

EXHIBIT B

IN THE UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

PA ADVISORS, LLC

Plaintiff

-v-

Civil Action No. 2-07CV480-RRR

GOOGLE, INC., et al.

Defendants

DEPOSITION OF
HON. GERALD J. MOSSINGHOFF

VOLUME 1 OF 1

Friday, February 12, 2010

11:09 A.M. TO 2:48 P.M.

held at
Washington, District of Columbia

1 Mr. Edkin. And I relied upon that and put that
2 in my report.

3 Q. Anything else?

4 A. I don't believe so, no.

5 Q. Did you actually read the Geller
6 patent?

7 A. I did.

8 Q. What is your understanding of the
9 invention of the Geller patent?

10 MR. YOVITS: Objection to the form of
11 the question.

12 A. I really don't have one. I didn't
13 understand it. I read it twice when I was
14 preparing the report, and twice yesterday, and I
15 still don't understand it.

16 BY MR. GIZA:

17 Q. Did you read the Dasan patent?

18 A. I did at the time -- I didn't read it
19 carefully. I did at the time that I was reading
20 my report, in preparing for Mr. Edkin's
21 deposition.

22 Q. Did you read the Ahn patent?

23 A. Same answer. I scanned it. I scanned
24 that, and I think there's a Siefert patent also.

25 So all three of those patents are part

1 of the transcript -- they're exhibits of
2 Mr. Edkin's deposition. And so I scanned them at
3 the time I was preparing my report. But I didn't
4 try to read them or understand them.

5 Q. You don't have any technical opinion
6 about those patents; is that correct?

7 MS. ROBERTS: Objection to form.

8 A. That's correct.

9 BY MR. GIZA:

10 Q. Did you read the Hoffberg patent?

11 A. No. I read the prosecution history,
12 and I don't recall whether that -- that was a
13 patent that was cited by the examiner, and I
14 don't remember whether the patents were part of
15 the prosecution history or not. If they were, I
16 scanned them; if they were not I did not. And I
17 can't tell you today whether I did or didn't.

18 Q. Did you consider any of the cited
19 prior art?

20 MS. ROBERTS: Objection, form.

21 A. No, not in any -- not in any way in
22 which I would try to understand them.

23 BY MR. GIZA:

24 Q. So you have no opinion as to the
25 content of the prior art cited in the prosecution

1 of the Geller patent.

2 MS. ROBERTS: Objection, form.

3 A. And what's the question? I'm sorry?
4 That sounded like a statement to me but ...

5 BY MR. GIZA:

6 Q. Well, I'm asking to you confirm it.
7 So, do you have an opinion as to the
8 content of the prior art cited in the prosecution
9 of the Geller patent?

10 A. No.

11 Q. Did you read the court's claim
12 construction?

13 A. No.

14 Q. Did you read any other expert reports
15 in this case?

16 A. Well, I was given the -- Mr. Gordon's
17 report some time ago, and I read that once
18 yesterday in preparing for this deposition.

19 Q. Have you ever worked with Mr. Gordon
20 before?

21 A. I don't believe so. If someone were
22 to hand me a picture of me shaking his hands at
23 some Patent and Trademark Office event, I
24 wouldn't deny it, but I can't put a name with the
25 face -- or a face with the name.

1 Q. Did you read the expert report of
2 Mr. Peters?

3 A. Yes.

4 Q. Is that on your Exhibit E?

5 A. No. It's referred to, though,
6 specifically in my -- in my -- it's specifically
7 cited in the text of the expert report, so it's
8 not on Exhibit E. But I did read that.

9 That was signed, as I recall, on
10 December 30, and I didn't sign my report until I
11 had an opportunity to read the final version of
12 it, which I did at that time.

13 Q. Did you read the entire report?

14 A. I paged through the entire report.
15 The part that I was -- that I read more
16 carefully, I think was entitled "materiality of
17 the references that weren't disclosed to the PTO"
18 or something like that. And so that's what I
19 read and quoted from in my report.

20 The remainder of the report, I leafed
21 through it, but I didn't try to understand it,
22 because it had nothing to do with exactly what I
23 was trying to do at the time, and that is to
24 quote Mr. Peters and sign my report.

