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September 16, 2025

Deposition of ROBSON F. STOREY, PH.D.,

ROUGH DRAFT

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1 THE VIDEOGRAPHER: Here begins Media Number 1 in
2 the videotaped deposition of Robson F. Storey, PhD, in
3 the matter of Brook Whittle, LTD versus Nestle USA,
4 Inc., et al. in the United States District Court
5 Eastern District of Texas Marshall Division. Case
6 Number 2:24-CV-00735-JRG-RSP.

7 Today's date is September 16th, 2025. And
8 the time on the video monitor is 11:06 a.m. Central
9 Time.

10 The remote videographer today is Benjamin
11 Zicardi representing Planet Depos. All parties of
12 this video deposition are attending remotely.

13 Would counsel please voice-identify
14 themselves and state whom they represent.

15 MR. SHI: Good morning, everyone. My name
16 is Lindsey Shi of the law firm Kirkland & Ellis. On
17 behalf of the plaintiff Brook & Whittle, Ltd. With me
18 today is Brandon Brown and Julien Crockett, both of
19 whom are also with Kirkland & Ellis.

20 MR. BENNETT: Hello, everyone. I'm John
21 Bennett of Frost Brown Todd. I represent defendants.
22 And I'm joined by Paul Linden and Derek Freitas also
23 of Frost Brown & Todd. And I also represent the
24 witness, Dr. Storey.

25 THE VIDEOGRAPHER: The court reporter today

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1 is Jill Doctor representing Planet Depos.

2 Would the reporter please swear in the
3 witness.

4 ROBSON STOREY, PHD,
5 having been first duly sworn,
6 was examined and testified as follows:

7 EXAMINATION

8 BY MR. SHI:

9 Q. Good morning, Dr. Storey. How are you
10 doing?

11 A. Good morning. Thank you.

12 Q. Dr. Storey, just to reintroduce myself, my
13 name is Lindsey Shi. And I represent Brook & Whittle
14 in these proceedings.

15 Would you please state your full name for
16 the record.

17 A. Yes. The full name is Robson, middle
18 initial F, Storey.

19 Q. And, Dr. Storey, where are you currently
20 located?

21 A. Hattiesburg -- well, I'm sitting in Oxford,
22 Mississippi, at the moment. But my main residence is
23 in Hattiesburg, Mississippi.

24 Q. Dr. Storey, have you been deposed before?

25 A. Yes.

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1 Q. How many times?

2 A. Maybe -- I don't know precisely. Perhaps
3 between 15 and 20 times.

4 Q. When was the last time you were deposed,
5 Dr. Storey?

6 A. I think it was approximately one year ago.

7 Q. If you think about the 15 to 20 times that
8 you've had your deposition taken, were they all in the
9 context of you providing testimony as an expert
10 witness?

11 A. Yes.

12 Q. Have you ever been deposed, for instance, in

13 connection with a car accident or something personal
14 involving yourself?

15 A. No.

16 Q. Okay. What kinds of cases -- strike that.

17 Have you ever testified in court before,

18 Dr. Storey?

19 A. Yes.

20 Q. How many times?

21 A. Probably about five.

22 Q. In each of those five cases where you

23 testified in court, was your deposition also taken in

24 those proceedings?

25 A. Yes.

1 Q. Okay. At a high level, can you describe
2 what kinds of cases you've provided testimony for,
3 whether it be deposition testimony or live trial
4 testimony?

5 A. I have -- I have testified in several patent
6 infringement cases. I'm searching my memory. I think
7 there was also, like, we didn't use to call them
8 interparty reviews, they were -- but they were
9 challenge -- like a challenge case. And I have also

10 testified in, I think, at least one product liability
11 case.

12 Q. All right. So if we set aside that product
13 liability case for the time being, what I heard you
14 say was the remainder of your testifying experiences
15 have been a mix of patent infringement lawsuits, like
16 the one we have in front of us, and also cases in
17 front of the patent office.

18 Is that accurate?

19 A. Yes.

20 Q. So, again, setting aside the product
21 liability case, with the remaining cases,
22 approximately how many were in district court
23 litigation, like the one we have here, and
24 approximately how many were in front of the patent
25 office?

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1 A. I think they've all been in either a federal
2 district court or, perhaps, a state court. I don't
3 think I've ever done anything in front of the patent
4 office.

5 Q. Let me reask the question.

6 Have you ever had your deposition taken in
7 connection with a case that was in front of the patent
8 office? Or in front of the PTAB, I should say.

9 A. No. To my knowledge, no.

10 Q. So, again, in connection with any IPR
11 proceeding or PGR, or EPR I suppose, you've never had
12 your deposition taken?

13 A. I think that is correct, yes.

14 Q. Okay. At a high level, can you describe the
15 subject matter of the, you know, approximately dozen
16 or 15 cases that you've provided testimony for?

17 A. Yes. The very last one that I was involved
18 in was a patent infringement case that dealt with the
19 protective coatings on the inside of beverage cans
20 such as beer cans. These would be polymer films that
21 protect the contents from the metal can and the metal
22 can from the contents. So that was one that I recall.

23 Another one dealt with biodegradable
24 polymers -- actually, two of them dealt with
25 biodegradable polymers. These are polyester polymers

1 that are used for controlled drug delivery in the
2 human body. And those had to do with specific polymer

3 types and whether or not specific products had certain
4 compositions. Those are the ones that are foremost in
5 my mind.

6 Another one that I dealt with was also
7 biomedical, and it had to do with catheter balloons.
8 And, in fact, that one was at the Eastern Texas
9 District in, I think, Marshall Texas.

10 Q. Outside of the case involving catheter
11 balloons, have you given deposition testimony or trial
12 testimony in any other case in the Eastern District of
13 Texas?

14 A. No.

15 Q. Okay. You just mentioned a handful of
16 cases, maybe three or four cases involving polymers.

17 If you think back to your other testifying
18 experiences, did those cases also involve polymers?

19 A. Yes.

20 Q. Would you say -- strike that.

21 What percentage of the cases that you've
22 provided testimony for involve polymers?

23 A. I believe 100 percent.

24 Q. Okay. Let me ask about that products
25 liability case you mentioned a moment ago.

1 Can you tell me what product or products are
2 at issue in that case?

3 A. Yes. It was -- it's been a while.

4 It was a biomedical implant, a catheter.

5 That's what it was. It was a catheter that failed in
6 use during a surgery.

7 Q. And just to be clear, this catheter that
8 failed during surgery was part of a different case
9 than the other catheter case you previously mentioned,
10 which was a patent infringement case.

11 Is that correct?

12 A. Yes. That's right. The case that I
13 mentioned was in the Eastern District of Texas was
14 balloon catheters, and this is an entirely different
15 matter. Yes.

16 Q. What percentage of your previous cases would
17 you say involve catheters in some way?

18 A. I would say just those two.

19 Q. Okay. If you think about all of your
20 testifying experiences, outside of polymers or polymer
21 science, has there been a common thread or a trend or
22 a specialty that you found yourself working inside of?

23 MR. BENNETT: Objection. Form.

24 THE WITNESS: It's -- well, I would say it's
25 always polymers, as I mentioned. But I've had -- I

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1 guess we could say that I've had a preponderance of
2 activity in the biodegradable area, and also in the
3 elastomers area, like those balloon catheters.

4 BY MR. SHI:

5 Q. What do you mean when you say biodegradable?

6 A. Mostly, I mean polyesters such as
7 polyglycolic acid, polylactic acid, copolymers of
8 those. Polycaprolactone. Those are all polyester
9 polymers that are used -- they're approved for use in
10 the human body as various things, such as drug
11 delivery depots, surgical sutures, other surgical
12 materials, like pins and screws and so forth. And
13 they are designed, once in the body, to eventually
14 bioabsorb into the body so that you do not have to
15 remove them eventually. For example, in a second
16 surgery.

17 Q. Understood.

18 So in that sense, at a high level,
19 biodegradable -- the cases that you've been a part of
20 that have to do with biodegradable polyesters, it's

21 not that they're biodegrading out in the environment,
22 but, rather, in a human body.

23 Is that accurate?

24 A. Well, I would say that it's accurate insofar
25 as what you said is true; but let me just amend it

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1 slightly by saying that there are uses for
2 biodegradable polymers outside of the human body.
3 For example, there are -- you can find
4 biodegradable picnic plates, forks, knives, and spoons
5 of the, you know, plastic variety that everybody is
6 used to, but they are made of materials such that
7 if -- if they are thrown out, you know, carelessly
8 into the environment, or even, in some cases,
9 landfilled, that they will -- that they will
10 biodegrade so that they're no longer present as the
11 polymer in the environment. So it can be outside of
12 the human body.

13 Q. Thanks for that context, Dr. Storey. I
14 think I understand what you're saying.

15 But just to confirm, the cases that you
16 personally have been a part of that involve

17 biodegradable polymers all have had to do with human
18 body or medical device applications.

19 Is that fair?

20 A. I think that is -- I think that is fair and
21 true, yes.

22 Q. How many of your cases that you've been a
23 part of have had to do with recycling, would you say?

24 A. None so far before this.

25 Q. All right. So given that you've been

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1 deposited many times before, I don't have to spend a ton
2 of time going over the ground rules. And we have been
3 talking a lot already.

4 But just so that we're all on the same page,
5 let me just go over some ground rules very quickly.

6 Dr. Storey, it's important that you respond
7 audibly to all my questions because the court reporter
8 is taking down everything that both of us are saying.

9 Does that make sense?

10 A. Yes.

11 Q. You've been good about this so far, but just
12 be sure that rather than nod or shake your head, you
13 answer the questions verbally yes or no.

10 Q. From time to time today, your attorney,
11 Mr. Bennett, may object to my questions. He just did
12 so. But do you understand that unless your attorney
13 instructs you not to answer, you will still need to
14 answer the question?

15 Do you understand that?

16 A. Yes, I understand that.

17 Q. All right. If you would like to take a
18 break at any time, just let me know and we can take a
19 break. The one thing I ask is if there is a question
20 pending, you please answer the question before we take
21 a break.

22 Is that fair?

23 A. Yes.

24 Q. Dr. Storey, do you understand that you are
25 under oath today?

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1 A. Yes.

2 Q. Is there anything that is preventing you
3 from testifying completely and truthfully today?

4 A. No.

5 Q. Do you have any questions for me about how
6 this deposition is going to work?

7 A. No.

8 Q. Can we go off the record very quickly?

9 MR. BENNETT: Sure with me. That's fine

10 with me.

11 MR. SHI: Thank you.

12 THE VIDEOGRAPHER: We are going off the

13 record. The time is 11:22 a.m.

14 (OFF THE RECORD AT 11:22 a.m. PT.)

15 (ON THE RECORD AT 11:25 a.m. PT.)

16 THE VIDEOGRAPHER: The time is 11:25 a.m.

17 We are back on the record.

18 BY MR. SHI:

19 Q. Dr. Storey, in your own words, can you

20 describe what you believe the purpose of today's

21 deposition to be?

22 A. I believe that it is in order to question me

23 about the claim construction declaration that I

24 submitted.

25 Q. What did you do to prepare for the

1 deposition today?

2 A. I met with John Bennett and Paul Linden

3 several times by remote, like Teams meeting.

4 Q. Was anyone else present at these meetings,
5 aside from Mr. Bennett and Mr. Linden?

6 A. In most cases, no. But at least in one
7 case -- no, two cases, there were -- there were
8 additional people.

9 In one case, there was an attorney, I think,
10 from Defendants' organization, a lady. Her name --
11 first name was Chantel, but I didn't catch the last
12 name. And then on a second occasion, there was two --
13 there were two attorneys, both, I think, from
14 Defendants' organization. And it was Chantel again
15 and then, I believe, the other person was a male.
16 First name, Scott.

17 Q. When you say Defendants' organization, do
18 you know if that was Nestle or Fuji Seal or both?

19 A. I don't know. And that's really why I said
20 Defendant. I wasn't -- I'm not sure.

21 Q. And that's okay. This is not a memory test.
22 When you say you met with Mr. Bennett and
23 Mr. Linden several times, can you provide a ballpark
24 figure?

25 A. Yes. I think it was exactly five times.

1 Q. You met with Mr. Bennett and Mr. Linden
2 exactly five times. And one of those five times, it
3 was with an attorney named Chantel, and another time
4 it was with both Chantel and Scott.

5 Is that fair?

6 A. That is absolutely exactly what happened.

7 Q. Approximately how long were each of these
8 meetings?

9 A. They varied. One was as short as
10 30 minutes. And I believe the longest one was not
11 quite two hours.

12 Q. In any of these five meetings, did you
13 review documents as part of your preparation?

14 A. Yes.

15 Q. What documents did you review?

16 MR. BENNETT: Dr. Storey, I instruct you not
17 to answer on the basis of attorney work product.

18 [Simultaneous speaking.]

19 MR. BENNETT: As far as the question was
20 asked about documents you reviewed during our
21 sessions.

22 BY MR. SHI:

23 Q. Dr. Storey, are you going to follow your
24 attorney's instruction?

25 A. Absolutely, yes.

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1 Q. Outside of the meetings with the attorneys
2 and your review of documents, did you do anything else
3 to prepare for your deposition?

4 A. Yes. I read over my own deposition. I read
5 over the patent. I read over the patent filed
6 history. And I read Dr. Erin Askounis's declaration.

7 Q. When you said you read over your own
8 deposition, I assume you mean you read over your own
9 declaration.

10 Is that right?

11 A. Oh. Yeah, I must have misspoke. I didn't
12 realize I said that. Yes. My own declaration. Yes.
13 Thank you.

14 Q. That's okay. I just want to be sure the
15 record is clear.

16 Can you tell me from when to when you
17 started and ended your preparation for the deposition?

18 A. Let's see. I think it -- I think it began
19 one week prior -- one week from yesterday. So that
20 would be a Monday, whatever date that is. So it's

21 been, like, eight days. But spread out. You know,
22 these small meetings have been scheduled as time
23 allowed, I think is what dictated that.
24 Q. So from September 8th to September 15th, you
25 prepared for your deposition by meeting with your

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1 attorneys, reviewing documents including your
2 declaration, the '422 patent, the file history, and
3 Dr. Askounis's declaration.
4 Is there anything else that you did in
5 preparation for your deposition today?
6 A. Yes. I also reviewed the extrinsic evidence
7 that was submitted both by myself -- the extrinsic
8 evidence that was included in my declaration. And
9 there were also, I believe, three pieces that were
10 submitted by plaintiff with Dr. Askounis's
11 declaration. And I reviewed those.
12 And I also reviewed -- just one moment. It
13 was a post grant proceeding, a preliminary response in
14 this Multi-Color case.
15 I'm sorry. My phone is ringing. I've got
16 to turn this thing off. It is -- it is silent. I
17 don't know why we heard that. I apologize.

18 And I think that is all, sir.

19 Q. Understood.

20 Just so the record is clear and we've got a
21 clear answer on this, the sum total of the documents
22 you reviewed in preparing for your deposition today
23 included your declaration submitted in this case, the
24 '422 patent file history, the '422 patent,
25 Dr. Askounis's declaration, the extrinsic evidence

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1 submitted by both parties, and certain documents
2 submitted in connection with a post grant proceeding
3 involving the '422 patent submitted by the Multi-Color
4 Corporation.

5 Do I have that correct?

6 A. Yes, sir.

7 Q. Okay. Are you familiar with the post grant
8 proceedings that you just mentioned involving the
9 Multi-Color Corporation?

10 A. Only insofar as the preliminary response
11 document that I -- that I read. That I reviewed.

12 Q. Were you retained as an expert in those
13 proceedings?

14 A. No.

15 Q. Are you aware that the company, American
16 Fuji Seal, Inc. has filed a petition for interparty's
17 review of the '422 patent?

18 A. Yes.

19 Q. And you were retained as an expert in those
20 proceedings; correct?

21 A. Yes.

22 Q. And you, in fact, submitted a declaration in
23 connection with that petition for IPR.

24 Is that correct?

25 A. Yes.

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1 Q. Okay. You were also retained by Defendants
2 in this case; correct?

3 A. I don't understand that question. Sorry.

4 Q. So the present case is Brook & Whittle
5 Limited as the plaintiff and the defendants are Nestle
6 and Fuji Seal International. You were retained as an
7 expert witness in this District Court litigation;
8 correct?

9 A. The one we're talking about now?

10 Q. Yes.

11 A. Yes.

12 Q. When were you retained?

13 A. I'm not quite certain of the date. Maybe

14 June, May or June of this year, perhaps. Let me think

15 back.

16 Probably May. May of this year. May

17 of 2025.

18 Q. May 2025 was prior to when American Fuji

19 Seal filed the IPR; correct?

20 A. I believe that is correct, yes, sir.

21 Q. Are you being compensated for your work and

22 opinions in this case?

23 A. Yes.

24 Q. Can I ask what your billing rate is,

25 Dr. Storey?

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1 A. Yes, you may ask.

2 Q. What is your billing rate?

3 A. It is \$600 per hour.

4 Q. How many hours have you billed to this case

5 so far?

6 A. This is going to be only an estimate.

7 Probably around 80, maybe.

8 Q. Has anyone assisted you in the work that
9 you've done for this case?

10 MR. BENNETT: Objection. Form.

11 BY MR. SHI:

12 Q. Let me rephrase.

13 Do you have an assistant or someone at the
14 university, for instance, who assists you with the
15 work that you do on this case?

16 A. I do. I do. But I've always considered --
17 I'm just trying to think if I've had anybody assist me
18 with this particular piece, this claim construction.
19 But in general, yes. In general, I do have a person
20 at the university who can run errands for me, who can
21 run certain tests for me. Yes.

22 Q. Did you do any testing in connection with
23 coming to your claim construction opinions?

24 A. No. I don't believe for claim construction.

25 Q. When you say that there is someone at the

1 university who can run errands for you, are you
2 talking about administrative errands, or is this
3 person someone that you're conferring with to reach

4 your opinions?

5 A. The former. Someone who can retrieve
6 something for me, like a -- if I'm looking for -- for
7 example, if I'm looking for a certain textbook that I
8 don't have at my house. I could call upon this person
9 and ask him to locate that for me at the university.
10 Often, it will simply be on someone's desk in the
11 polymer science and engineering department. And then
12 he might bring that book to me so that I might refer
13 to it. I can borrow it, in a sense.

14 Q. What is this person's name who runs errands
15 for you?

16 A. Michael Blanton.

17 Q. Has Mr. Blanton run tests on your behalf in
18 connection with your claim construction opinions?

19 A. No.

20 Q. And have either you or Mr. Blanton run tests
21 generally in connection with your work on this case?

22 MR. BENNETT: Objection.

23 I instruct you not to answer on the basis of
24 attorney work product.

25 BY MR. SHI:

1 Q. Dr. Storey, are you going to follow your
2 attorney's instruction?

3 A. Yes.

4 Q. Dr. Storey, when you said you estimated
5 around 80 hours of work on this case, does that
6 include your work on the American Fuji Seal IPR, or
7 are you considering that separately?

8 A. I was adding everything together. Both.
9 Both.

10 Q. Thank you.

11 So out of the 80 hours spent in total, how
12 many of those were spent on the IPR? And how many of
13 those were spent on the District Court litigation?

14 A. Probably about -- if I said 80 total,
15 probably about 60 on the IPR and approximately 20 or
16 so on this one. These are very approximate answers.

17 Q. Okay. Outside of Mr. Blanton, have any
18 other assistants helped you on either the IPR or the
19 District Court litigation?

20 A. No.

21 Q. Okay. Is Mr. Blanton a student at the
22 university?

23 A. No. He is a full-time technical employee.
24 He is a former student, whom I taught, but for many,

25 many years, he -- he's been what we would call a

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1 technician at the university.

2 Q. And just so we're clear for the record --

3 and I think I was the one who said this first. But

4 when I say the university, are we referring to the

5 University of Southern Mississippi?

6 A. That is correct.

7 Q. All right. Is Mr. Blanton someone who --

8 strike that.

9 Has Mr. Blanton reviewed the declaration

10 that you submitted in this case in connection with

11 claim construction?

12 A. No.

13 Q. Okay. Did you confer with Mr. Blanton in

14 arriving at any of your claim construction opinions?

15 A. No.

16 Q. I'd like to introduce as Exhibit 1, a

17 document titled Robson F. Storey - CV.

18 (DEPOSITION EXHIBIT NUMBER 1

19 WAS MARKED FOR IDENTIFICATION.)

20 THE TECHNICIAN: One moment.

21 MR. SHI: Thank you, Mr. Pantoja.

22 And for the record, this is a document
23 bearing a Bates number starting with BW0007383.
24 BY MR. SHI:
25 Q. Dr. Storey, can you see the exhibit on the

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1 screen?
2 A. I can, yes. Thank you.
3 Q. And I believe you're also able to download
4 it from the -- from the chat function in Zoom.
5 Do you see that?
6 A. Let me see. Oh, yeah. I do. Yeah. May I
7 try that?
8 Q. Sure. I think if you just click it, it
9 should let you download.
10 A. Okay. Oh, yeah. Okay. Let me just -- bear
11 with me. I want to be able to put it on my desktop.
12 I can't figure out how to do this. I'm so sorry.
13 Q. That's okay. Why don't we go off the record
14 for a brief moment while Dr. Storey downloads the
15 document.
16 MR. BENNETT: Sounds good.
17 THE VIDEOGRAPHER: We are going off the

18 record. The time is 11:43 a.m.
19 (OFF THE RECORD AT 11:43 a.m. PT.)
20 (ON THE RECORD AT 11:44 a.m. PT.)
21 THE VIDEOGRAPHER: The time is 11:44 a.m.
22 We are back on the record.
23 BY MR. SHI:
24 Q. So, Dr. Storey, if you look on the screen,
25 can you see Exhibit 1 in front of you?

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1 A. Yes, I can.
2 Q. You were also able to download Exhibit 1;
3 correct?
4 A. Yes. So I'm looking at it in two different
5 places. Yes.
6 Q. And just to confirm, you don't have anything
7 else open on your computer or desktop.
8 Is that right?
9 A. Nothing at the moment, no. These two
10 things. I had to close everything to find it on my
11 desktop.
12 Q. Is Exhibit 1 your current curriculum vitae?
13 A. Yes.
14 Q. All right. Under the address of Exhibit 1,

15 you've listed an address for the University of
16 Southern Mississippi.

17 Do you live on campus, Dr. Storey?

18 A. No, I do not.

19 Q. So this is a work address.

20 Is that correct?

21 A. That is -- that is correct.

22 Q. Okay. You mentioned that you are currently
23 in Oxford, Mississippi, but your main residence is in
24 Hattiesburg.

25 Is that correct?

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1 A. That is correct.

2 Q. You graduated in 1978 with two degrees, one
3 in mathematics and one in polymer science, from the
4 University of Southern Mississippi.

5 Is that correct?

6 A. Yes.

7 Q. And then in 1983, you received a PhD in
8 polymer science from the University of Akron in Akron,
9 Ohio.

10 Is that right?

11 A. That is correct.

12 Q. After receiving your PhD, you became a
13 professor of polymer science at the University of
14 Southern Mississippi; correct?

15 A. Actually, I was, for one year, at American
16 Cyanamid Company. And then I went to the University
17 of Southern Mississippi.

18 Q. I see.

19 Under education, it looks like you received
20 that PhD in 1983; correct?

21 A. That is correct. Officially. All degree
22 requirements had been completed in 1982, but the
23 official graduation, where you walk and you get your
24 diploma, did not occur until the -- May of 1983.

25 Q. Understood.

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1 So if I have the timeline correct, you
2 finished all your degree requirements in '82, and then
3 for approximately one year, you worked at the American
4 Cyanamid Company. And then in 1983, you formally
5 received that PhD.

6 Is that correct?

7 A. That is correct. And then -- that was in

8 May. And then -- and I was still at Cyanamid at that
9 time. And then in the fall of that same year, 1983,
10 that is when I started as an assistant professor.

11 Q. From 1983 to 1992, you were an assistant or
12 associate professor of polymer science at the
13 University of Southern Mississippi.

14 Is that correct?

15 A. That is correct.

16 Q. And then from 1992 all the way to 2021, you
17 held the position of professor of polymer science and
18 engineering at the University of Southern Mississippi.

19 Is that correct?

20 A. That is correct.

21 Q. You retired in 2021?

22 A. Yes, that is correct.

23 Q. And so as professor emeritus, that means
24 you're no longer teaching; correct?

25 A. That is correct.

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1 Q. Do you still do any research at the
2 university?

3 A. I don't have -- the answer to that is really

4 no. I don't have any laboratory that is my own or
5 grant money that's my own, but I -- I am able to use,
6 you know, certain facilities there, like the library.
7 And everybody knows me there, if I could put it that
8 way.

9 Q. Understood.

10 If you think about the ways you've occupied
11 your time since 2021, how much of your current job, if
12 you can call it a job, post retirement, is providing
13 expert opinion?

14 A. So you're really asking me, like, in
15 retirement, what fraction of my time is spent doing
16 this?

17 Is that --

18 Q. Yeah. Let me rephrase the question.

19 Are you currently working post retirement,
20 would you say?

21 A. I would -- I would call it -- yes. That I
22 am working. Yes. Like self-employed, yes.

23 Q. Right. And so I wasn't asking how much of
24 your total time is spent providing expert testimony, I
25 just wanted to know how much of your working time

1 would you say is spent providing expert testimony and
2 opinions.

3 A. Oh, I understand the question now.

4 I would say not 100 percent, but the vast
5 majority. I still -- I'll just give you an example.
6 I still am active as an emeritus professor. One good
7 example of this is, I continue to chair the
8 International Waterborne High Solids and Powder
9 Coatings Symposium, which is an annual symposium that
10 our school puts on.

11 So I still do that. So there are things
12 like that, but I would say I'm doing no other work
13 beyond that, other than expert witness work.

14 Did that make any sense at all? I hope it
15 did.

16 Q. It did make sense.

17 So if -- if you were to put a percentage on
18 it, how much of your post retirement working time is
19 spent providing expert testimony and opinions?

20 A. I'll say about -- about 90 percent would be
21 about right.

22 Q. At what point in your career did you start
23 providing testimony in lawsuits?

24 A. Let's see. I think it goes back to the
25 mid1990s, probably.

1 Q. So approximately 30 years.

2 Is that fair?

3 A. Yeah. That sounds fair. Yeah.

4 Q. So over the last 30 years, you've provided
5 testimony in, roughly, 15 cases, 5 of which you
6 provided trial testimony.

