

UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

WALTER KIDDE PORTABLE EQUIPMENT,)
INC.,)

Plaintiff,)

vs.)

FIRST ALERT, INC. AND BRK BRANDS,)
INC.,)

Defendants.)

ORIGINAL

Case No.
6:22-CV-566-ADA-DTG

VIDEOTAPED DEPOSITION OF JOHN PRATT, PH.D.

Irvine, California

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Volume I

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09:55:02 1 A I do.

09:55:03 2 Q And Conforti similarly refers to a technique to

09:55:10 3 prevent closure of the device when batteries are not

09:55:15 4 present; right, sir?

09:55:15 5 A It does.

09:55:20 6 Q If you flip to Paragraph 242, there's a reference

09:55:23 7 to "Byrne '354."

09:55:26 8 Do you see that?

09:55:26 9 A I do.

09:55:27 10 Q And Byrne '354 similarly refers to preventing

09:55:33 11 closure of the device if the battery is missing; is that

09:55:37 12 correct?

09:55:37 13 A Yes.

09:55:48 14 Q So each of DeLuca '487, Belano '240, and Byrne

09:55:56 15 refer to a device that presents -- prevents the closure of

09:56:02 16 the lid of the device when the battery's not present;

09:56:05 17 correct?

09:56:05 18 MR. SOSKIN: Objection.

09:56:06 19 THE WITNESS: Yes.

09:56:07 20 BY MR. KAZI:

09:56:07 21 Q And is it fair to refer to that as a battery

09:56:10 22 lock-out mechanism?

09:56:13 23 A That's fair.

09:56:15 24 Q Now, you reviewed Mr. DeLuca's transcript; right,

09:56:19 25 sir?

[REDACTED]

09:56:19 1 A I believe I did, yes.

09:56:22 2 Q And do you recall where Mr. DeLuca testified that

09:56:28 3 for a sealed-in battery product, you don't need a battery

09:56:32 4 lock-out mechanism?

09:56:35 5 A I -- I don't recall specifically.

09:56:37 6 Q Well, sir, do you agree that with the sealed-in

09:56:43 7 battery product, you don't need a battery lock-out

09:56:46 8 mechanism because the battery's already sealed in?

09:56:48 9 A I would agree.

09:57:09 10 Q Did you talk to any engineers at First Alert at

09:57:11 11 any point?

09:57:18 12 A No, I don't believe so.

09:57:22 13 Q Did you talk to Mr. Swieboda? Does that name

09:57:26 14 sound familiar?

09:57:27 15 A The name sounds familiar. I think I saw his

09:57:31 16 deposition transcripts or -- the name is familiar, but

09:57:35 17 I -- I don't recall talking with him.

09:57:37 18 Q Well, I'm not intending to trip you up, but I

09:57:40 19 thought there's somewhere in the report that you said you

09:57:43 20 talked to Swieboda.

09:57:44 21 And if there is --

09:57:45 22 A If there is, then I did. But I don't recall as I

09:57:48 23 sit here.

09:57:48 24 Q Well, if there is, I'll find it during the break

09:57:50 25 and we can ask about that.

10:04:24 1 Q And you said no prosecution history estoppel
10:04:27 2 events that you're aware of?
10:04:27 3 A Not that caught my attention, that's right.
10:04:30 4 Q Are you aware of or do you have any recollection
10:04:32 5 of any other material changes to the scope of the claims
10:04:35 6 in the file history?
10:04:37 7 A Not that I felt was relevant to these reports.
10:04:40 8 Q Do you believe the examiner did a good job in
10:04:43 9 their analysis of the patents?
10:04:44 10 MR. SOSKIN: Objection.
10:04:57 11 THE WITNESS: Yeah, I don't have an opinion.
10:04:59 12 BY MR. KAZI:
10:04:59 13 Q In your review of the file history, did you
10:05:01 14 identify any errors that the examiner made?
10:05:04 15 A Not that I -- not that caught my attention.
10:05:07 16 Q Did you identify any misstatements by the
10:05:09 17 applicant that you thought were important?
10:05:11 18 A No.
10:05:15 19 Q Did you identify any prior art that the examiner
10:05:19 20 analyzed incorrectly for some reason?
10:05:21 21 MR. SOSKIN: Objection.
10:05:22 22 THE WITNESS: No.
10:05:30 23 BY MR. KAZI:
10:05:30 24 Q So with respect to Exhibit 1, sir, we talked
10:05:39 25 about DeLuca '487 already, and you mentioned Malewski,