25 Q. Did you look at any of the exhibits to

1 Mr. Peters' report?

2 A. Yes, I'm sure I did. I don't
3 recall ... I don't recall what was in them, but I
4 would have -- I had the entire report, and I
5 would have leafed through them. But again,
6 focused on his section entitled "materiality."

7 Q. There were exhibits that were actually
8 separate documents. That's why I'm asking the
9 question separately.

10 Did you see any claim charts?

11 A. I can't tell you today that I did. I
12 don't know that I did.

13 Q. So is it fair to say you didn't rely
14 on any claim charts from Mr. Peters' report?

15 A. Basically what I relied upon is quoted
16 in my report.

17 Q. Did you look at the expert report of
18 Dr. Ryan?

19 A. No.

20 Q. Did you discuss your report with
21 anyone? Excepting counsel?

22 MS. ROBERTS: Objection, form.

23 A. And excepting Ms. Narrish, who typed
24 it for me, my secretary.

25 BY MR. GIZA:

1 his or her attorney, in urging the patentability
2 of a claim.

3 So in general, that's it. That's the
4 first part of it.

5 And if someone breaches their Duty of
6 Candor and Good Faith under either the pre-1992
7 standard or the post-1992 standard, then the
8 courts look to see whether they did so with
9 intent to deceive the U.S. Patent and Trademark
10 Office. And if the answer to both those
11 questions is yes, there was a breach of the Duty
12 of Candor and Good Faith, and there was intent to
13 deceive the U.S. Patent and Trademark Office,
14 then a court can hold the entire patent
15 unenforceable under the Doctrine of Inequitable
16 Conduct.

17 BY MR. GIZA:

18 Q. So you just described two standards
19 for determining materiality; right?

20 MS. ROBERTS: Objection, form.

21 A. Yes.

22 BY MR. GIZA:

23 Q. Which standard did you apply in your
24 analysis in this case?

25 A. In this case, I applied the standard

1 that was set forth in Mr. Peters' -- and that the
2 reasonable examiner would want to know about
3 these cases; and also the second standard that,
4 if, as he said, the missing documents -- the
5 documents that the patentee's attorney knew
6 about, but didn't cite to the Patent and
7 Trademark Office, that that would have rendered
8 obvious the claims of the '067 patent.

9 So really, I applied both standards:
10 The prima facie case of unpatentability, and the
11 reasonable examiner's test.

12 Q. Do you have any opinion on whether the
13 patentee refuted or was inconsistent before the
14 PTO? That prong of the test?

15 MS. ROBERTS: Objection, form.

16 A. I think the answer is yes. By urging
17 the allowance of claims which would otherwise be
18 determined as being obvious, I think the attorney
19 satisfied both tests of what a reasonable
20 examiner would want to know, and the question of
21 whether the missing references would have been
22 inconsistent with positions they took.

23 And I use as my basis for that the
24 actual Digital Control case, which actually said
25 something like that, that by urging the allowance

1 of a claim, which an attorney does when he
2 includes a claim in an application supported by a
3 declaration and submits it to the office, that
4 that attorney is urging the allowance of that
5 claim; that the prima facie case of
6 unpatentability is satisfied, and the test of
7 whether or not the lack of submitting the
8 documents was inconsistent with positions that
9 the examiner -- or that the applicant took.

10 (DEPOSITION EXHIBIT 3

11 MARKED FOR IDENTIFICATION)

12 MR. GIZA: The witness has been handed
13 Exhibit 3. It is a copy of the Mossinghoff
14 report.

15 BY MR. GIZA:

16 Q. Mr. Mossinghoff, can you confirm what
17 that document is?

18 A. This is the first part of my expert
19 report in this case. I now have Exhibits E and
20 D. There is A, B and C missing at this point.

21 Q. So, can you point out for me where in
22 your report you make the argument that the
23 applicant was either refuted or was inconsistent
24 in the positions it took before the PTO?

25 MR. YOVITS: Objection to the form of

1 the question.

2 A. I quote the report of Mr. Peters, in
3 my paragraph 17 on page 10, where he says, "The
4 prior art cited by the '067 patent in combination
5 with the Dasan and Siefert patents render the
6 '067 patent obvious."

