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IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

E. FRED SCHUBERT, ) VOLUME 2  
 )  
 Plaintiff, )  
 ) C.A. No. 12-924 (MN)  
 v. )  
 )  
 PHILIPS LUMILEDS LIGHTING )  
 COMPANY, LLC, et al., )  
 )  
 Defendants. )

Thursday, May 13, 2021  
8:30 a.m.  
Courtroom 4A  
Bench Trial

844 King Street  
Wilmington, Delaware

BEFORE: THE HONORABLE MARYELLEN NOREIKA  
United States District Court Judge

APPEARANCES:

FARNAN LLP  
BY: MICHAEL FARNAN, ESQ.

-and-

TROUTMAN PEPPER  
BY: JAMES MOORE BOLLINGER, ESQ.  
BY: KATHERINE HARIHAR, ESQ.  
BY: GERALD PORTER, ESQ.

Counsel for the Plaintiff

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**APPEARANCES CONTINUED:**

**COOCH & TAYLOR, P.A.**  
**BY: BLAKE A. BENNETT, ESQ.**

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**THE COURT: Good morning. Please be seated.**

**Anything we need to discuss before we resume?**

**MR. BOLLINGER: Not that I'm aware of, Your Honor.**

**MR. MOLANO: Nothing for defendant, Your Honor.**

**THE COURT: Okay.**

**MR. MOLANO: Your Honor, if we may begin, we would like to resume the deposition testimony of Janine Anderson, the BU paralegal.**

**THE COURT: Okay.**

**(Deposition testimony of Janine Anderson:)**

**Q. No, ma'am, the very first page of Exhibit 2 of the actual electronic file, the PDF. So it's the cover page of**

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08:34:02 1 the file folder. And if you look at those production  
08:34:04 2 numbers, it ends in 229?  
08:34:07 3 A. Oh, you want me back up at the file -- oh, okay.  
08:34:11 4 Q. Yes, please, ma'am. Thank you.  
08:34:13 5 A. I'm sorry. I misunderstood.  
08:34:15 6 Q. That's okay.  
08:34:16 7 A. I'm at 229. I'm there. All right.  
08:34:20 8 Q. So it has the -- it says ABAND, what does that mean  
08:34:26 9 to you?  
08:34:26 10 A. Abandoned.  
08:34:28 11 Q. Okay. And does that indicate to you that BU had  
08:34:31 12 abandoned this case?  
08:34:33 13 A. Yes.  
08:34:34 14 Q. Does that look like your handwriting?  
08:34:40 15 A. Oh, boy. I think so. I think that's my printing.  
08:34:54 16 Q. Okay. So kind of the same question as Exhibit 2,  
08:34:58 17 what I want to know is have you seen this document before  
08:35:00 18 and what is it? And I'll mention to you that if you look at  
08:35:06 19 the bottom right corner of each page again, I guess page 1  
08:35:10 20 it's kind of the top right, you have these Boston University  
08:35:14 21 production numbers again. So I will represent to you that  
08:35:17 22 this is something that Boston University produced in the  
08:35:25 23 litigation.  
08:35:26 24 A. Okay. So that first number on the right, the 354,  
08:35:30 25 are you referring to that?

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08:35:33 1 Q. Correct. And I actually think it's possible, Mike,  
08:35:36 2 this may be something that was produced in the Osram  
08:35:40 3 litigation initially?  
08:35:43 4 A. What are you asking, do I recognize it?  
08:35:45 5 Q. Correct, ma'am.  
08:35:47 6 A. Yes.  
08:35:50 7 Q. What is it, please?  
08:35:52 8 A. It's what we call a disclosure file.  
08:35:56 9 Q. And explain to me -- go ahead.  
08:35:59 10 A. A disclosure file is when our investigators disclose  
08:36:03 11 inventions to our office, at that time we would file in the  
08:36:12 12 disclosure file.  
08:36:16 13 Q. Would this disclosure file have been something that  
08:36:19 14 you prepared?  
08:36:21 15 A. Back in the -- yes, yes, I believe so. Yes.  
08:36:25 16 Q. And again, if you look up -- so am I correct that the  
08:36:31 17 very first page of this document, the one with the  
08:36:35 18 production number ending in 354, that looks to be a file  
08:36:41 19 folder, am I right about that?  
08:36:45 20 A. Yes. It's a type of a file folder, yes.  
08:36:48 21 Q. Okay. And again, we see BU 98-11. Would that be?  
08:36:52 22 A. Yes.  
08:36:55 23 Q. And this is something you would have prepared in the  
08:36:58 24 ordinary course of business at Boston University, correct,  
08:37:02 25 ma'am?

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08:37:02 1 A. Yes, I believe so, yes.

08:37:03 2 Q. And again, the BU 98-11 here corresponds to the '475  
08:37:09 3 Patent, is that correct?

08:37:10 4 A. Correct.

08:37:11 5 Q. Okay. Now, if you could help me understand, what is  
08:37:14 6 the difference between this Exhibit 3 and Exhibit 2? In  
08:37:19 7 other words, what's the difference between this file and the  
08:37:22 8 file that we just went through that was Exhibit 2? And I  
08:37:26 9 don't mean every single paper within it, I just mean  
08:37:30 10 broadly, what kind of stuff goes in this file and what kind  
08:37:33 11 of stuff goes in the case file that was Exhibit 2?

08:37:39 12 A. What goes in this file is the disclosure that we  
08:37:43 13 receive from the principal -- the investigator. Okay? No  
08:37:51 14 patent information goes in this file, we haven't filed a  
08:37:59 15 patent application yet. I would have to refresh my memory,  
08:38:13 16 but there may be documents in there when we reported the  
08:38:17 17 invention to the government, that information should be in  
08:38:26 18 there.

08:38:33 19 Q. Okay. Thank you for that, ma'am. Let's --

08:38:42 20 A. Oh, excuse me, if the invention was federally funded.

08:38:46 21 Q. Thank you.

08:38:47 22 A. If it wasn't federally funded, that would not apply.

08:38:52 23 Q. Ms. Anderson, just let us know once you have been  
08:38:54 24 able to pull it up and you've had a chance to look at it.  
08:38:58 25 It's about one page.

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- 08:39:01 1 A. Okay. Yeah, I think it's in front of me.
- 08:39:05 2 Q. Okay. And do you see at the bottom right corner this
- 08:39:08 3 has production number EFS 00006680?
- 08:39:16 4 A. Yes.
- 08:39:17 5 Q. Okay. Now, do you recognize this document,
- 08:39:21 6 Exhibit 4?
- 08:39:22 7 A. I don't remember seeing it. I mean, I'm seeing it
- 08:39:26 8 now, but I don't remember seeing it.
- 08:39:28 9 Q. What is Exhibit 4? Would you tell us, please?
- 08:39:31 10 A. It's from Sean Lee to Fred. It's saying -- notifying
- 08:39:44 11 Fred that we're not going to pay a maintenance fee.
- 08:39:49 12 Q. This is a September 2nd, 2009, e-mail from Sean Lee
- 08:39:55 13 to Dr. Schubert, cc'ing you; is that correct, ma'am?
- 08:40:00 14 A. Uh-huh, yes.
- 08:40:04 15 Q. What is your understanding, Ms. Anderson, of what's
- 08:40:07 16 happening in this e-mail?
- 08:40:08 17 A. Well, if I look at this e-mail, it's saying that do I
- 08:40:13 18 have to be approved for returning it to him.
- 08:40:19 19 Q. Anything else?
- 08:40:23 20 A. Well, indicating we're not going to pay the second
- 08:40:27 21 maintenance fee. That's what it says.
- 08:40:38 22 Q. Anything else?
- 08:40:39 23 A. If he wants it back, then it has to be approved by
- 08:40:44 24 our patent committee.
- 08:40:52 25 Q. Anything else?

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08:40:55 1 A. And he would have to reimburse Boston University for  
08:41:11 2 patent costs, and then I guess royalties will kick in.

08:41:21 3 Q. So this e-mail is about the '475 Patent, correct?

08:41:35 4 A. Yes.

08:41:37 5 Q. And I see Sean Lee is writing to Dr. Schubert. The  
08:41:46 6 first sentence of this e-mail, "I'm the case manager for the  
08:41:49 7 physical sciences cases in the technology development and we  
08:41:53 8 are in the process of consolidating our active portfolio."

08:41:58 9 Do you see that, ma'am?

08:41:59 10 A. Yes.

08:41:59 11 Q. Okay. What would a case manager at BU have typically  
08:42:02 12 done around that time? What would their job  
08:42:05 13 responsibilities be?

08:42:07 14 A. I don't know. They would have to interact with their  
08:42:12 15 inventors.

08:42:12 16 Q. Did you work with case managers at BU in the 2009  
08:42:18 17 time frame?

08:42:19 18 A. Well, yeah, yeah, they were in my office, yes.

08:42:27 19 Q. Do you understand this e-mail to be Sean Lee telling  
08:42:32 20 Dr. Schubert that BU planned not to pay the second  
08:42:36 21 maintenance fee for the '475 Patent by the due date?

08:42:42 22 A. I don't know. I mean, I don't remember this. I just  
08:42:49 23 don't remember it.

08:42:52 24 Q. Okay. Ma'am, so I'm asking reading it today, what is  
08:43:03 25 your understanding of what this e-mail means?

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08:43:06 1 A. That Sean notifying Fred that we're not going to pay  
08:43:15 2 the maintenance fee.

08:43:18 3 Q. So is it fair to say that BU was deliberately  
08:43:22 4 planning not to pay the maintenance fee for the '475 Patent  
08:43:26 5 and let the patent expire?

08:43:28 6 A. Yeah, that would be my understanding at the time that  
08:43:31 7 we were not going to pay the maintenance fee.

08:43:35 8 Q. Why not?

08:43:37 9 A. I don't remember why not. I don't remember.

08:43:42 10 Q. How would BU in late 2009 determine which patents it  
08:43:47 11 would and would not pay maintenance fees for?

08:43:51 12 A. I don't know. That wouldn't be my decision.

08:43:54 13 Q. Would that be somebody like Sean Lee's decision?

08:43:58 14 A. Yes.

08:43:59 15 Q. And Ms. Anderson, if you would please let us know  
08:44:03 16 when you have that document up.

08:44:05 17 A. I have it.

08:44:06 18 Q. Okay. Ma'am, would you please take a look at this  
08:44:09 19 document, Exhibit 5, and let us know if you recognize it?

08:44:12 20 A. Yes. Yes.

08:44:24 21 Q. What is it?

08:44:27 22 A. It's Fred communicating to Sean that he doesn't want  
08:44:32 23 to have the invention returned to him.

08:44:51 24 Q. Ma'am, this Exhibit 5, if you look at the very bottom  
08:44:55 25 e-mail on the thread, that is the same e-mail that we were

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08:44:59 1 just discussing as Exhibit 4. The e-mail --

08:45:02 2 A. Okay. Yes, correct.

08:45:04 3 Q. Thank you.

08:45:04 4 Then do you see Dr. Schubert responds, "Sean,  
08:45:09 5 thank you very much for the offer. Unfortunately, I would  
08:45:12 6 not be interested. Regards, Fred."

08:45:16 7 A. Yes.

08:45:16 8 Q. And then after that, Sean Lee forwards the e-mail  
08:45:20 9 string to you on September 2nd, 2009, at 4:30 p.m., is that  
08:45:28 10 correct, ma'am?

08:45:29 11 A. Yes.

08:45:29 12 Q. So on September 2nd, 2009, Sean offered to return the  
08:45:35 13 '475 Patent to Dr. Schubert, correct, ma'am?

08:45:37 14 A. Yes.

08:45:40 15 Q. And then on September 2nd, 2009, in this e-mail at  
08:45:45 16 4:22 p.m., Dr. Schubert declined the return offer, correct?

08:45:51 17 A. That's what the e-mail says.

08:45:56 18 Q. Okay. And I'm asking you, is there anything that you  
08:45:59 19 see that indicates that he wanted the patent?

08:46:03 20 A. I don't know how to answer that. I don't know.

08:46:06 21 Q. Do you see anything in Dr. Schubert's e-mail back to  
08:46:09 22 Sean Lee that indicates that Dr. Schubert wanted the patent  
08:46:12 23 returned to him?

08:46:14 24 A. No.

08:46:16 25 Q. Okay. Ms. Anderson, if you would please take a look

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08:46:19 1 at Exhibit 6 and let me know if you recognize the document?

08:46:23 2 A. Yes. Yes.

08:46:24 3 Q. What is this, Ms. Anderson?

08:46:29 4 A. Well, petition to accept an unintentionally delayed  
08:46:34 5 payment of a maintenance fee on an expired patent. It was  
08:46:38 6 filed with the Patent Office.

08:46:40 7 Q. Have you ever seen this document before?

08:46:42 8 A. I don't remember.

08:46:46 9 Q. Is this the petition that you were referring to  
08:46:48 10 earlier today in your testimony?

08:46:51 11 A. Yes.

08:46:57 12 Q. And is this a petition for the '475 Patent?

08:47:03 13 A. Yes.

08:47:07 14 Q. If you look, Ms. Anderson, at the page ending at 291,  
08:47:16 15 production number 291, it's the third page of the PDF file.  
08:47:24 16 If you would go there, please, ma'am.

08:47:26 17 A. Yes.

08:47:27 18 Q. And you see up near the top, it has "patent number"  
08:47:31 19 listed in one of those square boxes.

08:47:34 20 Do you see that, ma'am?

08:47:35 21 A. Yes.

08:47:36 22 Q. And what's the patent number that's listed there,  
08:47:40 23 ma'am?

08:47:42 24 A. 6,294,475.

08:47:44 25 Q. So let's look at the Exhibit 2, please. If you look

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08:47:47 1 at the file names in the chat, it starts with BU 000229. If  
08:47:54 2 you would open that back up, please, ma'am.

08:47:56 3 A. Wait a minute. 00 -- let me put my glasses on.  
08:48:01 4 00289?

08:48:03 5 Q. It's the second document that should be in your chat  
08:48:09 6 box, and the number in the file name is BU 000229.

08:48:15 7 A. 000 -- what? 229? I've got 268, I've got 6680,  
08:48:26 8 00354.

08:48:37 9 Q. Right before that.

08:48:38 10 A. 0054, I'm sorry, yeah. All right. Yeah.

08:48:43 11 Q. So, ma'am, if you would open that up, and then we'll  
08:48:46 12 take a look at that.

08:48:49 13 A. Yeah.

08:48:52 14 Q. Okay. Ma'am, if you would go, and you'll recognize  
08:48:56 15 this production number because it's the one we were just  
08:48:59 16 looking at, it's the one ending in 291, so I want you to  
08:49:02 17 please, ma'am, if you would go to the file and look at  
08:49:07 18 page 291 and tell me if it's the petition that we were just  
08:49:12 19 looking at as Exhibit 6?

08:49:14 20 A. All right. Wait a minute. 291?

08:49:17 21 Q. Yes, ma'am.

08:49:18 22 A. That's way down.

08:49:21 23 Q. Yes, ma'am.

08:49:22 24 A. 291. Yes, I'm there.

08:49:24 25 Q. And do you see that this is the same petition we were

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08:49:28 1 just looking at with the same production number?

08:49:30 2 A. Correct.

08:49:31 3 Q. So the petition that's Exhibit 6 is in the BU case  
08:49:37 4 file for the '475 Patent as Exhibit 2, correct, ma'am?

08:49:40 5 A. Correct.

08:49:40 6 Q. Do you have any reason to believe that you did not  
08:49:42 7 put that petition in the case file?

08:49:47 8 A. That I did not? No, I don't have a reason to believe  
08:49:52 9 I did not.

08:49:55 10 Q. Okay. And then if you go down, you can see that  
08:49:57 11 there's a "filer authorized by," and it says "Matthew Edward  
08:50:06 12 Connors"?

08:50:08 13 A. Yes.