7 Is that fair?

8 A. Yes, but I would also say that I have been
9 involved in some cases where I never testified. It's
10 common that I might help an attorney, let's say, with
11 something, and then it settles or I just never hear
12 from the attorney again. So there have been a few
13 things like that where I never provided any testimony.

14 Q. Approximately how many cases were you
15 retained but never provided any testimony, as you
16 described?

17 A. Yeah. I don't really know.

18 Q. Is it --

19 A. I couldn't say.

20 Q. Is it fewer than ten?

21 A. It's probably fewer than 15.

22 Q. Okay. If we focus on the actual 15 or so
23 cases where you provided testimony over the last
24 30 years, would you say that those cases have been
25 roughly spread out, approximately one every two years,

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1 or has -- have there been more cases in recent years
2 or fewer cases in recent years?

3 MR. BENNETT: Objection. Form.

4 THE WITNESS: I would say it's been fairly
5 spread out over the years. But it's -- it's decidedly
6 fits and starts. So over that 30 years, I might go
7 for a period when I had nothing going on. So, you
8 know, it's not -- it's not absolutely spread out, just
9 level all the way through.

10 BY MR. SHI:

11 Q. If you think about the 15 or so cases that
12 you've provided testimony for, approximately how many
13 of them were on behalf of plaintiffs and how many were
14 on behalf of defendants?

15 A. I would say it's fairly even. It's probably
16 approximately 50/50.

17 Q. And so if -- similar question. If we think
18 about the 15 or so cases that you've provided

19 testimony for, if we focus on the patent cases, how
20 many of them were on behalf of patent owners and how
21 many were on behalf of accused infringers?
22 A. Let's see. Probably slightly more on behalf
23 of accused infringers. But there is -- there has been
24 both, for sure, as -- according to my other answer.
25 Q. Is it close to 40 percent patent owners,

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1 60 percent accused infringer?
2 A. I don't know. I apparently should have
3 looked at my history more closely before I came today.
4 I don't know. Honestly. I don't want to
5 speculate.
6 Q. Okay. Let me scroll down in Exhibit 1,
7 which is your CV.
8 If we look at the research interests, I see
9 a lot of polymer-based phrases. There is no
10 recyclability or recycling-related topics in your
11 research; correct?
12 A. It doesn't say that there, no, no. But as a
13 practicing polymer science scientist, I am aware of it
14 and I've taught it. But, no, I've never -- I've never

15 really had a research emphasis in that. These are
16 just, you know, research emphases that I have lots of
17 papers dealing with.

18 Q. Okay. So to be clear, you haven't listed
19 any specific recycling topics in your research
20 interest in your CV; correct?

21 A. That is correct.

22 Q. All right. Just a second ago, you mentioned
23 that you've taught recycling. So let me go to the
24 teaching experience of your CV.

25 A. Mm-hmm.

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1 Q. Dr. Storey, can you point out to me which of
2 these classes, if any, involved you teaching
3 recycling?

4 A. Yeah.

5 The one that you see there, organic -- it's
6 the one, two, three -- the third one down. Organic
7 Polymer Chemistry I, junior undergraduate. That one
8 has discussion of recycling in some of the polymer
9 types that we discuss there.

10 And I think that there is another. Could
11 you scroll down. Wait. I've got one on my desktop.

12 Let me go look.

13 Yeah. That one, the very end, "The Polymer
14 Industry, an introduction to the major commercial
15 polymers, raw material sources, and the organization
16 of the polymer industry." We cover recycling in that
17 class as well.

18 So that's a sophomore class. And the other
19 one is a junior-level class.

20 Q. The word recycling isn't mentioned in the
21 description that you have in your CV of either of
22 those classes; correct?

23 A. Correct.

24 Q. How often did you teach Organic Polymer
25 Chemistry I, the junior undergraduate class?

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1 A. I've taught that every year for probably the
2 last -- until I retired. Up until retirement, for
3 probably 35 years.

4 Q. Okay. Same question with respect to The
5 Polymer Industry class, the sophomore undergraduate
6 class.

7 How frequently did you teach this class

8 while you were teaching?

9 A. Not -- not very frequently. And the reason
10 is simple. This is normally a class that a junior
11 faculty member gets stuck with. And so, you know,
12 when I was a junior faculty -- I did this a few times,
13 but I kind of graduated from it as I became senior.

14 Q. I see.

15 So the class is somewhat of an Alcatraz,
16 that if you're a junior member of the team, you end up
17 being stuck teaching; but as soon as someone else
18 junior comes along, they take over?

19 A. I hate to put it quite like that, but that's
20 a pretty fair characterization. Yes.

21 Q. I see that the last piece of the description
22 of this class is "the organization of the polymer
23 industry."

24 Is the polymer industry as a whole sort of
25 the context in which you're discussing recycling in

1 this class?

2 A. That -- that is fair. What we mean by
3 organization of the polymer industry is, basically,
4 polymer uses. So, like, examples of the

5 organizational structure would be the coatings
6 industry, the paint and coatings industry. That would
7 be one. The plastics industry. The rubber industry.
8 The composites industry. So that's what we mean by
9 the organization.

10 Q. Mm-hmm.

11 A. And principally, recycling would be when we
12 discuss the plastics industry.

13 Q. I see.

14 So would you say that recycling is a fairly
15 common topic in the discussion of the plastics
16 industry?

17 MR. BENNETT: Objection. Form.

18 THE WITNESS: I would say it's not really
19 the focus of that class, but it is certainly mentioned
20 because it's a contemporary societal concern. And we
21 want our students to be at least exposed to the issue
22 of recycling.

23 BY MR. SHI:

24 Q. All right. Your CV is very long. You've
25 certainly published a lot and, you know, you're very

1 well studied.

2 If we think about the PhD dissertations and
3 the master's theses that you've directed or supported,
4 I don't expect you to go line by line, but off the top
5 of your head, can you think of any of these that focus
6 on recycling?

7 A. I don't -- I wouldn't characterize any of
8 them to have focused on recycling.

9 Q. Understood. Let me scroll further down,
10 then.

11 And we're now at the lectures section of
12 your CV, which is on Page 9.

13 Dr. Storey, can you think of any of these
14 many lectures that you listed here that focused on
15 recycling?

16 A. Yes. Let me see. Because for a time --
17 bear with me. Scroll to, please -- if you see the
18 headings, they're dated. If you go to 2011, you'll
19 see a -- see that entry, biodegradable polymers,
20 Virginia Tech?

21 So this was a visiting lecture that I gave
22 by invitation at Virginia Tech. And although the
23 topic of this was on biodegradable polymers, it did
24 touch on the topic of recycling. Because if you
25 remember, the biodegradable polymers that I mentioned

1 earlier, that involved consumer polymers like picnic
2 plates, knives, forks, and spoons, those are largely
3 made of polyesters that are meant to degrade in the
4 environment. And those are related to recycling in
5 the sense that they are actually poisons. You know,
6 you don't want those kinds of polymers to enter a
7 recycling stream because they are not stable -- they
8 are, by design, not stable, and so you don't want to
9 have them enter the recycling stream.

10 So at least some of the work that I've done
11 on biodegradable polymers is sort of tangentially
12 related to recycling in that sense.

13 Q. So if I'm understanding you correctly,
14 Dr. Storey, biodegradable polymers are related to
15 recycling in that you don't want those particular
16 polymers to enter a recycling stream?

17 A. That is correct. That's what I'm saying.
18 Yes.

19 Q. Outside of this 2011 Virginia Tech lecture,
20 can you think of any of these other lectures that
21 relate to recycling?

22 A. Well, there are -- I don't -- that's the

23 only one that I remember because I was teaching as an
24 invited lecturer in a class. And I was asked, you
25 know, to relate to those sorts of things. And that's

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1 the only one I can think of off the top of my head
2 that did involve recycling.

3 Q. All right. Same -- I'm just going to have
4 similar questions throughout each section of your CV,
5 so you can probably see where I'm going next.

6 If we -- I think you have roughly 14 pages
7 of lectures in your CV.

8 And so -- here. On Page 24 of your CV,
9 Exhibit 1, you have research grants awarded.

10 Dr. Storey, do you see that?

11 A. I do.

12 Q. Do you know if any of these research grants
13 specifically relate to recycling?

14 A. Let's see. I don't think so, but let me
15 just scroll through and see if something jumps out at
16 me.

17 Q. All right. And I believe your grants span
18 from Page 24 to 41 of your CV.

19 A. Okay. Thank you.
20 I think the answer to your question is no.
21 Q. All right. If we go to Page 41 of your CV,
22 Exhibit 1.
23 A. Mm-hmm.
24 Q. I believe this is where articles and book
25 chapters are listed.

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1 Do you see that, Dr. Storey?
2 A. I do.
3 Q. Do any of these articles or books, to your
4 knowledge, focus on or relate to recycling in some
5 way?
6 MR. BENNETT: Objection. Form.
7 THE WITNESS: No, I don't think so.
8 MR. BENNETT: Mr. Shi, we've been going a
9 little over an hour. Might I propose that we have a
10 short bio break and then maybe a half hour or so on
11 the record before lunch. Would that work?
12 MR. SHI: Yeah. I was thinking that we'd go
13 until 10:30; but if we need a bio break, I'm happy to
14 do that. And then we can go for another half hour.
15 MR. BENNETT: Perfect.

16 Is that okay, Dr. Storey?
17 THE WITNESS: That would be appreciated,
18 actually.
19 MR. SHI: Let's do that, then.
20 THE VIDEOGRAPHER: We are going off the
21 record. The time is 12:09 p.m.
22 (OFF THE RECORD AT 12:09 p.m. PT.)
23 (ON THE RECORD AT 12:18 p.m. PT.)
24 THE VIDEOGRAPHER: The time is 12:18 p.m.
25 We are back on the record.

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1 MR. SHI: Could we please have Exhibit 1
2 back up on the screen, please? Thank you.
3 BY MR. SHI:
4 Q. Dr. Storey, I'm going to put up Page 67 of
5 Exhibit 1, which is the section of your CV that lists
6 books edited and then conference proceedings.
7 Do you see that?
8 A. Yes, I see it.
9 Q. When you say books edited, were you editing
10 the entire book, or just chapters of it?
11 A. Those are books that I edited the entire

12 book.

13 Q. All right. And the third thing listed here
14 looks like it's proceedings of a symposium.

15 Is that correct?

16 A. That is correct.

17 Q. And is this symposium still ongoing every
18 February in New Orleans?

19 A. Yes. That's the one that I mentioned
20 earlier.

21 Q. Understood.

22 If you think about these two books listed
23 and then the symposium proceedings, can you think of
24 any way that these books or symposium proceedings are
25 related to recycling?

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1 MR. BENNETT: Objection. Form.

2 THE WITNESS: Well, at that Waterborne High
3 Solids and Powder Coatings Symposium, over the years,
4 the paint industry is -- they are concerned with
5 recycling overspray, right. So in that sense, yes,
6 occasionally, there will be a paper that speaks about
7 that topic.

8 BY MR. SHI:

9 Q. And by that topic, you're referring to
10 recycling overspray in the paint industry?

11 A. That's right. When -- in coating operations
12 that, you know, utilize a booth, a spray -- a spray
13 head, very often, there -- you know, not everything
14 you spray at the part goes onto the part, and so you
15 get what's called overspray. And there are -- there
16 is an interest in the industry to reutilize that, not
17 just to throw it away.

18 Q. Okay. Then if we look at conference
19 proceedings, I believe this spans Page 67 to 83 of
20 your CV. Just at a high level, what exactly are these
21 conference proceedings listed? Are these posters or
22 papers presented?

23 A. They are -- very often, they're either a
24 poster or an oral talk. For example, if you just look
25 at these last two, 175 and 174, so these were papers

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1 that we gave at the Americans Chemical Society [sic]
2 meeting in San Diego.

3 So what happens is a -- an abstract or
4 extended abstract is submitted, and the attendees to

5 the meeting have that. And so when they go attend
6 your poster or attend your paper, they've already been
7 able to kind of review what you've done. So commonly
8 in the -- in academia, these are called preprints.
9 That's kind of a slang term for these extended
10 abstracts that folks publish prior to a meeting.

11 Q. Thank you. That's helpful context.

12 If we look at the many pages of conference
13 proceedings you have listed, can you identify any that
14 relate to recycling?

15 MR. BENNETT: Objection. Form.

16 THE WITNESS: I don't believe any relate
17 directly to recycling.

18 BY MR. SHI:

19 Q. And the last piece of your CV, this is at
20 the bottom of Page 83 of Exhibit 1, going into the
21 final page, Page 84 of Exhibit 1. This section is
22 titled Non-Refereed Journal Articles.

23 Do you see that?

24 A. I do.

25 Q. What is a non-refereed journal article?

1 A. It is a -- it's an article that was

2 submitted to -- often, it's a trade journal, either by
3 invitation or just a submitted paper, that is not sent
4 out for peer review but would simply be edited or
5 reviewed by the editor themselves.

6 I'll give you an example. So if you look
7 at, well, just the very first one, Coating -- Coatings
8 Tech journal. The 2013 paper. That was a paper that
9 I was asked to write. I don't even recall what it was
10 about, but I was asked to write that by the editor of
11 that trade magazine. And I wrote it. And I know that
12 he did not send it out, you know, for peer review,
13 like to an independent third party to review it. So
14 that's what it means.

15 Q. Understood.

16 Outside of that most recent one in 2013, it
17 looks like these non-refereed articles span from 1984
18 to 1996.

19 Do you see that?

20 A. I do.

21 Q. It looks like the vast majority of these
22 non-refereed articles relate to coatings or paints in
23 some way.

24 Is that fair?

25 MR. BENNETT: Objection.

1 THE WITNESS: That is absolutely correct.

2 Yes.

3 BY MR. SHI:

4 Q. At this point in your career, did you have a
5 particular focus on paints or coatings?

6 A. I -- I think I can explain this. Yeah.

7 The reason -- I think the reason that there
8 is a preponderance of coatings-type non-refereed
9 journal articles is because of my association with the
10 waterborne symposium. So I have a lot of interaction
11 with industrial folks in coatings. And that's sort of
12 how I came to write most of these.

13 Q. Okay. Understood.

14 So, Dr. Storey, we've been talking through
15 your CV. And you've mentioned in a few places that
16 certain topics, like biodegradable polymers or coating
17 technologies have a tangential relation to recycling.

18 Let me ask this: Are you familiar with the
19 organization APR?

20 A. Yes.

21 Q. And APR, to be clear, is the Association of
22 Plastic Recyclers.

23 Is that also your understanding?

24 A. Yes.

25 Q. How did you become familiar with APR?

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1 A. I just have heard about it over the years.

2 I don't -- I can't give you a specific incident.

3 Q. Can you describe, please, what -- your
4 understanding of what APR does?

5 A. I would say that they are -- there are like
6 many of these types of organizations. They are trade
7 organizations that are organized within certain
8 industries to help the industry solve problems, you
9 know, problems that everybody faces. Any issues that
10 everybody can get behind and -- you know, they're not
11 competing, they're all -- it's to everybody's benefit
12 to solve these problems, these organizations are put
13 together. They're usually -- the members are usually
14 from industry. They'll often have elected officers.
15 They'll often have external review boards. And
16 they're just there to -- as a trade organization for
17 that particular industry.

18 Q. Would you say that polymer scientists such
19 as yourself would be familiar with the APR?

20 MR. BENNETT: Objection. Form.

21 THE WITNESS: Not -- not so much because
22 I -- for my -- almost my entire career, I've been an
23 academician, and most of the folks that interact with
24 these organizations to any large extent would be
25 industrial folks. Industrial scientists and

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1 employees.

2 BY MR. SHI:

3 Q. I see.

4 So would you say that polymer scientists who
5 work in industry would be familiar with the APR?

6 MR. BENNETT: Objection. Form.

7 THE WITNESS: I would say that polymer
8 scientists that are in the plastics industry
9 definitely would. But many, many of the other
10 industries may as well also.

11 BY MR. SHI:

12 Q. Okay. Is it your understanding that the APR
13 publishes standards or guidelines on recycling certain
14 materials?

15 A. Yes.

16 Q. Is it your understanding that the APR issues
17 certificates to companies that produce materials that
18 meet certain recyclability criteria?

19 A. I'm not familiar with that.

20 Q. Okay. And then the last question I have for
21 you related to your CV, and it's -- I don't mean to
22 presuppose because this is a question that generally I
23 would ask of any expert witness.

24 But, Dr. Storey, have you ever had an
25 opinion excluded by a judge for any reason?

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1 A. No.

2 Q. Okay. Thank you. Let's take down
3 Exhibit 1. And I'd like to introduce as Exhibit 2 a
4 document titled Declaration of Dr. Robson F. Storey Re
5 Claim Construction.

6 (DEPOSITION EXHIBIT NUMBER 2
7 WAS MARKED FOR IDENTIFICATION.)

8 THE TECHNICIAN: One moment while I locate
9 that. Sorry. The folder that I had open for that is
10 frozen at the moment. It's taking a while to load.

11 MR. SHI: If that's the case, why don't we
12 just break for lunch here before we get into the next

13 exhibit. And then we can pick up after the break.

14 MR. BENNETT: Okay.

15 THE VIDEOGRAPHER: We are going off the

16 record. The time is 12:30 p.m.

17 (OFF THE RECORD AT 12:30 p.m. PT.)

18 (ON THE RECORD AT 1:03 p.m. PT.)

19 THE VIDEOGRAPHER: The time is 1:03 p.m. We
20 are back on the record.

21 BY MR. SHI:

22 Q. Dr. Storey, welcome back. How was your
23 lunch?

24 A. Thank you. It was fine. I appreciate it.

25 Q. Good to hear.

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1 Shown on the screen in front of you and
2 available for download in the chat window is
3 Exhibit 2, which is your declaration that you
4 submitted in this case related to claim construction.

5 Do you see that?

6 A. I do.

7 Q. And have you been able to download it? Or
8 do you happen to have a copy of it in front of you?

9 A. I am downloading it right now.

10 Q. Okay.

11 A. Okay. I have it.

12 Q. Great.

13 And just to be clear, do you have any hard

14 copies of any documents in front of you today at your

15 deposition?

16 A. I do, but they're not open. I have a folder

17 of stuff.

18 Q. I see.

19 So you have a folder off to the side, but

20 you're not looking at anything right now?

21 A. That is correct.

22 Q. Okay. If you do crack open that folder,

23 will you let me know?

24 A. I will. Sure.

25 Q. Okay. So what's being shown on screen is

1 Exhibit 2 in front of you, and what you've been able

2 to download, is your declaration in this case.

3 Is that correct?

4 A. Yes. Yes, sir, it is.

5 Q. And I'm going to scroll to the table of

6 contents and zoom out so I can fit the entire table of
7 contents on the screen. I guess it goes to the next
8 page.

9 Dr. Storey, are you seeing the table of
10 contents of your declaration?

11 A. Yes.

12 Q. And so I note that your declaration --
13 excuse me -- is divided into four sections. And then
14 Section 4 being analysis of disputed claim terms of
15 the '422 patent.

16 Is that correct?

17 A. That is correct.

18 Q. Let me ask this before we get into it.

19 Does this declaration contain the entirety
20 of your claim construction opinions in the District
21 Court case?

22 A. Yes.

23 Q. Okay. There is nothing that you need to add
24 to the declaration that you've already submitted;
25 correct?

1 A. No.

2 Q. No, that's not correct? Or no, that there
3 is nothing you need to add?

4 A. I'm sorry. I have nothing more to add at
5 this time.

6 Q. Okay. That's what I thought you meant. I
7 just -- for the record, I needed to be clear. So
8 thank you for clarifying.

9 If we look in the table of contents of
10 Exhibit 2, in your analysis section, I see that you
11 provide an analysis of three different terms.

12 Is that correct?

13 A. That is correct.

14 Q. The first term you analyze is polyethylene
15 terephthalate, PET; correct?

16 A. Correct.

17 Q. The second term you analyze is
18 crystallizable polyethylene terephthalate, PET.

19 Is that correct?

20 A. Yes.

21 Q. The third term you analyze is comprising
22 polyethylene terephthalate, PET.

23 Is that correct?

24 A. Yes.

25 Q. You are not offering any opinions on any

1 other terms of the '422 patent; correct?

2 A. That is correct.

3 Q. Right.

4 So you don't have any opinion as to the

5 construction of the term recyclable; right?

6 A. That is correct.

7 Q. And you don't have any opinions on the

8 construction of the term wherein the recyclable shrink

9 label is recyclable with a PET container.

10 Is that correct?

11 A. That is correct.

12 Q. Now, Dr. Storey, prior to offering claim

13 construction opinions in this case, you previously

14 analyzed the '422 patent in connection with American

15 Fuji Seals' IPR petition; correct?

16 A. Yes.

17 Q. And with respect to that IPR petition, you

18 offered a declaration; correct?

19 A. Yes.

20 Q. Is everything contained within Exhibit 2,

21 which is your declaration in this case, consistent

22 with the declaration you previously submitted in

23 connection with the American Fuji Seal IPR?

24 MR. BENNETT: Objection. Form.

25 THE WITNESS: I think so.

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1 BY MR. SHI:

2 Q. Okay. You think so, meaning you don't know
3 for sure if everything is consistent, or you have no
4 reason to believe that there are inconsistencies?

5 A. I think I have no reason to believe there
6 are inconsistencies.

7 Q. Okay. Fair enough.

8 Now, within Exhibit 2, if you would look
9 with me on Page 4 where Section 2 begins, titled
10 Applicable Legal Standards.

11 Let me know when you have reached that
12 section. And I will also do my best to put it on the
13 screen. So if that's more helpful for you to follow
14 along, we can do it that way.

15 A. Okay. I am there.

16 Q. Okay. In Paragraph 11 of Exhibit 2, you
17 state that: "Certain legal principles that relate to
18 my opinions were explained to me."

19 Do you see that?

20 A. Yes.
21 Q. Dr. Storey, you're not an attorney; correct?
22 A. I am not an attorney, correct.
23 Q. Right. So you don't have any formal legal
24 training?
25 A. That is correct.

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1 Q. And so, essentially, the legal principles
2 involved in this case were explained to you by your
3 counsel; correct?
4 A. Correct.
5 Q. And all of those legal standards that you
6 believe apply to your opinions are contained within
7 Section 2 of your declaration; correct?
8 A. Correct.
9 Q. Okay. If we look at Paragraph 12 of
10 Exhibit 2, you state that it's your understanding that
11 the Court will ultimately determine the matter of how
12 specific terms are construed.
13 Is that accurate?
14 A. Yes.
15 Q. And you state that your declaration intends
16 to assist the Court in understanding how a POSITA

17 would have understood certain disputed claim terms in
18 the context of the '422 patent as of the time of the
19 invention.

20 Is that correct?

21 A. Yes.

22 Q. And so you use this acronym, POSITA.

23 Is it your understanding that POSITA refers
24 to a person of ordinary skill in the art at the time
25 of the invention?

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1 A. Yes.

2 Q. So over the course of our deposition, if I
3 say POSITA or you say POSITA, we have a mutual
4 understanding that POSITA is a person of ordinary
5 skill in the art at the time of the invention of the
6 '422 patent; correct?

7 A. Correct.

8 Q. Okay. It's true that -- strike that.

9 It's your understanding that the general
10 standard for construing claim terms is what a POSITA
11 would have understood; correct?

12 A. Right. At the time of the invention.

13 Correct.

14 Q. Okay. You understand that in order to
15 construe terms, a Court will look at both the
16 intrinsic evidence first and then extrinsic evidence;
17 correct?

18 A. Correct.

19 Q. And you have that here in Section 2 of your
20 declaration; right?

21 A. That is right. Paragraph 14. Yes.

22 Q. Okay. And you also have an understanding
23 from counsel that a claim term is indefinite if it
24 fails to inform, with reasonable certainty, a POSITA
25 about the scope of the invention; correct?

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1 A. Correct.

2 Q. Is it your understanding that terms in a
3 patent claim are generally given their plain and
4 ordinary meaning?

5 MR. BENNETT: Objection. Form.

6 THE WITNESS: That's my sense of it, yes.
7 Because in the -- in the matters that I've been
8 involved in, we -- we don't construe every -- every
9 term or every limitation. So, yeah, I would say that

10 many of the claim terms would be given their plain and
11 ordinary meaning.

12 BY MR. SHI:

13 Q. Right.

14 You've been involved in more than a dozen
15 patent cases in the past; right?

16 A. That is correct.

17 Q. And you, yourself, are an inventor on
18 several patents; right?

19 A. Yes.

20 Q. And -- well, let me ask this: Have any of
21 your patents ever been litigated before?

22 A. No.

23 Q. Okay. So you know that, generally, not
24 every term of a patent claim will be construed by a
25 Court; correct?

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1 MR. BENNETT: Objection. Form.

2 THE WITNESS: Yes, I do understand that.

3 BY MR. SHI:

4 Q. And so for the terms of a claim that are not
5 construed, we are to give those terms their plain and

6 ordinary meaning; correct?

7 A. That is my understanding. Yes.

8 Q. You didn't list that understanding in

9 Section 2 of your declaration, though; right?

10 A. Well, in Paragraph 12, I do say specific
11 terms. So that -- that implies to me that not every
12 term, but certain specific terms are construed by the
13 Court.

14 Q. Right. I see that.

15 I'm just asking that nowhere in Section 2 of
16 your report did you write that you have an
17 understanding that the terms that are not construed
18 are given their plain and ordinary meaning; right?

19 A. No. I didn't write that in here. No.

20 Q. And similarly, you didn't write that,
21 generally, the terms in a patent claim are given their
22 plain and ordinary meaning; right?

23 A. I did not write that either.

24 Q. Do you have an understanding when claim
25 construction will deviate from the plain and ordinary

1 meaning of a term?

2 MR. BENNETT: Objection. Form.

3 THE WITNESS: I am aware of reasons how that
4 might happen.

5 BY MR. SHI:

6 Q. Right.

7 So for instance, if the patentee in the
8 specification of a patent recites an express
9 definition, that would be an appropriate reason to
10 deviate from the term's plain and ordinary meaning.

11 Would you agree?

12 A. I agree.

13 MR. BENNETT: Excuse me, Dr. Storey. Let me
14 object.

15 Objection. Form.

16 BY MR. SHI:

17 Q. Okay. You didn't write your understanding
18 of that concept in Section 2, though; correct?

19 A. No. I did not explicitly say that. No.

20 Q. Did counsel provide that concept to you?

21 MR. BENNETT: I instruct you not to answer.

22 Objection.

23 I instruct you not to answer on the basis of
24 work product. Unless --

25 [Simultaneous speaking.]