10:19:32 1 reattachment-prevention activation -- re- -- re-pre- --
10:19:38 2 reattachment-prevention mechanism that was known in the
10:19:40 3 art prior to the filing of these patents.
10:19:44 4 MR. SOSKIN: Can I have that -- just the first
10:19:45 5 part of that first sentence of that read back, please
10:19:50 6 read.
10:19:51 7 MR. KAZI: Or just the whole answer.
10:19:52 8 MR. SOSKIN: Yeah. Sure. That's fine.
10:19:53 9 (Record read as follows:)
10:19:04 10 "I don't believe they were
10:19:05 11 known in the art. There was attachment
10:19:11 12 mechanisms known in the art --
10:19:14 13 Watson '487 with -- Watson's
10:19:26 14 activation-prevention mechanism was
10:19:28 15 known in the art, but I'm not aware of a
10:19:32 16 reattachment-prevention activation --
10:19:36 17 re- -- re-pre- --
10:19:38 18 reattachment-prevention mechanism that
10:19:39 19 was known in the art prior to the filing
10:19:42 20 of these patents."
10:20:36 21 BY MR. KAZI:
10:20:36 22 Q The answer was a little jumbled, so let me just
10:20:39 23 ask one more time --
10:20:40 24 A Yeah. Thank you.
10:20:41 25 Q -- just for clarity of the record.

[REDACTED]

10:20:42 1 Are you aware of whether reattachment-prevention
10:20:53 2 mechanisms were known in the art prior to the filing of
10:20:55 3 the DeLuca patents?

10:20:59 4 A I'm not aware of reattachment-prevention
10:21:03 5 mechanisms for preventing reattachment of the second
10:21:05 6 portion to a first portion as disclosed in these patents.
10:21:10 7 I'm not aware of the presence of that in the art prior to
10:21:15 8 the filing of these patents.

10:21:21 9 Q Would a person of ordinary skill in the art know
10:21:25 10 the structure involved in attaching a smoke alarm to a
10:21:31 11 mounting bracket?

10:21:34 12 MR. SOSKIN: Objection.

10:21:34 13 THE WITNESS: Yes.

10:21:38 14 BY MR. KAZI:

10:21:39 15 Q And what is that structure?

10:21:40 16 A Well, generally -- it's not limited to this, but
10:21:43 17 generally, the structure is -- it's a bayonet-type
10:21:48 18 structure requiring placing the second portion against the
10:21:52 19 first portion and then rotating the second portion with
10:21:54 20 respect to the first portion.

10:22:03 21 That connection device is typically called a
10:22:09 22 "bayonet connector."

10:22:12 23 MR. KAZI: My real time's not working.
10:22:18 24 We could fix it at a break.

10:22:21 25 MR. SOSKIN: Oh, that's right.

12:53:11 1 A You destroy the alarm. But Byrne -- Byrne
12:53:14 2 teaches cutting the wire.

12:53:24 3 Q Do any of the replaceable batteries systems teach
12:53:30 4 a technique for permanently deactivating those replaceable
12:53:37 5 batteries systems?

12:53:38 6 A To the extent that you can put in a new battery
12:53:40 7 means that they're not permanently deactivated. They --
12:53:44 8 they don't teach any means of deactivation, other than,
12:53:48 9 like I said, cutting the wire in Byrne's '311 or removing
12:53:52 10 the batteries.

12:53:54 11 Q And you would agree with me, sir, that a system
12:53:57 12 with replaceable batteries, while you can remove
12:54:00 13 batteries, you can always add the batteries back as well;
12:54:03 14 correct?