08:50:08 14 Q. That's the same Matthew Connors that we were talking  
08:50:11 15 about earlier in the deposition, BU's outside patent  
08:50:14 16 counsel?

08:50:14 17 A. Yes.

08:50:15 18 Q. Ms. Anderson, if you would please pull that up and  
08:50:18 19 take a look at that. The question is going to be, are you  
08:50:24 20 familiar with this document?

08:50:26 21 A. I've got to make it bigger, yes. That's a document  
08:50:32 22 from the FileMaker database.

08:50:42 23 Q. And what is this, ma'am? Is this some sort of screen  
08:50:44 24 shot from the FileMaker database?

08:50:52 25 A. Yes.

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08:50:54 1 Q. Okay. This is a database that you would be working  
08:51:02 2 in as part of your ordinary course of business at BU,  
08:51:05 3 correct, ma'am?

08:51:06 4 A. Yes.

08:51:07 5 Q. Is it correct that in the ordinary course of business  
08:51:09 6 at BU you would enter information into this database around  
08:51:13 7 the time that you would have received the information?

08:51:16 8 A. Yes.

08:51:20 9 Q. Okay. Now, if you look at the upper left -- well, do  
08:51:23 10 you see that it says -- there's a box, red box that says "BU  
08:51:28 11 case number"? Do you see that?

08:51:30 12 A. Yes.

08:51:31 13 Q. And that's -- is that case number 98-11 there?

08:51:35 14 A. Yes.

08:51:35 15 Q. That's the case number for the '475 Patent, correct,  
08:51:39 16 ma'am?

08:51:39 17 A. Correct.

08:51:39 18 Q. So is this essentially a database screen shot of the  
08:51:43 19 records for the '475 Patent?

08:51:49 20 A. Correct.

08:51:49 21 Q. Go up from there, ma'am, if you would, status, it's  
08:51:53 22 near the top of the page. Hopefully this is easier and  
08:51:57 23 quicker to find since I know you're familiar with this  
08:52:01 24 database. Do you see it says abandoned?

08:52:02 25 A. Yes.

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- 08:52:03 1 Q. So does that mean that BU had abandoned the patent?
- 08:52:06 2 A. Yes.
- 08:52:10 3 Q. Ms. Anderson, is this the information that was pulled
- 08:52:15 4 recently from BU's FileMaker database?
- 08:52:17 5 A. Yep, I believe -- let me go up here.
- 08:52:20 6 Q. Sure. And you can scroll all the way to the right.
- 08:52:24 7 I want to make sure you have the time to take a look at
- 08:52:26 8 this.
- 08:52:26 9 A. Yes, I believe so.
- 08:52:27 10 Q. Okay. So, and you see under column F in the Excel
- 08:52:37 11 file, BU number, do you see 9811 there?
- 08:52:41 12 A. Under column F?
- 08:52:42 13 Q. Yes, ma'am.
- 08:52:44 14 A. Yes, I see it, yes.
- 08:52:46 15 Q. Okay. It's the same case number we have been
- 08:52:48 16 discussing for the '475 Patent, correct?
- 08:52:50 17 A. Correct.
- 08:52:51 18 Q. Okay. So, ma'am, what I'd like to do here is if you
- 08:52:56 19 would go to -- scroll all the way over, almost all the way
- 08:53:00 20 to column AR?
- 08:53:01 21 A. ER?
- 08:53:03 22 Q. AR. A as in apple, R as in rabbit.
- 08:53:12 23 So after you get to Z, it will start with AA,
- 08:53:18 24 and then you go to AR.
- 08:53:20 25 A. AR. I got that.

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08:53:21 1 Q. Okay. So you see it says "comments to user"?

08:53:25 2 A. Yes.

08:53:26 3 Q. And then you see your name is listed in the three

08:53:29 4 rows there?

08:53:29 5 A. Yes.

08:53:29 6 Q. Janine. That's you, correct, ma'am?

08:53:32 7 A. Correct.

08:53:33 8 Q. And that indicates that you put in the information in

08:53:35 9 these rows, correct, ma'am?

08:53:37 10 A. I believe so, yes.

08:53:41 11 Q. Okay. So, ma'am, if you would scroll over to the

08:53:52 12 right a bit more, and look at column BI.

08:53:55 13 A. I'm sorry, E did you say?

08:53:57 14 Q. B, B as in boy, I. Thank you.

08:54:01 15 A. Oh, boy, yes.

08:54:06 16 Q. So see the second row down there it says, "second

08:54:13 17 MAINT. Fee"?

08:54:15 18 A. Yes.

08:54:15 19 Q. And then if you look over to the right a little at

08:54:18 20 column B as in boy, N as in Nancy, do you see that says "do

08:54:22 21 not pay per Sean Lee; Fred Schubert agreed"?

08:54:28 22 A. Yes.

08:54:28 23 Q. USP 6294475?

08:54:32 24 A. Well, I would have to -- oh, yeah, it keeps going

08:54:32 25 yes.

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08:54:37 1 Q. So that indicates that you put in this comment,  
08:54:39 2 correct, ma'am?

08:54:40 3 A. Yes.

08:54:40 4 Q. Okay, ma'am. And if you would take a look at the row  
08:54:44 5 directly above that in column B as in boy, I, do you see  
08:54:48 6 "petition"?

08:54:49 7 A. Yes.

08:54:51 8 Q. Okay. And then if you would look over to the right  
08:54:53 9 to again column B as in boy, N as in Nancy, do you see that  
08:54:58 10 it says -- you may have to expand this. Could you read that  
08:55:05 11 to us, please?

08:55:06 12 A. BN?

08:55:08 13 Q. Yes, ma'am. B as in boy, N as in Nancy.

08:55:13 14 A. "Petition to accept." It goes all the way across.

08:55:18 15 Q. Yes, ma'am. If you would read that.

08:55:22 16 A. "Petition to accept unintentionally delayed payment  
08:55:27 17 of maintenance fee filed 4/22/10."

08:55:33 18 Q. And then?

08:55:34 19 A. Oh, "instructed Matt Connors on 4/22 to revive."

08:55:42 20 Q. And there's one more word, I believe.

08:55:43 21 A. Oh, "patent."

08:55:45 22 Q. So just so we have a clear record, let me read what I  
08:55:48 23 believe it says and you can confirm if you agree with me.  
08:55:52 24 It says, "petition to accept unintentionally delayed payment  
08:55:56 25 of maintenance fee filed 4/22/10. Instructed Matt Connors

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08:56:02 1 on 4/22 to revive patent."

08:56:07 2 A. Correct.

08:56:08 3 Q. Okay, ma'am. So based on what you have seen here and  
08:56:11 4 what you saw in Exhibit 8, the screen shot, is it correct  
08:56:14 5 that you would have entered those comments about the  
08:56:18 6 petition?

08:56:19 7 A. Correct.

08:56:20 8 Q. Okay, ma'am. So is it fair to say that you would  
08:56:24 9 have instructed Matt Connors on April 22nd to file the  
08:56:29 10 petition to revive the '475 Patent?

08:56:32 11 A. I don't remember it, but I entered it in the  
08:56:35 12 database.

08:56:36 13 Q. So based on your regular practice at BU, do you have  
08:56:39 14 any reason to doubt that you instructed Matt Connors on  
08:56:44 15 April 22nd, 2010 to file the petition to revive the '475  
08:56:52 16 Patent?

08:56:52 17 A. I probably did. I probably did instruct him.

08:56:56 18 Q. Do you have any reason to doubt that you did, that  
08:57:00 19 you did that?

08:57:02 20 A. No.

08:57:06 21 Q. What was your basis for instructing him to file a  
08:57:10 22 petition that certified that there had been unintentional  
08:57:14 23 delay in paying the maintenance fees?

08:57:18 24 A. I don't remember. I guess it was because Fred wanted  
08:57:21 25 to license the patent.

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08:57:28 1 Q. Okay. So that -- so how is that -- how does that  
08:57:32 2 lead to BU having unintentionally delayed paying the  
08:57:37 3 maintenance fees?

08:57:38 4 A. Because at the time, at the time we didn't have  
08:57:41 5 anybody to license the patent. There was no licensing  
08:57:47 6 interest at that time.

08:57:49 7 Q. "At that time" being what time, ma'am?

08:57:53 8 A. When it was initially due.

08:57:54 9 Q. Ma'am, who asked you -- who asked you to tell Matt  
08:57:58 10 Connors to revive the patent?

08:58:02 11 A. I don't know. It was probably Sean.

08:58:07 12 Q. How about Ashley Stevens?

08:58:10 13 A. I don't remember if it was Ashley. I don't remember  
08:58:13 14 exactly who told me to file the petition. I do not  
08:58:17 15 remember. Was it Sean? Was it Ashley? I don't remember  
08:58:25 16 who told me that.

08:58:26 17 Q. Is there anybody else you can think of that might  
08:58:29 18 have instructed you to do it?

08:58:31 19 A. No.

08:58:32 20 Q. Okay. Are you familiar with Exhibit 9, Ms. Anderson?

08:58:32 21 A. Yes.

08:58:32 22 Q. What is it?

08:58:32 23 A. It's a letter I sent to the agencies that funded this  
08:58:42 24 invention notifying them that we weren't going to pay the  
08:58:52 25 second maintenance fee.

Janine Anderson - video

08:58:58 1 Q. By "this invention," do you mean the '475 Patent?

08:59:03 2 A. Yes.

08:59:05 3 Q. And this is a letter sent by you to the Office of

08:59:13 4 Naval Research and National Science Foundation on

08:59:19 5 November 27th, 2000 --

08:59:20 6 A. Correct.

08:59:21 7 Q. I see up near the top left of this letter, this has

08:59:24 8 your then current title at BU, patent manager, technology

08:59:29 9 transfer?

08:59:29 10 A. Yes.

08:59:30 11 Q. That's accurate, ma'am?

08:59:31 12 A. That was my title at the time, yeah.

08:59:35 13 Q. Okay. And in the first paragraph, second sentence,

08:59:41 14 it says "this decision was made due to lack of commercial

08:59:51 15 interest in the invention."

08:59:53 16 Do you see that?

08:59:53 17 A. Yes.

08:59:54 18 Q. You're referring to BU's decision not to timely pay

08:59:58 19 the second maintenance fees for the '475 Patent, correct?

09:00:00 20 A. Correct.

09:00:02 21 Q. Everything in this letter that you wrote is accurate,

09:00:02 22 ma'am?

09:00:02 23 A. Yes.

09:00:10 24 Q. Would you have put it in the patent file?

09:00:12 25 A. Probably. I don't remember, but probably.

Janine Anderson - video

09:00:20 1 Q. Okay. If it's in one of the patent files we talked  
09:00:25 2 about earlier, is it safe to assume that you put it in  
09:00:29 3 there, ma'am?

09:00:29 4 A. Yes.

09:00:30 5 Q. So my question, ma'am, is have you seen this document  
09:00:34 6 before?

09:00:34 7 A. I don't remember if I've seen it. It might be in the  
09:00:37 8 patent file. If it's in the patent file I probably saw it,  
09:00:41 9 but I don't remember.

09:00:46 10 Q. Okay, so he says "Hi, Fred. Sorry I wasn't clear; I  
09:00:50 11 need to leave here at 2:00 p.m. for a 2:00 p.m. to 4:00 p.m.  
09:00:55 12 meeting so just before 2:00 or after 4:00 would work.  
09:00:57 13 Thanks, Sean."

09:00:58 14 Do you see that one?

09:00:59 15 A. Yes.

09:00:59 16 Q. And then keep corresponding there another one from  
09:01:02 17 Dr. Schubert to Sean Lee on December 2nd, 2009, at  
09:01:07 18 8:46 a.m.?

09:01:08 19 A. Yes.

09:01:08 20 Q. Okay. Dr. Schubert e-mails Sean Lee and says,  
09:01:12 21 "Sorry. My fault, I will call you at 4:15 p.m. Regards  
09:01:16 22 Fred."

09:01:16 23 A. Yeah.

09:01:18 24 Q. Okay. And then if you go up more, there is something  
09:01:21 25 at the top. Is that a calendar invite, maybe?

Janine Anderson - video

- 09:01:25 1 A. Wait a minute now. Yes. "Start, end."
- 09:01:33 2 Q. Is that what calendar invites would look like in BU's
- 09:01:38 3 e-mail system around that time?
- 09:01:41 4 A. Yes.
- 09:01:42 5 Q. You've seen those before, right, while you were
- 09:01:44 6 working at BU?
- 09:01:45 7 A. Yes.
- 09:01:47 8 Q. Do you know if that call for the calendar invite ever
- 09:01:51 9 took place?
- 09:01:51 10 A. No, I don't.
- 09:01:53 11 Q. Okay. And you said, ma'am, you don't remember seeing
- 09:01:55 12 this particular document before?
- 09:01:58 13 A. No, I don't.
- 09:02:00 14 Q. And Ms. Anderson, have you ever seen this document
- 09:02:05 15 before?
- 09:02:07 16 A. If it's in the file, then I've seen it.
- 09:02:12 17 Q. So if it's a document that BU had somewhere in its
- 09:02:16 18 files, you would have seen this document, correct?
- 09:02:18 19 A. If I had put it -- if it was in the file, I would
- 09:02:22 20 have seen it.
- 09:02:22 21 Q. My question for you, Ms. Anderson, is, do you see
- 09:02:25 22 there's an e-mail from Sean Lee to Dr. Schubert on
- 09:02:30 23 December 3rd, 2009?
- 09:02:32 24 A. At 6:15 p.m.?
- 09:02:35 25 Q. No, ma'am. Underneath that.

Janine Anderson - video

09:02:39 1 A. Underneath. I've got it, yeah, yeah. Yes, yes. I  
09:02:44 2 see it.

09:02:44 3 Q. What I'd like to know is, have you ever seen this  
09:02:49 4 e-mail before?

09:02:50 5 A. If it's in the file, I saw it.

09:02:59 6 Q. Okay. But I'd like -- do you have any specific  
09:03:02 7 recollection as you sit here today of ever seeing it before?

09:03:04 8 A. No, I don't remember.

09:03:07 9 Q. All right. Does that look like Sean Lee's signature  
09:03:11 10 block as you're looking at that?

09:03:12 11 A. Yes.

09:03:13 12 Q. Do you have any reason to doubt that this is an  
09:03:15 13 e-mail that Sean Lee sent Dr. Schubert December 3rd, 2009,  
09:03:20 14 at 5:09 p.m.?

09:03:23 15 A. Do I have any reason to doubt? No.

09:03:25 16 Q. So would you go ahead -- and have you read through  
09:03:28 17 that e-mail, that December 3rd, 2009, at 5:09 p.m. e-mail?

09:03:35 18 A. What? Yeah, well, I'm reading it.

09:03:41 19 Q. So I noted you kind of expressed maybe a little  
09:03:42 20 surprise on your face there.

09:03:48 21 Let me ask you. It talks about "Janine." Is  
09:03:52 22 your understanding as you read through this e-mail, it says  
09:03:55 23 right here, "As our patent manager, Janine is a notary, and  
09:03:58 24 is perhaps more honor bound than most to be truthful to the  
09:04:03 25 Patent Office."

Janine Anderson - video

09:04:04 1 Do you understand this e-mail to be referring to  
09:04:05 2 you?

09:04:07 3 A. Yes. It says my name. Yes.

09:04:10 4 Q. No other Janine in BU's OTD that this could have  
09:04:15 5 referred to, right, ma'am?

09:04:16 6 A. Yes. Correct. Correct.

09:04:17 7 Q. Okay. And then do you see -- so Dr. Schubert  
09:04:21 8 responded to Sean Lee's e-mail on December 3rd, 2009, at  
09:04:28 9 6:15 p.m., correct?

09:04:30 10 A. Yes. Thanks for your response. Yes.

09:04:31 11 Q. So let's take a look, if you would, ma'am, at the  
09:04:41 12 subject line. Do you see it says "invention BU 98-11"?