1 MR. BENNETT: I beg your pardon.

2 Unless you relied upon it in forming your
3 opinions that are contained in your declaration.

4 MR. SHI: Yeah. Let me reask the question.

5 I see the issue here.

6 BY MR. SHI:

7 Q. Dr. Storey, earlier, you stated that you
8 agreed that in the case of a specification reciting an
9 express definition, that would be an appropriate
10 reason to deviate from a term's plain and ordinary
11 meaning.

12 Do you recall saying that?

13 A. I do.

14 MR. BENNETT: Excuse me, Dr. Storey.

15 Objection. Form.

16 BY MR. SHI:

17 Q. Now, do you have that understanding because
18 of Counsel's instruction to you?

19 A. I've known that for a long time, both as an
20 expert witness and as an inventor on many patents
21 myself.

22 Q. Mm-hmm.

23 Would you agree that it might be appropriate

24 to deviate from the plain and ordinary meaning of a
25 term if there is evidence of disavowal of the full

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1 claim scope?

2 MR. BENNETT: Objection. Form.

3 THE WITNESS: Yes. For example, during
4 prosecution, this could happen. Yes.

5 BY MR. SHI:

6 Q. Okay. You didn't write that concept in
7 Section 2 of your declaration; right?

8 A. That is correct. I did not write it.

9 Q. Do you have an understanding of that concept
10 from counsel or from your own experience or something
11 else?

12 MR. BENNETT: Dr. Storey, I instruct you not
13 to answer insofar as it will reveal communications
14 with you that upon which you're not relying to form
15 your opinions. At least from counsel.

16 THE WITNESS: I am aware of the concept.
17 I've been involved in the prosecution of many of my
18 own patents. And I know that sometimes claims scopes
19 must be narrowed to overcome prior art. I've been
20 involved in doing it myself in prosecuting -- well,

21 when attorneys have prosecuted my own patents for
22 which I am an inventor.

23 BY MR. SHI:

24 Q. All right. So we've identified two -- or
25 strike that.

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1 We've agreed upon two reasons that one might
2 deviate from a term's plain and ordinary meaning,
3 which is an express definition under the specification
4 or a clear disavowal of claim scope.

5 Are you relying on either of those methods
6 of deviating from plain and ordinary meaning in your
7 declaration?

8 MR. BENNETT: Objection. Form.

9 THE WITNESS: Yes.

10 BY MR. SHI:

11 Q. Which one?

12 A. The disavowal.

13 Q. Mm-hmm. So you're relying on the disavowal
14 method of deviating from a term's plain and ordinary
15 meaning, but you didn't write anything about disavowal
16 in the legal standard section; correct?

17 MR. BENNETT: Objection. Form.

18 THE WITNESS: That's correct. I did not
19 talk about disavowal in that section.

20 BY MR. SHI:

21 Q. Other than express definition or disavowal,
22 are there any other reasons that you're aware of that
23 will justify deviating from a term's plain and
24 ordinary meaning?

25 MR. BENNETT: Objection. Form.

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1 THE WITNESS: The only thing I could think
2 of would be if the judge just did it, just decided to
3 do it.

4 BY MR. SHI:

5 Q. Okay.

6 A. I think that could happen.

7 Q. So outside of express definition or
8 prosecution history, disavowal, or a judge deciding
9 him or herself to construe the claims, you're not
10 aware of any other justification for deviating from
11 the term's plain and ordinary meaning; correct?

12 MR. BENNETT: Objection. Form.

13 THE WITNESS: I don't think of anything else

14 at the moment as I sit here.

15 BY MR. SHI:

16 Q. Okay. Let's take a look at Paragraph 16 of
17 Exhibit 2, which is where you talk about the
18 indefiniteness standard. We went over it a moment
19 ago.

20 Do you see Paragraph 16?

21 A. Yes.

22 Q. You indicate that it's your understanding
23 that determining indefiniteness rests on the
24 reasonable certainty that a POSITA would have about
25 the scope of the invention.

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1 Is that fair?

2 A. That is what I understand. Yes.

3 Q. What is the test to a reasonable certainty?

4 MR. BENNETT: Objection. Form.

5 THE WITNESS: Well, I look at it in the
6 following way: If a POSITA reads the claim in the
7 context of the specification and prosecution history
8 and, if, after doing so, the POSITA is still uncertain
9 about what's -- I guess the boundaries of the claim or

10 the scope of the claim, then it hasn't met the
11 reasonable certainty standard.

12 BY MR. SHI:

13 Q. Reasonable certainty doesn't mean absolute
14 certainty; correct?

15 MR. BENNETT: Objection. Form.

16 THE WITNESS: I think that's fair, yes.

17 BY MR. SHI:

18 Q. Okay. So, basically, there is some daylight
19 between reasonable certainty and absolute certainty?

20 MR. BENNETT: Objection. Form.

21 THE WITNESS: I think that's right. I'm not
22 an attorney, but I think that's right because,
23 otherwise, you would not need the adjective,
24 reasonable.

25 BY MR. SHI:

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1 Q. So I understand you're not an attorney, but
2 based on your own understanding, some uncertainty is
3 okay; right?

4 MR. BENNETT: Objection. Form.

5 THE WITNESS: I don't know.

6 BY MR. SHI:

7 Q. Okay. Let's go to Section 3 of your
8 declaration, Exhibit 2, which contains an overview of
9 the '422 patent, starting with a discussion of the
10 definition of a POSITA.

11 Do you see that?

12 A. Yes.

13 Q. Okay. So looking at Paragraph 17 of
14 Exhibit 2, you state that it is your opinion that a
15 POSITA would have a bachelor's degree in chemistry,
16 chemical engineering, polymer science, or a related
17 field, and two years of experience in designing,
18 manufacturing, or evaluating heat shrink film used for
19 packaging or labelling containers; right?

20 A. Correct.

21 Q. When you say two years experience, are you
22 talking about industry experience?

23 A. Yes.

24 Q. Okay. And in this particular case, we're
25 talking about the plastics industry; right?

1 A. I didn't restrict it to that. But that
2 would be very typical, yes.

3 Q. Okay. So a typical POSITA with respect to
4 the '422 patent would have two years of experience in
5 the plastics industry?

6 MR. BENNETT: Objection. Form.

7 THE WITNESS: Two years experience in
8 designing, manufacturing, or evaluating heat shrink
9 film used for packaging or labelling containers. That
10 would probably take place within the packaging
11 industry. Or -- excuse me. That would probably take
12 place within the plastics industry, is what I meant to
13 say.

14 BY MR. SHI:

15 Q. Understood. And thank you for clarifying
16 that.

17 Earlier, Dr. Storey, you mentioned that
18 practitioners in the industry -- excuse me.

19 Earlier, Dr. Storey, you mentioned that
20 practitioners in the plastics industry would be
21 familiar with APR guidelines on recycling.

22 Do you recall saying that?

23 A. I do.

24 Q. So is it your opinion that a POSITA, with
25 respect to the '422 patent, would also be familiar

1 with those APR recycling guidelines?

2 MR. BENNETT: Objection. Form.

3 THE WITNESS: I don't know.

4 BY MR. SHI:

5 Q. Okay. Would you agree that a POSITA would
6 have understood that the term recyclable with PET was
7 informed by industry practices and guidelines?

8 MR. BENNETT: Objection. Form.

9 THE WITNESS: Could you just repeat that?

10 BY MR. SHI:

11 Q. Sure.

12 Would you agree that a POSITA would have
13 understood that the term recyclable with PET was
14 informed by industry practices and guidelines?

15 MR. BENNETT: Objection. Form.

16 THE WITNESS: I would agree with that.

17 BY MR. SHI:

18 Q. Okay. Would you agree that a POSITA would
19 have understood that achieving recyclable with PET
20 status generally would have involved meeting
21 industry-recognized benchmarks?

22 MR. BENNETT: Objection. Form.

23 THE WITNESS: I don't know.

24 BY MR. SHI:

25 Q. Okay. We can come back to that in a second.

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1 Can you tell me, Dr. Storey, what your

2 familiarity with PET is?

3 A. Well, I am very familiar with it. I've

4 taught its synthesis properties and uses for probably

5 35 years at the university. I have a couple of

6 papers. I had one student who did some terephthalic

7 acid-based copolymers. So, yeah, I have a good

8 familiarity with it and a very good knowledge of it.

9 Q. Would you say a POSITA would, likewise, have

10 a good familiarity with PET and a very good knowledge

11 of PET?

12 A. I would say so. PET is the most important

13 polyester. It is one of the most important packaging

14 plastics. It is a very important fiber. Any student

15 coming out of our program in polymer science and

16 engineering at the bachelor's level would know what

17 PET is, and would know what it's used for. And would

18 know things about it, you know, like what it -- the

19 fact that it is crystalline in many of the cases, for

20 example, as the fiber. So yes.

21 Q. Right.

22 So to go back to my previous question , I
23 asked whether you agree that achieving recyclable with
24 PET status, whether a POSITA would understand if that
25 status -- or achieving that status would involve

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1 meeting industry-recognized benchmarks. And you said,
2 "I don't know."

3 My question is, is it that you don't know --
4 you don't have an opinion either way if achieving
5 recyclable with PET status involves meeting
6 industry-recognized benchmarks?

7 MR. BENNETT: Objection. Form.

8 THE WITNESS: As I understood your question,
9 I thought you were asking me whether a POSITA would
10 know that.

11 Is that the question being asked? Maybe I
12 don't understand that question. You've asked it
13 twice, so perhaps I'm misanswering something.

14 BY MR. SHI:

15 Q. My question was if you agree if a POSITA
16 would have understood that achieving recyclable with
17 PET status generally involves meeting

18 industry-recognized benchmarks.

19 A. And I said, "I don't know," and I stick with
20 that answer. And I feel that the reason for that is
21 that most -- most folks that are, you know, at the
22 POSITA level are not in -- I think those are sort of
23 business decisions. They strike me as marketing and
24 business decisions that a POSITA may or may not be
25 involved with in the context of this patent. A POSITA

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1 in the context of this patent. That's why I answered,
2 "I don't know."

3 Q. So you don't have an opinion as to what a
4 POSITA would know in terms of business decisions in
5 the plastics industry?

6 A. Correct.

7 Q. Okay. Do you agree with the underlying
8 statement that achieving recyclable with PET status
9 generally involves meeting industry-recognized
10 benchmarks?

11 MR. BENNETT: Objection. Form.

12 THE WITNESS: I'm really not familiar with
13 that concept, but it sounds -- I would think it

14 possible, but I don't want to speculate.

15 BY MR. SHI:

16 Q. Okay. Do you agree that the term recyclable
17 with PET in the context of PET labels is informed by
18 established industry practices and guidelines and
19 aimed at ensuring that labels do not impede or
20 contaminate the PET recycling process?

21 MR. BENNETT: Objection. Form.

22 THE WITNESS: Yes. I tend to think of it as
23 there are -- there are strict technical reasons for
24 making choices with regard to design, composition that
25 just make sense from a recycling point of view.

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1 Whether -- my problem is, I don't -- I don't
2 know whether a POSITA needs a governing body to help
3 him or her make these technical decisions. So I think
4 that's sort of the position that I'm coming from. I
5 think that you can apply knowledge in polymer science
6 to understand what, for example, a label should be
7 composed of and what it should not be composed of in
8 order that it be recyclable with a PET container.

9 BY MR. SHI:

10 Q. Okay.

11 MR. SHI: Mr. Pantoja, can we take down
12 Exhibit 2. And I'd like to go introduce Exhibit 3, if
13 you would. I believe it is a document with Bates
14 number AFS_00000999.

15 (DEPOSITION EXHIBIT NUMBER 3
16 WAS MARKED FOR IDENTIFICATION.)

17 BY MR. SHI:

18 Q. Dr. Storey, what we're showing you as
19 Exhibit 3, which is also available for download, is
20 your declaration submitted in connection with an IPR
21 petition filed by American Fuji Seal, Inc. related to
22 the '422 patent.

23 Do you see that?

24 A. Just a moment. Not yet. Let's see. Got
25 it.

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1 Q. Okay. So let me just ask the question
2 again.

3 Dr. Storey, is Exhibit 3 a declaration that
4 you authored in support of a petition for IPR related
5 to the '422 patent that was filed by American Fuji
6 Seal?

7 A. Yes.

8 Q. Okay. I'm going to scroll down to Page 2 of

9 Exhibit 3. This is an attestation page that was

10 executed June 24, 2025.

11 Dr. Storey, is that your name and signature

12 on this page?

13 A. Yes.

14 Q. Okay. In this document, you have opinions

15 related to the '422 patent; correct?

16 A. Correct.

17 Q. And everything in this document is your

18 opinion; right?

19 A. Yes.

20 MR. BENNETT: Objection.

21 Excuse me, Dr. Storey.

22 Objection. Form.

23 THE WITNESS: Yes.

24 BY MR. SHI:

25 Q. Earlier, you told me that you had no reason

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1 to believe that there was any conflict or

2 inconsistency between Exhibit 3, your IPR declaration,

3 and Exhibit 2, your claim construction declaration;

4 correct?

5 A. Correct.

6 Q. Okay. I'm going to direct your attention to
7 Page 64 of Exhibit 3, beginning on Paragraph 111,
8 which I'm now showing on the screen in front of you.

9 Do you see that?

10 A. Yes. Let me scroll to my larger one.

11 Q. Sure. And I can make the text bigger on
12 this view as well, if it will help.

13 A. I have it.

14 Q. Okay. So in Paragraph 111 of Exhibit 3, as
15 you state: "In my experience, a POSITA in May 2021
16 would have been aware that the term recyclable with
17 PET in the context of labels for PET containers was
18 not an abstract concept, but was informed by
19 established industry practices and guidelines aimed at
20 ensuring that labels did not impede or contaminate the
21 PET recycling process."

22 Is that your opinion?

23 A. Yes. And I -- I think I answered yes to
24 that question earlier.

25 Q. Right.

1 And so it's your opinion that a POSITA, at
2 the time of the '422 patent, would have been aware
3 that to achieve recyclable with PET status, that
4 determination would be informed by established
5 industry practices and guidelines; correct?

6 A. Yes.

7 Q. Okay. Let me scroll to Page 65, within the
8 same paragraph of Exhibit 3.

9 You state that: "These guidelines often
10 address factors such as the label material itself,
11 adhesives, ink washability in caustic solutions, and
12 separability from PET flake."

13 Do you see that?

14 A. Yes.

15 Q. And let me actually scroll up to the
16 previous sentence.

17 It's your opinion that organizations, such
18 as the APR in North America and similar bodies like
19 Petcore Europe, publish design guidelines and testing
20 protocols that define criteria for the compatibility
21 of labels with PET recycling.

22 Is that your opinion?

23 MR. BENNETT: Objection. Form.

24 THE WITNESS: Where are you reading?

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1 Q. At the bottom of Page 64 of Exhibit 3 to the
2 top of Page 65 of Exhibit 3.

3 A. Yes.

4 Q. All right. So is it your opinion that a
5 POSITA would have been familiar with the published
6 design guidelines and testing protocols from the APR
7 with respect to PET recycling?

8 A. Yes.

9 Q. Okay. And then the last sentence of
10 Paragraph 111 says: "A POSITA would understand that
11 achieving recyclable with PET status, particularly for
12 widespread commercial use, generally involves meeting
13 such industry-recognized benchmarks to ensure that the
14 label contributes to, rather than detracts from, the
15 circular economy of PET."

16 Is that your opinion?

17 A. Yes.

18 Q. Okay. Is that consistent with your
19 understanding of what a POSITA would have understood
20 vis-a-vis the APR?

21 MR. BENNETT: Objection. Form.

22 THE WITNESS: Yes.

23 BY MR. SHI:

24 Q. Okay. We can put that aside. And I will go
25 back to Exhibit 2. Actually, hold on. Let's go back

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1 to Exhibit 3. I apologize.

2 Within Exhibit 3, you have a section on
3 claim construction; right? And to be clear, that
4 section starts on Paragraph 56 in Section 4, which is
5 titled Claim Construction.

6 Do you see that?

7 A. I do.

8 Q. Okay. This section contains all of your
9 claim construction opinions with respect to the IPR;
10 correct?

11 A. With respect to the IPR and temporally as
12 well. This occurred maybe two or three months ago.

13 Q. Right.

14 Earlier, you testified that you were
15 retained in the District Court case in May of 2025,
16 which is before this declaration; right?

17 A. Yes.

18 Q. All right. If we look at Paragraph 57 of
19 Exhibit 3, you offer a construction for the term
20 adjacent.

21 Is that right?

22 A. Yes.

23 Q. And you did so because you identified an
24 express definition provided in the specification of
25 the '422 patent; correct?

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1 A. Correct.

2 Q. In the next paragraph, Paragraph 58, of
3 Exhibit 3, for IPR purposes, you identified the term
4 PPR for construction.

5 Is that correct?

6 A. That is correct.

7 Q. And you did so because you identified an
8 express definition within the '422 patent itself of
9 the term PPR; correct?

10 A. Correct.

11 Q. And PPR is somewhat of a technical term;
12 right?

13 A. It is. Yes.

14 Q. Okay. And then in Paragraph 59, you discuss

15 the term -- or the phrase recyclable shrink label is
16 recyclable with a PET container.

17 Is that right?

18 A. Yes.

19 Q. And you state that you have an understanding
20 that this phrase should not be given patentable
21 weight.

22 Is that correct?

23 A. That is correct.

24 Q. What does that mean, the phrase should not
25 be given patentable weight?

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1 A. It means that it's a functional definition
2 rather than, for example, a compositional definition.

3 Q. So is it your opinion that because it's a
4 functional definition, it really has no bearing on the
5 rest of the claim?

6 A. No, that's not my opinion. I was informed
7 of this, as you can read, "I understand and have been
8 informed," but -- and it was my understanding that in
9 this case, it was because it was functional and not
10 compositional; but nevertheless, we do have to look at

11 it, as I say later on in the paragraph.

12 Q. So I understand that you've been asked to
13 assume the phrase will be given patentable weight. I
14 am just trying to get at what your actual opinion is.

15 Should this phrase have a bearing on the
16 claim, or should it not? And I'm asking you what your
17 opinion is.

18 A. Okay. Well, I -- I actually think that it
19 should.

20 Q. Okay. So in your opinion, you believe that
21 the phrase should be given patentable weight?

22 A. Yes.

23 Q. Okay. If we scroll down, you say that your
24 understanding is compatible with established PET
25 container recycling streams. And specifically, you

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1 state that it's your understanding that this phrase
2 means the label is capable of entering the PET stream
3 simultaneously with a PET container and can undergo
4 the recycling process alongside the container.

5 Is that your opinion?

6 A. Yes.

7 Q. Okay. Let me scroll down to Paragraph 60 of

8 Exhibit 3. And this is the last paragraph of

9 Section 4, which is claim construction.

10 Do you see that? It's the last paragraph.

11 A. I do.

12 Q. In this paragraph, you explain that it's

13 your understanding that there are a couple of

14 transitional words used in the patent; correct?

15 A. Yes.

16 Q. And specifically, you state your

17 understanding that the terms comprising and comprises

18 are open-ended, meaning that they don't exclude other

19 components.

20 Is that correct?

21 A. That is correct.

22 Q. And it's also your understanding that a

23 different transitional phrase -- consisting of,

24 consists of, et cetera -- are closed-ended, which

25 means that they would ordinarily exclude other

1 components or steps; correct?

2 A. That is correct.

3 Q. Okay. Outside of these four things that

4 we've identified, specifically adjacent, PPR,
5 recyclable shrink label is recyclable with a PET
6 container, and transitional phrases, you don't offer
7 any other claim construction opinions in your IPR
8 declaration; correct?

9 A. That is correct.

10 Q. In the IPR, you did not propose that
11 polyethylene terephthalate, PET needs to be construed;
12 right?

13 A. No. I did not.

14 Q. And in the IPR, you did not propose that
15 crystallizable polyethylene terephthalate, PET needs
16 to be construed; right?

17 A. Yes. Right.

18 Q. And in the IPR, you did not propose any
19 construction for the phrase comprising polyethylene
20 terephthalate, PET; correct?

21 A. That is correct.

22 Q. So for the purposes of your IPR declaration,
23 for those terms involving polyethylene terephthalate,
24 or PET, you are applying the plain and ordinary
25 meaning of those terms; correct?

1 A. Could you repeat? I'm sorry.

2 Q. Sure.

3 For the purposes of your IPR declaration,
4 for the terms involving polyethylene terephthalate, or
5 PET, you are applying their plain and ordinary
6 meaning; correct?

7 A. I don't know if that's legally what I'm
8 doing. I didn't -- I didn't construe them here. I
9 didn't say anything about them here.

10 Q. Earlier, you indicated that it was your
11 understanding that, generally, terms are given their
12 plain and ordinary meaning.

13 Is that correct?

14 A. I did say that, but I'm going to have to
15 push back on you a little bit. This -- this document,
16 I didn't -- I did not say with regard to PET that I
17 thought it should have its plain and ordinary meaning.
18 I just didn't mention it at all.

19 Q. Okay. Is it your understanding that if you
20 don't provide any proposed construction for a term,
21 that its plain and ordinary meaning would apply in
22 that instance?

23 A. No, that is not my understanding.

24 Q. Okay. So if you are not applying any
25 specific construction for PET and you're not using the

1 plain and ordinary meaning of PET, what definition of
2 PET are you using for the IPR declaration?

3 A. I didn't -- I didn't define it at all. I
4 deferred that. I haven't thought about that.

5 Q. Mm-hmm.

6 You haven't thought about what PET would
7 mean in the context of your IPR declaration?

8 MR. BENNETT: Objection. Form.

9 THE WITNESS: I haven't read, reviewed, or
10 thought about my IPR declaration since the day I
11 signed it.

12 BY MR. SHI:

13 Q. That's understandable, Dr. Storey.

14 All I'm asking is, when you signed your IPR
15 declaration and when you wrote your IPR declaration,
16 in your mind, what did you imagine PET to be?

17 MR. BENNETT: Objection. Form.

18 THE WITNESS: If we want to get into that,
19 let's go to my current declaration because that
20 defines exactly what I think the construction of PET
21 should be.

22 BY MR. SHI:

23 Q. We can get into that in a second, Dr.

24 Storey. And I will ask about your opinions in your

25 current declaration in a moment; but for now, I'm

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1 asking what definition of PET you applied in writing
2 your IPR declaration.

3 MR. BENNETT: Objection. Form.

4 THE WITNESS: The definition that I applied
5 was the polyester homopolymer that is prepared from
6 terephthalic acid or one of its esters, plus ethylene
7 glycol, and no other monomer.

8 BY MR. SHI:

9 Q. Did you write that anywhere -- sorry. Keep
10 going. I didn't realize you weren't finished.

11 A. That has always been my understanding of
12 PET. It was at the time we did this.

13 And, in fact, I will just say that really is
14 the plain and ordinary meaning of PET, what I just
15 recited.

16 Q. Okay.

17 A. But I didn't call it that here. I didn't
18 talk about it at all here.

19 Q. Right.

20 You didn't see the need to propose a

21 construction for PET here; right?

22 A. Correct.

23 Q. Similarly, you didn't see a need to propose

24 a construction for crystallizable PET here; right?

25 A. Correct.

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1 Q. And similarly, you didn't see the need to

2 propose a construction for comprising PET here;

3 correct?

4 A. Correct.

5 Q. Okay. In fact, the phrases and terms that

6 you did propose constructions for, which are adjacent

7 and PPR, you didn't provide any opinions related to

8 those terms in the District Court litigation; correct?

9 A. Correct.

10 Q. Why not?

11 A. I was not asked to.

12 Q. Who made the decision to include or not

13 include the terms you opined on in your District Court

14 declaration?

15 MR. BENNETT: Dr. Storey, I instruct you not
16 to answer on the basis of work product at this time.

17 BY MR. SHI:

18 Q. Let me ask the question differently, Dr.
19 Storey.

20 Is it true that Counsel instructed you to
21 provide an opinion on certain terms in the IPR
22 declaration and certain terms in the District Court
23 litigation?

24 MR. BENNETT: Objection. Form.

25 THE WITNESS: For the -- for Exhibit 3, I

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1 honestly cannot remember. It's been three months. I
2 haven't thought about that.

3 For the current declaration, I would say
4 that I was given -- I was tasked -- I was asked to
5 offer my opinions on certain claim terms, and that's
6 what I did.

7 BY MR. SHI:

8 Q. Mm-hmm. I think I understand that.

9 So you did not have any input on which terms
10 you would provide a construction opinion on in the
11 District Court litigation; right?

12 A. I don't think that is correct either.

13 Q. Well, help me understand -- sorry. Please,

14 go ahead.

15 A. I was involved -- yes. I was involved in

16 discussions. I remember that. But I think

17 ultimately, the attorneys decided which claim terms

18 they wished me to focus on. And I -- I took that task

19 and I completed it.

20 Q. Mm-hmm. I see.

21 So as an example, in Exhibit 3, which is

22 your IPR declaration, you do have opinions related to

23 the meaning of the phrase recyclable shrink label is

24 recyclable with a PET container.

25 Is that correct?

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1 A. Yes.

2 Q. But in Exhibit 2, which is your District

3 Court declaration, you don't offer any opinions as to

4 the construction of that phrase; right?

5 A. Correct.

6 Q. And that's because the attorneys decided

7 that you would not offer an opinion on that phrase;

8 right?

9 MR. BENNETT: Objection.

10 I instruct you not to answer on the basis of
11 attorney work product.

12 MR. SHI: Well, I believe that the witness
13 already said, "The attorneys decided which claim terms
14 they wished me to focus on," so I'm just confirming
15 that.

16 MR. BENNETT: Same objection. Same
17 instruction.

18 Do you understand, Dr. Storey?

19 THE WITNESS: Are you asking me not to
20 answer?

21 MR. BENNETT: Don't answer the question.
22 Yeah, that's what I'm asking you. Don't answer the
23 question.

24 THE WITNESS: All right. I'm not going to
25 answer on advice of counsel.

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1 BY MR. SHI:

2 Q. Okay. Fair enough.

3 Let's go back to Exhibit 2. We have been
4 talking about the definition of POSITA. And I'd like

5 to get a little bit of your understanding, Dr. Storey,
6 about what a POSITA would have known at the time of
7 the patent.

8 Sorry. I actually meant to say Exhibit 3.
9 So let's strike that.

10 Going back to Exhibit 3, I'd like to get
11 some insight as to what you believe a POSITA would
12 have known at the time of the '422 patent.

13 So I'm in Section 5 of Exhibit 3, at the
14 bottom of Page 35 of Exhibit 3. And this is a section
15 related to state of the art and technical background.