12:54:04 15 A That's correct.

12:54:05 16 Q And so removing the batteries wouldn't be a
12:54:08 17 permanent way to deactivate the device; correct?

12:54:11 18 A That is correct.

12:54:20 19 Q Would a person of ordinary skill in the art be
12:54:52 20 motivated to modify a system that uses replaceable
12:54:56 21 batteries to make it such that you could permanently
12:54:59 22 deactivate it?

12:55:01 23 A Well, it's -- I think the answer to that is yes,
12:55:10 24 especially in view of Byrne '311.

12:55:14 25 Q So why would a person of ordinary skill in the

[REDACTED]

12:55:18 1 art take a system that uses replaceable batteries and then
12:55:20 2 modify it so that the system could be permanently
12:55:25 3 deactivated?

12:55:27 4 A Well, there's a -- on the replaceable battery
12:55:43 5 units, there's a ten-year life limit on the alarms
12:55:47 6 themselves. So while you may replace batteries every year
12:55:52 7 or two in a replaceable battery unit, at some point in
12:55:57 8 time you're going to want to get rid of the alarm itself
12:56:02 9 and replace it after, say, a ten-year period.

12:56:10 10 So having some means to deactivate -- permanently
12:56:15 11 deactivate the alarm so that it doesn't get reused would
12:56:21 12 make sense at the end of its useful life -- the alarm's
12:56:26 13 useful life, not the battery's.

12:56:29 14 Q If you could turn to Paragraph 728 of your
12:56:31 15 opening report, sir.

12:56:40 16 A Okay.

12:56:43 17 Q And you'll agree that Watson does not describe a
12:56:51 18 reattachment-prevention mechanism for preventing users
12:56:56 19 from reattaching an alarm portion to a mounting bracket
12:57:00 20 after permanent deactivation?

12:57:00 21 A I agree.

12:57:03 22 Q If you could turn to Paragraph 247 of your
12:57:06 23 opening report.

12:57:17 24 A I'm there.

12:57:18 25 Q In Paragraph 247, you state that -- and I'm

[REDACTED]

01:00:40 1 (As read:)

01:00:41 2 "A reattachment-prevention

01:00:43 3 mechanism to prevent reattachment of the

01:00:46 4 first and second portions once the

01:00:48 5 second portion is permanently

01:00:49 6 deactivated."

01:00:50 7 Right?

01:00:52 8 A Yes.

01:00:54 9 Q Is it your understanding of that claim language

01:00:57 10 that the claim language is satisfied if -- strike that.

01:01:27 11 Do you interpret the reattachment-prevention

01:01:29 12 mechanism to require -- or to prevent any subsequent

01:01:43 13 attempts to reattach portions of the alarm?

01:01:45 14 MR. SOSKIN: Objection.

01:01:47 15 THE WITNESS: Whether -- whether it's been

01:02:06 16 deactivated or not? Is -- is -- is that your --

01:02:10 17 BY MR. KAZI:

01:02:10 18 Q Well, that's a good clarification. So let me add

01:02:13 19 that to my question.

01:02:14 20 A Okay.

01:02:14 21 Q After an alarm has been deactivated, does the

01:02:19 22 reattachment-prevention mechanism of Claim 12 require the

01:02:24 23 prevention of all subsequent attempts to reattach portions

01:02:29 24 of the alarm?

01:02:31 25 A Yeah. Given my understanding of the plain and

01:02:34 1 ordinary meaning of "permanently deactivated," the answer
01:02:39 2 is yes.

01:03:06 3 Q But in Malewski, what you're pointing to is the
01:03:19 4 reattachment-prevention mechanism does not prevent all
01:03:27 5 subsequent attempts to reattach portions of the alarm;
01:03:33 6 right, sir?

01:03:34 7 A That's correct. One could reattach the Malewski
01:03:36 8 by just pushing in that key, whether the alarm is
01:03:42 9 deactivated or dead or not.