09:04:41 13 A. Yes.

09:04:41 14 Q. That's the BU case number for the '475 Patent,  
09:04:51 15 correct?

09:04:51 16 A. Yes, correct.

09:04:51 17 Q. So this e-mail must be about the '475 Patent, right,  
09:04:57 18 ma'am?

09:04:57 19 A. Correct.

09:04:58 20 Q. So -- and then it says -- let's look at Sean Lee's  
09:05:04 21 e-mail to Dr. Schubert. "I checked on the possibility of  
09:05:07 22 reviving the case after the missed due date."

09:05:11 23 Do you see that?

09:05:12 24 A. Yes.

09:05:13 25 Q. And does that -- the case, is it your understanding

Janine Anderson - video

09:05:16 1 that would refer to the BU 98-11?

09:05:20 2 A. I don't know.

09:05:22 3 Q. Can you think of anything else it might refer to?

09:05:26 4 A. No.

09:05:29 5 Q. Okay. So as you read this, is it your understanding

09:05:34 6 this is referring to reviving the '475 Patent after BU let

09:05:38 7 it expire by not paying the maintenance fees?

09:05:42 8 A. No.

09:05:43 9 Q. And the December 3rd, 2009, at 5:09 p.m. e-mail from

09:05:49 10 Sean Lee to Dr. Schubert, do you know if you were cc'd on

09:05:52 11 that e-mail?

09:05:53 12 A. I don't believe so.

09:05:54 13 Q. Okay. But you --

09:05:56 14 A. I don't think so.

09:05:57 15 Q. You can't tell really one way or the other, since

09:06:01 16 this is lower in the chain, correct, ma'am?

09:06:04 17 A. Right. Correct. I don't know.

09:06:05 18 Q. Okay.

09:06:08 19 A. I don't know if I was copied on it.

09:06:12 20 Q. Did you ever have any concerns about filing the

09:06:14 21 maintenance -- about reviving the '475 Patent?

09:06:24 22 A. No.

09:06:31 23 Q. So, ma'am, after seeing -- after seeing this, do you

09:06:32 24 have any concerns about the fact that BU revived the '475

09:06:33 25 Patent, and that you instructed an attorney to do that who

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09:06:43 1 certified unintentional delay in paying the fees?

09:06:47 2 A. No, I don't.

09:06:51 3 Q. Do you know how it came to be that after Sean Lee  
09:06:54 4 e-mailed Dr. Schubert this that BU ended up reviving the  
09:07:03 5 '475 Patent anyway?

09:07:05 6 A. Yes, it was revived. Yes, I know that.

09:07:13 7 Q. And how did that come to be after Sean Lee sent  
09:07:17 8 Dr. Schubert this e-mail?

09:07:19 9 A. Well, to the best of my recollection, Fred wanted to  
09:07:29 10 -- wanted to license the patent, came back and wanted to  
09:07:35 11 license the patent.

09:07:40 12 Q. Nobody ever expressed any concerns to you about the  
09:07:43 13 revival of the '475 Patent, is that your testimony?

09:07:48 14 A. Yes. Yes.

09:07:52 15 Q. Do you believe that you should be truthful in your  
09:07:56 16 dealings with your outside counsel so that they in turn  
09:08:00 17 would be truthful with the Patent Office?

09:08:03 18 A. I don't think I can answer you anymore. Yeah, I  
09:08:06 19 guess, yeah, I believe I should be truthful to the attorney.

09:08:32 20 Q. Do you think you were in the case of the petition to  
09:08:32 21 revive the '475 Patent?

09:08:40 22 A. Yes. At that time, yes, that's what I believed.  
09:08:44 23 Yes.

09:08:44 24 Q. What's that based on?

09:08:48 25 A. The abandonment was unintentional.

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09:08:52 1 Q. And what's your basis for saying "the abandonment was  
09:08:57 2 unintentional"?

09:08:58 3 A. I guess because at the time the patent wasn't  
09:09:01 4 licensed.

09:09:04 5 Q. So how does the patent being unlicensed make the  
09:09:07 6 abandonment unintentional?

09:09:09 7 A. I don't know. I don't know the answer.

09:09:10 8 Q. Have you ever seen Exhibit 12 before, Ms. Anderson?

09:09:14 9 A. Yes, I've seen it.

09:09:25 10 Q. Okay. What is it, ma'am?

09:09:27 11 A. It's a meeting -- it's a request for a meeting.

09:09:32 12 Q. Okay. And when would that meeting have been on?

09:09:36 13 A. It says January 15th, 2010.

09:09:44 14 Q. Does it say anything about the subject of that  
09:09:47 15 meeting?

09:09:50 16 A. "Meeting with Fred Schubert."

09:09:54 17 Q. What's it say down below in the main body of this  
09:09:58 18 calendar request?

09:09:59 19 A. "To discuss the revival and return of invention,  
09:10:03 20 currently abandoned at the USPTO."

09:10:06 21 Q. And this is a meeting request from Sean Lee to Ashley  
09:10:09 22 Stevens, you and Dr. Schubert, correct?

09:10:12 23 A. Yes.

09:10:12 24 Q. So here's my question, ma'am. Did you attend that  
09:10:15 25 meeting?

Janine Anderson - video

09:10:15 1 A. I don't remember.

09:10:16 2 Q. You don't remember anything about it whatsoever?

09:10:19 3 A. No, I do not remember that.

09:10:22 4 (End of videotape deposition.)

09:10:22 5 MR. MOLANO: Your Honor, if I may. There are a  
09:10:28 6 few evidentiary issues to address before we turn to the next  
09:10:32 7 witness.

09:10:32 8 THE COURT: You need to put in any exhibits you  
09:10:34 9 want to put in with Ms. Anderson. Why don't you do that  
09:10:37 10 first.

09:10:38 11 MR. MOLANO: That was my first question.

09:10:39 12 THE COURT: Evidentiary issues are supposed to  
09:10:42 13 be raised with me in the morning, so I don't understand why  
09:10:44 14 you're bringing them up now without an e-mail saying there  
09:10:47 15 were any.

09:10:49 16 MR. MOLANO: The evidentiary issue was, so  
09:10:51 17 should we go ahead --

09:10:53 18 THE COURT: Admit the exhibits, but I don't  
09:10:55 19 understand why you have an issue. Now explain to me why  
09:10:58 20 that wasn't raised when it was supposed to be raised, but do  
09:11:01 21 the exhibits first.

09:11:02 22 MR. MOLANO: My apologies, Your Honor. My issue  
09:11:05 23 was the exhibits. There is no issue. I wanted to raise the  
09:11:07 24 evidentiary issue, the evidentiary question of whether you  
09:11:10 25 want it submitted now or wait to the end?

Ashley Stevens - video

09:11:13 1

THE COURT: I want them submitted now.

09:11:17 2

MR. MOLANO: Thank you, Your Honor.

09:11:18 3

MS. DESAI: Your Honor, in light of the

09:11:19 4

testimony of Ms. Anderson we move to admit the following

09:11:22 5

joint exhibits that were submitted on the parties' joint

09:11:26 6

trial exhibit, that would be JTX 9, JTX 10, JTX 17, JTX 23,

09:11:35 7

JTX 24, JTX 29, JTX 19, and JTX 30. And that was the order

09:11:43 8

in way they were played during the deposition.

09:11:46 9

MR. BOLLINGER: No objection, Your Honor.

09:11:47 10

THE COURT: All right. Those are admitted.

09:11:48 11

(The above listed exhibits were admitted into

09:11:49 12

evidence.)

09:11:49 13

THE COURT: Next.

09:11:50 14

MR. MOLANO: At this point I would like to call

09:11:52 15

the next witness, Ashley Stevens, Your Honor, who was the BU

09:11:55 16

director at the time at issue.

09:11:58 17

THE COURT: Thank you.

09:11:58 18

(Deposition testimony of Ashley Stevens:)

09:12:04 19

Q. With that out of the way, Dr. Stevens, what's your

09:12:07 20

current business address?

09:12:12 21

A. 17 Yale Street, Winchester, Massachusetts 01890.

09:12:18 22

Q. Dr. Stevens, what degrees do you hold?

09:12:22 23

A. I hold a BA in natural sciences, an MA, and a D.PHIL

09:12:29 24

in physiochemistry, all from the University of Oxford.

09:12:32 25

Q. And did there come a time when your career began to

Ashley Stevens - video

09:12:37 1 focus primarily on matters of intellectual property?

09:12:41 2 A. Yes.

09:12:42 3 Q. When was that?

09:12:43 4 A. That would have been in August of 1982 when I  
09:12:46 5 resigned from Proctor & Gamble and joined a company called  
09:12:51 6 Biotechnica International, which was one of the first  
09:12:55 7 generation of biotechnology companies here in the Boston  
09:12:59 8 area.

09:13:01 9 Q. And since that time has your work continued to focus  
09:13:07 10 on matters of intellectual property?

09:13:09 11 A. I would say so, yes.

09:13:12 12 Q. How much of the intellectual property work that you  
09:13:15 13 have done since that time has focused on patents?

09:13:18 14 A. I would say the large proportion of it has involved  
09:13:26 15 patents.

09:13:26 16 Q. Can you describe as a general matter what type of  
09:13:34 17 work relating to patents you have focused on in your career?

09:13:40 18 A. In broad strokes, the evaluation of invention  
09:13:43 19 disclosures submitted by scientists, the decision whether to  
09:13:50 20 seek patent protection on them, and then on those that we  
09:13:52 21 did seek patent protection the obtaining of patents and the  
09:14:02 22 administration of patents, the licensing of those patents,  
09:14:06 23 and the administration of the license agreements governing  
09:14:12 24 those patents.

09:14:15 25 Q. During your time at Boston University, was part of

Ashley Stevens - video

09:14:18 1 your job responsibilities to supervise patent attorneys who  
09:14:21 2 were prosecuting patents on behalf of Boston University?

09:14:24 3 A. It was.

09:14:25 4 Q. How much of your time at Boston University would you  
09:14:27 5 approximate was devoted to that?

09:14:31 6 A. I've never really tried to make that breakdown.  
09:14:41 7 Obtaining patent was a big part of the work of the Office of  
09:14:49 8 Technology Development, and then licensing those patents,  
09:14:53 9 negotiating licenses, and then administering those licenses  
09:14:57 10 was another big part. So I would not want to put a  
09:15:01 11 percentage on it. If you'd force me to, I would say  
09:15:12 12 probably between 25 and 50 percent of my time would have  
09:15:15 13 been on patent matters.

09:15:18 14 Q. And while you were at Boston University, were  
09:15:25 15 obtaining patent and dealing with the licensing of those  
09:15:28 16 patents your primary two tasks?

09:15:32 17 A. Yeah, I think that was the primary function of the  
09:15:36 18 Office of Technology Development. You know, in addition we  
09:15:40 19 provided counsel to administrators, to faculty members on  
09:15:43 20 the issues involved, students, and so forth.

09:15:47 21 But primarily it was about evaluating the  
09:15:52 22 intellectual property disclosures we got from faculty,  
09:15:56 23 deciding which to seek patents on, and then trying to get  
09:16:00 24 those patents, and licensing them, and administering those  
09:16:04 25 licenses.

Ashley Stevens - video

09:16:08 1 Q. Did you ever take any formal intellectual property  
09:16:11 2 training courses to obtain knowledge in the space of  
09:16:17 3 intellectual property?

09:16:19 4 A. No.

09:16:21 5 Q. How about related to --

09:16:23 6 A. I taught them.

09:16:24 7 Q. Go ahead.

09:16:25 8 A. I said, I taught them.

09:16:28 9 Q. How did you go about obtaining enough knowledge about  
09:16:32 10 intellectual property to be able to teach classes on it?

09:16:37 11 A. Through years of experience, through working with  
09:16:40 12 multiple patent attorneys over the years, attending  
09:16:43 13 workshops at professional associations such as the licensing  
09:16:50 14 executive society, the association of university technology  
09:16:55 15 managers, and so forth.

09:16:57 16 Q. While you were employed by Boston University, did you  
09:17:02 17 regularly interact with patent counsel?

09:17:05 18 A. I did.

09:17:06 19 Q. During your time at Boston University, it was BU's  
09:17:09 20 policy to rely on outside patent counsel to track  
09:17:14 21 maintenance fee due dates?

09:17:16 22 A. That was the definitive. We had a pretty good  
09:17:19 23 tracking system internally that kept on top of things. But  
09:17:23 24 particularly when I first got there, things kept emerging  
09:17:28 25 from the woodwork that we didn't know about. We

Ashley Stevens - video

09:17:32 1 progressively caught up on that. And after Ms. Anderson  
09:17:36 2 joined the office, I think that she was a very experienced  
09:17:40 3 patent paralegal and brought a great deal of order to our  
09:17:45 4 systems.

09:17:47 5 Q. And how about in the 2009 to 2010 time frame, would  
09:17:52 6 Boston University have implemented its own tracking system  
09:17:55 7 by that point?

09:18:01 8 A. As I said, we had a database management system that  
09:18:06 9 we had developed ourselves, it was written in FileMaker Pro,  
09:18:13 10 I think it was, and I believe that gave us the capability to  
09:18:16 11 track actions.

09:18:19 12 Q. And do you recall specifically whether maintenance  
09:18:22 13 fees were tracked in the database management system?

09:18:26 14 A. I don't.

09:18:26 15 Q. Who at BU was responsible for inputting data into the  
09:18:31 16 database management system?

09:18:33 17 A. All of us could. I would say Ms. Anderson was  
09:18:37 18 primarily responsible, probably exclusively responsible for  
09:18:42 19 inputting the patent matters, the activities coming due.  
09:18:42 20 And she was also responsible for entering charges for each  
09:18:52 21 action, and assigning them to the case that they were  
09:19:02 22 incurred in connection with.

09:19:03 23 The licensing people had more responsibility for  
09:19:08 24 the licenses, and would enter the details of the financial  
09:19:12 25 terms and things like that.

Ashley Stevens - video

09:19:17 1 Q. Do you recall yourself ever inputting information  
09:19:20 2 into the database?

09:19:22 3 A. I'm sure I did, because I had my own case load.

09:19:26 4 Q. And do you recall anyone else who input data into the  
09:19:32 5 database as part of their regular job functions?

09:19:37 6 A. I think all of the licensing associates and  
09:19:45 7 assistants would have had occasion to do so. I think that  
09:19:51 8 we entered financial receipts, payments. I don't think the  
09:20:06 9 office manager or accounting managers did that, but I could  
09:20:12 10 be wrong.

09:20:15 11 Q. Dr. Stevens, what years were you employed by Boston  
09:20:19 12 University?

09:20:19 13 A. I joined Boston University, I believe, in May of  
09:20:23 14 1995, and I retired on February 29th, 2012. I continued to  
09:20:29 15 have an adjunct appointment in the School of Management at  
09:20:37 16 Boston University I believe until the end of the academic  
09:20:40 17 year, 2014-15. And I currently have a consulting  
09:20:46 18 relationship with a unit of Boston University.

09:20:50 19 Q. What unit of Boston University do you currently have  
09:20:53 20 a consulting relationship with?

09:20:55 21 A. It is called CARB-X. C-A-R-B, all capitals, hyphen  
09:21:02 22 X, which stands for combatting antibiotic-resistant bacteria  
09:21:09 23 and the X stands for accelerator. And that is a very large  
09:21:13 24 program funded by BARTA in the U.S., Welcome Trust, Bill and  
09:21:20 25 Melinda Gates, the German government, people like that, to

Ashley Stevens - video

09:21:26 1 develop new treatments of antibiotic-resistant bacteria and  
09:21:31 2 to get them into phase one clinical trials, and that program  
09:21:35 3 is run out of BU's law school.

09:21:37 4 Q. How long have you held that consulting position with  
09:21:42 5 CARB-X?

09:21:43 6 A. About two years, I believe.

