

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

AIRE TECHNOLOGY LIMITED,
Patent Owner.

IPR2022-01137
U.S. Patent No. 8,581,706

**DECLARATION OF DR. JOSHUA PHINNEY,
UNDER 37 C.F.R. § 1.68 IN SUPPORT OF
PETITIONER'S OPPOSITION TO MOTION TO AMEND**

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 A. Claim 2313

 B. Claim 2415

 C. Claim 2519

 D. Claim 2619

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I, Dr. Joshua Phinney, do hereby declare as follows:

I. INTRODUCTION

1. I am the Joshua Phinney who has previously submitted a declaration as Ex.1003 in this proceeding. The terms of my engagement, my background, qualifications and prior testimony, and the legal standards and claim constructions I am applying are set forth in my previous CV and declaration. *See* Ex.1003; Ex.1004. I offer this declaration in reply to Patent Owner's Motion to Amend filed in this proceeding.

2. I have been asked to provide my opinions with respect to substitute claims 23-26 ("Substitute Claims") as proposed in Patent Owner's Motion to Amend. It is my opinion that the specification of the '706 patent does not enable what is claimed. To the extent the claims were to be interpreted in a specific manner as described below, it is my opinion that the claims would have been obvious to a person having ordinary skill in the art ("POSITA") at the time of the alleged invention, in light of the prior art. It is also my opinion that the specification of the '706 patent does not enable what is claimed.

3. I am a Principal Engineer in the Electrical Engineering and Computer Science practice at Exponent, an engineering and scientific consulting firm headquartered at 149 Commonwealth Drive, Menlo Park, California 94025.

4. I have been retained as an independent expert consultant in this

proceeding before the United States Patent and Trademark Office (the “Patent Office”). I am being compensated for my work in this matter at my standard hourly rate. I am also being reimbursed for reasonable and customary expenses associated with my work and testimony in this investigation. My compensation is not contingent on the outcome of this matter or the specifics of my testimony.

5. I previously submitted an expert declaration in support of Apple, Inc.’s Petition for *inter partes* review (IPR) regarding U.S. Patent No. 8,581,706 (“the ’706 Patent”). *See* Ex. 1003. I understand that Patent Owner submitted a Patent Owner Response as well as a Motion to Amend (Paper 16, “Motion”) in IPR2022-01137. I submit this expert declaration in support of Petitioner’s Opposition to the Motion to Amend.

6. Details regarding my qualifications, testifying experience, employment history, fields of expertise, and publications are provided in my prior declaration and my CV, Ex. 1003; Ex.1004.

7. In the preparation of this declaration, I have studied the materials listed in Ex.1003. I have also considered the relevant legal standards, including the standard for obviousness, and any additional authoritative documents as cited in the body of this declaration; and my own knowledge and experience.

8. Unless otherwise noted, all emphasis in any quoted material has been added.

II. THE PROPOSED AMENDMENTS ADD NEW SUBJECT MATTER BY CLAIMING FUNCTIONALITY DIFFERENT THAN THE FUNCTIONALITY DESCRIBED IN THE SPECIFICATION.

9. It is my opinion that the proposed substitute claims are directed to concepts not supported by the specification of the '706 patent. It has been explained to me by counsel that claim amendments must be supported by the specification. In particular, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.

10. Here, a POSITA would not have concluded that the original specification provides written description support for the proposed claim amendments because the proposed substitute claims recite subject matter that is different than what is described in the specification.

A. Substitute claims 23 and 25-26 recite new matter by claiming concepts that differ from those described in the specification.

11. The proposed claim amendments add new matter because they claim a device with *different* functionality than what is described in the specification. Substitute claim 23 (proposed substitute for claim 11) has been amended to recite: “*wherein after selection of one of the plurality of applications, subsequent communication between the reading device and the selected application takes place without requiring any further steps.*” Motion, 4. Substitute claims 25-26 (proposed substitutes for claims 18 and 20) recite similar language. Motion, 7, 9.

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