7 And I use the fact that the Federal
8 Circuit has -- in the Digital Control case, has
9 said that submitting a claim, and in effect,
10 telling the Patent Office that it's an allowable
11 claim, and not disclosing references which would
12 make it not allowable, is inconsistent with a
13 position that the applicant took. And those are
14 almost the exact words of the Federal Circuit.

15 So if my report doesn't specifically
16 cite that, then I want to be very clear in this
17 deposition that that is my opinion, that there
18 are three grounds:

19 One is the pre-'92 ground that says a
20 reasonable examiner would have wanted to know
21 about prior art which renders claims obvious.

22 Two, the -- so that's the first one.
23 Secondly, that it would create a prima
24 facie case of patentability.

25 And third, using the Digital Control

1 court interpretation, it would be inconsistent
2 with urging the allowance of a claim which would
3 otherwise not be allowable because it would be
4 obvious under section 35 USC Section 103. So ...

5 (REPORTER REQUESTED CLARIFICATION)

6 BY MR. GIZA:

7 Q. So where specifically in your report
8 do you disclose your third argument that you just
9 made?

10 MR. YOVITS: Objection to the form of
11 the question --

12 MS. ROBERTS: Object, form.

13 A. Yeah, I don't see that I've disclosed
14 it specifically here. And that's why I'm being
15 so clear in deciding to tell you it is my third
16 ground in this deposition, so there's no
17 surprises to you that that would be my opinion.

18 BY MR. GIZA:

19 Q. Did you cite the Digital Controls case
20 in your report at all?

21 A. I did, indeed. (Perusing document)
22 On page 8, paragraph 12, I cite the Digital
23 Control versus Charles Machine Works case.

24 Q. And is there an explanation for why
25 you cited that in your report?

1 MS. ROBERTS: Objection, form.

2 A. No. I think the case speaks for
3 itself by the fact that, if something satisfies
4 the -- what they refer to as a reasonable
5 examiner test, which was the pre-1992 test, that
6 it is material. And then it goes on to say ...
7 "That is, we have yet to determine whether the
8 new standard is the same as the reasonable
9 examiner or if the new standard is narrower,
10 whether a misstatement is material under the
11 reexamination but arguably not material under
12 this, but still meets the threshold of
13 materiality."

14 It's cited, from what I indicated, the
15 fact that the case itself says that if one is
16 urging the allowance of a claim, and has material
17 not disclosed, which would render the case not
18 allowable, that that does satisfy the test of --
19 it's (b)2, I think, in the regulation Rule 56,
20 that not citing it is inconsistent with -- not
21 with the -- not citing the reference is
22 inconsistent with urging allowance of a claim,
23 and satisfies that part of the new regulation.

24 BY MR. GIZA:

25 Q. So I hear you articulating the

1

1 argument regarding Digital Control's case, but we
2 agree that it's not specifically articulated in
3 your report; right?

4 MS. ROBERTS: Objection, form.

5 A. That part of it is not particularly --
6 not specifically articulated in my report, and
7 that's why I want to be very clear at this
8 deposition that that is my opinion, and I would
9 propose to testify to that effect.

10 MR. GIZA: Okay. Let's go ahead and
11 take a break.

12 THE VIDEO OPERATOR: This includes
13 videotape number 1 in the deposition of Gerald J.
14 Mossinghoff. We are going off the record at
15 12:07 P.M.

16
17 (LUNCH RECESS TAKEN AT 12:07 P.M.)

18
19 * * *

1 granted as a patent.

2 And there is the test that says it's
3 inconsistent with assertions of patentability.
4 That would fall under asserting an argument of
5 patentability, which the circuit has said --
6 Federal Circuit has indicated, urging the
7 allowance of a claim which is otherwise not
8 allowable is inconsistent with that.

9 So you named one of three.

10 The non-cumulativeness applies to all
11 three. And then there are three separate ones
12 after that, and you named one of the three, and I
13 named the other two.

14 Q. Okay. So let's break it down.

15 If the undisclosed references are
16 cumulative to the cited prior art in the
17 prosecution, then under no circumstances can
18 there be materiality; correct?