09:21:45 7 Q. And what is your role with CARB-X.

09:21:51 8 A. They asked -- particularly when they are evaluating  
09:21:55 9 proposals for funding from new companies, and they  
09:22:02 10 frequently have questions about intellectual property, about  
09:22:06 11 licenses that they have from universities, other companies,  
09:22:12 12 and I answer the questions that they direct my way.

09:22:18 13 Q. And are you generally providing advice on issues  
09:22:24 14 related to patents, or other types of intellectual property?

09:22:28 15 A. These are generally relating to patents.

09:22:31 16 Q. Do you currently hold any employment positions other  
09:22:35 17 than a consultant at CARB-X?

09:22:39 18 A. Well, I wouldn't characterize them as employment  
09:22:43 19 positions. I have a number of consulting relationships. Is  
09:22:47 20 that what you want me to talk about?

09:22:50 21 Q. Yes. So what other consulting relationships do you  
09:22:54 22 currently have?

09:22:57 23 A. So since I left Boston University, even before I  
09:23:01 24 left, I was asked to chair the patent committee at the  
09:23:05 25 Forsyth Institute, F-O-R-S-Y-T-H, Institute, which is an

Ashley Stevens - video

09:23:15 1 affiliate of the Harvard Dental School, and so I chair the  
09:23:25 2 patent committee there.

09:23:27 3 I have a number of different contractual  
09:23:30 4 engagements with the World Intellectual Property  
09:23:35 5 Organization in Geneva. And I think those are my currently  
09:23:42 6 ongoing consulting relationships. And then other consulting  
09:23:46 7 assignments come up on an ad hoc basis. I'm currently  
09:23:55 8 engaged in two lawsuits.

09:23:58 9 Q. And what is your role as chairman of the patent  
09:24:06 10 committee at Forsyth Institute?

09:24:12 11 A. So the patent committee at Forsyth is a small  
09:24:18 12 institution, although it is the largest recipient of grant  
09:24:22 13 funds from the National Institute of Craniofacial and Dental  
09:24:27 14 Research, it's still small, 20 odd million, has limited tech  
09:24:33 15 transfer office, and the patent committee evaluates new  
09:24:39 16 inventions and decides on whether to file patent  
09:24:44 17 applications on them.

09:24:48 18 And the committee consists of internal Forsyth  
09:24:53 19 people and then external people, some individuals with  
09:24:59 20 product development expertise, and some venture capitalists.

09:25:03 21 Q. You mentioned the term "tech transfer." What is your  
09:25:08 22 understanding of that term, please?

09:25:10 23 A. It's technology transfer, we often abbreviate to tech  
09:25:17 24 transfer. And it refers in the context of academic  
09:25:21 25 institutions to the identification, protection, and

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09:25:25 1 licensing of intellectual property created by faculty, staff  
09:25:32 2 and students at these institutions.

09:25:35 3 Q. You also mentioned that you're currently involved in  
09:25:39 4 two lawsuits. Is that as an expert witness?

09:25:42 5 A. It is.

09:25:42 6 Q. And do you have your own consulting business to  
09:25:46 7 provide expert witness services?

09:25:49 8 A. Well, I do it through an entity called Focus IP  
09:25:54 9 Group, LLC, although in honesty I have to admit "group" is a  
09:26:00 10 slight exaggeration. It is, in fact a 1-1 consulting  
09:26:05 11 company.

09:26:05 12 Q. So you are the only employee of Focus IP Group, LLC?

09:26:09 13 A. I am.

09:26:10 14 Q. Do you provide consulting services through Focus IP  
09:26:16 15 Group, LLC other than serving as an expert witness?

09:26:19 16 A. Yes. I run all of my consulting assignments through  
09:26:23 17 Focus IP Group.

09:26:27 18 Q. So, for example, CARB-X, the Forsyth Institute, those  
09:26:32 19 are all run through Focus IP Group?

09:26:35 20 A. Correct.

09:26:36 21 Q. In your experience as an expert witness, what types  
09:26:39 22 of issues are you typically retained to opine on?

09:26:42 23 A. So I characterize my practice as falling into two  
09:26:46 24 areas. I do patent infringement cases, and my role is to  
09:26:51 25 come up with damages under the reasonable royalty theory of

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09:26:58 1 damages and infringement. That is, I think, around  
09:27:04 2 one-third of my practice. And then the remaining two-thirds  
09:27:08 3 I classify as breach of contract, and that can be anything.

09:27:13 4 Q. Do you have any degrees in economics or finance?

09:27:20 5 A. I do not.

09:27:21 6 Q. How did you obtain an understanding of damages law  
09:27:25 7 for patent infringement cases?

09:27:30 8 A. By working -- initially I worked very closely with an  
09:27:35 9 economic firm that provides litigation support, that is the  
09:27:40 10 analysis group which is headquartered here in Boston, I  
09:27:41 11 worked closely with them.

09:27:48 12 And just like my knowledge of patent matters, it  
09:27:51 13 was acquired -- my knowledge was acquired on the job.

09:27:58 14 Q. And for approximately how many years have you been  
09:28:01 15 providing expert testimony on patent matters?

09:28:05 16 A. I think the first case I was engaged on was in 1997.

09:28:12 17 Q. And you also mentioned your secondary as an expert  
09:28:17 18 would be breach of contract. Do those cases also involve  
09:28:21 19 intellectual property issues?

09:28:22 20 A. These are generally licensing cases, or business  
09:28:25 21 relationship cases. And I limit my practice to the life  
09:28:29 22 sciences area. I think I've done one case involving a  
09:28:32 23 business method. By and large I work on chemistry,  
09:28:36 24 biochemistry, microbiology, drugs, biopharmaceuticals,  
09:28:42 25 medical devices, diagnostics.

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09:28:52 1 Q. And when did you begin providing expert witness  
09:28:55 2 testimony on breach of contract matters?

09:28:58 3 A. I would have to look at my resume. Certainly the  
09:29:03 4 first couple of -- few cases I did were patent infringement,  
09:29:07 5 so some probably relatively modest number of years after  
09:29:13 6 1997.

09:29:15 7 Q. What does RTTP stand for?

09:29:18 8 A. RTTP is a Registered Technology Transfer  
09:29:23 9 Professional. And this is a credential that is awarded by  
09:29:26 10 the ATTP, which is the Alliance of Technology Transfer  
09:29:31 11 Professionals. And that was an organization that was set up  
09:29:34 12 in about 2010 by five national technology transfer  
09:29:39 13 associations; AUTM in the U.S.; Praxis -- what was it called  
09:29:46 14 -- I think it was called Praxis Unico at the time in the  
09:29:51 15 U.S.; ESTP in Europe; CKA in Australia; and the Association  
09:29:58 16 of Technology Managers of Taiwan in Taiwan.

09:30:03 17 Q. When did you obtain the RTTP certification?

09:30:06 18 A. I was, again, in the first crop, and I think that  
09:30:10 19 that first generation was awarded in 2011, I believe.

09:30:17 20 Q. If I could please ask you to turn to the second page  
09:30:25 21 of this resume. If you see at the bottom of each page there  
09:30:32 22 are stamped page numbers, so this one will end with Stevens  
09:30:38 23 000015.

09:30:38 24 A. Okay.

09:30:39 25 Q. So you list three positions here for Boston

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09:30:43 1 University. The first one is executive director of  
09:30:46 2 Technology Transfer. Do you see that? By first, I mean  
09:30:50 3 chronologically.

09:30:51 4 A. I do.

09:30:52 5 Q. What is the Technology Transfer Office at Boston  
09:30:56 6 University?

09:30:56 7 A. So that is somewhat of an abbreviation. I think my  
09:31:00 8 initial title when I joined was director, office of  
09:31:03 9 technology transfer, and there were various reorganizations  
09:31:07 10 over the years, and I finished up as executive director,  
09:31:11 11 Technology Transfer in the Office of Technology Development.

09:31:18 12 Q. Is Technology Transfer a separate entity from the  
09:31:21 13 Office of Technology Development?

09:31:24 14 A. No, it was part of the Office of Technology  
09:31:27 15 Development. When I first joined, organizationally I was  
09:31:31 16 part of an entity called Community Technology Fund, which  
09:31:35 17 was a small wholly-owned venture capital fund run by Boston  
09:31:41 18 University, an organization, I was part of that.

09:31:44 19 Q. And did that organization that you initially joined,  
09:31:52 20 did that at some point become or rename to the Office of  
09:32:02 21 Technology Development or was it a completely separate  
09:32:05 22 group?

09:32:05 23 A. No, it evolved. At some point the technology -- the  
09:32:09 24 venture capital fund was shut down and other activities were  
09:32:12 25 added, a facility to help faculty start companies, funds to

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09:32:28 1 support initial development of technologies, proof of  
09:32:32 2 concept prototyping, and at some point we took  
09:32:42 3 responsibility for running the incubator that was located at  
09:32:49 4 Protonix Center. And these steps took place progressively  
09:32:58 5 over time.

09:33:00 6 Q. And was the -- at what point did your role shift to  
09:33:07 7 the technology transfer group?

09:33:10 8 A. I was on technology transfer from when I joined,  
09:33:18 9 which is why I said here, I just have the one line covering  
09:33:21 10 fifteen years. Within the community technology fund my role  
09:33:24 11 was to head technology transfer. Then as we became the  
09:33:29 12 Office of Technology Development, then again I managed the  
09:33:32 13 technology transfer function.

09:33:34 14 Q. And what year did the Office of Technology  
09:33:37 15 Development form?

09:33:39 16 A. As I sit here today, I can't recall.

09:33:43 17 Q. Do you recall approximately how many years into your  
09:33:54 18 tenure at Boston University?

09:33:57 19 A. I think it would have been probably sometime in the  
09:34:00 20 early 2000s.

09:34:01 21 Q. And once the Office of Technology Development was  
09:34:03 22 formed, what was the relationship between the Technology  
09:34:06 23 Transfer Group and the Office of Technology Development?

09:34:08 24 A. Well, the managing director was my boss, and then I  
09:34:12 25 had peers who ran the incubator, who ran the startup company

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09:34:18 1 assistance, and who ran the technology development  
09:34:22 2 maturation fund.

09:34:26 3 Q. Is it the case that all of the intellectual property  
09:34:30 4 and licensing activities we discussed earlier were in the  
09:34:36 5 domain of the Technology Transfer Group?

09:34:39 6 A. I would characterize that as being correct.

09:34:42 7 Q. And the other functions you mentioned such as running  
09:34:46 8 the incubator and the technology development maturation  
09:34:52 9 fund, would those have been run by other parts of the Office  
09:34:58 10 of Technology Development?

09:34:58 11 A. Correct. The directors who reported to the managing  
09:35:03 12 director.

09:35:03 13 Q. And just for clarity, if I use the term OTD today,  
09:35:09 14 you'll understand that to mean the Office of Technology  
09:35:12 15 Development?

09:35:12 16 A. I do.

09:35:13 17 Q. When you joined the technology -- or when you joined  
09:35:19 18 Boston University, how many employees were working with you  
09:35:34 19 in the area of technology transfer?

09:35:38 20 A. With me was one-and-a-half people.

09:35:42 21 Q. Who were those people?

09:35:45 22 A. There was an assistant director, Susan. I don't  
09:35:49 23 remember her last name. She was married to an Indian, so it  
09:35:54 24 was an Indian name. She was the assistant director.

09:36:05 25 And then there was a temporary part-time

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09:36:09 1 administrative assistant.

09:36:10 2 Q. And was your role from the outset director of the  
09:36:15 3 Technology Transfer Group?

09:36:17 4 A. Director, Office of Technology Transfer I believe was  
09:36:20 5 my title.

09:36:21 6 Q. So throughout your tenure with technology transfer,  
09:36:35 7 was there anyone that you reported to within technology  
09:36:38 8 transfer, or were you reporting up to a higher level?

09:36:43 9 A. No, the community technology fund had a managing  
09:36:47 10 director, John Bagley, and at that point the community  
09:36:54 11 technology fund had two functions, technology transfer and  
09:36:59 12 venture capital, and there was a director of venture capital  
09:37:06 13 and a director of technology transfer, both reporting to the  
09:37:12 14 managing director. There was a small venture technology  
09:37:20 15 maturation fund then, which I administered.

09:37:27 16 Q. And when the OTD was formed, is it also the case that  
09:37:32 17 you were then reporting to the managing director of the OTD?

09:37:37 18 A. Correct.

09:37:37 19 Q. When the Office of Technology Development was formed,  
09:37:42 20 how many employees were working in the area of technology  
09:37:46 21 transfer?

09:37:47 22 A. I'm going to say it was Janine, Sean Lee, and John  
09:37:52 23 Jensen, Rick Clark, and April Everett. Myself. I think  
09:38:00 24 there were the dedicated staff. And there was an office  
09:38:12 25 manager who provided accounting services. We may have had

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09:38:16 1 another administrative assistant.

09:38:18 2 That was kind of myself on top, Janine managing  
09:38:22 3 the patent estate, two people on the physical sciences  
09:38:26 4 portfolio, two people on the life sciences portfolio, and  
09:38:31 5 general support from the office manager.

09:38:35 6 Q. And did all of the employees ultimately report to  
09:38:41 7 you?

09:38:42 8 A. The office manager did not.

09:38:46 9 Q. And how about in the 2009-2010 time frame, were there  
09:38:51 10 any changes in the employees of the technology transfer?

09:38:57 11 A. No. Those were the people. There have been some  
09:39:03 12 turnover previously, but I think by then Rick and Sean and  
09:39:09 13 April and John were very competent, each of them.

09:39:14 14 Q. What was Sean Lee's role in technology transfer?

09:39:19 15 A. I believe his job title was licensing associate,  
09:39:24 16 physical sciences.

09:39:28 17 Q. And what responsibilities did he have as licensing  
09:39:31 18 associate, physical sciences?

09:39:33 19 A. He was the lead person on physical sciences  
09:39:37 20 inventions across the university.

09:39:42 21 Q. And what types of responsibilities did he have as the  
09:39:48 22 lead scientist? In other words, what did he do on a  
09:39:52 23 day-to-day basis?

09:39:53 24 A. So Jon Jensen, his licensing assistant, would have  
09:40:00 25 received physical sciences invention disclosures, evaluated

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09:40:06 1 them, recommended to the group which ones to pursue patent  
09:40:11 2 protection on, sought licensees, negotiated licenses,  
09:40:18 3 executed licenses, administered the license agreements, the  
09:40:22 4 gamut of technology transfer.

09:40:26 5 Q. Do I have it correct that Jon Jensen served as an  
09:40:30 6 assistant to Sean?

09:40:31 7 A. I believe his title was licensing assistant. Sorry,  
09:40:35 8 licensing assistant, physical sciences.

09:40:40 9 Q. Who was in a higher level position, Sean or Jon, do  
09:40:47 10 you recall?

09:40:47 11 A. The associate was higher than the assistant.

09:40:50 12 Q. Do you recall whether Jon reported to Sean?

09:40:55 13 A. Yes.

09:40:56 14 Q. And then did Sean report to you?

09:40:58 15 A. Yes.

09:41:03 16 Q. You mentioned one of Sean's responsibilities would  
09:41:08 17 have been recommending to the group which invention  
09:41:13 18 disclosures to pursue patent protection on. Who had final  
09:41:18 19 say on whether or not to pursue patent protection for a  
09:41:22 20 submitted invention disclosure?

09:41:25 21 A. At the end of the day the buck stopped with me, but  
09:41:28 22 we managed the patent portfolio as a group.

09:41:32 23 Q. And did you typically follow Sean Lee's  
09:41:38 24 recommendations?

09:41:39 25 A. I would say as a general proposition, yes.

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09:41:47 1 Q. Can you recall approximately how many times you did  
09:41:52 2 not follow his recommendations?

09:41:54 3 A. I don't recall.