16 Do you see that, Dr. Storey?

17 A. I'm getting there.

18 Yes. Mm-hmm.

19 Q. Okay. So I believe you testified to this
20 earlier, but just so that the record is clear, it's
21 your opinion that a POSITA's general knowledge would
22 have included the widespread use of PET; correct?

23 A. Yes, that's correct.

24 Q. Is it true that at the time of the '422
25 patent, and still today, PET is a dominate material

1 for beverage and food containers?

2 A. That is absolutely correct. Yes.

3 Q. Would you agree that a POSITA would have
4 known that fact as well?

5 A. Yes.

6 Q. Is it true that at the time of the '422
7 patent and today, labels used on PET bottles need to
8 be compatible with established PET recycling streams?

9 MR. BENNETT: Objection. Form.

10 THE WITNESS: I don't think it's always
11 mandatory if -- if the label can be separated easily,
12 such as with a flotation mechanism. So that would be
13 different. It wouldn't be recycled with the bottle.

14 BY MR. SHI:

15 Q. Right. I think my question was a little bit
16 different. And you're one step ahead of me. I think
17 you're currently thinking about removal versus
18 recyclable with a bottle.

19 I was just asking if it's important that the
20 bottles need to be compatible -- or excuse me. I was
21 just asking if the labels used on PET bottles, in some
22 capacity, just need to be compatible with the
23 established PET recycling streams?

24 A. Yes. If it includes what I said, yes. I
25 agree.

1 Q. Right.

2 And when you say if it includes what I said,
3 I believe you are talking about either removing a
4 label from the PET bottle or that the label is
5 constructed in a way that allows it to be flaked with
6 the PET bottle.

7 Is that correct?

8 A. That's what I meant. Yes, that's correct.

9 Q. And a POSITA would have been aware of this
10 at the time of the '422 patent; correct?

11 A. That is correct, yes.

12 Q. When we're talking about PET recycling
13 streams, can you help me understand, what exactly is a
14 recycling stream?

15 A. Well, it's a -- well, it's many, many
16 things. So it is post consumer collection. That's
17 part of it. Delivery to a reprocessing center,
18 subjection to whatever method is being conducted at
19 that center, whether it's flotation or whether it's
20 regrind, caustic wash, or both. And then delivery of
21 the regrind, which is called recycled PET or RPET, to
22 a compounder, who then could turn it into usable

23 pellets. So that's kind of the outline of the entire
24 stream, if you will.
25 Q. Understood.

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1 So a PET recycling stream would be all of
2 the steps you just described, but specifically with
3 respect to a PET recyclable object.

4 Is that fair?

5 A. Yes. And I actually should also say that
6 PET is very nice also because it can be -- one can
7 utilize tertiary recycling, which is -- PET is
8 amenable to hydrolysis back to its constituent
9 monomers. And then brand-new PET could be made from
10 that. So that's one of the advantages of PET as
11 opposed to other polymers, like polyolefins.

12 MR. BENNETT: We've been going about an
13 hour. Can we take a break in a moment, please?

14 MR. SHI: Yeah. Let me get a couple of
15 questions in. And we can take a break in a couple of
16 moments.

17 BY MR. SHI:

18 Q. Dr. Storey, just a moment ago, you mentioned

19 hydrolysis. So I want to confirm that when you're
20 talking about hydrolysis with respect to PET, you're
21 talking about using a hydrolysis reaction to break PET
22 down, essentially, into terephthalic acid and ethylene
23 glycol.

24 Is that right?

25 A. That's what I meant. Yes, that's right.

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1 Q. Is it possible that PET can undergo
2 glycolysis as well?

3 A. Yeah. I mean, that's basically the reverse
4 of the polymerization mechanism that it is made by.

5 Q. Right.

6 So if PET undergoes glycolysis instead of
7 breaking down into terephthalic acid and ethylene
8 glycol, it will break down to BHET.

9 Is that right?

10 A. B -- what was your acronym? I'm sorry.

11 Q. BHET.

12 A. BHET. What does that stand for?

13 Q. Well, I believe it stands for
14 bis(2-hydroxyethyl) terephthalate.

15 A. Oh. All right. Ask your question again.

16 Q. Right.
17 So we were talking about the hydrolysis of
18 PET. And now I want to focus on the glycolysis of
19 PET.
20 If PET --
21 A. I understand now exactly what you're saying.
22 Q. Just so the record is clear, let me ask my
23 final question again and you can answer. And we can
24 take a break.
25 So if PET undergoes glycolysis rather than

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1 hydrolysis, instead of breaking down to form
2 terephthalic acid and ethylene glycol, PET will
3 essentially break down to BHET.
4 Is that correct?
5 A. That's correct.
6 Q. Okay. Let's take a break. Would you say
7 ten minutes? Does that sounds okay?
8 MR. BENNETT: Can we go closer to 12 or 15?
9 MR. SHI: Yeah. Yeah, let's come back
10 at the 15. And if we could get a breakout room, that
11 would be great.

12 THE VIDEOGRAPHER: We are going off the
13 record. The time is 2:04 p.m.
14 (OFF THE RECORD AT 2:04 p.m. PT.)
15 (ON THE RECORD AT 2:21 p.m. PT.)
16 THE VIDEOGRAPHER: The time is 2:21 p.m. We
17 are back on the record.
18 BY MR. SHI:
19 Q. Welcome back, Dr. Storey. During the break,
20 did you have any discussions with your counsel about
21 your testimony?
22 A. No.
23 Q. Okay. I was reviewing the transcript. And
24 there are a couple of things I want to revisit about
25 the claim construction positions in the IPR

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1 declaration, just so the record is clear on this. Let
2 me see.
3 While I prepare this, Dr. Storey, you
4 understand that a deposition is not like a regular
5 conversation, in that, we're creating a written
6 record; right?
7 A. I understand that.
8 Q. So will you forgive me if I might ask a

9 question in a different way just so we get a clear
10 record?

11 A. Yes. Go ahead.

12 Q. Okay. With respect to your claim
13 construction opinions in your IPR declaration, you'll
14 agree with me that there is essentially no overlap
15 between the terms you've offered for construction in
16 your IPR declaration and the terms that you've offered
17 in your District Court declaration; right?

18 A. Let me review the section for a moment,
19 please.

20 Q. Sure.

21 A. So your question was, are they mutely
22 exclusive, I believe.

23 Q. I'll ask the question again.

24 Would you agree with me that there is
25 essentially no overlap between the terms you've

1 offered for construction in your IPR declaration and
2 the terms you've offered in your District Court
3 declaration?

4 A. Well, I -- I offered adjacent in the IPR,

5 and I did not offer that in -- in the claim
6 construction.

7 I offered a construction of PPR, or
8 commented on it, and I did not in the claim
9 construction declaration.

10 And recyclable shrink label is recyclable
11 with a PET container, I offered that in the IPR
12 declaration, but I did not offer that in the claim
13 construction.

14 I did mention that I understood the meaning
15 of compromising, I believe, in both. So that's my
16 understanding.

17 Q. Okay. So outside of the transitional term
18 comprising, which, itself, is not a disputed term in
19 any of the proceedings, there is no overlap between
20 the terms you've offered for construction in the IPR
21 and the terms that you're opining on in the District
22 Court litigation; correct?

23 A. Well, see, I don't know what the word
24 overlap means in your question.

25 Q. You don't know what overlap means?

1 A. I know what overlap means. I'm just -- I've

2 got three terms here that I've mentioned. They are
3 not the same as the ones in the other one. That's how
4 I will put it to you.

5 Q. The terms you've offered for construction in
6 the IPR are not the same as the terms you've offered
7 for construction in the District Court litigation;
8 correct?

9 A. Correct.

10 MR. BENNETT: Objection. Form.

11 BY MR. SHI:

12 Q. Why have you proposed different terms in
13 your two different declarations?

14 MR. BENNETT: Objection. Form.

15 THE WITNESS: I don't know.

16 BY MR. SHI:

17 Q. Okay. So you have -- you just have no
18 answer as to why there are significant differences
19 between the terms offered in both of your
20 declarations?

21 MR. BENNETT: Objection. Form.

22 THE WITNESS: That is correct.

23 BY MR. SHI:

24 Q. Okay. Do you understand that the meanings
25 of terms can significantly change the scope of a

1 patent?

2 MR. BENNETT: Objection. Form.

3 THE WITNESS: Yes. I understand that.

4 BY MR. SHI:

5 Q. So do you think it's appropriate to offer
6 terms that broadly construe a patent in an IPR
7 proceeding and then offer terms that narrowly construe
8 a patent in a District Court proceeding?

9 MR. BENNETT: Objection. Form.

10 THE WITNESS: Would you repeat the question,
11 please.

12 BY MR. SHI:

13 Q. Sure.

14 Do you think it's appropriate to offer terms
15 that broadly construe a patent in an IPR proceeding
16 and then offer terms that narrowly construe a patent
17 in a District Court proceeding?

18 MR. BENNETT: Objection. Form.

19 THE WITNESS: I don't know. I've never
20 thought about that.

21 BY MR. SHI:

22 Q. Okay. So you don't have an opinion either

23 way as to whether or not that's appropriate?

24 MR. BENNETT: Objection. Form.

25 THE WITNESS: Yes, I have no opinion on

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1 that.

2 BY MR. SHI:

3 Q. Okay. Why did you not propose that the term
4 adjacent be construed in the District Court
5 litigation?

6 MR. BENNETT: Objection. Form.

7 THE WITNESS: I was not asked to do so.

8 BY MR. SHI:

9 Q. Okay. So setting aside what you were asked
10 to do and what you were not asked to do, do you think
11 adjacent should have been offered for construction in
12 the District Court proceeding?

13 A. I have no opinion.

14 Q. Okay. Same question for the term PPR.

15 Why did you not propose that term be
16 construed in the District Court litigation?

17 MR. BENNETT: Objection. Form.

18 THE WITNESS: Because I was not asked to.

19 BY MR. SHI:

20 Q. Okay. So, again, setting aside what you
21 were asked and not asked to do, do you have an opinion
22 as to whether PPR should have been offered for
23 construction in the District Court proceeding?

24 MR. BENNETT: Objection. Form.

25 THE WITNESS: I have no opinion.

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1 BY MR. SHI:

2 Q. All right. Is it your understanding that
3 recyclable shrink label is recyclable with a PET
4 container, or something very similar to that phrase,
5 has been offered for construction in the District
6 Court opinion -- or excuse me, in the District Court
7 litigation?

8 MR. BENNETT: Objection. Form.

9 THE WITNESS: I'm going to open up my binder
10 that's next to me, here. You told me to tell you when
11 I did that.

12 BY MR. SHI:

13 Q. Sure.

14 A. Would you repeat the question, please.

15 Q. Is it your understanding that the phrase

16 recyclable shrink label is recyclable with a PET
17 container, or something very similar to that phrase,
18 has been offered for construction in the District
19 Court litigation?

20 MR. BENNETT: Objection. Form.

21 THE WITNESS: Yes.

22 BY MR. SHI:

23 Q. Why did you not offer any opinion on that
24 phrase in the District Court litigation --

25 MR. BENNETT: Objection.

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1 [Simultaneous speaking.]

2 BY MR. SHI:

3 Q. -- offered an opinion on that phrase in the
4 IPR declaration?

5 MR. BENNETT: Sorry.

6 Objection. Form.

7 THE WITNESS: I was not asked to do so.

8 BY MR. SHI:

9 Q. Okay. Outside of what you were asked and
10 not asked to do, do you have an opinion on whether
11 that phrase should have been -- strike that.

12 Outside of what you were asked and not asked

13 to do, do you have an opinion as to whether or not you
14 should have offered an opinion on that phrase in the
15 District Court proceeding?

16 MR. BENNETT: Objection. Form.

17 THE WITNESS: No.

18 BY MR. SHI:

19 Q. Okay. Dr. Storey, I have to ask.

20 Did the attorneys write some of these
21 opinions, or are these all your opinions?

22 MR. BENNETT: I -- objection.

23 I instruct you not to answer on the basis of
24 work product insofar as your answer is not -- the
25 question is beyond whether these opinions are yours.

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1 THE WITNESS: I've been instructed not to
2 answer, so I will not.

3 BY MR. SHI:

4 Q. Dr. Storey, are the claim construction
5 opinions in Exhibit 3 your opinions?

6 A. Everything in Exhibit 3 are my opinions.

7 Q. Are the claim construction opinions in
8 Exhibit 2 your opinions?

9 A. Everything in Exhibit 2 are my opinions.
10 Q. You have no opinions as to which terms
11 should be construed in one proceeding or the other;
12 correct?
13 MR. BENNETT: Objection. Form.
14 THE WITNESS: I don't have an opinion about
15 why they are different. The questions that you asked
16 me already, I told you I did not have an opinion.
17 BY MR. SHI:
18 Q. Okay. Earlier, you mentioned you were going
19 to crack open your binder. Let me ask what documents
20 you have in your binder.
21 A. My declaration, which is Exhibit 2.
22 Q. Okay.
23 A. A declaration of Dr. Erin Askounis. The
24 joint claim construction and prehearing statement
25 pursuant to patent L.R. 4-3. The '422 patent itself.

1 The file wrapper of the '422 Patent.
2 Three pieces of extrinsic evidence submitted
3 by Plaintiffs. One is Webster's New World College
4 Dictionary, another is Handbook of Plastics Elastomers
5 and Composites edited by Charles A. Harper.

6 A Dictionary of Science and Technology. I
7 guess it's edited by Simon Collin.

8 Multi-Color Corporation, petitioner, versus
9 Brook & Whittle Limited, patent owner. Patent owner's
10 preliminary response. Extrinsic evidence that I
11 offered or Defendant offered.

12 An excerpt from the book Polymer Science and
13 Technology, Joel R. Fried. Handbook of Polymers,
14 George Wypych. The MERCK Index, 9th edition. And the
15 MERCK Index, 14th edition. A textbook written by
16 Painter and Coleman titled Fundamentals of Polymer
17 Science, an excerpt therefrom. Polymer Handbook, 4th
18 edition; Brandrup, Immergut, Grulke editors. Two
19 excerpts therefrom. A textbook, Principles of
20 Polymerization, George Odian, an excerpt therefrom. A
21 textbook, Polymer Chemistry: An Introduction, written
22 by Malcolm P. Stephens, an excerpt therefrom. A
23 textbook, Polymer Chemistry: Introduction to
24 Indispensable Science; author, David Teegarden,
25 excerpt therefrom.

1 And that's the entirety of the binder.

2 Q. Dr. Storey, you mentioned that you had what
3 you described as the file wrapper of the '422 patent.
4 Do you recall saying that?
5 A. I do.
6 Q. That's the file history of the '422 patent;
7 right?
8 A. I think it is called the prosecution
9 history. The two terms I've heard it referred to in
10 my navigation of these waters is the prosecution
11 history or the file wrapper.
12 Q. Okay. Earlier, I believe you used the term
13 file history, which is why I used that term. But I
14 think we're talking about the same thing here, the
15 prosecution history.
16 Is that fair?
17 A. I think so. File history makes sense to me.
18 I just -- I didn't know that I had used it.
19 Q. Do you have the entire prosecution history,
20 which I believe is more than 400 pages long, in your
21 binder?
22 A. I don't know.
23 Q. Okay. If you look at the document that you
24 described as the file wrapper in your binder,
25 approximately how many pages long is that document?

1 A. Let me see.

2 It looks like it's approximately 469 pages.

3 Q. You mentioned that in your binder, you have
4 a document you described as Multi-Color Corporation,
5 petitioner, versus Brook & Whittle Limited, patent
6 owner.

7 Do you recall saying that?

8 A. I do.

9 Q. Is that the petition for PGR filed by
10 Multi-Color Corporation, or is that some other
11 document?

12 A. Well, I'll read what's on the front cover.

13 "United States Patent and Trademark Office,
14 before the PTAB, before the Patent Trial and Appeal
15 Board, Multi-Color Corporation, Petitioner, V Brook &
16 Whittle Limited, Patent Owner, PGR 2025-00025. And
17 then it recites the patent number. And then below
18 that -- in other words, the '422 patent number. And
19 then below that, it says: "Patent owner's preliminary
20 response."

21 Q. Dr. Storey, had you seen this document
22 before today's deposition?

23 A. The preliminary response document?

24 Q. Yes.

25 A. Yes.

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1 Q. What's the date of the preliminary response
2 document you have in front of you?

3 A. I don't know.

4 Q. Okay. You're aware that prior to the
5 preliminary response document, there was a petition
6 filed by Multi-Color Corporation involving the '422
7 patent; right?

8 A. That's my understanding.

9 Q. Did you consider that PGR petition filed by
10 Multi-Color Corporation when you wrote your
11 declaration for the IPR petition?

12 A. No.

13 Q. Okay. At the time that you wrote your
14 declaration for the IPR petition, were you aware that
15 Multi-Color Corporation had filed a PGR petition with
16 respect to the '422 patent?

17 A. I don't -- I don't know, actually.

18 Q. You don't know, or you don't remember?

19 A. I guess I don't remember.

20 Q. Okay. If you don't remember, how can you be
21 sure that you didn't consider the PGR petition when
22 you wrote your IPR declaration?

23 A. Because I see that the -- I did find a date,
24 by the way. I had to go back to the back of it. And
25 I'm talking now about what's in my binder, the

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1 preliminary response. It's dated June 23rd. And my
2 declaration for the IPR proceeding is dated June 24th.

3 And so I'm fairly certain that those dates
4 are right on top of each other, that I did not
5 consider or know about this at the time I prepared
6 that earlier declaration. There would not have been
7 time.

8 Q. Right. That's the date of the response.
9 What I'm asking about is the petition that preceded
10 the response.

11 And I'll represent to you that that petition
12 was filed some time in January of 2025, I believe.

13 A. Okay.

14 Q. Do you have any reason to doubt that the
15 petition filed by MCC was sometime in 2025?

16 A. No.

17 Q. So I'll ask again.

18 If you don't remember being aware of
19 Multi-Color Corporation's PGR filing, how can you be
20 sure that you didn't consider that PGR petition when
21 you wrote your IPR declaration?

22 A. Well, I think that if I had considered it, I
23 would remember it.

24 Q. Okay. You can't say for certain whether you
25 did or didn't consider the PGR petition filed by

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1 Multi-Color Corporation in writing your IPR
2 declaration?

3 A. I can't be sure.

4 Q. Let's go back to Exhibit 3. I'd like to
5 direct your attention to Paragraph 79 of Exhibit 3.
6 And I believe in this section, you're talking about a
7 purported prior art reference called Lee.

8 Does that sound familiar to you, Dr. Storey?

9 A. What paragraph is it, please?

10 Q. Paragraph 79 of Exhibit 3.

11 A. Okay. Let me read it first.

12 Okay. Please ask your question.

13 Q. Paragraph 79 of Exhibit 3, which is your IPR
14 declaration, discusses a purported prior art reference
15 called Lee.

16 Is that correct?

17 A. That is correct.

18 Q. Okay. Your opinion in this paragraph is
19 that Lee discloses a polyester resin blend comprising
20 PET.

21 Do you see that?

22 MR. BENNETT: Objection. Form.

23 THE WITNESS: Right. It's the first
24 sentence. Yes.

25 BY MR. SHI:

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1 Q. And then in parentheses, you state that the
2 PET can be virgin or recycled PET.

3 Is that correct?

4 A. That's what it says, yes.

5 Q. And when you say that's what it says, what
6 you really mean is that's what you said in your
7 declaration; correct?

8 MR. BENNETT: Objection. Form.

9 THE WITNESS: That is what my declaration

10 says.

11 BY MR. SHI:

12 Q. And you wrote your declaration; correct?

13 A. And I wrote my declaration. Correct.

14 Q. Can you help me understand the difference
15 between virgin and recycled PET?

16 A. Yes.

17 Q. Please, go ahead.

18 A. Virgin means that it is PET made directly
19 from the monomers. And recycled PET means created
20 through a recycling stream, as we have discussed
21 earlier.

22 Q. Both virgin and recycled PET are PET; right?

23 A. Virgin PET is PET. Recycled PET may vary
24 depending upon, you know, what particular plant that
25 it comes from. I think it's understood that recycled

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1 PET might not be quite as pure as virgin. But if it
2 says recycled PET, I believe that the intent is that
3 it be pure PET.

4 Q. Okay. So if I'm understanding you
5 correctly, with recycled PET, the purity may vary, but

6 is it fair to say that a POSITA would still understand
7 recycled PET to be PET?

8 MR. BENNETT: Objection. Form.

9 THE WITNESS: I could barely hear. Was
10 there an objection?

11 MR. BENNETT: Yes.

12 THE WITNESS: I actually can't hear John
13 very well.

14 MR. BENNETT: Sorry, Dr. Storey. Yes.
15 Objection. Form.

16 THE WITNESS: I think that a POSITA would
17 consider -- would consider recycled PET to be PET, but
18 with the reservation that it might not be as of high a
19 quality as virgin PET.

20 BY MR. SHI:

21 Q. All right. Understood.

22 In your discussion of Lee on Paragraph 79 of
23 Exhibit 3, you indicate that Lee's disclosure of PET
24 can either be virgin or recycled PET.

25 Is that correct?

1 A. Yes. And -- that is what I wrote. And I
2 feel that the reason I wrote that is because that's

3 what Lee wrote.

4 Q. Do you agree with what Lee wrote?

5 MR. BENNETT: Objection. Form.

6 THE WITNESS: I don't have any reason to
7 object to it. I haven't verified that it's true, if
8 that's what you're asking. But if I felt that Lee was
9 unreliable, I would not have relied on it.

10 BY MR. SHI:

11 Q. So in your opinion, Lee is reliable in its
12 disclosure of a resin blend comprising PET, which can
13 be virgin or recycled PET; right?

14 MR. BENNETT: Objection. Form.

15 THE WITNESS: I have no reason to believe
16 that it's not so. I haven't verified it.

17 BY MR. SHI:

18 Q. Do you need to independently verify a
19 reference or a source before relying on it?

20 MR. BENNETT: Objection. Form.

21 THE WITNESS: Not necessarily.

22 BY MR. SHI:

23 Q. Mm-hmm.

24 Dr. Storey, at the time of the '422 patent,
25 would you agree that a POSITA would have been aware of

1 an industry need to develop packaging components,
2 including shrink labels, that are fully compatible
3 with established PET recycling streams?

4 MR. BENNETT: Objection. Form.

5 THE WITNESS: I would agree, yes.

6 BY MR. SHI:

7 Q. Okay. Would you agree that as of the '422
8 patent, a POSITA would have been aware of an industry
9 need to achieve light shielding for product integrity
10 as well as compatibility with PET recycling for
11 environmental sustainability and regulatory
12 compliance?

13 MR. BENNETT: Objection. Form.

14 THE WITNESS: Yes.

15 BY MR. SHI:

16 Q. All right. Would you agree with me that a
17 POSITA would have understood that both of those goals
18 were driven by prominent market forces and central
19 design goals for packing solutions for PET containers?

20 A. Please repeat that.

21 Q. Sure.

22 Would you agree that a POSITA would have
23 understood that the goals of achieving light shielding

24 for product integrity as well as compatibility for PET
25 recycling were driven by prominent market forces and

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1 central design goals for packaging solutions for
2 PET-designed containers?

3 MR. BENNETT: Objection. Form.

4 THE WITNESS: I don't know.

5 BY MR. SHI:

6 Q. Okay. Let's look at Paragraph 173 of
7 Exhibit 3, which is the IPR declaration.

8 It's your opinion that a POSITA working in
9 May of 2021, which is the priority date of the '422
10 patent, would have been acutely aware of the dual
11 requirements of achieving effective light shielding
12 for product integrity and ensuring seamless PET
13 recycling compatibility for environmental
14 sustainability and regulatory compliance.

15 Is that your opinion?

16 A. Give me a moment to read my full paragraph
17 here.

18 Q. Sure.

19 A. All right. Would you repeat your question,
20 please.

21 Q. Is it your opinion that a POSITA at the time
22 of the '422 patent would have been acutely aware of
23 the dual requirements of achieving effective light
24 shielding for product integrity and ensuring seamless
25 PET recycling compatibility for environmental

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1 sustainability and regulatory compliance?

2 A. Yes.

3 Q. Is it your opinion that a POSITA would have
4 recognized that developing shrink labels capable of
5 dressing both of these needs was a key objective
6 driven by prominent market forces and central design
7 goals for advanced packaging solutions for PET
8 containers?

9 A. Yes.

10 Q. Okay. Let's turn now to Exhibit 2, which is
11 your claim construction declaration in the District
12 Court litigation. And we'll start from the top with
13 respect to PET.

14 So if you would, please join me at Page 11
15 of Exhibit 2. There is a section titled Analysis of
16 Polyethylene Terephthalate (PET) Claimed Term.

17 Do you see that?

18 A. Yes, I see it.

19 Q. Okay. So in this section, you offer some
20 background on polymers and monomers and a chemical
21 process called polymerization.

22 Is that fair?

23 A. Yes. That's fair.

24 Q. If we look at Paragraph 39 of Exhibit 2, you
25 have an opinion that polyethylene terephthalate, or

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1 PET, belongs to the family of polymers known as a
2 polyester.

3 Is that right?

4 A. That's correct.

5 Q. And so because PET is a polyester, you opine
6 that it's derived from two monomers, one being a
7 diacid and one being a diol.

8 Is that correct?

9 MR. BENNETT: Objection. Form.

10 THE WITNESS: That is correct.

11 BY MR. SHI:

12 Q. If we scroll down to Paragraph 43 of
13 Exhibit 2, you opine that in the specific case of PET,

14 which is a polyester, the diacid monomer is
15 terephthalic acid and the diol monomer is ethylene
16 glycol.
17 Is that correct?
18 A. That is correct.
19 Q. And I see you have a footnote that says in
20 the case of the terephthalic acid, instead of using a
21 diacid monomer, you can use an ester form of that
22 monomer.
23 Is that correct?
24 A. That is correct.
25 Q. When you say the diacid may be substituted

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1 by one of its esters in Footnote 1 of Paragraph 43,
2 are there many different esters of terephthalic acid?
3 MR. BENNETT: Objection. Form.
4 THE WITNESS: Yes.
5 BY MR. SHI:
6 Q. One such ester is dimethyl terephthalate.
7 Is that correct?
8 A. Yes. That's correct.
9 Q. And is it called that because there is a --

10 excuse me, there is a methyl group on either side of
11 that chemical structure?