19 A. That's correct. Yes.

20 Q. And with the same condition.

21 So if the undisclosed prior art is
22 cumulative of the cited prior art references in
23 the prosecution, then there can be no inequitable
24 conduct finding; correct?

25 A. I believe that's correct, yes.

1 MS. ROBERTS: Objection, form.

2 A. Again, that sounds like a statement,
3 again, not a question.

4 BY MR. GIZA:

5 Q. Let me rephrase.

6 So outside of the opinion provided by
7 Mr. Peters, do you have any separate opinion as
8 to whether the undisclosed prior art establishes
9 a prima facie case of unpatentability --

10 A. No --

11 Q. -- in this case?

12 A. No. Sorry I interrupted you. The
13 answer is no.

14 Q. That's okay.

15 So, in your opinion, the sole support
16 that the undisclosed prior art establishes a
17 prima facie case of unpatentability is the
18 statement by Mr. Peters, and I'll quote: "The
19 prior art patents cited in the '067 patent, in
20 combination with the Dasan and Siefert patents
21 render the '067 patent obvious." Correct?

22 MS. ROBERTS: Objection to form.

23 A. Well, I think you could add that an
24 independent reason is that those two patents were
25 identified in the search report, the PCT search

1 Q. Okay. So just so that we're clear:
2 You've expressed no independent opinion about
3 obviousness in this case; right?

4 A. That is correct --

5 MS. ROBERTS: Objection to form.

6 A. I'm relying upon Dr. Peters -- or
7 Mr. Peters' opinion that I state in my report.

8 BY MR. GIZA:

9 Q. Okay. Let's talk about intent.
10 It's your understanding that,
11 inequitable conduct requires an intent to
12 deceive; is that right?

13 A. Well, it requires a breach of the Duty
14 of Candor and Good Faith, and added to that, an
15 intent to deceive the U.S. Patent and Trademark
16 Office.

17 Q. And how does one determine whether
18 there is an intent to deceive the U.S. Patent
19 Office?

20 A. Well, it's a determination by the
21 trier of fact, and in the case of inequitable
22 conduct, that is usually the judge acting alone,
23 although there have been cases where a judge will
24 ask a jury for special instructions.

25 The courts have generally recognized

1 from the surrounding circumstances.

2 There are cases where there is even
3 lack of specific knowledge of what was not
4 disclosed to the Patent and Trademark Office, and
5 the courts have held that that was inequitable
6 conduct. And probably the most often cited case
7 in that regard is the Brasseler case, Judge
8 Gajarsa's decision in Brasseler.

9 So I think direct evidence of intent
10 would be an e-mail from some applicant who writes
11 to his brother-in-law and says, boy, I really
12 fooled the Patent Office today. I didn't tell
13 them about this reference that's a dynamite
14 reference. That would be direct evidence. And I
15 don't think that's required, or even present in
16 most cases.

17 Q. So I'm asking a little bit of a
18 different question. I'm asking whether
19 inequitable conduct requires a finding of
20 subjective intention to deceive; in other words,
21 was there a person with a duty to the Patent
22 Office who, as an individual, had an intent to
23 deceive the Patent Office?

24 A. I don't know how to answer that. I
25 don't testify on intent; I don't give opinions.

1 If someone asks me -- one of the people that
2 engage me ask me to give an opinion on intent, I
3 would not do that.

4 I would give opinions -- or statements
5 regarding intent. And I have done that in court.

6 I have given evidence in court that a
7 material misrepresentation was made in a
8 declaration to the Patent and Trademark Office
9 had a very, very high materiality, probably as
10 high as one could imagine in the Patent and
11 Trademark Office. That evidence was received by
12 the court, and in effect, adopted by the court in
13 finding that there was inequitable conduct.

