PHINNEY, PH.D.,
UNDER 37 C.F.R. § 1.68**

TABLE OF CONTENTS

A.	Introduction.....	3
B.	Substitute claims 21 and 22 fail to inform with reasonable certainty, those skilled in the art about the scope of the invention.	4
C.	POSITAs would have found substitute claims 21-23 obvious under 35 U.S.C. § 103 over Kato.....	6
	a. Summary	6
	b. Detailed Analysis	11
D.	Declaration.....	33

I, Joshua Phinney, Ph.D., declare:

A. Introduction

1. I am making this supplemental declaration at the request of Apple Inc. in the matter of the *Inter Partes* Review IPR2022-00118 of U.S. Patent No. 10,804,740 (the “740 Patent”) to An et al. The terms of my engagement, my background and qualifications, prior testimony, and the legal standards and claim constructions that I am applying are set forth in my previous CV and declaration. *See* Ex.1003; Ex.1004.

2. In the preparation of this declaration, I have studied the materials noted in my previous declaration, as well as the following additional materials:

- (1) **Ex.1016** – Plaintiff’s Preliminary Disclosure of Asserted Claims and Infringement Contentions to Apple Inc.
- (2) **Ex.1017** – U.S. Patent Publication No. 2008/0164840 to Kato et al. (“Kato”).
- (3) **Ex.1019** – *The Merriam-Webster Dictionary*, Merriam-Webster, Inc., 1995.
- (4) **Ex.1020** – The Wayback Machine, capture of “Separate | Define Separate at Dictionary.com” on February 7, 2012, <https://web.archive.org/web/20120207103735/http://dictionary.referen>

ce.com:80/browse/separate.

3. In forming the opinions expressed below, I have considered:

(1) The documents listed above, and

(2) My own knowledge and experience, including my work experience in the field of wireless power, as described below.

B. Substitute claims 21 and 22 fail to inform those skilled in the art about the scope of the invention with reasonable certainty.

4. It is my opinion that substitute claims 21 and 22 in Patent Owner's Motion to Amend fail to inform a person of ordinary skill in the art ("POSITA") about the scope of the claimed invention with reasonable certainty. In particular, the new requirement of a "separate" connecting unit creates an internal contradiction. A POSITA would not have understood how the connecting unit is "separate from the coil, the first connection terminal, and the second connection terminal" in view of the originally claimed requirement that the "connecting unit comprises: a third connection terminal *connected* to the first connection terminal" and "a fourth connection terminal *connected* to the second connection terminal."

5. Substitute claims 21 and 22 recite "a discrete connecting unit separate from the coil, the first connection terminal, and the second connection terminal" (underlining denoting newly added claim language). The added requirement that

the connecting unit be “separate” from the first and second connection terminals contradicts the originally claimed requirement that the connecting unit be “connected” to the first and second connection terminals. For example, the “connecting unit comprises: a third connection terminal *connected* to the first connection terminal” and also comprises “a fourth connection terminal *connected* to the second connection terminal.” The amended claim requires the connecting unit to be both (i) “connected” to the first and second connection terminals (via the third and fourth connection terminals) and (ii) “separate” from the first and second connection terminals.

6. I note that the specification of the '740 patent does not use the term “separate” with respect to the connecting unit. For example, the '740 patent does not recite that the connecting unit is “separate” from any other element in the wireless power receiver. In fact, the term “separate” does not appear at all in the '740 patent specification. The specification instead describes the connection terminals of the connecting unit as being “connected” to the other connection terminals by a solder. Ex.1001, 5:46-60, 6:34-39, 7:14-19,13:7-12. For example, Ex.1001, 5:46-60 states:

In detail, the first connection terminal 210 of the coil unit 200 may be connected to the first connection terminal 310 of the connecting unit 300 through a first solder 10 and the second

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.