12 A. Yes.

13 Q. Is dimethyl ester also an ester of -- excuse
14 me.

15 Is diethyl terephthalate also an ester of
16 terephthalic acid?

17 A. Yes.

18 Q. Is dipropyl terephthalate also an ester of
19 terephthalic acid?

20 A. Yes.

21 Q. So in these examples, the di- of the
22 dimethyl or diethyl or dipropyl tells you that its the
23 same functional group on either side of the monomer.

24 Is that correct?

25 A. Well, it says that both ester functions on

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1 the molecule are derived from the same alcohol.

2 Q. Got it.

3 So in the case of, for instance, dimethyl
4 terephthalic, the functions on either side of the
5 molecule are both derived from methanol.

6 Is that correct?

7 A. Right. That is correct. Each of the esters
8 on the terephthalic acid molecule, derived from
9 terephthalic acid consistent of -- was it ethyl, the
10 one that you used? Whatever one you used, yes,
11 they're both the same.

12 Q. Okay. Is methyl ethyl terephthalate a
13 possible ester of terephthalic acid?

14 A. It's theoretically possible, yeah. Yes,
15 it's possible.

16 Q. Right.

17 So with respect to the ester form of
18 terephthalic acid, you can theoretically have a
19 different functional group on either side of the
20 molecule; right?

21 A. Yes.

22 Q. Earlier, I mentioned, you know, the first
23 three examples -- dimethyl, diethyl, dipropyl.

24 Is it possible that we keep going up the
25 chain? For instance, is dibutyl terephthalate

1 possible?

2 A. Yes.

3 Q. And dipentyl terephthalate is also possible?

4 A. Yes.

5 Q. And so on and so forth. These are just

6 possible ester forms of terephthalic acid; right?

7 A. Yes.

8 Q. Is there an upper limit on reasonableness?

9 Like, how high up can we go in terms of making a --

10 making an ester form of terephthalic acid?

11 A. Normally, that would be dictated by

12 availability of the particular alcohol under

13 consideration.

14 Q. So, for instance, if ethenol and propanol

15 are readily available, it's more likely that we could

16 get diethyl terephthalate and dipropyl terephthalate;

17 right?

18 A. Well, I would say that it would be

19 practically easier to create the molecule, yes, if

20 it's available.

21 Q. All right. I'm trying to find in your

22 declaration where you first list your opinion as to

23 the definition of PET. I think it's here.

24 So if you look with me in Paragraph 57 of

25 Exhibit 2, you state that a POSITA -- sorry. You

1 state that: "The term PET in the '422 patent has its
2 ordinary chemical meaning, i.e. a polymer prepared
3 from terephthalic acid (or dimethyl terephthalate) and
4 ethylene glycol, and not any other monomers."

5 Is that your opinion?

6 A. Yes.

7 Q. Okay. So I notice here that with the
8 terephthalic acid, you do include as an alternative
9 the common ester, which is dimethyl terephthalate;
10 right?

11 A. That's correct.

12 Q. And it's your opinion that you can either
13 terephthalic acid or dimethyl terephthalate, and the
14 only difference is the contents, say, that you would
15 get out of it would be different; right?

16 A. That's correct.

17 Q. Right.

18 So if you prepare PET using terephthalic
19 acid, you'll essentially get water. And if you
20 prepare it using dimethyl terephthalate, you'll get
21 methanol.

22 Is that correct?

23 A. That is correct.

24 Q. Okay. It's also possible, then, is it not,

25 to make PET from diethyl terephthalate?

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1 A. Yes, it is possible.

2 Q. But your definition of PET does not allow
3 for that possibility; correct?

4 A. The only -- to my knowledge, the only ester
5 of terephthalate that is used commercially is
6 dimethyl. And I think that that is why I decided to
7 write dimethyl. I could have written "or one of its
8 esters," but none of them are practically important.

9 Q. Okay. I understand that you have the
10 concept of what's commercially common or commercially
11 feasible.

12 All I'm asking is that your definition of
13 PET does not account for the possibility of making PET
14 with a different ester of terephthalic acid.

15 Is that true?

16 A. Well, in my mind, you could use any ester.
17 And so I think -- I think -- I think it's unimportant,
18 though, because these are the only two that matter.
19 The only ones that we're ever going to be concerned
20 with are these two.

21 Q. And that's your opinion because that's
22 what's common in the industry.
23 Is that correct?
24 A. Well, it's just common everywhere. I teach
25 it in my class. Nobody will use an ester other than

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1 dimethyl because dimethyl yields the most economical
2 process.
3 There is a concept in chemistry called atom
4 efficiency. And if you don't have to -- I mean, for
5 example, if you used one of your examples, pentyl,
6 well, then you're dealing with a much larger
7 condensate. It's more volume. It's going to take
8 more tanker trucks to haul it away. It's going to
9 cost more to buy it. And so forth and so on.
10 So, yes, theoretically, you could make --
11 you could do any ester you wanted, but nobody does
12 that.
13 Q. For now, Dr. Storey, I'm not focused on what
14 people are doing. But I'm just focused on what's
15 possible.
16 And so just so we have a clear record, I
17 believe this is what you're saying.

18 You can make PET with any ester of
19 terephthalic acid, including ones you have not listed
20 in your proposed definition; correct.
21 A. No, I don't -- I don't know that you can do
22 it from any ester. We're talking. Theoretically, but
23 I don't know whether it's practically possible.
24 Q. So, again, I'm not talking about practically
25 possible.

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1 A. But I --
2 [Simultaneous speaking.]
3 BY MR. SHI:
4 Q. Right. Dr. Storey, you have to understand
5 that I --
6 A. Excuse me.
7 [Simultaneous speaking.]
8 THE WITNESS: I'm sorry. Excuse me. I'm
9 sorry.
10 BY MR. SHI:
11 Q. Okay. Let's just reset.
12 It is possible to create PET with esters of
13 terephthalic acid other than what you've listed in

14 your proposed definition; correct?

15 A. Correct.

16 Q. Okay. Earlier -- well, let me just make
17 sure we understand the concept here. No. Strike
18 that.

19 Earlier, we talked about BHET.

20 Do you recall that?

21 A. Yes.

22 Q. And you do have an understanding of what
23 BHET is; right?

24 A. Yes.

25 MR. SHI: Mr. Pantoja, I believe that there

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1 is a document that we've sent over that's titled --

2 and you'll have to forgive me. It's titled

3 bis(2-hydroxyethyl)terephthalate.PDF. And I'd like to

4 introduce this as a demonstrative, please.

5 THE TECHNICIAN: Can you repeat that? Is it

6 the one with the BHET?

7 MR. SHI: Yes. I'll spell it for the court

8 reporter. It's B-I-S, open paren, 2-Hydroxyethyl,

9 close paren, terephthalate.

10 THE TECHNICIAN: I see that. There is

11 actually two separate ones. There is one with the
12 parentheses with the BHET in there. Would you like
13 that one, or the one without it?

14 MR. SHI: With the paren, please. Thank
15 you.

16 THE TECHNICIAN: No problem.

17 (DEMONSTRATIVE EXHIBIT NUMBER 1
18 WAS MARKED FOR IDENTIFICATION.)

19 MR. SHI: Mr. Pantoja, can we please mark
20 this as Demonstrative 1?

21 THE TECHNICIAN: One moment.

22 BY MR. SHI:

23 Q. All right. Dr. Storey, what I'm showing
24 you, which is what has been marked as Demonstrative
25 Exhibit 1, is a structure that I've labeled as BHET.

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1 Do you see that?

2 A. Yes.

3 Q. To your knowledge, is this an accurate
4 depiction of BHET?

5 A. It is accurate.

6 Q. How does BHET play into the synthesis of

7 PET?

8 A. It is an intermediate. And it is arrived at
9 by reacting either terephthalic acid or dimethyl
10 terephthalate with excess ethylene glycol and then
11 removal, you know, with contaminate removal of the
12 water or the methanol, whichever is being used,
13 whether it's the acid itself or the dimethyl ester.
14 And then this is further heated. And approximately
15 one of those 2 moles, or 2 equivalents, of ethylene
16 glycol, and then removed back out to give the PET
17 product.

18 So this is -- this is an intermediate in all
19 of the commercial processes that are used to make PET.

20 Q. In the case of recycled PET, is it your
21 understanding that PET can be -- can undergo
22 glycolysis to break down to form BHET?

23 A. Yes. That is possible. Yes.

24 Q. And once that happens, is it possible to
25 reform PET by polymerizing or polycondensating BHET?

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1 A. Yes.

2 Q. So with respect to that polycondensation
3 reaction, BHET is a monomer used to create PET;

4 correct?

5 MR. BENNETT: Objection. Form.

6 THE WITNESS: During a ternary recycling

7 process, yes.

8 BY MR. SHI:

9 Q. And I believe you said this before, but

10 recycled PET is PET; right?

11 A. Yes.

12 Q. Okay. Your definition of PET does not list

13 BHET as a possible monomer to create PET; correct?

14 A. Well, it really does because BHET is simply

15 a combined form of the two monomers that I -- that I

16 quote. So I disagree. I think that my definition

17 would easily include this.

18 Q. Your definition does not literally recite

19 BHET, either by acronym or by its full chemical name;

20 correct?

21 A. That is correct. But a POSITA would

22 understand that this intermediate is created along the

23 way from the two monomers that I create, that I list

24 in my definition.

25 Q. Dr. Storey, are you aware that a POSITA

1 could go on the internet and purchase BHET?

2 MR. BENNETT: Objection. Form.

3 THE WITNESS: I -- I am not -- I'm not
4 surprised by that at all. I haven't ever ordered it,
5 but I'm not surprised by that.

6 BY MR. SHI:

7 Q. You have no reason to doubt that a POSITA
8 could go online and purchase BHET; right?

9 MR. BENNETT: Objection. Form.

10 THE WITNESS: I have no reason to doubt
11 that.

12 BY MR. SHI:

13 Q. And so if a POSITA were to go online and
14 purchase BHET and subject the BHET to a
15 polycondensation reaction, that POSITA could make PET;
16 correct?

17 MR. BENNETT: Objection. Form.

18 THE WITNESS: Correct.

19 BY MR. SHI:

20 Q. Okay. Let's take a short break here. Maybe
21 until 1:30 my time.

22 MR. BENNETT: How about just a hair more
23 than that? That's only nine minutes from now.

24 MR. SHI: Sure. 1:35, maybe?

25 MR. BENNETT: Sure.

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1 MR. SHI: Let's do that.

2 MR. BENNETT: Thank you.

3 THE VIDEOGRAPHER: We are going off the
4 record. The time is 3:21 p.m.

5 (OFF THE RECORD AT 3:21 p.m. PT.)

6 (ON THE RECORD AT 3:36 p.m. PT.)

7 [Simultaneous speaking.]

8 THE VIDEOGRAPHER: The time is 3:36 p.m. We
9 are back on the record.

10 Sorry, Counsel.

11 MR. SHI: I apologize.

12 BY MR. SHI:

13 Q. Welcome back, Dr. Storey. Before we took a
14 break, we were talking about BHET and recycled PET.

15 Do you recall that?

16 A. Yes.

17 Q. In your definition of PET -- or, rather, I
18 should say in your proposed construction of PET, does
19 this exclude recycled PET?

20 A. No. I don't think so.

21 Q. Okay. Before we move on, I'd like to

22 understand, Dr. Storey, your reasons for opining that
23 PET should be construed. And so in my review of your
24 declaration -- well, sorry. Let me ask this.

25 You don't opine that the patent itself has

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1 an express definition of PET that you're adopting;

2 correct?

3 A. I believe that is correct. Yes.

4 Q. Okay. You have an opinion, however, that
5 the applicant of the '422 patent made a disclaimer of
6 scope with respect to PET.

7 Is that your opinion?

8 MR. BENNETT: Objection. Form.

9 THE WITNESS: I think the reduction in
10 scope, what was more limiting the shrink film to PET
11 instead of a larger shopping list of other types of
12 polymers.

13 BY MR. SHI:

14 Q. Okay. If I'm understanding your opinion
15 correctly, then -- excuse me.

16 If I'm understanding your current testimony
17 correctly, it's your opinion that in the prosecution

18 history of the '422 patent, it's not that the
19 applicant limited what PET is, but, rather, limited
20 other unnamed polymers -- excuse me -- removed other
21 polymers besides PET from the list.

22 Is that correct?

23 A. No. I don't -- I don't think you said that
24 quite right. I mean, the patent -- the patent does
25 limit -- you said -- I thought I heard you say that

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1 the patent is not limiting what PET could be. I
2 think -- I think you must have changed your question.

3 Can you start that over? Just ask the
4 question again, please, sir.

5 Q. Yeah. Let me try to reframe this.

6 I'm trying to understand what bases you have
7 for opining that this term needs to be construed. And
8 we've established that that basis is not any express
9 definition in the patent.

10 Can we agree on that?

11 A. Yes.

12 Q. Okay. And if you recall -- if you recall
13 earlier, we went through three avenues that could
14 justify deviation from the plain and ordinary meaning.

15 And express definition was one of them, a judge
16 deciding to construe a term on his or her own was
17 another, and then the third way is some disclaimer in
18 the prosecution history.

19 Do you recall that?

20 A. Yes.

21 Q. So since a judge hasn't decided to construe
22 this and since there is no express definition in the
23 patent, I'm asking you if it's your opinion that there
24 is some disclaimer in the prosecution history that
25 justifies the need to construe this term.

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1 MR. BENNETT: Objection. Form.

2 THE WITNESS: I'm going to open my binder
3 and look into the prosecution history so that I can
4 fairly answer your question.

5 I'm not sure that it is a specific
6 disclaimer. I just -- I just am afraid that a
7 layperson could be -- could make a mistake in
8 thinking, you know, that every polymer that contains
9 ethylene glycol residues and terephthalic acid
10 residues is, therefore, PET. And that's -- that's

11 just fundamentally untrue. And I was worried that a
12 mistake could be made by a layperson, like a juror.

13 BY MR. SHI:

14 Q. Okay. I think I understand. So --

15 A. It's explained in my report. That -- my
16 worry is actually in my report.

17 Q. Thank you, Dr. Storey. I think I understand
18 what you're saying.

19 So are you referring to the section of
20 Exhibit 2, your claim construction report, starting in
21 Paragraph 81 under the heading Potential for Jury
22 Confusion and Misunderstanding?

23 A. Yes.

24 Q. Okay. So it sounds like there was some
25 confusion a moment ago with the question about

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1 disclaimer.

2 But from your response just now where you're
3 saying, "I'm not sure that it is a specific
4 disclaimer," and then you pivoted to the juror point,
5 I just want to be sure that we've laid your opinions
6 out accurately.

7 So you would agree with me that your opinion

8 and decision to construe the term PET is not motivated

9 by any express definition in the patent; correct?

10 A. Correct.

11 Q. And you would agree with me that your

12 opinion and decision to construe the term PET is not

13 motivated by any disclaimer that you saw in the

14 prosecution history; correct?

15 A. Correct.

16 Q. And you would agree with me that your

17 opinion and decision to construe the PET is not

18 motivated by any judge applying a construction of PET

19 that the judge decided to take upon him or herself;

20 correct?

21 A. Not so far. No.

22 Q. So your answer to my question is so far,

23 that is correct?

24 A. So far, that is correct. Yes.

25 Q. Okay. And so the only motivation and

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1 justification that you've presented in your

2 declaration is -- strike that.

3 The only justification you've presented in

4 your declaration for why PET needs to be construed is
5 your opinion that a layperson, such as a juror, may
6 misunderstand what PET is; correct?

7 A. Correct.

8 Q. Okay. Let me mark as Exhibit 4 a new
9 exhibit. I just need to be sure I get the Bates
10 number correct.

11 MR. SHI: Mr. Pantoja, if you would please
12 bring up and mark as Exhibit 4 a document with Bates
13 number NUSA_0003453.

14 (DEPOSITION EXHIBIT NUMBER 4
15 WAS MARKED FOR IDENTIFICATION.)

16 THE TECHNICIAN: Would you like for this to
17 be marked as Exhibit 4?

18 MR. SHI: Yes, please.

19 THE TECHNICIAN: Thank you.

20 BY MR. SHI:

21 Q. Dr. Storey, what's being shown in front of
22 you as Exhibit 4 is, I believe, an excerpt from the
23 Handbook of Polymers published in 2012 by George
24 Wypych.

25 Do you see that?

1 A. I do.

2 Q. Was Exhibit 4 one of the extrinsic
3 references that you relied on in coming to your
4 opinions in Exhibit 2?

5 A. Yes.

6 Q. I notice it says "Handbok of Polymers."
7 Is that just a typo?

8 MR. BENNETT: Objection. Form.

9 THE WITNESS: I assume so.

10 BY MR. SHI:

11 Q. All right. So if you look with me on the
12 third page of this excerpt in Exhibit 4, you see that
13 this document purports to provide some data or facts
14 about PET.

15 Is that fair?

16 A. That's fair. Yes.

17 Q. For instance, on the first page, we see the
18 structure of the monomer -- or, rather, the repeating
19 unit of PET. And we see some historical facts about
20 PET.

21 Do you see that?

22 A. Yes.

23 Q. If you look with me under Synthesis, I
24 believe this is dimethyl terephthalate and ethylene
25 glycol shown here; right?

- 1 A. Let's see. It's terephthalic acid.
- 2 Q. Oh, excuse me. Terephthalic acid. You're
- 3 right. So let me ask the question again.
- 4 Under Synthesis, terephthalic acid and
- 5 ethylene glycol are shown; correct?
- 6 A. Correct.
- 7 Q. Under Method of Synthesis, the handbook says
- 8 several processes can be used.
- 9 Do you see that?
- 10 A. Yes.
- 11 Q. Some examples of the several processes
- 12 mentioned are transesterification, direct
- 13 esterification, and polycondensation.
- 14 Do you see that?
- 15 A. Yes.
- 16 Q. And polycondensation --
- 17 A. It doesn't -- it doesn't --
- 18 [Simultaneous speaking.]
- 19 BY MR. SHI:
- 20 Q. Go ahead.
- 21 A. I thought you said direct polycondensation.

22 It says transesterification, direct esterification,
23 and polycondensation.

24 Q. Yes.

25 Polycondensation is the reaction we were

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1 discussing previous with respect to BHET

2 polycondensing to form PET; right?

3 A. I would say they -- they all follow under
4 the umbrella of polycondensation. All of the things
5 that we've talked about so far.

6 Q. Okay. Fair enough.

7 I want to direct your attention to the page
8 ending in Bates Number 3459, which is printed
9 Page 389.

10 A. Okay. Let's see. Okay.

11 Q. This page has to do with weather stability
12 properties of PET.

13 Do you see that?

14 A. Yes.

15 Q. And that's because PET has some
16 sensitivities with respect to things like UV exposure.

17 Is that fair?

18 A. That is fair, yes.

19 Q. And so listed here are several stabilizers
20 that are used with PET; right?
21 A. Yes, many. Yes, many stabilizers. Yes.
22 Q. And so these stabilizers are used in the
23 preparation of PET; correct?
24 A. No. I wouldn't -- they're additives that
25 are used -- additives that are added to the -- to the

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1 flake after it has been prepared. I mean, these
2 are -- you would call these post polymerization
3 additives.
4 I would -- I just I object to the word
5 prepare. A chemist, when he talks about preparing
6 something, that would be the initial polycondensation.
7 These -- this would be part of the compounding process
8 to create an item of commerce that's sold to molders
9 and so forth.
10 Q. So help me understand this.
11 What's sold to molders and so forth is PET;
12 correct?
13 MR. BENNETT: Objection. Form.
14 THE WITNESS: Yes, but there are

15 different -- there are different products that have
16 different additives such as these. So, yeah, it's
17 PET, but there are different manufacturers that may
18 use different stabilizers and so forth.

19 I just wouldn't -- I wouldn't say that these
20 compounds are used in the preparation of PET because
21 that would be confusing. Preparation is more the
22 synthesis of the polymer. This would -- this would
23 be, you know, adding an additive package in a
24 compounding shop and chopping it into pellets, and
25 then selling that on the open market to be used by

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1 molders and blow molders and fiber formers and so
2 forth. I mean, PET for fiber might need an entirely
3 different stabilizer package than something for
4 bottles, for example.

5 BY MR. SHI:

6 Q. That makes sense.

7 So that the PET that is sold for particular
8 applications may have a different set of stabilizers
9 and additives than PET sold to someone else for a
10 different application.

11 Is that fair?

12 MR. BENNETT: Objection. Form.
13 A. That's exactly what I'm saying. Yes.
14 MR. BENNETT: Excuse me.
15 Objection. Form.
16 BY MR. SHI:
17 Q. And so -- maybe I'll take the word prepared
18 out of the equation.
19 Some species of PET are sold including some
20 of these stabilizers; correct?
21 A. Correct.
22 Q. And some of these stabilizers themselves are
23 polymers; right?
24 A. Let's see. 2024. I see one reference to
25 polymers in here, but it's a little confusing. Let's

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1 see. It says --
2 Q. Maybe I can short-circuit some of this
3 searching because there is a lot of text.
4 It appears that some of the stabilizers
5 mentioned include categories such as polymers with
6 maleic anhydride, polymers with
7 2,4-dichloro-6-(4-morpholinyl)-1,3,5-triazine.

8 Do you see those references, Dr. Storey?

9 A. Yeah, that's exactly the one -- I do, yes.

10 Q. So is it fair to say that some of the

11 stabilizers used with PET in certain applications are,

12 themselves, polymers?

13 A. I actually don't know. I don't know what

14 those are. I don't want to speculate.

15 Q. I don't know that I'm asking you to

16 speculate as to what they are.

17 Would you agree that polymers are listed

18 under Stabilizers that are included in PET sold for

19 certain applications?

20 MR. BENNETT: Objection. Form.

21 THE WITNESS: I see the word polymers, but I

22 don't know what those are. I don't know whether the

23 polymer is a carrier, used to bring in a stabilizer.

24 Because that sometimes occurs.

25 Let me explain. It is possible to -- for a

1 compounder to, for example, take a quantity tee of

2 PET, let's say that they buy on the market, that has

3 not yet been compounded with additives. And that

4 compounder may put a whole bunch of an additive in it,

5 like this
6 2,4-dichloro-6-(4-morpholinyl)-1,3,5-triazine, and
7 then sell that as a concentrate. And then a molder
8 somewhere could use that concentrate at a certain
9 fraction with his PET pellets and then blow mold
10 bottles with it or what have you.

11 So I'm really not certain what this author
12 is saying when he says polymers. And, therefore, I am
13 hesitant to say to you, yes, these are actually
14 polymeric stabilizers. They could be concentrates. I
15 really don't know. And I'd rather not answer this
16 until I do a little more research on this.

17 BY MR. SHI:

18 Q. Okay. If we think about some of the other
19 stabilizers that are listed here, could any of them be
20 considered monomers?

21 A. Well, I mean, some of them are monomers.

22 Q. Can you let me know which ones?

23 A. Well, I just -- right off the top of my
24 head, I mean, I see 1,6-hexanediamine, which is the
25 monomer that's used to make Nylon 66. So that's one.

1 I mean, it's a huge list. I haven't looked through
2 every one of them. But, yes, there is one that I see
3 could be a monomer. And it's about midway down,
4 1,6-hexanediamine.

5 Q. Right here. Is that 1,6-hexanediamine?

6 This is the one you're referring to?

7 A. That is it. Yes, sir.

8 Q. Okay. So you've identified at least one
9 monomer on this list.

10 Would it surprise you if some of the other
11 stabilizers listed here were also monomers?

12 A. No. I mean, I see another one. I see
13 maleic anhydride. That's a monomer. You can look --
14 it's very near the one you just pointed out. Go --
15 from the 1,6-hexanediamine, go up one and over two.
16 Maleic anhydride.

17 Q. All right.

18 A. That's a monomer. So there may be some in
19 here that could be classified as monomers.

20 Q. Just so the record is clear, in Exhibit 4,
21 under Stabilizers, there are at least two examples of
22 monomers listed. And there could be more.

23 Is that fair?

24 A. That's the only two that I found. But there
25 are definitely two that I see, yes.

1 Q. Okay. Let's scroll down to Page 3 --

2 Bates-stamped ending in 3460, which is printed

3 Page 390 of Exhibit 4.

4 On this page, there is a section called

5 Processing.

6 Do you see that, Dr. Storey?

7 A. Yes.

8 Q. And there are some examples of typical

9 processing methods, such as blow molding, extrusion,

10 et cetera.

11 These are the types of things that you were

12 discussing earlier; right?

13 A. Yes, they are.

14 Q. So do these refer to the active shaping PET

15 for particular applications?

16 A. Yes.

17 Q. Under this processing section, there is a

18 subsection that says "additives used in final

19 products."

20 Do you see that?

21 A. Yes.

22 Q. And then further down, there are several

23 examples of applications listed; right?

24 A. Yes.

25 Q. And so I think this will be very similar to

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1 our discussion about weather stabilizers.

2 But is it true that different applications
3 for PET will need to have different properties
4 depending on what those applications are?

5 MR. BENNETT: Objection. Form.

6 THE WITNESS: I think -- I think generally
7 that is true, yes.

8 BY MR. SHI:

9 Q. And so there is a list of additives used in
10 final products.

11 And so are these things that are added to
12 the PET resin at the processing step?

13 A. They could be, yes.

14 Q. These are things that could be added to PET
15 depending on the application that that PET is used
16 for.

17 Is that fair?

18 A. Yes. That is fair.

19 Q. In the additives section, there are several
20 large categories, including fillers, antistatics,
21 antiblocking, release, and slip.

22 Do you see all of those categories?

23 A. I do.

24 Q. And so my understanding is that some of
25 these have to do with the friction of PET.

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1 Is that fair?

2 MR. BENNETT: Objection. Form.

3 THE WITNESS: Well, these -- well,
4 certainly, slip is. But they're not all -- I mean,
5 each of these has a certain function. But I would
6 agree with you that -- that slip is an additive that
7 is designed to reduce the coefficient of friction on
8 the surface of the molded part. And that could be
9 there for -- simply for processing, to facilitate
10 processing or to facilitate construction of a more
11 complicated part from something that you've molded. I
12 mean, there could be many reasons why someone would
13 use that in their process.

14 BY MR. SHI:

15 Q. If you think about the category called

16 antistatics, is it your understanding that these are
17 additives that reduce or inhibit electrostatic buildup
18 or discharge of a material?

19 A. That -- that is -- I think that is correct,
20 yes.

21 Q. So some examples of antistatic additives
22 used in PET include polyaniline and
23 polyisophthalene.

24 Do you see that?

25 A. I do.

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1 Q. Those are examples of polymers; right?