14 The Critikon case, which I cite in my
15 footnote one on page ... on page 4, beginning on
16 page 4 in footnote 1. That case -- I don't cite
17 it for intent. I cite it for a totally different
18 proposition, and I think it's a good proposition
19 to put in an expert's report, and that is what
20 the MPEP is, the fact that it does not have a
21 force of law but is well-known to those
22 registered to practice and reflects presumptions,
23 that case later on had Judge Giles Sutherland
24 Rich, who was a great fan of inventors, and
25 inventive activity, say that if all a person had

1 disclosed; that the -- so I personally have --
2 and I think that word is often used -- an abiding
3 conviction, that the prior art cited by the PCT
4 in the PCT search as a "Y" references, and then
5 Mr. Peters' analysis, or opinion that it was
6 material when taken in connection with art that
7 was cited in the Patent and Trademark Office
8 grant of the '067 patent, I personally have an
9 abiding conviction that there was a breach of the
10 Duty of Candor and Good Faith.

11 Whether that would satisfy a
12 hypothetical instruction to a jury or not, I
13 don't know. I'm not a civil procedure person.

14 BY MR. GIZA:

15 Q. Okay. So just to clean that up: Is
16 it true that you have no opinion as to whether
17 the evidence of materiality in this case is clear
18 and convincing?

19 MS. ROBERTS: Objection to form.

20 A. I wasn't asked to reach that opinion,
21 and I don't have that opinion.

22 BY MR. GIZA:

23 Q. Thank you. Does the Dasan patent
24 disclose the use of user profiles?

25 A. According to Mr. Peters, it does. | And

1 I'm relying upon that.

2 Q. Did you independently verify that?

3 A. No. I don't believe I'm capable of
4 doing that.

5 Q. Does the Siefert patent disclose the
6 use of user profiles?

7 A. Same answer. According to Mr. Peters,
8 it does have that feature.

9 Q. Did you independently verify whether
10 Siefert uses -- strike that.

11 Did you independently verify whether
12 the Siefert patent discloses the use of user
13 profiles?

14 A. No. No.

15 Q. Does the Dasan patent disclose
16 retrieving search results that reflect the user's
17 social, cultural, educational --

18 (REPORTER REQUESTED CLARIFICATION)

19 Q. Does the Dasan patent disclose
20 retrieving search results that reflect a user's
21 social, cultural, educational, economic
22 background, or psychological profile?

23 A. I don't know the answer to that.

24 Q. Does the Siefert patent disclose
25 retrieving search results that reflect the user's

1 difference between the first sentence starting
2 with, "The prior art does not," and the following
3 sentence that talks about the Dasan and Siefert
4 patents.

5 You do not have the opinion that Dasan
6 and Siefert disclose retrieving search results
7 that reflect the user's social, cultural,
8 educational, economic background or psychological
9 profile; right?

10 A. I'm sorry, can we have that read back?
11 I didn't ... either have it repeated or read
12 back, one or the other. I didn't quite get it.

13 Q. I'll reiterate the question.
14 Do you have an opinion whether the
15 Dasan and Siefert patents disclose retrieving
16 search results that reflect a user's social,
17 cultural, educational, economic background or
18 psychological profile?

19 A. No, not specifically.

20 Q. If Dasan and Siefert do not disclose
21 retrieving search results that reflect a user's
22 social, cultural, educational, economic
23 background or psychological profile, does it make
24 any difference to the materiality analysis if the
25 prior art also does not disclose those?

1 Mossinghoff. We're going off the record at 1:44
2 P.M.

3 (RECESS TAKEN FROM 1:44 TO 1:55 P.M.)

4 THE VIDEO OPERATOR: This begins
5 videotape number 3 in the deposition of Gerald J.
6 Mossinghoff. The time is now 1:55 P.M. We are
7 back on the record.

8 BY MR. GIZA:

9 Q. Mr. Mossinghoff, I'm trying to get an
10 understanding of paragraph 18 of your report; in
11 particular, the third to last sentence and the
12 penultimate sentence.

13 Can you take a look at those?

14 A. It's the third sentence?

15 Q. The third to last sentence.

16 A. Third to last.

17 Q. And the penultimate.

18 A. So it's, "According to Mr. Peters"?

19 Q. No, the sentence starting after that.
20 "The prior art does not, however."

21 A. (Perusing document) Yes. Okay.

22 Q. So, is it your opinion that the prior
23 art does not disclose the use of user profiles?

24 A. Well, I say, "The prior art does not,
25 however, discuss the use of user profiles or

1 retrieving search results that reflect a user's
2 social, cultural, educational and economic
3 background or psychological profile."