09:41:55 4 Q. And for cases that you did not personally keep, would  
09:42:01 5 Sean Lee have the final say on whether or not to pay  
09:42:05 6 maintenance fees, or did he have to run that by you?

09:42:08 7 A. It was a collective decision when we set our budgets  
09:42:13 8 for the year. We set our budgets on a case-by-case basis.

09:42:19 9 Q. Who would be involved in making that collective  
09:42:24 10 decision?

09:42:25 11 A. All the employees of Technology Transfer, Janine  
09:42:30 12 Anderson, Sean Lee, John Jensen, Rick Clark, April Everett,  
09:42:36 13 myself, and the accounting person who we worked with.  
09:42:44 14 Primarily the executive staff, and less the accounting  
09:42:48 15 person. They were much more concerned with the physical  
09:42:53 16 implementation, entering bills and things like that.

09:43:00 17 Q. And we talked about her briefly already, but what  
09:43:04 18 were Ms. Anderson's job responsibilities in the Technology  
09:43:10 19 Transfer Group?

09:43:10 20 A. So she was the point person on patent matters. All  
09:43:15 21 patent correspondence came to her. She was responsible for  
09:43:19 22 filing it, entering the details of the correspondence in the  
09:43:24 23 database management system, she supervised the patent bills.  
09:43:29 24 I think we had a clerical person to physically enter the  
09:43:35 25 case amounts in the database, but Janine supervised it. She

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09:43:42 1 generated reimbursement bills that go out to licensees. And  
09:43:48 2 she had overall responsibility for tracking the patent  
09:43:51 3 budget.

09:43:55 4 Q. When you say patent correspondence came to her, does  
09:43:59 5 that mean that all correspondence that technology transfer  
09:44:05 6 received from inventors, the Patent Office, outside patent  
09:44:08 7 counsel would go to Ms. Anderson?

09:44:11 8 A. I'm not sure inventors necessarily, but certainly  
09:44:15 9 Patent Offices and outside counsel, all of that  
09:44:18 10 correspondence went to her, and she would open it and take  
09:44:23 11 appropriate actions.

09:44:27 12 Q. Was she the only employee in Technology Transfer who  
09:44:31 13 was in regular communication with BU's outside patent  
09:44:36 14 counsel?

09:44:37 15 A. No. The licensing people might contact counsel to  
09:44:41 16 discuss specific cases.

09:44:44 17 Q. And by that you mean the licensing associates and  
09:44:51 18 assistants?

09:44:56 19 A. Correct.

09:44:57 20 Q. And you mentioned also that Janine Anderson would be  
09:45:02 21 the point person for receiving patent-related  
09:45:05 22 correspondence. Would she then forward typically that  
09:45:09 23 correspondence to the others within the Technology Transfer  
09:45:12 24 Group?

09:45:12 25 A. She would, yes.

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09:45:15 1 Q. Do you know who Mr. Nijhawan is?

09:45:19 2 A. I do.

09:45:20 3 Q. Who is he?

09:45:21 4 A. He became managing director of the Office of  
09:45:27 5 Technology Development and took over responsibility for  
09:45:31 6 technology transfer when I became special assistant to the  
09:45:36 7 vice-president for research.

09:45:37 8 Q. So then is it the case that Mr. Nijhawan took over  
09:45:42 9 your position at the Technology Transfer Group?

09:45:46 10 A. Yes.

09:45:47 11 Q. And did you ever overlap with him in the Technology  
09:45:52 12 Transfer Group?

09:45:52 13 A. So I maintained an office for my two years as  
09:45:58 14 vice-president -- as special assistant for vice-president of  
09:46:01 15 research in 53 Bay State Road, so we were physically  
09:46:08 16 overlapping, but I would say we were not -- when he took  
09:46:13 17 over I stepped away.

09:46:17 18 Q. And when did you step away from your role as director  
09:46:26 19 of Technology Transfer Group?

09:46:29 20 A. I believe immediately after the February 2010 patent  
09:46:36 21 committee meeting which I introduced Mr. Nijhawan as my  
09:46:41 22 successor, and I think he took over forth with.

09:46:44 23 Q. Do you recall who at the OTD, we'll say in the 2009  
09:46:52 24 to 2010 time period, would have had responsibility for  
09:46:57 25 instructing outside counsel to make payments due to the

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09:47:00 1 **Patent Office?**

09:47:01 2 A. **Janine Anderson.**

09:47:04 3 Q. **And would someone at the OTD have had to instruct**  
09:47:09 4 **Ms. Anderson to instruct counsel to make the payments?**

09:47:14 5 A. **I think I answered this earlier. I said that we**  
09:47:21 6 **would have decided which maintenance fees we were going to**  
09:47:25 7 **pay as part of the patent budgeting cycle, and then**  
09:47:35 8 **Ms. Anderson would have probably touched base and said,**  
09:47:40 9 **"hey, we agreed we're going to pay this one, it's coming**  
09:47:44 10 **due, I'm going to pay it, is that correct?" That would**  
09:47:48 11 **probably have been an informal conversation. We were all**  
09:47:51 12 **close together in a small space.**

09:47:54 13 Q. **And who would she have had that touch base**  
09:47:58 14 **conversation with typically?**

09:48:02 15 A. **With the individual who had responsibility for the**  
09:48:05 16 **case.**

09:48:07 17 Q. **So for physical science cases, that person would be**  
09:48:12 18 **Sean Lee?**

09:48:14 19 A. **Probably, yes.**

09:48:16 20 Q. **As best you can tell, in the 2009 to 2010 time frame**  
09:48:21 21 **you were not aware of any specifics about the process for**  
09:48:22 22 **reviving abandoned patents, is that correct?**

09:48:31 23 A. **Correct. I don't believe that I have previously gone**  
09:48:32 24 **through the process of providing an abandoned patent.**

09:48:32 25 Q. **How many patents during your time at the OTD did BU**

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09:48:41 1

**attempt to revive?**

09:48:43 2

A. **So you say "patents," therefore I assume you mean**

09:48:54 3

**issued patents where the maintenance fee had not been paid.**

09:49:00 4

Q. **For the record, Exhibit 2 is a copy of United States**

09:49:04 5

**Patent No. 6,294,475.**

09:49:08 6

A. **I have it.**

09:49:09 7

Q. **Dr. Stevens, do you recognize this document?**

09:49:12 8

A. **Yes.**

09:49:15 9

Q. **What is it?**

09:49:16 10

A. **It's an issued U.S. patent issued to the Trustees of**

09:49:21 11

**Boston University, invented by E. Fred Schubert, Dean A.**

09:49:26 12

**Stocker, titled, "Crystallographic Wet Chemical Etching of**

09:49:31 13

**III-Nitride Material.**

09:49:35 14

Q. **And do you understand when we were referring to the**

09:49:38 15

**'475 Patent just a few minutes ago that this is the patent**

09:49:41 16

**being referred to?**

09:49:42 17

A. **I do.**

09:49:43 18

Q. **And as we move forward through the deposition today,**

09:49:47 19

**you would understand if we use the term '475 Patent, we are**

09:49:51 20

**referring to the patent shown here in Exhibit 2?**

09:49:54 21

A. **I do.**

09:49:55 22

Q. **During your time at BU, do you recall interacting**

09:49:58 23

**with Professor Schubert?**

09:50:02 24

A. **Yes.**

09:50:03 25

Q. **What do you recall about your interactions with him?**

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09:50:08 1 A. So he worked in the gallium nitride area, which was  
09:50:15 2 an area of great interest to BU through the pioneering work  
09:50:20 3 of Professor Ted Moustakes.

09:50:23 4 Q. Do you recall whether you were involved in  
09:50:25 5 communications with Professor Schubert regarding the return  
09:50:29 6 of the patent?

09:50:31 7 A. Depends what you mean by "communications." I was  
09:50:36 8 clearly part of the discussion. I made the recommendation  
09:50:39 9 to the patent committee that we return the invention to  
09:50:44 10 Professor Schubert.

09:50:46 11 Q. Do you recall having any communications directly with  
09:50:50 12 Professor Schubert about the return of the '475 Patent to  
09:50:53 13 him?

09:50:54 14 A. I think the primary point of contact was Dr. Lee.

09:51:01 15 Q. So is it the case that you can't remember one way or  
09:51:07 16 the other whether you communicated directly with Professor  
09:51:12 17 Schubert in the 2009 time frame?

09:51:14 18 A. My testimony would be I think it is highly unlikely I  
09:51:19 19 communicated with him directly.

09:51:22 20 Q. Do you see the second listed inventor on the '475  
09:51:32 21 Patent is Dean A. Stocker?

09:51:35 22 A. I do.

09:51:36 23 Q. Do you recall anything about Dean Stocker?

09:51:38 24 A. I couldn't put a face to the name. My understanding  
09:51:42 25 is he was one of the Professor Schubert's graduate students,

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09:51:49 1 and I presume that his patent resulted from the subject of  
09:51:55 2 his Ph.D.

09:51:57 3 Q. Do you recall one way or the other whether or not you  
09:52:02 4 ever communicated with Dean Stocker?

09:52:06 5 A. When Professor Schubert expressed an interest in  
09:52:17 6 taking title to the patent, we would have contacted  
09:52:20 7 Dr. Stocker to ask if he was interested in being part of  
09:52:26 8 this.

09:52:30 9 Q. Do you recall contacting Dr. Stocker specifically, or  
09:52:34 10 is that just a matter of policy that BU would contact all  
09:52:39 11 inventors?

09:52:41 12 A. My recollection of the communication to the patent  
09:52:46 13 committee said that we have been in contact with Dr. Stocker  
09:52:50 14 to ascertain his interest and have not had reply. So that  
09:52:56 15 communication had taken place before the patent committee  
09:52:59 16 meeting.

09:53:01 17 Q. If you could look still on the first page of the  
09:53:07 18 patent, do you see on the right-hand column about a third of  
09:53:12 19 the way down there's a parenthetical number 74, "Attorney,  
09:53:19 20 Agent, or Firm - Samuels, Gauthier & Stevens"?

09:53:22 21 A. Yes.

09:53:30 22 Q. Are you familiar with that law firm?

09:53:32 23 A. I am.

09:53:33 24 Q. Was it one of BU's regular outside patent counsel?

09:53:36 25 A. It was.

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09:53:37 1 Q. So at the -- we'll say in the 1998 through early  
09:53:41 2 2000s time period, do you recall how many outside patent  
09:53:49 3 counsel firms BU would typically employ?

09:53:55 4 A. The total number I don't know. There was probably a  
09:54:03 5 core group of four or five that we sent the bulk of the work  
09:54:08 6 to. There may have been other firms that had one case for  
09:54:14 7 historical reasons.

09:54:17 8 Q. Was Samuels, Gauthier & Stevens one of those core  
09:54:22 9 firms?

09:54:23 10 A. I would characterize them that way.

09:54:25 11 Q. And was an attorney named Matthew Connors the primary  
09:54:32 12 attorney that BU interacted with at Samuels Gauthier and  
09:54:37 13 Stevens?

09:54:37 14 A. I believe so.

09:54:38 15 Q. After the '475 Patent issued in 2001, do you recall  
09:54:42 16 what BU did with it?

09:54:44 17 A. I'm sure we would have sought licensing interest. We  
09:54:53 18 would have worked with Professor Schubert for his ideas on  
09:54:59 19 who might be interested. By then we had an established  
09:55:02 20 relationship with the Cree Company and I'm sure -- which I  
09:55:12 21 managed that relationship, and I'm sure I would have brought  
09:55:21 22 this patent to Cree's attention.

09:55:25 23 Q. So as you sit here today, is it your recollection  
09:55:29 24 that BU chose to abandon the '475 Patent by not paying the  
09:55:38 25 second maintenance fee because there was no success in

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09:55:41 1 commercializing the invention?

09:55:44 2 A. Yeah, we were not aware of commercial interest in it.

09:55:49 3 Q. And that lack of commercial interest is the reason  
09:55:52 4 why BU chose to abandon the '475 Patent by not paying the  
09:55:56 5 second maintenance fee, is that right?

09:55:58 6 A. I would say probably that, combined with the fact  
09:56:02 7 that Professor Schubert was no longer at BU. This case is  
09:56:07 8 now what we used to call an orphan, and it was that much  
09:56:11 9 more difficult to find licensees if the professor had left  
09:56:17 10 and we were no longer generating new research related to  
09:56:23 11 that area of technology.

09:56:26 12 Q. Did BU have a policy of asking inventors to take over  
09:56:32 13 patents for which BU did not intend to pay the maintenance  
09:56:36 14 fee?

09:56:36 15 A. I would say broader than that. It was our policy to  
09:56:41 16 offer inventions that we no longer wanted to faculty. It  
09:56:50 17 might be at the provisional commercial stage if we had  
09:56:53 18 decided not to convert, or if we had decided to abandon  
09:56:59 19 prosecution prior to issuance, or is this post-issuance.

09:57:05 20 It was generally our policy to be as supportive  
09:57:09 21 of faculty's entrepreneurial aspirations as we could and if  
09:57:16 22 we had no interest, then we would certainly ask them if they  
09:57:19 23 had interest, and we felt we had clearly friendly terms to  
09:57:23 24 allow them to do that.

09:57:25 25 Q. And in your answer when you refer to faculty, are you

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09:57:29 1 referring to the particular faculty members who were the  
09:57:33 2 named inventors of the particular patent case?

09:57:37 3 A. Yes. And I should have said faculty, staff and  
09:57:40 4 students. We didn't get many inventions from staff, but  
09:57:44 5 certainly students were involved in a lot of cases.

09:57:48 6 Q. So to the best of your recollection, did BU always  
09:57:51 7 pay the maintenance fees on its own?

09:57:54 8 A. My recollection is that we tried to do that as a way  
09:57:57 9 to save money that we readily could.

09:58:01 10 Q. But is it also true that sometimes BU would have  
09:58:04 11 outside counsel pay maintenance fees?

09:58:09 12 A. I don't recall.

09:58:11 13 Q. And your recollection is that after the maintenance  
09:58:19 14 fee was not paid for the '475 Patent, then the '475 Patent  
09:58:23 15 expired, correct?

09:58:24 16 A. That is my recollection, yes.

09:58:26 17 Q. And we touched on this earlier, but your recollection  
09:58:35 18 is also that the '475 Patent was later revived, correct?

09:58:40 19 A. That's what I have since become aware of. As I  
09:58:44 20 said, my last action as director of technology transfer or  
09:58:50 21 executive director of technology transfer at BU was at the  
09:58:55 22 patent committee. I believe I also wrote up minutes of that  
09:59:00 23 meeting since I conducted it, and then I was out of there, I  
09:59:05 24 was special assistant to the vice-president for research,  
09:59:08 25 and I took no further part in any of the routine operations

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09:59:12 1 of technology transfer.

09:59:14 2 Q. Sure.

09:59:16 3 Do you recall when you left technology transfer  
09:59:18 4 in February of 2010 whether there was a plan in place to  
09:59:29 5 revive the '475 Patent?

09:59:38 6 A. No. The first issue was would the patent committee  
09:59:42 7 agree to return it to Professor Schubert, and that decision  
09:59:45 8 was reached. It was my expectation that we would return it  
09:59:52 9 to Professor Schubert and he would do the reviving.

09:59:59 10 Q. Do you recall any -- whether you had any discussions  
10:00:03 11 before leaving the Technology Transfer Group whether or not  
10:00:10 12 the '475 Patent could be revived?

10:00:14 13 A. Yes.

10:00:17 14 Q. And do you recall who those discussions were with?

10:00:21 15 A. Yes.

10:00:22 16 Q. Who were they with?

10:00:23 17 A. Matt Connors. And I'm not sure I would characterize  
10:00:29 18 them as discussions. My best recollection is it was a  
10:00:33 19 discussion.

10:00:34 20 Q. And do you recall any discussions or communications  
10:00:38 21 with Professor Schubert about whether or not the '475 Patent  
10:00:43 22 could be revived?