01:04:08 10 Q In -- can you pull up your rebuttal report, sir?

01:04:19 11 A Okay.

01:04:20 12 Q And specifically I'm looking at 153.

01:04:41 13 MR. SOSKIN: Paragraph or page?

01:04:42 14 MR. KAZI: Paragraph.

01:04:42 15 BY MR. KAZI:

01:05:04 16 Q And I have here, sir, a P1010 with its packaging,
01:05:08 17 which I will hand over to you with the packaging.

01:05:12 18 MR. KAZI: I'll mark this as Exhibit --

01:05:16 19 THE STENOGRAPHER: Eight.

01:05:17 20 MR. KAZI: -- 8.

01:05:17 21 MR. SOSKIN: And you want to rephrase your
01:05:20 22 statement?

01:05:22 23 THE WITNESS: You said it was a P1010.

01:05:25 24 MR. KAZI: P1210. Thank you.

01:05:27 25 Yeah. So just to be clear: What I'm marking as

[REDACTED]

03:29:18 1 That's all that's shown here. I mean, it leaves
03:29:58 2 open -- it leaves the door open for other things, but yes,
03:30:02 3 that's -- that's -- it says what it says.

03:30:07 4 MR. KAZI: Going to hand you a document that
03:30:08 5 we've marked as Exhibit 12.

03:30:15 6 Is that right? Exhibit -- do you know what
03:30:16 7 exhibit we're on?

03:30:17 8 THE STENOGRAPHER: 13.

03:30:18 9 MR. KAZI: 13.

03:30:18 10 (Exhibit 13 was
03:30:36 11 marked for identification.)

03:30:36 12 BY MR. KAZI:

03:30:41 13 Q Do you recognize Exhibit 13?

03:30:42 14 A Yes.

03:30:43 15 Q Exhibit 13 is Malewski; right, sir?

03:30:46 16 A It is.

03:30:47 17 Q If you could turn to Paragraph 573 of your
03:30:50 18 opening report. Let me know when you're there.

03:31:01 19 A I'm there.

03:31:01 20 Q Now, Paragraph 573 is your description of -- or
03:31:05 21 your analysis of the Malewski reference as it relates to
03:31:09 22 the permanent-deactivation mechanism limitations; is that
03:31:15 23 correct?

03:31:15 24 A Yes.

03:31:20 25 Q Now, you don't actually rely upon Malewski to

03:31:25 1 disclose permanent deactivation; is that correct?

03:31:27 2 MR. SOSKIN: Objection.

03:31:28 3 THE WITNESS: Yeah, I don't contend that Malewski

03:31:34 4 discloses permanent deactivation.

03:31:38 5 BY MR. KAZI:

03:31:38 6 Q You rely on the teachings of Watson to disclose

03:31:42 7 permanent deactivation; correct?

03:31:44 8 A Watson does disclose permanent deactivation, yes.

03:31:47 9 Q And for the purpose of your opinions here with

03:31:51 10 respect to Malewski, you rely upon the teachings of Watson

03:31:55 11 to render obvious the limitation relating to permanent

03:31:58 12 deactivation; is that correct?

03:32:06 13 A Would you repeat that please?

03:32:09 14 Q Sure.

03:32:09 15 I'll just ask it again because I -- my real time

03:32:12 16 here is not working.

03:32:18 17 THE STENOGRAPHER: You want me to read it,

03:32:19 18 Counsel?

03:32:20 19 MR. KAZI: Yes, please.

03:32:20 20 (Record read as follows:)

03:31:47 21 "And for the purpose of your

03:31:50 22 opinions here with respect to Malewski,

03:31:52 23 you rely upon the teachings of Watson to

03:31:55 24 render obvious the limitation relating

03:31:57 25 to permanent deactivation; is that

03:45:45 1 could, but that's not taught in Watson -- how to
03:45:49 2 reactivate it once it's been deactivated.

03:45:52 3 Q Now, you're referring to the second switch as a
03:45:55 4 deactivation switch but Watson refers to it as a
03:45:57 5 battery-drain position; right?