4 That was my understanding at the time.

5 Q. Right. I'm just trying to break it
6 down, the disjunctive "or"; right?

7 So you're saying that the prior art
8 does not discuss the use of user profiles, and
9 the prior art also does not discuss use of
10 retrieving search results that reflect the user's
11 social, cultural, educational, economic
12 background, or psychological profile; correct?

13 A. Yes.

14 Q. Okay. Immediately after that, you
15 have a sentence that says, "The Dasan and Siefert
16 patents disclose the use of user profiles.

17 A. Yes. Based upon what Mr. Peters says.

18 Q. So this is not your independent
19 opinion at all.

20 A. No. This is based upon the paragraph
21 that I cite of him, which is paragraph 17.

22 Q. Okay.

23 A. And I say, "Based upon paragraphs 11
24 through 17."

25 Q. So, what I'm focusing on is the

1 A. Not to me. I would still rely upon
2 Mr. Peters.

3 Q. Okay. Did you read the Hoffberg
4 patent?

5 A. No. I think you asked that earlier.
6 The answer is no. I -- if it was part of the
7 prior -- or the prosecution history, I looked at
8 it and paged through it, but I did not read it or
9 try to understand it.

10 Q. And so you don't have any independent
11 opinion about what Hoffberg discloses.

12 A. I do not.

13 Q. And do you adopt the opinion that
14 Mr. Peters has about the Hoffberg patent?

15 MS. ROBERTS: Objection, form.

16 A. Not in connection with my specific
17 report, although he does mention, I think, in
18 his -- as I recall, he mentions it in his report.
19 But I didn't feel like I needed to quote it in my
20 report.

21 BY MR. GIZA:

22 Q. So, if Hoffberg disclosed the use of
23 user profiles, wouldn't that be relevant to your
24 materiality analysis?

25 A. Well, it would be contrary to what

1 opinion is, based on whatever hypothetical
2 disagreement you're referring to.

3 BY MR. GIZA:

4 Q. So if the cited prior art discloses
5 the use of user profiles, then your opinion of
6 materiality will be affected.

7 A. No. I just would -- I wouldn't change
8 my opinion unless I knew what Mr. Peters would
9 say about whatever hypothetical disagreement
10 somebody has with what he's already said.

11 Q. If Mr. Peters admits that the cited
12 prior art discloses the use of user profiles,
13 will that change your materiality analysis?

14 MS. ROBERTS: Objection, form.

15 A. I don't know. I'd ask counsel to see
16 what he would say about whether or not the
17 undisclosed prior art that was identified as
18 being relevant, given the new opinion, whatever
19 hypothetical opinion that is, what he would say
20 about it.

21 In other words, I would rely upon him.
22 I wouldn't independently reach my own conclusion.

23 BY MR. GIZA:

24 Q. Okay. So, the comparison of the cited
25 prior art to Dasan and Siefert, that analysis you

1 BY MR. GIZA:

2 Q. Let me just clarify. So is it true
3 that your opinion in this case does not relate at
4 all to the undisclosed Ahn reference?

5 A. Well, my opinion is based on
6 Mr. Peters' opinion, and his opinion does not
7 include the Ahn reference, and so my opinion does
8 not include the Ahn reference.

9 Q. Okay. Thank you.

10 Is it true that both the international
11 search report and the preliminary examination --
12 sorry, the international preliminary examination
13 report were reviewed by Mr. Kim Yeh Vu?

14 A. I'm not sure of that. I've got here
15 in my footnote 5 that Ms. Peggy Harrod, who
16 completed the PCT international preliminary
17 search report, did it as acting for Mr. Vu.

18 And then, I have in the text, in my
19 paragraph 13, that James R. Matthews is acting
20 for Kim Yeh Vu.

21 And I don't necessarily think that
22 necessarily means that it was reviewed by Mr. Vu.

23 Q. Is it true that Mr. Vu is -- strike
24 that.

25 Is it true that the Mr. Vu you refer