10:00:45 23 A. I did not have discussions with him.

10:00:47 24 Q. And at the time you left the OTD, did you have an  
10:00:52 25 understanding of whether or not reviving the '475 Patent

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10:00:56 1 would require BU to pay a fee to the Patent Office?

10:01:00 2 A. I believe a fee would be paid. I had not got into  
10:01:07 3 the mechanics of who would be paying that fee. As I said,  
10:01:13 4 it was my expectation that BU would return the patent in its  
10:01:19 5 dead state to Professor Schubert, and he would be  
10:01:23 6 responsible for the attempt to revive it.

10:01:27 7 Q. Why do you recall that being your expectation?

10:01:42 8 A. Why do I recall?

10:01:44 9 Q. Yes. Do you recall any communications or any written  
10:01:48 10 documents setting that out?

10:01:51 11 A. No. That was my expectation.

10:01:53 12 Q. And do you remember communicating that expectation to  
10:01:59 13 anyone?

10:01:59 14 A. I don't recall.

10:02:01 15 Q. So at the time you left the OTD, was it your  
10:02:05 16 understanding that as long as the fee was paid to the Patent  
10:02:11 17 Office, the patent could automatically be revived?

10:02:15 18 A. I don't believe it was automatic. Application had to  
10:02:19 19 be made.

10:02:19 20 Q. And do you recall whether there were any requirements  
10:02:22 21 in the application, other than the payment of the fee?

10:02:22 22 A. I believe the failure to pay the fee had to have been  
10:02:32 23 unavoidable or unintentional. I believe I recall those  
10:02:42 24 words from some Patent Office document, in something  
10:02:42 25 somewhere.

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10:02:49 1 Q. I'll read the question again. Do you recall whether  
10:02:52 2 there were any requirements in the application other than  
10:02:55 3 the payment of a fee?

10:02:57 4 A. I think I said something like the failure to pay the  
10:03:01 5 maintenance fee had to have been unavoidable or  
10:03:07 6 unintentional. Those are the words I have in the back of my  
10:03:13 7 mind that I was aware of.

10:03:17 8 Q. Do you recall whether that was your understanding at  
10:03:21 9 the time you left the OTD?

10:03:23 10 A. I believe it was.

10:03:24 11 Q. And at the time you left the OTD, do you recall  
10:03:27 12 whether Sean Lee also understood that the failure to pay had  
10:03:31 13 to be unintentional or unavoidable?

10:03:34 14 A. I think you could more properly ask that question of  
10:03:40 15 Dr. Lee, but I think we had a common understanding.

10:03:47 16 Q. And before your deposition preparation, did you have  
10:03:50 17 any knowledge that the petition to revive the '475 Patent  
10:03:54 18 was filed on April 22nd, 2010?

10:04:00 19 A. I was not aware of that.

10:04:02 20 Q. And if you could please go back to the prior page, so  
10:04:05 21 that's the one ending in 291. Just let me know when you're  
10:04:10 22 there.

10:04:12 23 A. I'm there.

10:04:12 24 Q. Do you see about halfway down the page that there is  
10:04:16 25 a box that starts, "statement," and then --

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10:04:21 1 A. I see that.

10:04:23 2 Q. -- continues, "the undersigned certifies that the  
10:04:27 3 delay in payment of the maintenance fee to this patent was  
10:04:30 4 unintentional."

10:04:32 5 Do you see that?

10:04:32 6 A. I do.

10:04:33 7 Q. Do you understand this certification to relate to the  
10:04:40 8 requirement you testified to earlier concerning the delay in  
10:04:43 9 paying the maintenance fee to be -- now is it your  
10:04:47 10 understanding that the '475 Patent was revived on the basis  
10:04:50 11 of the delay in paying the maintenance fee being  
10:04:53 12 unintentional?

10:04:54 13 A. That's what this statement says.

10:04:57 14 Q. And are you aware one way or the other whether  
10:05:01 15 Mr. Connors was aware of the any of the facts surrounding  
10:05:05 16 the delay in paying the maintenance fee at the time he filed  
10:05:09 17 his application?

10:05:13 18 MR. RADER: I just want to caution the witness,  
10:05:15 19 you're not to disclose the contents of the conversation or  
10:05:18 20 conversations you had with Mr. Connors. But if this is a  
10:05:21 21 yes or no question as to whether you're aware, just your  
10:05:25 22 awareness of whether he new those facts, which I think it  
10:05:31 23 is, you can answer that.

10:05:32 24 A. The answer would be yes.

10:05:35 25 Q. Is it your understanding that yes, Mr. Connors was

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10:05:38 1 aware of the facts surrounding the delay in paying the  
10:05:41 2 maintenance fee at the time he filed his application?

10:05:44 3 A. Yes.

10:05:45 4 Q. Dr. Stevens, earlier you testified that one reason  
10:05:50 5 that BU let the maintenance fee lapse was that there was no  
10:05:55 6 commercial interest in the '475 Patent.

10:05:57 7 Do you recall whether or not Mr. Connors at the  
10:06:02 8 time he filed this petition was aware that a reason BU let  
10:06:07 9 the fee lapse was the lack of commercial interest in the  
10:06:11 10 patent?

10:06:12 11 A. Michael?

10:06:17 12 Q. I'm not asking for any legal advice, I'm just asking  
10:06:19 13 for facts that Mr. Connors knew?

10:06:22 14 A. Michael, I feel this is too close. I think I am  
10:06:25 15 going to decline to answer.

10:06:28 16 Q. Dr. Stevens, to the best of your recollection, at the  
10:06:31 17 time that Mr. Connors filed the petition to revive the '475  
10:06:36 18 Patent, what facts concerning the delay in paying the second  
10:06:40 19 maintenance fee was he aware of.

10:06:43 20 A. This sounds to me to be more detailed and closer to a  
10:06:47 21 breach of privilege than your previous one. It seems to me  
10:06:51 22 you're asking me to tell you what I told Mr. Connors.  
10:06:55 23 Previously you asked me if he was aware of the facts of the  
10:07:00 24 decision not to pay the maintenance fee.

10:07:02 25 By the beginning of September, we were not aware

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10:07:14 1 of commercial interest in the '475 Patent, and that we had  
10:07:21 2 determined not to pay the second maintenance fee  
10:07:25 3 accordingly.

10:07:28 4 I don't recall whether -- I assume I would have  
10:07:34 5 also told him that, at the beginning of September, Professor  
10:07:39 6 Schubert declined the offer of taking over the patent.

10:07:44 7 Those are the facts.

10:07:47 8 Q. Are there any other facts that you can recall as you  
10:07:51 9 sit here today?

10:07:52 10 A. No. I mean, obviously the fact that now Professor  
10:08:03 11 Schubert wanted it, obviously that's why we're having the  
10:08:06 12 conversation.

10:08:07 13 Q. And was anyone else present for your communication  
10:08:13 14 with Mr. Connors? I'm not asking for anything about the  
10:08:18 15 communications. Just was it just the two of you, or was  
10:08:22 16 there someone else involved in the discussion?

10:08:24 17 MR. RADER: That's okay. You can answer that.

10:08:26 18 A. I don't believe anybody else was involved.

10:08:31 19 Q. And do you recall how long, approximately, your  
10:09:00 20 discussion was with Mr. Connors?

10:09:03 21 A. No.

10:09:06 22 Q. Do you recall would it have been more than five  
10:09:09 23 minutes?

10:09:09 24 A. I don't recall. I don't think it takes very long to  
10:09:13 25 communicate that fact pattern.

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10:09:16 1 Q. Dr. Stevens, I just sent through the chat a document  
10:09:20 2 that will be Exhibit 6 to your deposition. That's document  
10:09:24 3 bearing the Bates number EFS 00006680. And just take a  
10:09:32 4 moment to look at it, and then let me know whether or not  
10:09:35 5 you recognize this document.

10:09:38 6 A. I have seen this in the course of preparing for this  
10:09:50 7 matter.

10:09:54 8 Q. And do you have an understanding of what's happening  
10:09:57 9 in this e-mail?

10:09:58 10 A. I do.

10:09:59 11 Q. And what's your understanding?

10:10:02 12 A. That based on the collective decision not to pay the  
10:10:05 13 second maintenance fee we are offering the case to  
10:10:09 14 Dr. Schubert.

10:10:11 15 Q. Do you see in the first sentence of the e-mail, Sean  
10:10:17 16 writes, "I'm the case manager for the physical science  
10:10:21 17 cases." Do you see that?

10:10:22 18 A. I do.

10:10:22 19 Q. Do you know what he's referring to by the term "case  
10:10:26 20 manager"?

10:10:27 21 A. He's in charge of the cases in the physical science  
10:10:31 22 portfolio, as I have previously testified.

10:10:35 23 Q. And do you see, if you go to the second paragraph,  
10:10:39 24 he's referring to the '475 Patent in the first sentence?

10:10:42 25 A. Yes, ma'am.

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10:10:48 1 Q. And then he continues, "we have paid the first  
10:10:51 2 maintenance fee but as part of effort to reduce our  
10:10:54 3 portfolio we are planning on not paying the second fee of  
10:10:58 4 \$1,300 due September 25, 2009."

10:11:01 5 Is that consistent with your recollection of the  
10:11:04 6 decision of the OTD?

10:11:07 7 A. Yes. I think it's consistent with my testimony here  
10:11:11 8 today.

10:11:11 9 Q. And do you see where it says, "part of the effort to  
10:11:15 10 reduce our portfolio"?

10:11:17 11 A. I do not.

10:11:18 12 Q. Do you know what he's referring to there?

10:11:21 13 A. Our effort to keep our patent expenditures within the  
10:11:25 14 budget the university has allocated to us. Since we are  
10:11:32 15 getting new cases coming in every year, this inevitably  
10:11:38 16 requires terminating older cases if they don't look like  
10:11:43 17 they have value to make way for them.

10:11:45 18 Q. And is that referring to the typical yearly process  
10:11:47 19 you mentioned of deciding which patents to maintain, or was  
10:11:52 20 there a special effort going on in the OTD around this time?

10:11:55 21 A. No, it was a constant struggle to set the budget, and  
10:12:00 22 then to live within the budget.

10:12:02 23 Q. And do you see in the -- in his first paragraph he  
10:12:06 24 says, "we are in the process of consolidating our active  
10:12:12 25 portfolio"?

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10:12:12 1

A. Yes.

10:12:13 2

Q. Is that referring to the same thing you just

10:12:15 3

testified to?

10:12:15 4

A. Yes, it's the same as reducing our portfolio in the next paragraph.

10:12:20 5

10:12:20 6

Q. So is it correct to say that as of September 2nd,

10:12:24 7

2009, BU did not believe that the '475 Patent had sufficient commercial value to justify paying the second maintenance

10:12:29 8

fee?

10:12:33 9

10:12:33 10

A. We were not aware of commercial value, we haven't

10:12:37 11

been when we set the budget, and nothing had changed to

10:12:40 12

change our minds and decision.

10:12:44 13

Q. I've just sent you a chat of what will be Exhibit 7

10:12:49 14

to your deposition, and it's a document bearing Bates range

10:12:52 15

BU 000268 to 269. And Dr. Stevens, once you have been able

10:13:01 16

to open that and take a look at it, just let me know if you

10:13:05 17

recognize it.

10:13:05 18

A. I have, again, seen this in preparation for this

10:13:09 19

deposition.

10:13:12 20

Q. And you can't recall seeing it at any other time --

10:13:15 21

A. No.

10:13:15 22

Q. -- is that correct?

10:13:17 23

A. You can see from the header of the two e-mails

10:13:21 24

referenced here that I am not copied on either.

10:13:23 25

Q. So if you scroll down -- I apologize. I read the

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10:13:30 1 Bates number wrong. This is just a one-page document. So  
10:13:34 2 do you see the bottom e-mail here is the same e-mail we just  
10:13:37 3 looked at in Exhibit 6?

10:13:38 4 A. Yes.

10:13:38 5 Q. Okay. And then you see the thread continues with a  
10:13:42 6 response from Professor Schubert saying, "Sean, thank you  
10:13:45 7 very much for the offer. Unfortunately" -- presumably  
10:13:50 8 should be unfortunately -- "I would not be interested."

10:13:53 9 Do you see that?

10:13:54 10 A. I do.

10:13:54 11 Q. So do you recall learning at around this time that  
10:13:58 12 Professor Schubert had declined Dr. Lee's offer to return  
10:14:02 13 the '475 Patent to him?

10:14:04 14 A. I don't recall. I doubt there would be any need for  
10:14:09 15 me to if it was going along the path we had established back  
10:14:13 16 in May or June when we set the patent budget. Whether it  
10:14:18 17 was mentioned at one of our weekly technology transfer team  
10:14:23 18 meetings, I don't recall.

10:14:25 19 Q. So you don't recall when you became aware that  
10:14:29 20 Professor Schubert had declined the offer?

10:14:32 21 A. No.

10:14:34 22 Q. Do you recall ever finding out why Professor Schubert  
10:14:37 23 wrote on September 2nd, 2009, that he would not be  
10:14:42 24 interested?

10:14:44 25 A. No.

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10:14:46 1 Q. Do you know whether anyone at the OTD had discussions  
10:14:49 2 with Professor Schubert concerning why he was not interested  
10:14:52 3 in the patent as of September 2nd, 2009?

10:14:57 4 A. Nope.

10:15:04 5 Q. And can you recall having any conversations with  
10:15:07 6 Dr. Lee about his offer to Professor Schubert or Professor  
10:15:12 7 Schubert's response?

10:15:16 8 A. I think you said with Dr. Lee. And the answer is no,  
10:15:19 9 I don't.

10:15:21 10 Q. Okay. If could go to the initial e-mail in the  
10:15:31 11 chain, so that's the e-mail from Sean Lee to Professor  
10:15:37 12 Schubert. Do you see in the third paragraph of that e-mail  
10:15:41 13 Dr. Lee where is a sentence beginning with "our patent  
10:15:48 14 committee would have to approve this"?

10:15:54 15 A. Yes.

10:16:01 16 Q. And can you just take a minute just to read that  
10:16:04 17 sentence.

10:16:04 18 A. I read it.

10:16:06 19 Q. Okay. Is the patent committee that Dr. Lee is  
10:16:12 20 referring to here the Charles River Campus Patent Committee  
10:16:16 21 that you testified about earlier?

10:16:18 22 A. Correct, the Photonics Center is on the Charles River  
10:16:22 23 Campus.

10:16:24 24 Q. And am I correct that you sat on that committee?

10:16:30 25 A. No. I was -- I characterized myself as secretary to

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10:16:35 1 the committee. I organized the meetings, I prepared the  
10:16:39 2 materials, I sent them out, but I was not a member of the  
10:16:42 3 patent committee.

10:16:44 4 Q. So does that mean that you were not involved in the  
10:16:46 5 decisions made by the patent committee?

10:16:48 6 A. Correct, I did not take votes. I mean, I did not  
10:16:52 7 cast votes.

10:16:54 8 Q. Do you see that Dr. Lee writes that -- he specifies,  
10:17:00 9 "the condition that the inventor reimburse BU for sunk  
10:17:06 10 patent costs and a ten percent royalty from any future  
10:17:09 11 income the patent generates"?

10:17:12 12 Do you know why BU would insist on receiving a  
10:17:15 13 ten percent royalty on future income the patent generates?

10:17:19 14 A. It was a compensation for having invested the money  
10:17:23 15 in the intellectual property. We were giving the inventor  
10:17:29 16 back, and we were giving it back on very generous terms. We  
10:17:33 17 were only asking for our patent costs to be reimbursed if  
10:17:38 18 the patent generates income, so getting ten percent on top  
10:17:43 19 of that seemed fair and equitable.

10:17:47 20 Q. And did BU always insist on receiving a ten percent  
10:17:52 21 royalty on future income on the patents that it offered to  
10:17:57 22 return to inventors?