2 A. Yes.

3 Q. And you can tell that they're polymers
4 because they have the prefix poly.

5 Is that fair?

6 A. Yes.

7 Q. All right. All right. Let's set Exhibit 4
8 to the side. And we can come back to Exhibit 2.

9 I'm going to scroll down to your opinions
10 related to crystallizable PET, which begin on
11 Paragraph 88 of Exhibit 2.

12 A. Yes.

13 Q. It's your understanding that the phrase
14 crystallizable PET only appears in Claim 18 of the
15 '422 patent.

16 Is that correct?

17 A. Yes.

18 Q. So it's also your opinion that the term
19 crystallizable is a simple modifier that describes an
20 inherent fundamental capability of PET.

21 Is that your opinion?

22 A. Yes.

23 Q. Is all PET inherently capable of
24 crystalizing?

25 A. Yes.

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1 Q. You can't think of any examples of PET that
2 are amorphous and cannot crystalize at all?

3 MR. BENNETT: Objection. Form.

4 THE WITNESS: It is possible to inhibit
5 crystallization. But even when that is done, it
6 doesn't mean that the PET could not crystalize under a
7 different set of conditions, okay. So what I'm saying
8 is that PET inherently has the ability, or the

9 tendency even, to crystalize; although, it is possible
10 to inhibit it and it is possible to enhance it.

11 BY MR. SHI:

12 Q. If a POSITA were to inhibit the
13 crystallizability of PET, it's your opinion that that
14 does not remove the crystallizability of PET.

15 Is that fair?

16 MR. BENNETT: Objection. Form.

17 THE WITNESS: Well, as long as the POSITA
18 did not do anything to irreversibly change the PET,
19 then I -- then I do agree with that.

20 For example, it is possible to inhibit
21 crystallization simply by clenching rapidly to a lower
22 temperature and, thereby, almost completely inhibit
23 crystallization. But the same polymer could then
24 simply be annealed at a higher temperature and have
25 the PET crystalize. So that's what I mean.

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1 BY MR. SHI:

2 Q. Dr. Storey, you just brought up the idea of
3 irreversible changes; although, it seems like your
4 example about changing the temperature is a reversible

5 change.

6 Is that right?

7 A. Changing the temperature is a reversible

8 change. That is exactly right.

9 Q. Can you provide an example of an

10 irreversible change that would completely inhibit the

11 ability of PET to crystalize?

12 A. Possibly degradation by oxidation might be

13 an example. There may be additives that could be

14 added -- although, I can't name any, but there could

15 be additives that were capable of inhibiting

16 crystallization. And those additives might be

17 difficult or impossible to remove back out of the

18 polymer.

19 Q. So PET that has been sufficiently degraded

20 by oxidation may be irreversibly changed, such that it

21 can no longer crystalize.

22 Is that right?

23 A. I'm saying that that's possible, yes.

24 Q. And it's also possible that certain

25 additives could permanently affect or completely

1 inhibit the ability of PET to crystalize if those

2 additives cannot be removed from the PET that they're
3 added to.

4 Is that possible?

5 A. It is possible, yes.

6 Q. Is that also true of blends?

7 MR. BENNETT: Objection. Form.

8 THE WITNESS: It is -- could you ask that --
9 could you ask a full question there, please?

10 BY MR. SHI:

11 Q. I'll ask a full question.

12 Is it possible that if PET is blended with a
13 different polymer that the property of PET could
14 change such that it would no longer be able to be
15 crystalized? Strike that. I'll ask my question
16 simpler.

17 Is it possible that a POSITA could blend PET
18 with a different polymer in such a way that that PET,
19 as part of a blend, can no longer crystalize?

20 A. I don't know.

21 Q. So it could be possible, but you just don't
22 know of any examples or counter-examples?

23 MR. BENNETT: Objection. Form.

24 THE WITNESS: I just don't know.

25 BY MR. SHI:

1 Q. Okay. So you have no opinion either way?

2 MR. BENNETT: Objection. Form.

3 THE WITNESS: No opinion either way.

4 BY MR. SHI:

5 Q. All right. Looking back at your opinions in

6 Exhibit 2 related to crystallizable PET. We went

7 through this with PET. I'm trying now to understand

8 the bases for proposing a construction for this term.

9 Would you agree that there is no express

10 definition of crystallizable polyethylene

11 terephthalate PET used in the patent that you're

12 adopting in your opinion?

13 A. I don't believe the patent defines what

14 crystallizable PET is.

15 Q. Right.

16 So you would agree with me, then, that

17 you're not relying on any express definition of

18 crystallizable PET to justify the need to construe

19 this term?

20 Is that fair?

21 A. I think that is fair. Yes.

22 MR. BENNETT: Objection. Form.

23 BY MR. SHI:

24 Q. As of your declaration, Exhibit 2, you're
25 not relying on any decision by a judge to construe

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1 crystallizable PET; correct?

2 A. Correct.

3 Q. And you are not relying on any prosecution
4 history disclaimer to justify the need to construe
5 crystallizable PET as a term; correct?

6 A. Correct.

7 Q. Okay. In your opinion, why should the Court
8 construe the term crystallizable polyethylene
9 terephthalate?

10 A. I didn't want -- I didn't want a layperson,
11 such as a juror, to think that crystallizable PET is
12 something special or something different than the PET
13 that I construed above. Since there was no guidance
14 in the patent as to what that meant, I did not want
15 there to be confusion on anyone's part to think that
16 crystallizable PET is something other than PET. I
17 think that's the simplest way I can explain the reason
18 for my desire to construe that term.

19 Q. I understand that.

20 So if you look with me in Paragraph 102 of
21 Exhibit 2, which is your claim construction
22 declaration, it is your opinion that adopting the
23 construction that you proposed provides essential
24 clarity for the jury.

25 Is that fair?

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1 A. Yes. I think -- yes. 102 is exactly what I
2 was just saying, yes. "Adopting this construction
3 provides essential clarity for the jury." Yes.

4 Q. Okay. In this section, you haven't
5 provided -- strike that.

6 Outside of providing clarity for a jury, you
7 haven't cited any other reason to deviate from the
8 plain and ordinary meaning of crystallizable PET.

9 Is that right?

10 MR. BENNETT: Objection. Form.

11 THE WITNESS: I actually was somewhat
12 concerned that the plain and ordinary meaning of
13 crystallizable PET could be confusing to certain
14 persons, only because there are additives that can be
15 compounded into PET that enhance its rate of

16 crystallization. And so I just -- I just felt like
17 there was potential for there even to, maybe, not be
18 universal recognition of a plain and ordinary meaning.
19 And I just wanted to make sure that everybody
20 understood that it was -- it was just PET because all
21 PET -- all native PET has the capability to
22 crystalize. And when I say native, what I mean is PET
23 that has not been purposely altered or degraded such
24 that it can no longer crystalize.
25 BY MR. SHI:

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1 Q. I think I understand what you're saying. My
2 question was a little bit different. But I can see
3 where we're passing in the night, so let me ask my
4 question again. And I think this will clear it up.
5 Dr. Storey, outside of providing clarity to
6 a jury and avoiding confusing a jury, you don't cite
7 any other reason to deviate from the plain and
8 ordinary meaning of crystallizable PET.
9 Is that right?
10 MR. BENNETT: Objection. Form.
11 THE WITNESS: I agree.
12 BY MR. SHI:

13 Q. When you use the term native PET -- let me
14 be sure I have this right. You said when I --
15 Dr. Storey, your definition of native PET is
16 PET that has not be purposely altered or degraded such
17 that it can no longer crystalize. I believe that's
18 what you just said.
19 Is that accurate?
20 A. That is exactly what I just said.
21 Q. If we could turn to Exhibit 3, which is your
22 IPR declaration. I think you used a different term.
23 Give me one moment.
24 So looking at Exhibit 3, which is your IPR
25 declaration, I'm going to direct your attention to go

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1 Paragraph 163, which is on Page -- which begins on
2 Page 89 of Exhibit 3.
3 Dr. Storey, do you see Paragraph 163 of
4 Exhibit 3?
5 A. Yes. I'd like to read it first.
6 Q. Of course.
7 A. Okay. I've read it.
8 Q. So in Paragraph 163, you have the opinion

9 that a certain purported prior art reference called
10 Schurr -- S-C-H-U-R-R -- discloses crystallizable PET
11 by virtue of disclosing PET.

12 Is that correct?

13 MR. BENNETT: Okay. Form.

14 THE WITNESS: Yes, it is correct. I say
15 that PET has synthesized from these standard monomers,
16 meaning terephthalic acid and 1,2-ethanediol is
17 inherently a semi-crystalline polymer. This is
18 exactly consistent with what's in my present
19 declaration. It's inherently crystallizable. It's
20 inherently a semi-crystalline polymer.

21 BY MR. SHI:

22 Q. Right.

23 So if we look to the second page of
24 Paragraph 163, you state: "Because Schurr discloses
25 the use of standard PET, it necessarily discloses the

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1 use of a material that is inherently crystallizable."

2 Is that your opinion?

3 A. Yes.

4 Q. So, here, you use the phrase standard PET;
5 earlier, you said native PET. I'm trying to

6 understand if those mean the same thing to you.

7 A. They do.

8 Q. Okay. Earlier, we -- or earlier, I believe
9 you brought up some examples of ways that you could
10 irreversibly change PET so that it would no longer be
11 standard or native.

12 Is that right?

13 A. Yes.

14 Q. Okay. Can we please mark as Exhibit 5 the
15 document that is titled US Patent 11,961,422.

16 (DEPOSITION EXHIBIT NUMBER 5
17 WAS MARKED FOR IDENTIFICATION.)

18 MR. BENNETT: Mr. Shi, might now be a good
19 time to take a break? It's been an hour.

20 MR. SHI: Give me five to ten, and then we
21 can take a break.

22 MR. BENNETT: Yeah. If we can go closer to
23 five than ten. Yeah.

24 MR. SHI: Okay. I'll do my best.

25 BY MR. SHI:

1 Q. Dr. Storey, do you recognize the document

2 shown as Exhibit 5 in front of you?

3 A. I do.

4 Q. This is the '422 patent that is at the heart

5 of the present case.

6 Is that correct?

7 A. That is correct.

8 Q. You've reviewed this document before; right?

9 A. Yes.

10 Q. Okay. I'm going to direct your attention to

11 the very back, where the claims are listed. We are in

12 Column 28 of the '422 patent, which is Exhibit 5.

13 About Line 21 is where the claims of the patent begin.

14 Do you see that, Dr. Storey?

15 A. Yes.

16 Q. I'm not going to read the whole thing out

17 loud, but I will read the first part -- excuse me. I

18 will read the first part of it. "What is claimed is,

19 1, a recyclable shrink label comprising a heat shrink

20 film comprising polyethylene terephthalate (PET)..."

21 Do you see that?

22 A. Yes.

23 Q. So PET is recited in Claim 1.

24 Do you agree?

25 A. Yes.

1 Q. I want to direct your attention now to
2 Claim 18 of the '422 patent, which is Exhibit 5. This
3 claim is found on Column 30, Line 4.

4 Do you see that?

5 A. Yes.

6 Q. Claim 18 depends from Claim 1.

7 Is that your understanding?

8 A. Yes.

9 Q. Right.

10 So it's your understanding that,
11 essentially, all of the other limitations of Claim 1
12 are included as if they were fully written out.

13 Is that correct?

14 A. Yes. That's my understanding.

15 Q. The extra limitation that Claim 18 adds
16 beyond what's recited in Claim 1 is simply where in
17 the heat shrink film comprises crystallizable
18 polyethylene terephthalate PET.

19 Do you agree?

20 A. Yes.

21 Q. Your opinion is that all PET is
22 crystallizable; correct?

23 MR. BENNETT: Objection. Form.

24 THE WITNESS: Yes. PET is inherently
25 crystallizable by its nature. Yes, I agree.

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1 BY MR. SHI:

2 Q. In your opinion, is there a difference
3 between Claim 1 and Claim 18?

4 MR. BENNETT: Objection. Form.

5 THE WITNESS: To me, it doesn't -- it
6 doesn't effectively add an additional limitation. So
7 to me, it seems to be about the same claim. Yes.

8 BY MR. SHI:

9 Q. So the record is clear, in your opinion,
10 there is no difference between Claim 1 and Claim 18;
11 right?

12 MR. BENNETT: Objection. Form.

13 THE WITNESS: I don't really know. I
14 think -- I think this is a legal issue. I don't know
15 anything about redundancy of dependent claims or
16 anything like that.

17 To me, crystallizable polyethylene
18 terephthalate is just terephthalate -- polyethylene
19 terephthalate. So as a non attorney, to me, it seems

20 like it's the same and no different.

21 BY MR. SHI:

22 Q. Okay. So as a non attorney, but as someone
23 who himself has patents, in your non attorney opinion,
24 Claim 1 and Claim 18 are the same; right?

25 MR. BENNETT: Objection. Form.

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1 THE WITNESS: That's -- I think so, yes.

2 BY MR. SHI:

3 Q. All right. Let's take a break here. We can
4 go off the record.

5 THE VIDEOGRAPHER: We are going off the
6 record. The time is 4:34 p.m.

7 (OFF THE RECORD AT 4:34 p.m. PT.)

8 (ON THE RECORD AT 4:52 p.m. PT.)

9 THE VIDEOGRAPHER: The time is 4:52 p.m. We
10 are back on the record.

11 BY MR. SHI:

12 Q. Dr. Storey, I want to turn, next, to your
13 opinions regarding the phrase comprising polyethylene
14 terephthalate. I believe this starts on Paragraph 103
15 of Exhibit 2, which is your claim construction
16 declaration.

17 Do you see that?

18 A. Not yet. Let me find that. Bear with me.

19 Okay.

20 Q. So earlier, we discussed your proposed

21 construction of polyethylene terephthalate, or PET.

22 This phrase is a bit different because it has that

23 transitional phrase comprising in it.

24 Is that fair?

25 A. Yes.

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1 Q. Now, earlier, when we were discussing your

2 IPR declaration, I think we agreed that it's your

3 understanding that the term comprising or comprises is

4 open-ended, which means that it doesn't exclude

5 additional or unrecited elements or steps.

6 Is that right?

7 A. Right. The other -- yes. It could contain

8 other unnamed or unlisted materials.

9 Q. Right.

10 And so beyond what you wrote in your IPR

11 declaration, what you wrote here in your claim

12 construction declaration is consistent that it's your

13 understanding that comprising must include PET but
14 could also include other things.

15 Is that fair?

16 A. Yes.

17 Q. And to bolster that understanding that you
18 have, you looked at the prosecution history and you
19 saw that there previously were other claims that were
20 proposed and later stricken -- or withdrawn, I should
21 say. And that -- sorry. Strike that. I think that's
22 a different concept.

23 You -- to bolster your understanding of what
24 comprising means, you compared Claim 1 to Claim 5 of
25 the '422 patent.

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1 Is that correct?

2 A. Yes. I talked about Claim 5 using the
3 language consists of, which is a closed-ended term, in
4 contrast to the open-ended compromises.

5 Q. Okay. So let's take a look at that claim
6 just to be sure we're talking about the same thing.

7 So I'm opening up Exhibit 5 once more, which
8 is the '422 patent. And before we get into that the
9 claims themselves, I do want to direct your attention

10 to Column 3 of Exhibit 5. Starting in Line --

11 starting at Line 15. So let me know when you're

12 there.

13 A. Which column?

14 Q. Column 3, starting at Line 15, please.

15 A. Okay. I'm there.

16 Q. Okay. So if you look with me, the patent

17 indicates that whenever it uses the word comprises,

18 that means a certain step or element is included and

19 other steps or elements are not included.

20 Did you review this definition in coming to

21 your opinion?

22 A. I read this -- yes. I did read this part of

23 the patent.

24 Q. And then similarly, at Column 3, Line 21,

25 the patent states that consisting of is different.

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1 And consisting of not only includes the listed element

2 or step, but it also excludes anything else.

3 Is that your understanding?

4 A. Yes.

5 Q. And did you rely on this disclosure of the

6 patent in coming to your opinion?

7 A. I definitely -- I did use this to understand
8 what was meant by Claim 5. Yes.

9 Q. I also do want to direct your attention to
10 the next paragraph on Column 3, which begins on
11 Line 34. There is a third term that the patent
12 introduces. That term is substantially.

13 Do you see that?

14 A. Yes.

15 Q. And when the patent uses the term
16 substantially, what it means is that the next thing
17 that follows the substantially has a quantitative
18 component of at least 90 percent -- or at least about
19 90 percent.

20 Do you see that?

21 A. I see that.

22 Q. And conversely, if the patent uses the term
23 not substantially, they mean the inverse of that so
24 that the thing that follows not substantially is no
25 more than 10 percent.

1 Do you see that?

2 A. I see that, yes.

3 Q. So would you agree that when the patent
4 discusses the term substantially, there is a
5 quantitative component; but when the patent discusses
6 the term comprises, there is no quantitative
7 component?

8 MR. BENNETT: Objection. Form.

9 THE WITNESS: I agree. Comprises is
10 open-ended. It could be -- it could be anywhere from
11 the barest fraction of 1 percent up to
12 99-and-a-fraction percent.

13 BY MR. SHI:

14 Q. Let's turn now to Claim 5. If I could find
15 my scroll bar. I will attempt to get both Claim 1 and
16 Claim 5 on the screen. There we go.

17 You can probably see where I'm going with
18 this, but just so the record is clear and your
19 opinions are clear, Claim 1 recites the heat shrink
20 film comprising PET.

21 Do you see that?

22 A. Yes.

23 Q. Claim 5 further specifies that that heat
24 shrink film recited in Claim 1 now must consist of
25 PET.

1 Do you see that?

2 A. Yes.

3 Q. So you would agree with me, then, that
4 Claim 1 requires a film that has PET in some capacity
5 but allows for other things to comprise the heat
6 shrink film.

7 Is that fair?

8 A. I'm not sure what you mean by capacity.

9 Q. Okay. I'll reframe the question.

10 Would you agree with me that Claim 1
11 requires a heat shrink film that includes PET and
12 could include other things?

13 A. Yes.

14 Q. And you would agree with me that the
15 difference between Claim 1 and Claim 5 is that with
16 respect to Claim 5, the heat shrink film must only
17 include PET and cannot include any other things?

18 A. It can't include any other polymers. I
19 agree that it cannot include other polymers. The film
20 itself has to contain only polyethylene terephthalate
21 as its sole polymer component.

22 Q. I understand.

23 So in your opinion, Claim 1 recites a heat

24 shrink film that must include PET and can possibly
25 include other polymers.

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1 Is that fair?

2 A. Yes. That is my understanding, yes.

3 Q. The difference between Claim 1 and Claim 5,
4 in your opinion, is that Claim 5 requires that the
5 heat shrink film consist of PET and no other polymers.

6 Is that fair?

7 A. I agree.

8 Q. Let's go back to Exhibit 2, which is your
9 claim construction declaration. And I believe we are
10 still on Paragraph 103 at the top of Page 31. Let me
11 know when you see that.

12 A. Okay.

13 Q. So in your opinion, you write: "By using
14 both the open-ended term comprising in the independent
15 claim and the close-ended term consistent of in the
16 dependent claim, the patentee made it clear that the
17 scope of Claim 1 was intended to cover films that
18 contain PET and films that are not 100 percent PET."

19 Is that your opinion?

20 A. Yes, that's my opinion.

21 Q. Okay. If we go to the next paragraph, which
22 is 104, you state: "The specification reenforces this
23 ambiguity..."

24 Do you see that?

25 A. Yes.

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1 Q. What ambiguity are you talking about here?

2 A. Yeah, that actually -- that really should
3 say "creates an ambiguity."

4 Q. So what you've written here is not quite
5 correct, then; right?

6 MR. BENNETT: Objection. Form.

7 THE WITNESS: I would rather not
8 characterize it that way. There is an ambiguity, but
9 I -- but there is a grammatical problem because I
10 didn't -- I talked about it as if it had been
11 discussed right above when, really, it's discussed
12 right below. So I may be guilty of structuring the
13 sentence poorly, but it's not wrong and it's not --
14 I'm not trying to pivot away from it or disavow it. I
15 think it should say the specification creates an
16 ambiguity, and then we can read on.

17 BY MR. SHI:

18 Q. I understand that.

19 So you're not suggesting that Paragraph 103
20 presents an ambiguity; right?

21 A. I'm not saying that. I'm just saying -- I'm
22 changing the topic. The specification creates an
23 ambiguity, and then we read on.

24 Q. Okay. So for me and my team and anyone else
25 reading your declaration, we should understand

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1 Paragraph 104 to start with the specification creates
2 an ambiguity, rather than saying the specification
3 reenforces this ambiguity.

4 Is that fair?

5 A. That's fair.

6 Q. All right. And to be clear, there is no
7 ambiguity introduced by your opinions in
8 Paragraph 103; right?

9 A. I don't think there is any ambiguity with
10 regard to the comparison between the open-ended term
11 comprising and the close-ended term consist of, no.

12 Q. Right.

13 And, in fact, you said that the patentee

14 made it clear that Claim 1 was intended to cover films
15 that contained PET and films that are not 100 percent
16 PET.

17 Is that right?

18 A. Yes. I did write that, and that is what I
19 meant above there. Yes.

20 Q. Okay. So if we look at the remainder of
21 Paragraph 104, you are now indicating that the
22 specification creates an ambiguity.

23 Can you explain to me what that ambiguity is
24 as you perceive it?

25 A. Yes.

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1 So the patent states that the film may be
2 made of PET in a combination with other polymers,
3 including PETG, polyvinyl chloride (PVC), polystyrene
4 or oriented polystyrene, lactic acid polypropylene,
5 and polyethylene.

6 Well, this creates an ambiguity because,
7 from the perspective of the POSITA, who is focused on
8 PET recycling, which is the purpose of the patent,
9 this list is compounding because it is clear that some

10 of these things -- for example, PVC is a good example.
11 And PLA is a good example. These are contaminants,
12 known contaminants that cannot be entered into a PET
13 recycling stream.

14 And so the problem is, if you have a film
15 that comprises PET, and the patent is saying that the
16 other components could be these other things used in
17 combination with PET, then that creates a problem when
18 you read the whole claim in context because the claim
19 says that it must also be recyclable with a PET
20 container. And so that's -- that's the ambiguity.
21 And that's the problem that I see here.

22 Q. I understand what you're saying, Dr. Storey.
23 I'm still having a hard time understanding what
24 exactly is ambiguous.

25 As I understand your testimony, you believe

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1 that PET is incompatible with some of these other
2 polymers with respect to recycling, but I'm not sure
3 what the ambiguity is.

4 MR. BENNETT: Objection. Form.

5 THE WITNESS: Well, I think it's a
6 contradiction. It's confusion because other polymers.

7 The teaching of the patent says that you can have
8 other polymers in here, like polyvinyl chloride. But
9 polyvinyl chloride cannot be tolerated in a recycling
10 stream, and so that creates -- it creates an
11 ambiguity, a contradiction.

12 BY MR. SHI:

13 Q. Dr. Storey, do you understand that an
14 ambiguity and a contradiction are two separate things?

15 MR. BENNETT: Objection. Form.

16 THE WITNESS: I do understand that they are
17 different.

18 BY MR. SHI:

19 Q. What you've identified, Dr. Storey, is what
20 you believe to be a contradiction between using PET
21 and PVC in combination and the ability of that
22 combination to be recycled.

23 Is that fair?

24 MR. BENNETT: Objection. Form.

25 THE WITNESS: Yes. And I think more than

1 that, I believe that it -- it also is the basis for my
2 belief that the claim is indefinite because I think

3 that a POSITA would not -- would not know what could
4 be used and what couldn't be used and how much of
5 something that could be used that is a known poison.

6 BY MR. SHI:

7 Q. Didn't you say in Paragraph 105 that it is
8 fundamental knowledge that a POSITA wouldn't use a
9 material like PVC and PLA with PET?

10 A. I did say that, yes.

11 Q. So your opinion is, actually, a POSITA would
12 know full well what can and can't be used; correct?

13 MR. BENNETT: Objection. Form.

14 THE WITNESS: A POSITA should know that PVC
15 should be avoided.

16 BY MR. SHI:

17 Q. POSITAs should know that PVC should be
18 avoided in combination with PET.

19 Is that your opinion?

20 A. Well, in -- yes. If it is to go into a
21 recycling stream, that is my opinion, yes.

22 Q. Is it your position that a POSITA should
23 know that PLA should be avoided in combination with
24 PET if the resulting combination is to go into a
25 recycling stream?

1 A. And that -- yes. And that is why the patent
2 would be confusing to the POSITA.

3 Q. Didn't you just say a POSITA should know
4 these things?

5 MR. BENNETT: Objection. Form.

6 THE WITNESS: Yes.

7 BY MR. SHI:

8 Q. So, really, a POSITA would not be confused
9 because he or she would know, well, gosh, I'm not
10 supposed to put PET and PVC together if this thing is
11 going to be recycled.

12 Isn't that right?

13 MR. BENNETT: Objection. Form.

14 THE WITNESS: A POSITA should know that.

15 BY MR. SHI:

16 Q. And, in fact, a POSITA at the time of the
17 patent would have known that; correct?

18 A. Yes.

19 Q. All right. You mentioned the term
20 indefinite. And I was going to get into
21 indefiniteness in a bit. I'm still a little bit stuck
22 on ambiguity, as you stated in Paragraph 104, because
23 I'm still having a hard time really understanding what
24 it is that you find ambiguous.

25 Can you help me understand that, please?

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1 MR. BENNETT: Objection. Form.

2 THE WITNESS: To me, reading the patent,
3 when the written description talks about using PET in
4 combination with many other things, it just seemed to
5 be compounding to me.

6 And if ambiguity was the -- perhaps it's not
7 the right word. But it just didn't make sense to me
8 to name these -- all of these different polymers that
9 could be used in combination with PET when the goal of
10 the patent is to have a shrink film that's recyclable
11 with a PET container.

12 BY MR. SHI:

13 Q. Dr. Storey, let me put it to you this way.

14 If I go to a pizza parlor, and I'm buying a
15 pizza for myself and a pizza for my friend, who is a
16 vegetarian -- are you with me so far?

17 A. Yes.

18 Q. There are a lot of toppings available at the
19 pizza parlor, some of which are meat.

20 Is that fair?

21 MR. BENNETT: Objection. Form.

22 THE WITNESS: Yes.

23 BY MR. SHI:

24 Q. I know that for a particular application for
25 my friend, who is a vegetarian, meat is incompatible

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1 with her pizza; right?

2 MR. BENNETT: Objection. Form.

3 THE WITNESS: Yes.

4 BY MR. SHI:

5 Q. So I know that in this particular case, I'm
6 not going to order a pizza with meat on it for her,
7 but for me, I might; right?