03:45:59 6 A You might be right.

03:46:01 7 Q So in Watson, Watson equates "deactivation" with
03:46:07 8 battery drain; is that correct?

03:46:08 9 MR. SOSKIN: Objection.

03:46:08 10 THE WITNESS: Well, Watson has a battery drain.
03:46:11 11 He doesn't necessarily equate "deactivation" --
03:46:13 12 "deactivation" is defined by the specification in claims
03:46:17 13 of the '158 and '445 patent in terms of this patent
03:46:22 14 infringement case --

03:46:22 15 BY MR. KAZI:

03:46:22 16 Q But in terms --

03:46:23 17 A Not -- not by the prior art patents.

03:46:25 18 Q In terms of your descriptions you just offered,
03:46:28 19 you referred to the battery drain switch of Watson as a
03:46:32 20 deactivation switch; is that correct?

03:46:33 21 A I did.

03:46:44 22 Q Now, as you just explained, Watson discloses a
03:46:50 23 switch that allows it to be activated. And the question
03:46:53 24 Malewski raises is that, once you deactivate it, it's
03:46:58 25 unclear whether you could reactivate it.

03:47:01 1 Is that fair?

03:47:01 2 A Watson is silent to that, yes.

03:47:04 3 Q And that's an issue that Malewski identifies as a

03:47:16 4 problem in the prior art; is that correct?

03:47:19 5 A Yes.

03:47:35 6 Q And it's a problem in the prior art from the

03:47:38 7 perspective of Malewski at least in the -- in the -- the

03:47:43 8 scenario that's recited here in column one, lines 30

03:47:50 9 through 32, where the device needs to be deactivated

03:47:53 10 during shipment; right? Let me withdraw that and ask

03:47:57 11 it -- a different question.

03:48:02 12 Once the device has been activated, what Malewski

03:48:07 13 says is you can't ship that device -- strike that.

03:48:13 14 Malewski says it's undesirable to ship an

03:48:16 15 activated device or hold that activated device in

03:48:23 16 inventory; correct?

03:48:24 17 A Because of battery life.

03:48:26 18 Q Is it just battery life or is it also safety

03:48:30 19 concerns for shipping?

03:48:31 20 A Well, he didn't say safety concerns. He talks

03:48:35 21 about --

03:48:35 22 Q Oh, you're right. Battery life?

03:48:36 23 A -- battery life.

03:48:54 24 Q Would you agree that Malewski is criticizing the

03:49:02 25 fact that Watson's disclosure does not specify or clarify

03:50:45 1 THE WITNESS: I'd have to go through Malewski
03:50:48 2 again, read the patent.
03:50:49 3 BY MR. KAZI:
03:50:49 4 Q But sitting here today as you've reviewed column
03:50:53 5 one, at least, are you aware of any other objective that
03:50:59 6 Malewski frames as relevant to its invention, other than
03:51:03 7 the ability to reactivate after deactivation?
03:51:07 8 A Yeah, my recollection is that's -- that's what he
03:51:10 9 brings to the party is reactivation -- a multiuse switch.
03:51:29 10 MR. KAZI: Okay. I'm going to pass the witness.
03:51:31 11 MR. SOSKIN: All right. Just give me -- we'll go
03:51:33 12 off the record.
03:51:34 13 THE VIDEOGRAPHER: The time is 3:51 p.m.
03:51:38 14 We are now off the record.
03:51:40 15 (Break in proceedings.)
03:58:54 16 THE VIDEOGRAPHER: The time is 3:58 p.m.
03:59:08 17 We are now back on the record.
03:59:11 18 ---oOo---
03:59:12 19 EXAMINATION
03:59:12 20 BY MR. SOSKIN:
03:59:13 21 Q All right. If we can go to --
03:59:16 22 Peter Soskin. I represent First Alert. I'm
03:59:19 23 going to ask you a few questions on redirect.
03:59:21 24 If you go to Exhibit 1, please, to Paragraph 244.
03:59:35 25 A I'm there.