10:18:00 23 A. So our practice evolved as we started returning. I  
10:18:05 24 would characterize it as bifurcate.

10:18:40 25 Q. So BU would want to recoup the costs it had put --

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10:18:45 1 sunk into patents when --

10:18:47 2 THE COURT: Is there an issue?

10:18:49 3 Q. When BU would require the ten percent ongoing  
10:18:52 4 royalty, do you recall approximately how often it wound up  
10:18:56 5 making, or wound up recouping its own patent costs?

10:19:01 6 A. I think when I learned about this matter --

10:19:04 7 THE COURT: Stop.

10:19:08 8 MR. BOLLINGER: It seems like a significant  
10:19:10 9 section got cut out.

10:19:14 10 MR. EBERSOLE: That's part of the original video  
10:19:15 11 from the videographer that was at the deposition.

10:19:18 12 MR. BOLLINGER: What we're doing I guess is just  
10:19:21 13 going by the transcript.

10:19:23 14 MR. EBERSOLE: Correct.

10:19:23 15 THE COURT: Okay. I didn't do that. So if you  
10:19:25 16 really want me to look at that, you got to replay that  
10:19:28 17 because I was just sitting there watching umbrellas come up.

10:19:32 18 MR. BOLLINGER: He left out our counter, so I  
10:19:36 19 would request that we go back, "bifurcate" is the last thing  
10:19:40 20 he said, so if you can bring that word up, I don't think  
10:19:43 21 it's more than about twenty seconds or so.

10:19:46 22 MR. MOLANO: No objection, Your Honor.

10:19:53 23 (Video)

10:19:54 24 Q. When BU would require the ten percent ongoing  
10:19:57 25 royalty, do you recall approximately how often it wound up

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10:20:02 1 making -- or wound up recouping its own patent costs?

10:20:06 2 A. I think when I learned about this matter, and if this  
10:20:10 3 had generated revenues to BU, this was the first one I was  
10:20:14 4 aware of.

10:20:16 5 Q. The '475 Patent is the first patent you're aware of  
10:20:20 6 that generated --

10:20:21 7 THE COURT: This isn't it. You got to go back  
10:20:24 8 to where he said something and then he just sat there while  
10:20:28 9 the screen scrolled.

10:20:30 10 MR. BOLLINGER: The word is "bifurcate". That's  
10:20:32 11 the last word he said while he was still live on the video.

10:20:45 12 (Video played:)

10:20:47 13 A. So our practice evolved as we started returning. I  
10:20:51 14 would characterize it as bifurcate. If we had typically  
10:20:56 15 only invested minimal funds, typically for less than \$1,500  
10:21:00 16 for a provisional application, we might just say, "here it  
10:21:05 17 is, go have fun." If we had proceeded to make a significant  
10:21:10 18 investment as we had here, then we would ask for some patent  
10:21:14 19 costs to be reimbursed as 25 percent of future income, and  
10:21:18 20 then be reimbursed ten percent thereafter.

10:21:22 21 Q. So BU would want to recoup the costs it had put --  
10:21:26 22 sunk into patents when it returned them to inventors,  
10:21:30 23 correct. Dr. Stevens, when BU would require the ten percent  
10:21:34 24 ongoing royalty, do you recall approximately how often it  
10:21:42 25 wound up making -- or wound up recouping its own patent

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10:21:45 1

costs?

10:21:46 2

A. I think when I learned about this matter, and if this

10:21:50 3

had generated revenues to BU, this was the first one I was

10:21:53 4

aware of.

10:21:56 5

Q. The '475 Patent is the first patent you're aware of

10:22:00 6

that generated revenue to BU under the ongoing royalty

10:22:04 7

requirement, is that correct?

10:22:06 8

A. Yes, this was the first time where the inventor could

10:22:10 9

do a better job with it than we could. I think I said

10:22:14 10

earlier we returned patents or offered to return them purely

10:22:21 11

as a service to faculty to encourage their entrepreneurial

10:22:28 12

aspirations.

10:22:30 13

Q. But it is correct that BU does include terms of the

10:22:34 14

transfer to include an ongoing stake in the patent, is that

10:22:40 15

right?

10:22:40 16

A. Correct. We felt it was a very user-friendly way to

10:22:48 17

do it. Because just as the basic deal between an inventor

10:22:52 18

and the university, whereby we will sign our inventions over

10:22:58 19

to you and in return we get a risk-free 30 percent of the

10:23:00 20

income, we have to put no money up for the patent and we get

10:23:07 21

thirty percent off the top, that's pretty user-friendly.

10:23:12 22

And when we gave it back to them, we didn't ask

10:23:14 23

for reimbursement up front, we say you only reimburse us if

10:23:18 24

you make any money out of it. It was continuing that highly

10:23:22 25

user friendly aspect to the faculty member.

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10:23:25 1 Q. Well, it wasn't always the case that there was no  
10:23:28 2 upfront payment, right, before -- if you look at Exhibit 7,  
10:23:33 3 Dr. Lee does put a term there that the inventor would  
10:23:37 4 reimburse BU for the sunk patent costs, in this case  
10:23:44 5 \$27,000; correct?

10:23:45 6 A. Yeah, I think -- but I think you need to read that in  
10:23:49 7 conjunction with the "and," it then says "a ten percent  
10:23:56 8 royalty," and both of those halves of that sentence are  
10:24:00 9 qualified by "from any future income the patent generates."

10:24:05 10 Now, this is just a summary of the deal. And  
10:24:08 11 when we get to a more detailed contractual form, that would  
10:24:11 12 have been spelled out a little more clearly.

10:24:15 13 I can see how your interpretation reads, but I  
10:24:19 14 think, and given my alma mater I'm proud to say this, for  
10:24:26 15 your interpretation to hold sway you would have needed to  
10:24:31 16 insert what is called an Oxford coma after the parentheses  
10:24:37 17 after the 27,000. And I think without that Oxford coma,  
10:24:41 18 then the "from any future income the patent generates"  
10:24:45 19 applies to both the sunk patent costs and the ten percent  
10:24:48 20 royalty.

10:24:48 21 Q. Okay. We'll get to the more precise language, and we  
10:24:52 22 can look at it then.

10:24:52 23 So after -- well, do you recall whether as of  
10:25:00 24 September 2009 that BU had made a similar offer to Dean  
10:25:02 25 Stocker?

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10:25:09 1 A. September 2009 covers thirty days. This was at the  
10:25:15 2 beginning. I believe by the end, by the time we got to the  
10:25:21 3 patent committee meeting -- sorry, September. That's in  
10:25:27 4 February.

10:25:29 5 I don't recall when we contacted Dr. Stocker.

10:25:34 6 Q. And do you recall what BU did with the '475 Patent  
10:25:37 7 after it received Professor Schubert's e-mail on  
10:25:44 8 September 2nd, 2009, saying that he would not be interested?

10:25:48 9 A. I don't think we would have done anything.

10:25:57 10 Q. So in other words, BU just let the patent expire by  
10:26:02 11 not paying the fee on September 25th?

10:26:05 12 A. Correct.

10:26:07 13 Q. Are you aware of when the next time Professor  
10:26:12 14 Schubert was in contact with BU about the '475 Patent?

10:26:20 15 A. My recollection is purely from documents I've seen in  
10:26:26 16 this matter that it was in December, but I'm sure you're  
10:26:32 17 going to put something in front of me.

10:26:34 18 Q. Okay. But beyond what you've done to prepare for  
10:26:38 19 your deposition, you don't have an independent recollection  
10:26:42 20 of when the next communication was, is that right?

10:26:43 21 A. No. I mean, I know it was before the patent  
10:26:46 22 committee, and my expectation is that would have been the  
10:26:51 23 first time that it rows to my level, since everything else  
10:26:55 24 was kind of -- up to that point was on auto pilot.

10:27:00 25 Q. I just, Dr. Stevens, in the chat a document which

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10:27:05 1 will be Exhibit 8 to your deposition, which is a document  
10:27:08 2 produced in this case bearing the Bates number BU 001145  
10:27:14 3 through 46.

10:27:16 4 Do you recognize this document, Dr. Stevens?

10:27:22 5 A. I do. This is from the FileMaker Pro database  
10:27:27 6 management system that I talked about earlier that we had  
10:27:31 7 developed ourselves using the local IT consultant.

10:27:37 8 Q. And do you see in -- here at the top of the page in  
10:27:44 9 red there's a cell that says, "BU case number," and  
10:27:51 10 underneath it lists "98-11"?

10:27:54 11 A. Yep.

10:27:55 12 Q. So do you understand this database entry to relate to  
10:27:59 13 the '475 Patent?

10:28:00 14 A. I do.

10:28:01 15 Q. Okay. And if you could please scroll down to the  
10:28:05 16 last page of the document. Let me know when you have that  
10:28:12 17 oriented correctly?

10:28:14 18 A. Yes.

10:28:16 19 Q. Okay. Do you see about halfway down the page there  
10:28:19 20 is a red box titled "prosecution history"?

10:28:32 21 A. Oh, yes.

10:28:36 22 Q. And then do you see there is an entry for "petition,"  
10:28:40 23 and if you look on the action date that's April 22nd, 2010?

10:28:42 24 A. Is there a question there?

10:28:52 25 Q. Yeah. I'm just asking if you see that.

Ashley Stevens - video

10:28:58 1

A. I do.

10:29:00 2

Q. And then underneath it do you see there's an entry

10:29:04 3

for an action of second maintenance with a note next to it

10:29:10 4

that says, "do not pay per Sean Lee: Fred Schubert agreed:

10:29:15 5

USP 6,294,45"?

10:29:20 6

A. I see that. Correct.

10:29:23 7

Q. Would Sean Lee have had the authority on his own to

10:29:28 8

decide not to pay the fee?

10:29:31 9

A. So as I said, this was something we had agreed in the

10:29:36 10

patent budget setting meeting, and what we're seeing here is

10:29:41 11

-- my guess is this would have been Janine making this entry

10:29:46 12

and entering the confirmation that Fred Schubert had agreed.

10:29:51 13

Q. So your understanding is that this entry indicates

10:30:01 14

that Professor Schubert agreed with the decision not to pay

10:30:06 15

the second maintenance fee for the patent, is that right?

10:30:08 16

A. Correct.

10:30:09 17

Q. I'm going to put another document through the chat.

10:30:14 18

Dr. Stevens, I have just placed in the chat, it will be

10:30:20 19

Exhibit 9 to your deposition. It is an Excel spreadsheet

10:30:25 20

with a Bates number BU 001550. Okay. Row 2 on your screen

10:30:31 21

which says, "petition to accept unintentionally delayed

10:30:37 22

payment of maintenance fee filed 4/22 /10; instructed Matt

10:30:42 23

Connors on 4/22 to revive patent." Do you see that?

10:30:47 24

A. I see that.

10:30:48 25

Q. Without revealing the contents of any conversations

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10:30:51 1 with Mr. Connors, do you know who instructed Mr. Connors on  
10:30:56 2 April 22nd to revive the patent?

10:30:57 3 A. No. This was after I was transferred to special  
10:31:01 4 assistant to the vice-president for research.

10:31:06 5 Q. And is it your understanding that Janine Anderson  
10:31:11 6 would have placed this entry into the database?

10:31:15 7 A. Yes. I can see, by the way, by the entry in line 4  
10:31:25 8 "9/25/2005" in column BM, and then in column BN, "paid  
10:31:35 9 3/24/05 by a USPTO deposit account." This goes back to our  
10:31:43 10 earlier discussion on whether counsel paid maintenance fees  
10:31:46 11 or whether BU did, and I simply had a USPTO deposit account.  
10:31:50 12 And this indicates that the first maintenance fee was paid  
10:31:53 13 out of that account.

10:31:55 14 Q. Out of BU's own account?

10:31:57 15 A. Yes.

10:31:59 16 Q. And Dr. Stevens, I've just placed into the chat a  
10:32:02 17 document that will be Exhibit 10 to your deposition, which  
10:32:07 18 is a document produced in this case with Bates number BU  
10:32:11 19 000451.

10:32:14 20 Can you just take a moment to look through this  
10:32:19 21 document, and then let me know whether or not you recognize  
10:32:22 22 it?

10:32:23 23 A. Again, I have seen this in preparation for this  
10:32:25 24 deposition.

10:32:26 25 Q. Otherwise, you have not seen it, is that correct?

Ashley Stevens - video

- 10:32:32 1 A. Right. It's dated November -- oh, no. Sorry.
- 10:32:41 2 Q. Do you see that this is a letter sent on November 27,
- 10:32:50 3 2009, by Janine Anderson?
- 10:32:51 4 A. Correct.
- 10:32:52 5 Q. And does this appear to be the OTD's standard
- 10:32:55 6 letterhead?
- 10:32:57 7 A. Yes, in recent times after BU rebranding, yes.
- 10:33:06 8 Q. And do you see that the letter is addressed to a
- 10:33:12 9 Ms. Carol Petrosky and Ms. Walda J. Jacobs?
- 10:33:17 10 A. Yes.
- 10:33:18 11 Q. Do you recall who either of those individuals are?
- 10:33:20 12 A. One, it says, is associate counsel, and the other is
- 10:33:24 13 patent assistant.
- 10:33:25 14 Q. And do you see in the subject line that this relation
- 10:33:28 15 to -- there's a line "U.S. patent number 6,294,475"?
- 10:33:38 16 A. Yes.
- 10:33:38 17 Q. Then do you see that the letter states in the first
- 10:33:41 18 paragraph, "Boston University decided not to pay the second
- 10:33:45 19 year US maintenance due September 25, 2009, for the
- 10:33:52 20 above-referenced patent (copy enclosed). This decision was
- 10:33:52 21 made due to lack of commercial interest in the invention."
- 10:33:52 22 Do you see that?
- 10:33:52 23 A. I do.
- 10:33:52 24 Q. Do you agree with the -- with those two sentences?
- 10:34:02 25 A. I think that is consistent with our discussion so far

Ashley Stevens - video

10:34:08 1

today.

10:34:09 2

Q. And would Ms. Anderson have the authority to send out

10:34:13 3

a letter like this on her own, or would she have had to run

10:34:18 4

this by someone else in the OTD?

10:34:21 5

A. This was routine. Under the provisions of the

10:34:29 6

Bayh-DohI Act you are obliged to notify the government

10:34:32 7

before you let the patent lapse in case the government

10:34:34 8

wishes to pay the maintenance fee for you. And I'm told in

10:34:37 9

the very early days of Bayh-DohI, they did that from time to

10:34:42 10

time. By now it had become a form procedure, and obviously

10:34:47 11

we're doing this two months after the patent has lapsed,

10:34:53 12

which is why Ms. Anderson is apologizing for the lateness of

10:34:59 13

this notice.

10:35:00 14

Q. And is it your understanding that as of the

10:35:03 15

November 27th, 2009, date on this letter, BU still believed

10:35:07 16

that there was no commercial interest in the '475 Patent?

10:35:15 17

A. I think that's true. I think based on documents I've

10:35:24 18

seen in preparation for this deposition, Dr. Schubert's

10:35:30 19

expression of interest came later.

10:35:34 20

Q. I just placed into the chat what will be Exhibit 11

10:35:38 21

to your deposition, which is a document bearing the Bates

10:35:42 22

numbers BU 001360 through 63.

10:35:52 23

So if you can scroll to page 1361, which is the

10:36:00 24

second page of the document, do you see at the bottom of

10:36:03 25

that page there is a copy of the September 2nd, 2009, e-mail

Ashley Stevens - video

10:36:10 1 from Sean Lee to Professor Schubert that we looked at  
10:36:13 2 earlier?

10:36:15 3 A. Yes.

10:36:17 4 Q. And above that is another copy of Professor  
10:36:20 5 Schubert's response from that same date. Do you see that?

10:36:24 6 A. I do.