8 MR. BENNETT: Objection. Form.

9 THE WITNESS: Sir, I don't -- I don't know.
10 I don't know what you would do.

11 BY MR. SHI:

12 Q. All right. Let's take an actual look at the
13 piece of the patent that you think is ambiguous, which
14 I believe you cited as Column 1, 52 to 65.

15 So are you with me? Column 1, starting on
16 line 52 of the patent.

17 A. Yes.

18 Q. The patent discloses: "The heat shrink film
19 may include or be made of polyester, polyolefin, or a
20 combination thereof."

21 Is that correct?

22 A. That's what it says, yes, sir.

23 Q. "In some cases, the heat shrink film
24 includes or is made of polyethylene terephthalate
25 (PET), polyethylene terephthalate glycol-modified

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1 (PETG), polyvinyl chloride (PVC), polystyrene or
2 oriented polystyrene (OPS), polylactic acid (PLA),
3 polypropylene (PP), polyethylene (PE), or a
4 combination thereof."

5 Did I read that correctly?

6 A. Yes, you did.

7 Q. This disclosure does not say you must use
8 PET and each one of these other polymers.

9 It doesn't say that; right?

10 A. No.

11 Q. It, in fact, doesn't say you have to use PET
12 at all for this particular embodiment; right?

13 A. Well, Claim 1 says that you have to use PET.

14 Q. I understand. But I'm not asking about
15 Claim 1, I'm asking about the portion of the patent
16 that you identified as creating an ambiguity. So I'm
17 going to ask the question again.

18 This disclosure of the patent does not say
19 you must use PET at all; right?

20 MR. BENNETT: Objection. Form.

21 THE WITNESS: This portion of the patent
22 does not say that, I agree.

23 BY MR. SHI:

24 Q. In fact, the next sentence of this paragraph
25 that you've cited says: "In some cases, the heat

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1 shrink film consists of polyethylene terephthalate
2 (PET), polyethylene terephthalate glycol-modified
3 (PETG), polyvinyl chloride (PVC)..." et cetera, "or a
4 combination thereof."

5 Correct?

6 A. Correct.

7 Q. Again, the patent does -- this disclosure of
8 the patent does not require the use of PET at all for
9 this particular embodiment; correct?

10 MR. BENNETT: Objection. Form.

11 THE WITNESS: I don't -- I don't have an
12 opinion.

13 BY MR. SHI:

14 Q. Okay. So you don't have an opinion about
15 this portion of the patent that you cited in your
16 declaration?

17 MR. BENNETT: Objection. Form.

18 THE WITNESS: I agree that this section of
19 the patent -- whether it's an embodiment or not, I
20 don't know, but this section of the patent that I
21 quoted does not require PET. I agree with that.

22 BY MR. SHI:

23 Q. The last sentence of this paragraph states:
24 "In some cases, the heat shrink film consists of
25 polyethylene terephthalate (PET)."

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1 Did I read that correctly?

2 A. Yes.

3 Q. So only when we get to the very last
4 sentence of this paragraph, in some cases, we have a
5 situation where the entire shrink film is made of PET
6 and no other polymers.

7 Would you agree?

8 A. Yes.

9 Q. Okay. So let's go back to your declaration

10 in Paragraph 104.

11 Do you understand that the paragraph we just

12 looked at together is the only thing you cite in

13 Paragraph 104?

14 MR. BENNETT: Objection. Form.

15 THE WITNESS: Yes, it's the only thing I

16 cite.

17 BY MR. SHI:

18 Q. And, yet, the only thing you cite does not

19 say that a POSITA must make a film out of PET and, for

20 instance, polyvinyl chloride?

21 MR. BENNETT: Objection. Form.

22 THE WITNESS: Yes. The part that I cite

23 does not require using PET with polyvinyl chloride.

24 BY MR. SHI:

25 Q. Let's move to Paragraph 105 of your

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1 declaration. You state in this paragraph: "The

2 patent provides no guidance on the scope of a claim

3 that suggests combining PET with other unnamed

4 substances to achieve a recyclable film."

5 Do you see that?

6 A. I do.

7 Q. You also state that the patent "fails to
8 demonstrate how to create a recyclable film by
9 combining PET with other unnamed substances, including
10 possible unknown contaminants."

11 Did I read that correctly?

12 A. Yes.

13 Q. Is it your opinion that to craft a
14 nonindefinite claim that the patent needed to list out
15 how to make every single possible combination that was
16 disclosed in the specification?

17 MR. BENNETT: Objection. Form.

18 THE WITNESS: I think my problem with it is
19 that anything -- anything other than PET is a problem.

20 BY MR. SHI:

21 Q. You can't think of any blend or combination
22 of PET and something else that would be recyclable?

23 A. No, I cannot.

24 Q. Let's go to Paragraph 103 of Exhibit 3,
25 please, which is your IPR declaration.

1 A. Which paragraph?

2 Q. Oh, excuse me. It is a different paragraph
3 than the one I said. Give me one second.
4 Paragraph 79, please. Let me know when
5 you're there.

6 A. I'm there.

7 Q. All right. In Paragraph 79 of your IPR
8 declaration, you are discussing a purported prior art
9 reference, the Lee reference.
10 Do you see that?

11 A. Yes.

12 Q. This is your opinion: "Lee discloses a
13 polyester resin blend comprising PET, which can be
14 virgin or recycled PET, and a specific copolyester
15 resin."

16 Did I read that correctly?

17 A. Yes.

18 Q. Your opinion further states: "This
19 copolyester resin is engineered with particular
20 comonomers, including a diol moiety derived from a
21 comonomer containing cyclohexanedimethanol,
22 4-(hydroxymethyl)cyclohexymethyl, 4" -- et cetera.
23 Do you see that?

24 A. Yes.

25 Q. "And specific diacid-derived moieties

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1 designed to control the film's crystallization

2 behavior."

3 Did I read that correctly?

4 A. Yes.

5 Q. So in your opinion, Lee has disclosed a

6 blend comprising PET and something else that is not

7 PET; correct?

8 A. Yes.

9 Q. Okay. Let's look at Paragraph 80 of

10 Exhibit 3. This is your opinion: "A key teaching of

11 Lee, highly relevant to its purpose, is that its heat

12 shrinkable label 'can be reused while attached to a

13 PET container, et cetera, and is expected to be useful

14 for providing continuously usable plastics that have

15 been recently attracting attention.'"

16 Did I read that correctly?

17 A. Yes. I'm quoting Lee there.

18 Q. Right.

19 You're quoting Lee, which seems to suggest

20 that whatever it's describing can be recycled while

21 attached to a PET container.

22 Is that correct?

23 A. That is correct, but there are -- there are
24 other opinions about this. You know, the APR document
25 that you have brought up in the -- already today says

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1 that you cannot use these things in a PET recycling
2 stream.

3 Q. I see.

4 So you think Lee is wrong.

5 Is that right?

6 MR. BENNETT: Objection. Form.

7 THE WITNESS: I don't think Lee is wrong in
8 terms of many of the things that he's saying here, but
9 I'm just telling you that not everyone agrees that
10 those polymer blends that he talks about are
11 permissible in a PET recycling stream.

12 BY MR. SHI:

13 Q. Do you agree that the polymer blends that
14 Lee is talking about are permissible in a PET
15 recycling stream?

16 MR. BENNETT: Objection. Form.

17 THE WITNESS: I think -- you know, I don't

18 have an opinion on that, really. I just know that
19 some folks, the APR document for example, says that
20 this cannot be used. Lee says it can.

21 But for the purposes of the current
22 proceeding, I know that Applicant put forth the APR
23 document. It says that you should not use those
24 things. It's detrimental, I believe was the word that
25 was used, in a recycling stream. And so that is what

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1 I'm basing this indefiniteness argument on.

2 BY MR. SHI:

3 Q. So you have no opinion on whether Lee's
4 disclosed heat shrinkable label can be processed
5 within a standard PET recycling stream.

6 Is that right?

7 MR. BENNETT: Objection. Form.

8 THE WITNESS: That's correct.

9 BY MR. SHI:

10 Q. Well, let's look at Paragraph 215 of the
11 same document on Exhibit 3.

12 Let me know when you're there.

13 A. Which one? 215?

14 Q. That's right. It's on Page 110 of

15 Exhibit 3.

16 A. Yeah. I'm looking at paragraph numbers.

17 Okay.

18 Q. This is your opinion. I'm reading from the
19 second sentence. "Lee's central teaching is the
20 provision of a PET-based shrink film specifically
21 engineered through careful control of blend
22 composition and resulting crystallizability so that
23 the label can be reused while attached to a PET
24 container and successfully processed within standard
25 PET container recycling streams."

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1 Did I read that correctly?

2 A. Yes.

3 Q. So it is, in fact, your opinion that Lee
4 teaches a heat shrink film that comprises PET and
5 something that is not PET, that it can be successfully
6 processed within a standard PET recycling stream?

7 A. That is -- that is Lee's teaching.

8 Q. And do you agree?

9 A. I think it -- I have no opinion because it's
10 contradicted by other sources that I've read.

11 Q. Dr. Storey, this is your opinion. And these
12 are words that you wrote; correct?

13 [Simultaneous speaking.]

14 MR. BENNETT: Objection. Form. Objection
15 form.

16 THE WITNESS: Yes.

17 BY MR. SHI:

18 Q. Isn't it true that Lee is a prior art
19 reference that you are relying on for an invalidity
20 opinion of the '422 patent?

21 MR. BENNETT: Objection. Form.

22 THE WITNESS: Yes.

23 BY MR. SHI:

24 Q. You are essentially telling the PTAB that
25 the '422 patent is invalid, in part, based on what Lee

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1 teaches; correct?

2 MR. BENNETT: Objection. Form.

3 THE WITNESS: In part, yes.

4 BY MR. SHI:

5 Q. And now you're telling me in this deposition
6 that, you know what, we should ignore what Lee teaches
7 because it's contradicted by something else.

8 Is that right?

9 MR. BENNETT: Objection. Form.

10 THE WITNESS: I'm just saying I don't have

11 an opinion.

12 BY MR. SHI:

13 Q. I hate to disagree with you, Dr. Storey, but

14 I think you do have an opinion, and it's Exhibit 3 in

15 front of us.

16 Is this not your opinion?

17 MR. BENNETT: Objection. Form.

18 THE WITNESS: I have no opinion.

19 BY MR. SHI:

20 Q. So to be clear, you have no opinion as to

21 whether or not you agree or disagree with something

22 you wrote in your own declaration?

23 MR. BENNETT: Objection. Form.

24 THE WITNESS: I don't know.

25 BY MR. SHI:

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1 Q. You don't know, meaning you have no answer

2 to my question; right?

3 A. I have no answer to your question.

4 Q. Okay. Let's take a break here.

5 MR. BENNETT: Okay. Five minutes?

6 MR. SHI: Let's go to 45.

7 MR. BENNETT: Okay.

8 THE VIDEOGRAPHER: We are going off the

9 record. The time is 5:36 p.m.

10 (OFF THE RECORD AT 5:36 p.m. PT.)

11 (ON THE RECORD AT 5:50 p.m. PT.)

12 THE VIDEOGRAPHER: The time is 5:50 p.m. We

13 are back on the record.

14 BY MR. SHI:

15 Q. Welcome back, Dr. Storey. Before -- in the

16 last session, before we turned to your IPR

17 declaration, you said something. I believe it was

18 something like you're just -- you're not sure if there

19 is a material that is a blend of PET that can also be

20 recycled with PET.

21 Do you recall saying that?

22 A. Yes.

23 Q. Okay. Isn't it true that the determination

24 of whether something has PET is an entirely different

25 analysis than the determination of whether that

1 material is recyclable with PET?

2 A. So you're asking is a determination that a
3 material contains PET different? Is that what you
4 meant by have?

5 Q. Right, right. They're just -- they're
6 different questions; right?

7 A. Well, they are different questions. Yes, I
8 agree with that. But they're related -- they're
9 probably going to be related questions. But, yes,
10 they're different questions.

11 Q. All right.

12 MR. SHI: Mr. Pantoja, if you could bring up
13 the demonstrative exhibit titled Chart. And let's
14 mark this as Demonstrative Exhibit Number 2.

15 (DEMONSTRATIVE EXHIBIT NUMBER 2
16 WAS MARKED FOR IDENTIFICATION.)

17 BY MR. SHI:

18 Q. All right. Dr. Storey, what you're being
19 shown --

20 A. Hold on one -- just one second. I didn't --
21 I lost my -- I wanted to load it on to my desktop. I
22 didn't --

23 THE WITNESS: I don't have that link,
24 Mr. Videographer.

25 BY MR. SHI:

1 Q. So, Dr. Storey, there is no link to this
 2 one.

3 MR. SHI: Unless, William, if you want to --
 4 can you drop it in the chat?

5 THE TECHNICIAN: Yeah. It's been dropped
 6 into the chat for a while.

7 THE WITNESS: Well -- but I can't see it
 8 because it -- it's not visible to me.

9 MR. SHI: Let's go off the record.

10 THE VIDEOGRAPHER: We are going off the
 11 record. The time is 5:52 p.m.

12 (OFF THE RECORD AT 5:52 p.m. PT.)

13 (ON THE RECORD AT 5:53 p.m. PT.)

14 THE VIDEOGRAPHER: The time is 5:53 p.m. We
 15 are back on the record.

16 BY MR. SHI:

17 Q. Let's see. Dr. Storey, what we're showing
 18 on the screen in front of you is what's been marked as
 19 Demonstrative Exhibit 2.

20 Do you see it?

21 A. I see it, yes.

22 Q. Okay. So earlier, you indicated that it was
23 your understanding that the question of if something
24 includes PET is different than the question of whether
25 something is recyclable with a PET bottle.

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1 Do you recall saying that?

2 A. Well, I -- yes. I remember agreeing with
3 that, yes.

4 Q. You agreed with that statement; right?

5 A. Yes.

6 Q. What I've made is just a little chart. I
7 used the word has; I understand that you would rather
8 I say includes. We can pretend that the word had has
9 includes if you wish. But on the left, there are,
10 essentially, two choices for material, right. It's
11 that the material either includes PET or it doesn't.

12 Would you agree with that?

13 A. I'm still trying to comprehend your chart
14 here. So -- let's see. Has PET. No PET.

15 So the bottom row, reading across, there is
16 no PET in the -- in the label.

17 Is that what we're saying?

18 Q. So, Dr. Storey, with this chart, what I'm

19 trying to illustrate are the different possibilities
20 for any given label.

21 Are you okay with that?

22 A. Yeah, I'm still trying to understand what
23 you're doing here. Why is one green?

24 Q. Well, I'll get to that, but for now,
25 Dr. Storey, I'm asking you a question.

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1 That is, would you agree that for any given
2 material, it either includes PET or it doesn't?

3 A. Yes.

4 Q. Okay. Would you agree that for any given
5 material, it is either recyclable with a PET bottle or
6 it is not?

7 A. That one is less cut-and-dry than the first
8 one. So I'm --

9 Q. Okay.

10 A. But, yeah -- I mean, it depends, okay. It
11 depends, perhaps, on the recycling center. It depends
12 on the intended use of the regrind and so forth and so
13 on. But, yeah, so...

14 Q. So is your answer that you agree or

15 disagree?

16 A. I think I -- I think -- I disagree that it's
17 black and white. I agree -- this is sort of like a
18 logic chart, okay. I've seen these before.

19 I agree that something either has, to use
20 your word, PET in it or it doesn't have PET in it.
21 But I don't agree that a label is either recyclable
22 with a PET bottle or not because, in one, say,
23 recycling plant, maybe it works; in another one, maybe
24 it doesn't work. So, no, I do not agree.

25 Q. Dr. Storey, earlier, you testified that it

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1 was your opinion that a POSITA would understand that
2 achieving recyclable with PET status, particularly for
3 widespread commercial use, generally involves meeting
4 such industry-recognized benchmarks, as published by
5 the APR.

6 Do you recall that testimony?

7 A. I do.

8 Q. So would you agree, then, that as a POSITA
9 would understand, a label being recyclable with a PET
10 bottle, a POSITA would ask, "Well, does that label
11 meet industry-recognized benchmarks"?

12 A. I maintain my answer. I still think that
13 there is not complete agreement on what is recyclable
14 and what is not recyclable.
15 Q. Okay. Let's go back to your IPR
16 declaration. Exhibit 3 at Paragraph 111. Let me know
17 when you're there.
18 A. Oh, Exhibit 3. Which paragraph, sir?
19 Q. 111.
20 A. Okay.
21 Q. In Exhibit 3, which is your declaration, you
22 opine that a POSITA would understand that achieving
23 recyclable with PET status, particularly for
24 widespread commercial use, generally involves meeting
25 such industry-recognized benchmarks."

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1 Do you see that?
2 A. Practices and Guidelines. Yes, I see that.
3 Q. Dr. Storey, I'm looking at the last sentence
4 of Paragraph 111.
5 A. Oh, on Page 65?
6 Q. Correct.
7 A. Uh-huh. "A POSITA would understand that

8 achieving recyclable with PET status, particularly for
9 widespread commercial use, generally involves meeting
10 such industry-recognized benchmarks to ensure the
11 label contributes to, rather than detracts from, the
12 circular economy of PET."

13 Yes, that's what I wrote.

14 Q. So it is your opinion that a POSITA
15 understanding -- strike that.

16 It is your opinion that to a POSITA, whether
17 or not something is recyclable with PET depends on
18 whether that something meets industry-recognized
19 benchmarks; correct?

20 MR. BENNETT: Objection. Form.

21 THE WITNESS: Yes.

22 BY MR. SHI:

23 Q. Okay. Would you agree with me that for any
24 given label, it will either meet industry-recognized
25 benchmarks or it will not meet industry-recognized

1 benchmarks for recyclable with PET status?

2 MR. BENNETT: Objection. Form.

3 THE WITNESS: Yes.

4 BY MR. SHI:

5 Q. Okay. Thank you.

6 Can we please go off the record for two

7 minutes?

8 THE VIDEOGRAPHER: We are going off the

9 record. The time is 6:02 p.m.

10 (OFF THE RECORD AT 6:02 p.m. PT.)

11 (ON THE RECORD AT 6:04 p.m. PT.)

12 THE VIDEOGRAPHER: The time is 6:04 p.m. We

13 are back on the record.

14 BY MR. SHI:

15 Q. Dr. Storey, before the break, we were

16 discussing the chart marked Demonstrative Exhibit 2.

17 You indicated that you weren't sure about the standard

18 of whether or not something is recyclable.

19 Do you recall saying that?

20 A. Yes.

21 Q. And then we looked at your opinion in the

22 IPR petition, and you agreed with me that a POSITA

23 would determine whether or not something is recyclable

24 with PET based on whether it meets industry-recognized

25 benchmarks; correct?

1 MR. BENNETT: Objection. Form.

2 THE WITNESS: Yes.

3 BY MR. SHI:

4 Q. Okay. So let's look at a new demonstrative
5 exhibit that is labeled D03 Revised Chart. It's
6 available for download. It's also being shown on the
7 screen.

8 Dr. Storey, do you see that?

9 A. I see it. And I have downloaded it.

10 (DEMONSTRATIVE EXHIBIT NUMBER 3
11 WAS MARKED FOR IDENTIFICATION.)

12 BY MR. SHI:

13 Q. Okay. So earlier, you described this as
14 sort of a logic chart.

15 Is that fair?

16 A. I did describe it as such, yes.

17 Q. Okay. So you'll agree with me that there
18 are four possible outcomes if we were considering the
19 two questions, does a label include PET and does a
20 label meet industry-recognized benchmarks for
21 recyclable with PET status.

22 Is that fair?

23 A. That is fair.

24 Q. And so would you agree that these four
25 quadrants represent the four possible outcomes of

1 considering those two questions simultaneously?

2 A. Yes.

3 Q. In the upper left-hand quadrant that's been
4 colored green, is it your understanding that a label
5 that falls within this quadrant is within the scope of
6 the patent provided that it meets all the other
7 limitations of the patent?

8 MR. BENNETT: Objection. Form.

9 THE WITNESS: Yes.

10 BY MR. SHI:

11 Q. For the other three quadrants that are
12 highlighted in pink, is it your understanding that a
13 label that falls on one of those quadrants would not
14 be in the scope of the '422 patent regardless of what
15 other limitations it meets?

16 MR. BENNETT: Objection. Form.

17 THE WITNESS: I agree. Outside of the
18 scope, those three, yes.

19 BY MR. SHI:

20 Q. All right. You can set that to the side.
21 And we'll go back to Exhibit 2, which is your claim
22 construction declaration.

23 Let's -- if you look with me at
24 Paragraph 108 of Exhibit 2. Let me know when you're
25 there.

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1 A. All right.

2 Q. In this paragraph, it's your opinion that
3 the applicant of the '422 patent disclaimed some scope
4 in the prosecution history.

5 Is that correct?

6 MR. BENNETT: Objection. Form.

7 THE WITNESS: Yes. I believe that to be the
8 case.

9 BY MR. SHI:

10 Q. Specifically, it's your opinion that the
11 applicant of the '422 patent disclaimed any label that
12 is meant to merely separate from PET and, instead,
13 limited the invention to films that are recovered with
14 the PET stream.

15 Is that your opinion?

16 MR. BENNETT: Objection. Form.

17 THE WITNESS: Yes.

18 BY MR. SHI:

19 Q. Okay. And then in the last sentence of
20 Paragraph 108, it's your opinion that a POSITA would
21 understand that the applicants limited the claims to
22 only PET-based films that are recovered with the PET.
23 A. Yes. That is my opinion.
24 Q. Let's go to Paragraph 111 of Exhibit 2.
25 It's your opinion, Dr. Storey, that the

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1 phrase PET-based provides no objective boundary;
2 right?
3 A. It is vague, yes. It's my opinion it is
4 vague. And it provides -- thereby provides no
5 objective boundary.
6 Q. Would it surprise you, Dr. Storey, to learn
7 that you yourself used the phrase PET-based no fewer
8 than 18 times in your IPR declaration?
9 MR. BENNETT: Objection. Form.
10 THE WITNESS: I don't know if that would
11 surprise me or not.
12 BY MR. SHI:
13 Q. If you look with me at Exhibit 3, and
14 specifically at Paragraph 114.
15 Let me know when you're there.

16 A. I'm there.
17 Q. In Paragraph 114, you're discussing a prior
18 reference, Schurr.
19 Is that correct?
20 A. Yes.
21 Q. In the middle of the first sentence, you
22 opine that: "A POSITA would still find it obvious to
23 ensure that a label based on Schurr's PET-based film
24 was recyclable with a PET container and a co-mingled
25 stream."

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1 Do you see that?
2 A. Yes.
3 Q. What did you mean when you said PET-based
4 film?
5 A. I don't really recall. You know, I have not
6 looked at this for three months, so I'm not really
7 sure what was going through my mind then.
8 Q. Okay. So you have no opinion as to what you
9 meant when you said PET-based film in this instance in
10 Exhibit 3?
11 A. I don't recall what I meant.

12 Q. Okay. So -- I understand you, I just -- as
13 an answer to my question, sitting here today, you
14 can't provide me an answer because you can't recall
15 what you meant.

16 Is that correct?

17 MR. BENNETT: Objection. Form.

18 THE WITNESS: That is -- that is correct.

19 BY MR. SHI:

20 Q. And for the other dozen and a half instances
21 in your declaration, Exhibit 3, where you used the
22 phrase PET-based, similarly, is it correct that you
23 can't tell me what you meant by that phrase?

24 MR. BENNETT: Objection. Form.

25 THE WITNESS: I cannot recall what I meant

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1 by that phrase.

2 BY MR. SHI:

3 Q. Okay. Let's go back to Exhibit 2. If you
4 look with me -- starting on Paragraph 116 of
5 Exhibit 2. Let me know when you're there.

6 A. I'm there.

7 Q. In this paragraph, you provide the opinion:

8 "...if the Court determines that the phrase comprising

9 PET does not render the claims invalid, then the Court
10 should nevertheless provide a construction that
11 reflects the Applicant's representations to the USPTO
12 regarding the invention."

13 Is that your opinion?

14 A. Yes.

15 Q. And then when you -- if you were to scroll
16 down to Paragraph 118 of Exhibit 2, you propose an
17 alternative construction. And that construction is "a
18 heat shrink film the majority of which is polyethylene
19 terephthalate."

20 Is that your proposal?

21 A. That is my proposal, yes.

22 Q. By a majority, do you mean 51 percent?

23 A. I mean greater than 50 percent.

24 Q. So the right way to interpret your proposed
25 construction is a heat shrink film that is greater

1 than 50 percent polyethylene terephthalate.

2 Is that fair?

3 A. That is fair.

4 Q. Where did the 50 percent number come from?

5 A. Just the logical reasoning that if it was
6 less, then it would not be considered PET-based. It's
7 just the only -- the only interpretation that -- that
8 I felt made sense in this -- in this case.

9 Q. So if I'm understanding you correctly, the
10 greater than 50 percent figure came from your logical
11 interpretation of what it could mean to be PET-based.

12 Is that right?

13 A. Yes. That's right.

14 Q. Is that the same understanding of PET-based
15 that you applied in your IPR declaration?

16 MR. BENNETT: Objection. Form.

17 THE WITNESS: I don't remember the context
18 of those 18 occurrences that you refer to. I'm sorry.
19 I don't recall.

20 BY MR. SHI:

21 Q. In Paragraph 118, you don't cite to anything
22 in the patent about greater than 50 percent
23 polyethylene means PET-based; right?

24 A. No. Because the PET-based term didn't even
25 come from the patent. It came from the -- it came

1 from the prosecution history.

2 Q. And are you aware that within the
3 prosecution history, it originally came from the APR?

4 A. Yes. The APR that was submitted to the
5 patent office by Applicant. Yes.

6 Q. In Paragraph 118, you don't cite to any APR
7 document; correct?

8 A. Well, I do in a sense, in the last sentence
9 because the PET-based term, the -- in parentheses,
10 that came from the prosecution history.

11 Q. Where in Paragraph 118 do you write the word
12 APR?

13 A. Well, I don't do it in 18. I do it earlier.
14 I do it elsewhere.

15 Q. So let me ask my question again.

16 In Paragraph 118, you don't have any
17 citation sentence that cites to anything issued by the
18 APR.

19 Is that correct?

20 MR. BENNETT: Objection. Form.

21 THE WITNESS: I don't in 118, but I do
22 earlier in my development of this very complicated
23 concept. It is -- it is. I cite it. It's up in
24 Paragraph 110. It is -- I agree with you, it is not
25 in 118.

