

# **EXHIBIT A**

1                   IN THE UNITED STATES DISTRICT COURT  
2                   EASTERN DISTRICT OF TEXAS  
3                   MARSHALL DIVISION  
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6  
7 PA ADVISORS, LLC

8                   Plaintiff

9           -v-

Civil Action No. 2-07CV480-RRR

10 GOOGLE, INC., et al.

11                   Defendants  
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15                   DEPOSITION OF

16                   HON. GERALD J. MOSSINGHOFF  
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18                   VOLUME 1 OF 1  
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20                   Friday, February 12, 2010

21                   11:09 A.M. TO 2:48 P.M.  
22

23                   held at

24                   Washington, District of Columbia  
25

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 AFTERNOON SESSION

2 12:44 P.M.

3 THE VIDEO OPERATOR: This begins  
4 videotape number 2 in the deposition of Gerald J.  
5 Mossinghoff. The time is now 12:44 P.M. We are  
6 back on the record.

7 BY MR. GIZA:

8 Q. Good afternoon.

9 A. Good afternoon.

10 Q. Right before we broke for lunch, we --  
11 you articulated a new opinion about the  
12 undisclosed prior art being inconsistent with or  
13 refuting a position that the applicant took.

14 Was there any reason why --

15 MR. YOVITS: Objection -- sorry.

16 BY MR. GIZA:

17 Q. -- the opinion was not in your report?

18 MR. YOVITS: Objection to the form of  
19 the question.

20 A. Yeah, I wouldn't say it's a new  
21 opinion. I think it's inherent in my report.  
22 The fact is by quoting Mr. Peters, and by quoting  
23 and referring to the Digital Control case, I  
24 think it's there.

25 BY MR. GIZA:

1 Q. So where exactly in your report is it?

2 A. Well, I just --

3 MS. ROBERTS: Objection to form.

4 A. Just the fact that they're -- my  
5 paragraph 18, I point out that they breached  
6 their Duty of Candor and Good Faith after I've  
7 outlined that duty being defined in the original  
8 Rule 56, and in the 1992 amended Rule 56.

9 So I point out what the duty is, but  
10 very specifically. And I said, I believe in my  
11 opinion that the -- Mr. Geller and his attorney  
12 Mr. Edkin breached their Duty of Candor and Good  
13 Faith in failing to do it.

14 So I think a fair reading of my report  
15 is that, having defined what the duty is, under  
16 Digital Control, and I said they breached the  
17 duty, that I was applying both the pre and the  
18 post-rule as I articulated that rule in the  
19 earlier parts of my report.

20 Now, you indicated that you didn't  
21 think that was the case, and I wanted to be sure  
22 that this record was clear that I do believe that  
23 the two aspects of the 1992 rule were breached,  
24 and I used Digital Control, in effect, as  
25 authority for saying that, if you are urging the

1 allowance of a claim, as you are when you file it  
2 in the Patent and Trademark Office, and the  
3 material not disclosed is inconsistent with that,  
4 that that does breach the Duty of Candor and Good  
5 Faith.

6           So I wouldn't characterize as a new  
7 position, but I want to make sure that that is my  
8 position, and articulate that at this deposition.

9 BY MR. GIZA:

10 Q. So is there anywhere in your report  
11 that you expressly discuss that the undisclosed  
12 prior art refutes, or is inconsistent with a  
13 position that the applicant took?

14 MS. ROBERTS: Objection, form.

15 A. I believe it's inherent in my report  
16 where I do talk about the Digital Control case,  
17 which is where they make that statement.

18           And I quote, in my paragraph 11 on  
19 page 8, that, "Under the section information is  
20 material to patentability, when it is cumulative  
21 to information -- when it is not cumulative to  
22 information already of record, and it establishes  
23 by itself or in combination with other  
24 information a prima facie case of unpatentability  
25 or it refutes or is inconsistent with a position

1 that the applicant takes in opposing an argument  
2 of unpatentability" -- I don't think he's done  
3 that -- "or asserting an argument of  
4 patentability."

5 I think under Digital Control, they  
6 say that urging the allowance of a claim which  
7 you do when you file it in a patent application  
8 that has an oath and declaration with it, you're  
9 doing that. So I'd say asserting an argument of  
10 patentability is covered, and it's covered under  
11 Digital Control. That's why they say that  
12 Digital Control has both -- the new and the old  
13 rule are still applicable.

14 BY MR. GIZA:

15 Q. Okay. I understand your current  
16 belief that it is inherent in your report.

17 Is there anywhere that the argument  
18 that the undisclosed prior art refutes or is  
19 inconsistent with the position that the applicant  
20 took, expressly made in your report?

21 MS. ROBERTS: Objection, form.

22 A. I'd say yes, and it's expressly made  
23 in the quotation of Mr. Stanley Peters, where he  
24 says, "The prior art patents cited in the '067  
25 patent in combination with Dasan and Siefert