1 BY MR. SHI:

2 Q. Let's look at Paragraph 110.

3 Where in Paragraph 110 did you cite to the

4 APR?

5 A. Well, it's right -- it's right above there.

6 In Paragraph 109, I am quoting Plaintiff in the post
7 grant proceeding. And they -- "During prosecution,
8 Applicant overcame a 103 rejection stating that the
9 shrink labels taught by Mitchell... are not made of
10 PET and would not be recyclable with a PET container,
11 because labels made of other materials, including
12 polypropylene, polyethylene, and paper, are considered
13 contaminates in a PET recycling stream and need to be
14 removed for the PET container to be recycled.
15 Applicant further explained that" -- and this is the
16 title of that APR document -- "Shrink Sleeve Labels on
17 PET Containers APR Resource Document states: 'APR
18 recommends films that are compatible with PET
19 recycling such as films that float in water and that
20 can be separated, and PET-based films" -- that's where
21 it comes from. "PET-based films that crystalize and
22 can be recovered with the PET stream. Applicant

23 distinguished the Mitchell reference stating it does
24 not fall into the second category and is not
25 recyclable with the PET stream. Thus, Applicant

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1 informed a POSITA that the claimed invention was
2 limited to PET-based films."

3 Q. So thank you for reading all of that into
4 the record.

5 My question to you is, where, in any of the
6 guidance that you just read, suggests that 50 percent
7 is the right number -- or greater than 50 percent is
8 the right number?

9 MR. BENNETT: Objection. Form.

10 THE WITNESS: It doesn't. It is -- it is
11 vague. It's very vague, PET-based films. And so I am
12 providing a proposed alternative construction -- this
13 is an alternative construction -- that makes the most
14 sense to me. The heat shrink film the majority of
15 which is polyethylene terephthalate.

16 There is no support for this in the patent
17 because the patent never even mentions -- it never
18 states the words PET-based. That came from the
19 prosecution history, which I just read into the

20 record.

21 BY MR. SHI:

22 Q. Outside of what makes logical sense to you,
23 Dr. Storey, you don't rely on anything else to
24 determine a greater than 50 percent figure in your
25 alternative construction; correct?

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1 A. That is correct. I find it to be the only
2 reasonable interpretation for the term.

3 Q. Okay. Let's take a break here. It can be
4 fairly short. I don't need a ton of time for this
5 break.

6 THE VIDEOGRAPHER: We are going off the
7 record. The time is 6:21 p.m.

8 (OFF THE RECORD AT 6:21 p.m. PT.)

9 (ON THE RECORD AT 6:28 p.m. PT.)

10 THE VIDEOGRAPHER: The time is 6:28 p.m. We
11 are back on the record.

12 BY MR. SHI:

13 Q. Dr. Storey, thank you very much for your
14 time today. At this point, I have no further
15 questions. Pending anything that your counsel may ask

16 you.

17 A. Thank you.

18 MR. BENNETT: We will need to go off the
19 record for just a moment, please.

20 MR. SHI: Okay.

21 THE VIDEOGRAPHER: We are going off the
22 record. The time is 6:28 p.m.

23 (OFF THE RECORD AT 6:28 p.m. PT.)

24 (ON THE RECORD AT 7:17 p.m. PT.)

25 THE VIDEOGRAPHER: The time is 7:17 p.m. We

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1 are back on the record.

2 EXAMINATION

3 BY MR. BENNETT:

4 Q. Good evening, Dr. Storey. I have a few
5 follow-up questions for you.

6 MR. BENNETT: I beg your pardon. The
7 concierge, could the concierge please bring up
8 Exhibit 2.

9 THE TECHNICIAN: One moment.

10 BY MR. BENNETT:

11 Q. And, Dr. Storey, you have a copy available
12 to you of your -- Exhibit 2, your declaration?

13 A. I do.

14 Q. If you could open that up as well.

15 A. I have it open.

16 Q. Okay.

17 MR. BENNETT: And then I can control the

18 screen? Am I able to control the -- I sure am.

19 Wonderful. Scrolling to Paragraph 65.

20 BY MR. BENNETT:

21 Q. Dr. Storey, could you please read to

22 yourself Paragraph 65. And let me know when you're

23 done.

24 A. Okay. I'm done.

25 Q. Do you recall a discussion earlier with

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1 counsel for Plaintiff regarding the specific ester
2 that was in your proposed construction, the specific
3 ester of TPA that was in your proposed construction
4 for PET?

5 A. Yes.

6 [Simultaneous speaking.]

7 MR. SHI: Objection. Form.

8 BY MR. BENNETT:

9 Q. As -- you've read Paragraph 65, Dr. Storey?

10 A. Yes.

11 Q. Would you have any concern if the Court
12 construed PET to include, really, any ester of TPA,
13 not just TPA's dimethyl ester?

14 A. I would have no problem with that because
15 any ester would work. And it would give the same PET
16 polymer.

17 Q. Just to clarify your earlier testimony, why
18 is it that you proposed that -- TPA's dimethyl ester
19 specifically, rather than just any ester?

20 A. Because that's the only one that is used
21 commercially in the whole world.

22 MR. BENNETT: William, could you please
23 bring up Exhibit 3. And it may be easier for you if
24 you could just scroll to the end, please. Thank you.
25 I could take it over from here.

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1 BY MR. BENNETT:

2 Q. Dr. Storey, do you recall being asked
3 whether you had considered Multi-Color's petition in
4 preparing your declaration in connection with AFS's
5 petition for interparty's review?

6 A. I do recall that.

7 Q. Please look at Appendix A on the screen.

8 And let me know when you've looked at it.

9 A. Okay. Keep scrolling. Okay. Okay.

10 Q. Does that refresh your recollection whether

11 you, indeed, had considered the Multi-Color petition?

12 A. It does. I didn't.

13 Q. I believe close to the beginning of the

14 deposition, you were asked -- withdrawn.

15 MR. BENNETT: Could you please, William, go

16 to Exhibit 2?

17 BY MR. BENNETT:

18 Q. Okay. Exhibit 2 is the declaration you

19 submitted in connection with claim construction in

20 this litigation.

21 Isn't that right, Dr. Storey?

22 A. Yes.

23 Q. You were asked toward the beginning of this

24 deposition whether this exhibit contains all of your

25 now-existing opinions regarding claim construction.

2 A. Yes.

3 Q. After you submitted this declaration, you
4 have had an opportunity to review -- withdrawn.

5 After you submitted this declaration, did
6 you have an opportunity to review the declaration of
7 Brook & Whittle's expert?

8 A. Yes.

9 Q. Do you have any opinions regarding her
10 declaration and her opinions in her declaration?

11 A. I do.

12 Q. What are those opinions?

13 A. She, in her declaration, incorrectly equates
14 copolymers with blends. And she makes the claim that
15 a copolymer, for example PETG, contains PET. But this
16 is completely incorrect and against the principles of
17 polymer science. And, in fact, no copolymer can
18 contain PET.

19 MR. SHI: Sorry. I need to object to that
20 question on the basis of form.

21 MR. BENNETT: William, I'm going to drop in
22 chat the declaration. Could you mark this, please, as
23 the next exhibit number.

24 (DEPOSITION EXHIBIT NUMBER 6
25 WAS MARKED FOR IDENTIFICATION.)

1 THE TECHNICIAN: This will be Exhibit 6.

2 MR. BENNETT: Yeah. One moment, please,
3 though.

4 And then, William, if you could kindly bring
5 up this exhibit when you're ready to do so.

6 THE TECHNICIAN: One moment.

7 MR. SHI: I'm going to lodge a standing
8 objection to this entire line of questioning, but I
9 will repeat my objections question by question.

10 MR. BENNETT: William, could you please turn
11 to Page 20? Thank you.

12 BY MR. BENNETT:

13 Q. Dr. Storey, could you please read
14 Paragraph 56 -- withdrawn.

15 I'm going to scroll to the top.

16 Dr. Storey, do you see what's been marked as
17 Exhibit 6?

18 A. Yes.

19 MR. SHI: Object to form.

20 BY MR. BENNETT:

21 Q. Do you have an understanding of Exhibit 6?

22 MR. SHI: Object to form.

23 THE WITNESS: Yes. This is a declaration

24 submitted by Dr. Erin Askounis regarding claim
25 construction in this matter.

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1 BY MR. BENNETT:

2 Q. Have you read this declaration, Dr. Storey?

3 MR. SHI: Object to form.

4 THE WITNESS: Yes.

5 BY MR. BENNETT:

6 Q. You testified that she incorrectly equates
7 copolymers with blends.

8 Do you recall that testimony?

9 MR. SHI: Object to form. Leading.

10 THE WITNESS: Yes. I recall.

11 BY MR. BENNETT:

12 Q. And that she makes the claim that a
13 copolymer, for example PETG, contains PET.

14 Did I quote your --

15 A. Yes.

16 Q. -- testimony correctly?

17 MR. SHI: Object to form.

18 THE WITNESS: Yes. And she does it in
19 several places in the declaration.

20 BY MR. BENNETT:

21 Q. Could you please read Paragraph 56 to
22 yourself.

23 MR. SHI: Object to form.

24 THE WITNESS: Okay.

25 BY MR. BENNETT:

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1 Q. Is Paragraph 56 an example of her --
2 withdrawn.

3 Dr. Storey, do you have an opinion regarding
4 the contents of Paragraph 56?

5 MR. SHI: Object to form.

6 THE WITNESS: I do.

7 BY MR. BENNETT:

8 Q. What is your --

9 A. She makes a statement here --

10 [Simultaneous speaking.]

11 THE WITNESS: -- that a copolymer or polymer
12 blend with PET could be considered as a material
13 comprising PET irrespective of the amount of PET used
14 in the copolymer or polymer blend.

15 It is true that a polymer blend could
16 contain some amount of PET, but it is impossible for a

17 copolymer to contain any PET.

18 BY MR. BENNETT:

19 Q. This might be difficult, the way it's
20 showing on the screen, but I would like you to read to
21 yourself, please, the entirety of Paragraph 57. Just
22 let me know when you're ready for me to go to the next
23 page.

24 A. Okay. Next page.

25 Okay.

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1 Q. I'd like to direct your attention to the
2 last sentence.

3 I'll read it aloud. "However, contrary to
4 Defendants' alternative construction, the resulting
5 PETG and PCTG material in each case is still a
6 material, quote, comprising polyethylene terephthalate
7 (PET), closed quote."

8 Did I read that correctly?

9 MR. SHI: Objection. Form. Leading.

10 THE WITNESS: You read it correctly, yes.

11 BY MR. BENNETT:

12 Q. Do you have -- withdrawn.

13 Do you agree with that statement?
14 MR. SHI: Objection. Form.
15 THE WITNESS: No.
16 BY MR. BENNETT:
17 Q. Does -- is PETG a material that comprises
18 PET?
19 A. No.
20 Q. I'm going to scroll up to the figure that
21 was included in connection with this paragraph. And
22 I'm going to zoom in on the lower right corner. I'm
23 going to try to zoom in -- there we are -- on the
24 lower right corner.
25 Dr. Storey, do you see the area that my

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1 mouse is hovering over?
2 A. I do.
3 MR. SHI: Objection. Form.
4 BY MR. BENNETT:
5 Q. Could you describe for the record what I am
6 hovering over, but the portion, please?
7 MR. SHI: Objection. Form.
8 THE WITNESS: Well, you're hovering over
9 what she is showing as the product of the reaction

10 between terephthalic acid and the mixed glycols,
11 ethylene glycol and 1,4-cyclohexanedimethanol. She
12 shows a resulting copolymer, but on -- she's naming a
13 portion of it PET, but that is not what you get when
14 you polymerize these three monomers together.

15 What she's showing on the part that she
16 labels PET, she's showing a succession of alternating
17 terephthaloyl, oxyethylene, oxy structural units. And
18 she shows them all segregated together with no -- with
19 no other monomers in there. And that is not what
20 happens when you copolymerize these three monomers.
21 You get a random type of copolymer.

22 And so there is no PET in that copolymer as
23 she has tried to show there. It just doesn't exist.
24 Both sides, the bracket where it says M and the
25 bracket where it says N, neither of those are pure

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1 materials as she has so indicated. These are random
2 copolymers. They contain repeat units from both --
3 they contain a terephthaloyl, oxyethylene, oxy repeat
4 unit, and they also contain terephthaloyl, oxy,
5 methylene, cyclohexylene, methylene, oxy repeat units.

6 Nowhere does it contain PET polymer.

7 BY MR. BENNETT:

8 Q. Just to clarify, it says -- withdrawn.

9 Just to clarify, this portion of the figure

10 has a subportion labeled PET.

11 Do you see that?

12 MR. SHI: Objection. Form. Leading.

13 THE WITNESS: I do see it.

14 BY MR. BENNETT:

15 Q. So is it your testimony that despite the

16 label of PET, there is, indeed, no PET in PETG?

17 MR. SHI: Objection. Form. Leading.

18 THE WITNESS: Yes. That is -- and I said

19 that earlier. That -- there is no PET in there.

20 That's her label, but it's inaccurate.

21 MR. BENNETT: William, could you please

22 bring up Exhibit 2 again?

23 THE TECHNICIAN: Exhibit 2 is on the screen.

24 MR. BENNETT: Thank you.

25 BY MR. BENNETT:

1 Q. Dr. Storey, are you able to see the entirety

2 of Paragraph 55 from your declaration on Exhibit 2?

3 A. Yes, I can see it.

4 Q. Could you please read that to yourself. And

5 let me know when you've finished.

6 A. I'm finished.

7 Q. I'd like to direct your attention to the

8 last sentence, beginning with "the absence of any

9 such..."

10 Do you see that?

11 A. Yes.

12 Q. I'll read it. "The absence of any such

13 express broadening language combined with the explicit

14 teaching" -- withdrawn.

15 "The absence of any such expressed

16 broadening language combined with the explicit listing

17 of PETG as a separate material demonstrates to a

18 POSITA that the term PET was intended to have its

19 ordinary chemical meaning."

20 Did I read that right, Dr. Storey?

21 MR. SHI: Objection. Form. Leading.

22 THE WITNESS: Yes, you read it right.

23 BY MR. BENNETT:

24 Q. Is it your opinion -- withdrawn.

25 There was some testimony earlier and some

1 questions earlier about the plain and ordinary meaning
2 of claim terms.

3 Do you recall that?

4 A. Yes.

5 Q. Is your proposed construction of PET the
6 plain and ordinary meaning of PET in light of the
7 patent and the file wrapper?

8 A. Yes.

9 Q. Dr. Storey, could you please read
10 Paragraph 95 to yourself. And let me know when you've
11 finished.

12 A. I'm finished.

13 Q. Is your proposed construction of
14 crystallizable PET the plain and ordinary meaning?

15 MR. SHI: Object to form.

16 THE WITNESS: Yes.

17 BY MR. BENNETT:

18 Q. You testified earlier about ways that PET
19 can be degraded to lose its crystallinity or
20 crystallizability.

21 Do you recall that testimony?

22 A. I do.

23 Q. So the record's clear, is it your testimony

24 that some PET is not crystallizable?

25 MR. SHI: Object to form.

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1 THE WITNESS: No.

2 MR. BENNETT: Withdrawn. Withdrawn.

3 BY MR. BENNETT:

4 Q. Did you testify earlier about ways that PET
5 can be made noncrystallizable?

6 A. Yes.

7 MR. SHI: Object to form.

8 BY MR. BENNETT:

9 Q. Would those instances of PET, therefore, not
10 be crystallizable PET under your proposed
11 construction?

12 MR. SHI: Object to form.

13 THE WITNESS: Would you repeat that
14 question?

15 BY MR. BENNETT:

16 Q. Would those instances of PET, therefore, not
17 be considered crystallizable PET under your proposed
18 construction?

19 MR. SHI: Object to form. And leading.

20 THE WITNESS: I didn't hear that. I was

21 going to say, they would not be crystallizable, but
22 they've been altered or modified. They're not native
23 PET. They're not unadulterated or unchanged PET.
24 BY MR. BENNETT:
25 Q. Yep. I'm just looking for a yes or no,

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1 Dr. Storey. So I'm going -- I'll ask a different
2 question.
3 Well, I'll ask the question again.
4 Are there instances of PET that are not
5 crystallizable PET?
6 MR. SHI: Object to form.
7 THE WITNESS: No.
8 BY MR. BENNETT:
9 Q. Dr. Storey, you testified earlier that there
10 are instances of PET that are degraded such that they
11 lose the ability to be crystallizable PET.
12 Do you recall that testimony?
13 A. Yes.
14 Q. Other than forms of PET that have undergone
15 that degradation process, that are not crystallizable
16 PET?

17 MR. SHI: Object to form. Leading.
18 THE WITNESS: Yes.
19 BY MR. BENNETT:
20 Q. So in other words, isn't it true that there
21 are forms of PET that are not crystallizable PET?
22 MR. SHI: Same objections.
23 THE WITNESS: Yes.
24 BY MR. BENNETT:
25 Q. Okay.

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1 MR. SHI: I want to note for the record --
2 excuse me. I want to make an objection on the record
3 that the line of questioning is argumentative.
4 MR. BENNETT: I don't think you're allowed
5 to do that.
6 [Simultaneous speaking.]
7 MR. BENNETT: You're only allowed to say
8 "objection. Form." You're allowed to say "objection.
9 Leading." You're allowed to instruct the witness not
10 to answer because of attorney-client privilege.
11 You're not allowed to give editorialization or
12 explanations as to the bases beyond form unless I ask
13 you. So I object to your deviating from the local

14 rules of the Eastern District Texas.

15 Could you please pull up Exhibit -- one
16 moment -- 5, William.

17 THE TECHNICIAN: Exhibit 5 is on the screen.

18 MR. BENNETT: Thank you.

19 BY MR. BENNETT:

20 Q. Dr. Storey, could you please read Claim 1 to
21 yourself. And let me know when you've done so.

22 A. Okay.

23 Q. Do you recall your testimony regarding how
24 PVC and PLA are considered contaminants in a PET
25 recycling stream?

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1 MR. SHI: Objection. Leading.

2 THE WITNESS: Yes.

3 BY MR. BENNETT:

4 Q. Could you please look at Claim 5 and read it
5 to yourself. And let me know when you've done so.

6 A. Okay.

7 Q. Do you recall being asked that the
8 difference between Claim 5 and Claim 1 is the
9 narrowing of the claim with the use of consists of

10 PET? Do you recall that discussion, Dr. Storey?

11 MR. SHI: Object to form. Leading.

12 THE WITNESS: Yes.

13 BY MR. BENNETT:

14 Q. Getting back to your testimony about PVC and

15 PLA, remind me, if you would, regarding the nature of

16 PVC and PLA -- withdrawn.

17 Are PVC and PLA contaminants in a PET

18 recycling stream?

19 A. Yes.

20 Q. Other than PVC and PLA, are there any

21 non PVC substances that could be tolerated in some

22 amount in Claim 1?

23 MR. SHI: Object to form.

24 THE WITNESS: Well, if you had -- if you had

25 a copolymer that had very -- I don't know how much it

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1 would be, but had a small -- let's say a small amount

2 of a third monomer, and it was able to -- it didn't

3 phase separate from the PET, then it could be -- it

4 could be recyclable with that, I think.

5 MR. SHI: Objection. Nonresponsive.

6 BY MR. BENNETT:

7 Q. Yeah, Dr., Storey, I'm going to rephrase as
8 sort of a yes/no question, if I could, please.

9 Other than PVC and PLA, are there non --
10 withdrawn.

11 Other than PVC and PLA, are there non PET
12 substances that could be tolerated in some amount in
13 Claim 1?

14 MR. SHI: Object to form.

15 THE WITNESS: Yes.

16 BY MR. BENNETT:

17 Q. Can you give me an example, please?

18 A. A copolymer that had a preponderance, but
19 not total, diol content consisting of ethylene.

20 MR. BENNETT: I pass the witness.

21 Thank you, Dr. Storey.

22 EXAMINATION

23 BY MR. SHI:

24 Q. Dr. Storey, I just have a couple of
25 questions to follow up.

1 MR. SHI: But before I get into those
2 questions, I do want to note for the record that the

3 plaintiff, Brook & Whittle, is going to reserve all
4 rights with respect to Counsel's inappropriate line of
5 questioning. That is completely outside the scope of
6 direct testimony.

7 BY MR. SHI:

8 Q. Dr. Storey, would you say it was about
9 45 minutes between when I stopped asking you questions
10 and your counsel started asking you questions?

11 MR. BENNETT: Objection. Form.

12 THE WITNESS: I don't -- I don't know how
13 long it was, but it was longer than our 15-minute
14 break. I do know that.

15 BY MR. SHI:

16 Q. Right. Because your counsel requested a
17 15-minute break, and that was roughly, I believe, 6:30
18 your time.

19 Is that fair?

20 MR. BENNETT: Objection to form.

21 THE WITNESS: I don't recall, actually. I'm
22 sorry.

23 BY MR. SHI:

24 Q. Okay. I'll represent to you that it was
25 about 45 minutes from the time I stopped asking you

1 questions to the time your counsel started asking you
2 questions.

3 Do you have any reason to doubt that?

4 A. No.

5 Q. During that span of 45 minutes, were you in
6 a breakout room with your counsel?

7 A. Not for the whole time, but I was for a
8 portion of the time.

9 Q. For how many minutes, approximately, were
10 you in a breakout room with your counsel between the
11 time I stopped asking you questions and the time your
12 counsel started asking you questions?

13 A. I don't know.

14 Q. Okay. Was it more than five minutes?

15 MR. BENNETT: Objection. Form.

16 THE WITNESS: It was probably more than
17 five.

18 BY MR. SHI:

19 Q. Was it more than 15 minutes?

20 MR. BENNETT: Objection. Form.

21 THE WITNESS: I don't know.

22 BY MR. SHI:

23 Q. This happened an hour ago, and you don't
24 know how long you were in the breakout room with your

25 counsel?

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1 MR. BENNETT: Objection. Form.

2 THE WITNESS: I didn't time it.

3 BY MR. SHI:

4 Q. Was it approximately half of the 45-minute
5 break that you were in a breakout room with your
6 counsel?

7 MR. BENNETT: Objection. Form.

8 THE WITNESS: I don't know.

9 BY MR. SHI:

10 Q. Okay. While you were in a breakout room
11 with your counsel, did you discuss with your counsel
12 your testimony or the testimony you were planning to
13 give when your counsel was asking you questions?

14 MR. BENNETT: Dr. Storey, I instruct you not
15 to answer.

16 Objection.

17 I instruct you not to answer on the basis of
18 work product and attorney-client privilege.

19 BY MR. SHI:

20 Q. Dr. Storey, are you going to follow your

21 counsel's instruction?

22 A. Yes.

23 Q. What did you talk about with your counsel
24 during that long break between when I stopped asking
25 you questions and when you started -- when your

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1 counsel started asking you questions?

2 MR. BENNETT: Objection. Form. And also,
3 objection.

4 I instruct you not to answer on the basis of
5 work product doctrine and attorney-client privilege.

6 BY MR. SHI:

7 Q. Dr. Storey, are you going to follow your
8 counsel's instruction not to answer my question?

9 A. Yes.

10 Q. Is there anything non privileged that you
11 can tell me about what you discussed with your counsel
12 during that 45-minute break?

13 MR. BENNETT: Objection. Form. And
14 objection.

15 I instruct you not to answer, Dr. Storey, on
16 the basis of attorney-client privilege and work
17 product doctrine.

18 BY MR. SHI:

19 Q. Dr. Storey, are you going to follow your
20 counsel's instruction?

21 A. Yes.

22 Q. You're going to follow your counsel's
23 instruction despite my question asking you if there
24 was anything non privileged that you can tell me?
25 Because that's a yes-or-no question.

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1 MR. BENNETT: He's not an attorney, Mr. Shi.
2 How is he going to be able to answer that? We can do
3 this off the record, but he can't answer that. He's
4 not an attorney.

5 MR. SHI: Again, I'm going to ask my
6 questions. Counsel, if you're lodging an objection,
7 I'd ask that you limit it to form or leading. I
8 suppose fair is fair.

9 MR. BENNETT: Yeah.

10 I instruct you not to answer, Dr. Storey.

11 MR. SHI: Okay.

12 BY MR. SHI:

13 Q. And just as a reminder, Dr. Storey, at any

14 point, you can have a discussion regarding privilege
15 with your counsel if you have a privileged question in
16 your mind.

17 Do you understand that?

18 A. I didn't know it, but if you say so, I
19 accept it.

20 Q. Okay. So with that in mind, specifically
21 keeping in mind that at any point, if you have a
22 question about a privilege, you can ask for a
23 discussion with your counsel, I'm just going to ask it
24 again.

25 Is there anything non privileged that you

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1 can tell me you discussed with your counsel during the
2 45 minutes from when I stopped asking you questions
3 and your counsel started asking you questions?

4 MR. BENNETT: Objection.

5 I instruct you not to answer insofar,
6 Dr. Storey, as your answer would reveal attorney work
7 product or attorney-client communications.

8 BY MR. SHI:

9 Q. Dr. Storey, can you answer without revealing
10 work product or attorney-client communications --

11 privileged communications?

12 A. I'm going to follow my attorney's
13 instructions and not answer.

14 Q. Okay. Let's take a quick break. I've been
15 sitting at my desk for about an hour waiting for the
16 return. So let me just make I have nothing else. But
17 let's take maybe five minutes.

18 THE VIDEOGRAPHER: We are going off the
19 record. The time is 7:54 p.m.

20 (OFF THE RECORD AT 7:54 p.m. PT.)

21 (ON THE RECORD AT 8:00 p.m. PT.)

22 THE VIDEOGRAPHER: The time is 8:00 p.m. We
23 are back on the record.

24 BY MR. SHI:

25 Q. Dr. Storey, thank you, again, very much for

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1 your time and testimony today. I have no further
2 questions at this time.

3 A. Thank you.

4 MR. BENNETT: Thank you. We will review and
5 sign.

6 MR. SHI: Okay.

7 THE VIDEOGRAPHER: Before I take us off the
8 record, Jill, would you like to get copy orders on the
9 record.

10 MR. BENNETT: Yeah. If we can get a rough
11 and a copy. We don't need a video, but of the
12 transcript, yes, please.

13 THE VIDEOGRAPHER: Is that all you needed,
14 Jill?

15 THE COURT REPORTER: Yes, Benjamin. Thank
16 you.

17 THE VIDEOGRAPHER: Okay. This marks the end
18 of the deposition of Robson F. Storey, PhD. We are
19 going off the record at 8:01 p.m., Central Time.

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