10:36:26 7 Q. Okay. If you go above that, then do you see that  
10:36:31 8 there is an e-mail from Professor Schubert to Sean Lee  
10:36:34 9 stating that he "would like to follow-up on our e-mail  
10:36:38 10 conversation of September this year. I have a couple of  
10:36:41 11 questions and wonder if I could give you a call? How about  
10:36:45 12 today, Wednesday, maybe in the afternoon?" Do you see that?

10:36:50 13 A. I do.

10:36:51 14 Q. Do you recall ever seeing this communication before?

10:36:55 15 A. Only in preparation for this deposition.

10:36:58 16 Q. Do you recall being -- outside of your preparation  
10:37:01 17 for this deposition, do you recall being made aware that  
10:37:05 18 Professor Schubert had requested a follow-up conversation  
10:37:08 19 with Sean Lee?

10:37:10 20 A. I mean, I recall being made aware that at some point  
10:37:15 21 that he said, "I think I want this back." But I don't  
10:37:21 22 recall when -- I certainly -- Sean wouldn't have told me  
10:37:24 23 about this at this point until he'd had that first follow-up  
10:37:30 24 conversation and learned what the couple of questions were.

10:37:34 25 Q. Okay. And then do you see, if we continue to move

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10:37:37 1 up, the next two e-mails there, Dr. Lee and Professor  
10:37:44 2 Schubert schedule a call for Thursday, December 3rd?

10:37:47 3 A. Yep. And.

10:37:54 4 Q. And as we go, eventually there is an e-mail at the  
10:37:58 5 top this from Professor Schubert that says, "sorry my fault,  
10:38:01 6 I will call you at 4:15 p.m."?

10:38:04 7 A. Yep.

10:38:04 8 Q. Do you see that?

10:38:06 9 A. I do.

10:38:09 10 Q. Do you recall, were you involved in the phone call on  
10:38:16 11 December 3rd, 2009?

10:38:18 12 A. I don't think so. I mean, I wasn't copied on the  
10:38:21 13 correspondence.

10:38:21 14 Q. Do you recall finding out about the December 3rd,  
10:38:25 15 2009, phone call?

10:38:26 16 A. As I said, at some point I was made aware that Fred  
10:38:30 17 had changed his mind. Whether it was in this phone call  
10:38:34 18 that I learned that, I don't know. I mean, sorry, in this  
10:38:38 19 phone call that we learned that he changed his mind, and  
10:38:42 20 then it would have been communicated to me, I don't know.

10:38:42 21 Q. And what do you recall learning about Professor  
10:38:54 22 Schubert changing his mind?

10:38:55 23 A. I'd sooner wait until you put documents in front of  
10:39:00 24 me. I don't like depositions to become a memory test.

10:39:02 25 Q. Well, do you recall ever finding out why Professor

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10:39:13 1 Schubert changed his mind about his interest in the '475  
10:39:20 2 Patent?

10:39:20 3 A. No. What I recall is he said he changed his mind and  
10:39:24 4 he would like it back, if that could be done.

10:39:28 5 Q. Please let me know once you've had a chance to pull  
10:39:31 6 up that document.

10:39:33 7 A. I have it.

10:39:34 8 Q. Have you ever seen this document before?

10:39:42 9 A. Only in preparation for this deposition.

10:39:45 10 Q. Okay. So you don't recall ever seeing this document  
10:39:48 11 earlier?

10:39:49 12 A. No. And I don't see me being copied on it, so  
10:39:55 13 whether this form of Sean would include -- whether Sean  
10:39:59 14 would have copied me or not I can't speak to.

10:40:06 15 Q. Okay. So if you look at the second e-mail that  
10:40:09 16 starts about halfway down the page, it was on Thursday,  
10:40:13 17 December 3rd, 2009, at 5:09 p.m., "Sean Lee wrote," do you  
10:40:18 18 see that?

10:40:18 19 A. Yes.

10:40:19 20 Q. So that e-mail, it doesn't indicate who was copied on  
10:40:22 21 it. Do you have any recollection of being copied on this  
10:40:25 22 e-mail?

10:40:26 23 A. No, I don't.

10:40:29 24 Q. And do you have any doubt that Sean Lee sent this  
10:40:32 25 e-mail on Professor Schubert on December 3rd, 2009?

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10:40:36 1 A. I have no reason to doubt that he did.

10:40:41 2 Q. And do you have any reason to doubt that this e-mail  
10:40:49 3 was sent by Sean Lee in the ordinary course of business at  
10:40:52 4 his role at BU?

10:40:56 5 A. In the course of business this would have been part  
10:40:59 6 of his responsibilities managing the portfolio and  
10:41:02 7 interacting with the faculty inventors, ex-faculty  
10:41:07 8 inventors.

10:41:08 9 Q. If you look at the e-mail continues, "the Patent  
10:41:12 10 Office allows for reviving only if it can be explained in  
10:41:16 11 good faith that the abandonment was unintentional."

10:41:20 12 Do you see that?

10:41:21 13 A. I see that.

10:41:22 14 Q. So do you recall whether or not as of December 2009  
10:41:27 15 you shared that belief with Dr. Lee?

10:41:31 16 A. Well, I am familiar, you know, I obviously understand  
10:41:39 17 the common usage of the word intentional and unintentional.  
10:41:44 18 However, patent practice is an extremely specialized and,  
10:41:52 19 some would say, arcane part of the law and certainly neither  
10:42:00 20 Sean nor I were experts on what intentional and  
10:42:06 21 unintentional meant in the context of practice before the  
10:42:10 22 Patent Office and the ability to revive a patent. We --  
10:42:15 23 neither of us were qualified to practice before the Patent  
10:42:22 24 Office.

10:42:25 25 Q. Okay. Do you recall ever discussing with Sean Lee

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10:42:28 1 what it means for an abandonment to be unintentional?

10:42:36 2 A. I don't recall that I did.

10:42:38 3 Q. Do you recall taking any steps to find out what it  
10:42:41 4 means for an abandonment to be unintentional?

10:42:46 5 A. No.

10:42:47 6 Q. Do you recall as of December 3rd, 2009, whether you  
10:42:50 7 had a belief as to whether BU had intentionally or  
10:42:54 8 unintentionally abandoned the '475 Patent?

10:42:57 9 A. As I said, I have an understanding of the common  
10:43:01 10 usage of the meaning of the word intentional and  
10:43:06 11 unintentional. I do not have any understanding of how those  
10:43:10 12 words are interpreted in the practice before the Patent  
10:43:16 13 Office.

10:43:18 14 Q. Do you recall taking any steps to find out what the  
10:43:21 15 Patent Office considers to be an unintentional delay?

10:43:24 16 A. No, I did not.

10:43:26 17 Q. Dr. Stevens, do you recall whether or not Sean Lee  
10:43:30 18 ever took any steps to find out what it means for a delay to  
10:43:34 19 be unintentional?

10:43:38 20 A. No, I don't.

10:43:41 21 Q. So, you'd agree that in this e-mail Sean Lee states  
10:43:44 22 his belief that the patent, the '475 Patent, was abandoned  
10:43:48 23 intentionally; correct?

10:43:51 24 A. It appears that that is his understanding at this  
10:43:54 25 point.

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10:44:01 1 Q. And we saw that BU ultimately certified that the  
10:44:06 2 delay was unintentional, correct?

10:44:13 3 A. You showed me that document earlier today, yes.

10:44:15 4 Q. And do you see that the e-mail continues, "as our  
10:44:19 5 patent manager, Janine is a notary and so is perhaps more  
10:44:23 6 honor bound than most to be truthful to the Patent Office."

10:44:27 7 Do you see that?

10:44:28 8 A. I do.

10:44:28 9 Q. And do you understand "Janine" to be referring to  
10:44:33 10 Janine Anderson?

10:44:34 11 A. I do.

10:44:35 12 Q. And could you consider Janine Anderson to be an honor  
10:44:39 13 bound honest person?

10:44:41 14 A. I do.

10:44:43 15 Q. Does this e-mail -- this series of e-mails refresh  
10:44:47 16 your recollection as to whether the conversation was that  
10:44:52 17 you had with Mr. Connors?

10:44:53 18 A. I think this would say that this was after  
10:44:56 19 December 2nd and before December 10th.

10:45:02 20 Q. Dr. Stevens, have you ever seen this document before?

10:45:06 21 A. I only recall seeing it in the context of preparation  
10:45:11 22 for this litigation.

10:45:13 23 Q. Do you know how BU obtained a copy of this document?

10:45:22 24 A. Well, sent from Fred Schubert to Sean Lee, so I  
10:45:29 25 assume it came from Sean's file. But I have no idea.

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10:45:33 1 Q. And do you see that there is a date on this document  
10:45:36 2 of February 2nd, 2010?

10:45:38 3 A. I see that.

10:45:39 4 Q. And in "reference: BU patent 45 by Schubert and  
10:45:45 5 Stocker"?

10:45:46 6 A. I see that.

10:45:47 7 Q. So is it your understanding that this memorandum is  
10:45:50 8 relating to the '475 Patent?

10:45:51 9 A. I do.

10:45:52 10 Q. And do you see the memorandum begins, "this  
10:45:58 11 memorandum is to confirm the following. I am interested to  
10:46:00 12 acquire ownership of the '475 Patent currently owned by BU."

10:46:05 13 Do you see that?

10:46:05 14 A. I read that.

10:46:07 15 Q. Is it your understanding that as of February 2nd,  
10:46:12 16 2010, Professor Schubert had expressed his interest to BU in  
10:46:15 17 reacquiring the '475 Patent?

10:46:19 18 A. That's how I read that.

10:46:21 19 Q. And do you see the last bullet point that says,  
10:46:26 20 "effective immediately, I am willing to pay USPTO fees  
10:46:32 21 associated with the patent"?

10:46:34 22 A. I see that.

10:46:35 23 Q. Do you understand that reference to USPTO fees to  
10:46:39 24 refer to the second maintenance fee that had not been paid?

10:46:44 25 A. I mean, it seems to me there were two fees likely

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10:46:47 1 becoming due, the maintenance fee and any fee associated  
10:46:52 2 with an assignment of BU's interest to Professor Schubert.  
10:46:56 3 I think both of those were liable to have costs associated.  
10:47:03 4 Q. Okay. And do you read Professor Schubert's statement  
10:47:07 5 to cover both of those costs?  
10:47:11 6 A. Yes. I'm sorry. Fees as in the plural, yes.  
10:47:16 7 Q. Do you have an understanding whether as of  
10:47:20 8 February 2nd, 2010, BU had reached any conclusions about  
10:47:24 9 whether or not the '475 Patent could in good faith be  
10:47:28 10 revived at the Patent Office?  
10:47:31 11 A. I think I said earlier it was my expectation that we  
10:47:34 12 would transfer the dead patent back to Professor Schubert  
10:47:45 13 and he would revive it, and I think this agreement here is  
10:47:48 14 consistent with that expectation of mine.  
10:47:52 15 Q. And can you recall any documents that would have set  
10:47:55 16 out that BU would transfer a dead patent back to Professor  
10:47:59 17 Schubert?  
10:47:59 18 A. He says, "I am interested to acquire ownership of the  
10:48:08 19 '475 Patent currently owned by BU," it's currently dead. So  
10:48:12 20 he says he wants to acquire a dead patent.  
10:48:15 21 Q. In your time at BU, are you aware of BU ever  
10:48:19 22 transferring a dead patent back to an inventor?  
10:48:22 23 A. No. I told you this was the first time that I had  
10:48:25 24 been involved in revival of a patent after a decision not to  
10:48:31 25 pay a maintenance fee.

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10:48:33 1 Q. Okay. So is it also true that you have never in your  
10:48:39 2 time at BU recommended to the patent committee that BU  
10:48:43 3 should return a dead patent to an inventor?

10:48:51 4 A. I think that is correct.

10:48:54 5 Q. Do you know whether as of February 2nd, 2010,  
10:49:02 6 Professor Schubert had an understanding of whether or not  
10:49:06 7 the '475 Patent could be in good faith revived with the  
10:49:11 8 Patent Office?

10:49:15 9 A. I don't know.

10:49:16 10 Q. Well, Professor Schubert here is indicating his  
10:49:20 11 agreement to pay the PTO fees, correct?

10:49:28 12 A. Correct.

10:49:30 13 Q. So in this memorandum, Professor Schubert expresses  
10:49:35 14 his willingness to immediately pay the USPTO fees, right?

10:49:39 15 A. Yes.

10:49:39 16 Q. So that doesn't sound like he's expecting to acquire  
10:49:42 17 a dead patent, does it?

10:49:44 18 A. I think it does.

10:49:46 19 Q. Excuse me. That doesn't sound like he's expecting to  
10:49:49 20 acquire a patent that he can't revive, right?

10:49:52 21 A. I would agree with that statement, yes.

10:49:52 22 Q. So then is your understanding that as of  
10:49:55 23 February 2nd, 2010, Professor Schubert believed that he  
10:50:00 24 would be able to revive the '475 Patent?

10:50:05 25 A. It certainly appears from this agreement that he

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10:50:08 1 thought there would be a positive outcome.

10:50:10 2 Q. And do you recall, are you aware of why Professor  
10:50:13 3 Schubert believed that he would be able to revive the '475  
10:50:20 4 Patent?

10:50:20 5 A. No, I'm not aware.

10:50:22 6 Q. Okay. So this is a series of e-mails from  
10:50:27 7 February 4th, 2010. Do you see that?

10:50:34 8 A. I do.

10:50:36 9 Q. Do you see the top e-mail on the first page of the  
10:50:40 10 document is an e-mail from Janine Anderson to you?

10:50:44 11 A. Yep.

10:50:45 12 Q. So is it your understanding as of February 4th, 2010,  
10:50:49 13 BU believed that the return of the '475 Patent to Professor  
10:50:53 14 Schubert was moving forward?

10:50:54 15 A. Yes.

10:50:56 16 Q. And do you believe that -- or is it your  
10:50:59 17 understanding that as of February 4th, 2010, BU believed  
10:51:03 18 that it was, in fact, going to return the '475 Patent to  
10:51:06 19 Professor Schubert?

10:51:07 20 A. Well, it would have to be approved by the patent  
10:51:10 21 committee, and I'm sure by then we were starting to prepare  
10:51:14 22 for that patent committee meeting. The patent committee had  
10:51:18 23 not previously declined to have or refused a recommendation  
10:51:22 24 to return an invention to inventors, so I'm sure we in  
10:51:25 25 having every expectation that this would go through, but it

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10:51:34 1 weren't a done deal at that point.

10:51:36 2 Q. In your time at BU, approximately how many patents

10:51:39 3 did OTD return to inventors?

10:51:44 4 A. I don't know.

10:51:45 5 Q. Was it more than ten?

10:51:47 6 A. In my time?

10:51:50 7 Q. Yes.

10:51:51 8 A. I would have thought it was less than ten, but I

10:51:55 9 could be wrong.

10:51:56 10 Q. Would it be more than five?

10:51:58 11 A. I -- my gut feel, and that's all it is, I have no

10:52:04 12 basis for it other than a gut feel, is that it would

10:52:08 13 probably have been no more than five.

10:52:10 14 Q. But in every case where the OTD recommended to the

10:52:21 15 patent committee to return a patent, the patent committee

10:52:26 16 approved that request, is that correct?

10:52:28 17 A. That is my recollection, yes.

10:52:30 18 Q. Do you see this is a single e-mail from Sean Lee to

10:52:34 19 you and Janine Anderson on February 16th, 2010?

10:52:39 20 A. I see that.

10:52:42 21 Q. What is your understanding of what the subject line

10:52:44 22 in this e-mail is referring to?

10:52:46 23 A. This was a typical sentence for Sean, for your

10:52:49 24 perusal. Patent committee 1b letter. 1b was a clause in

10:52:52 25 the patent policy that allowed an inventor to own inventions

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10:53:00 1 under certain circumstances it was probably inaccurate to  
10:53:08 2 use it in the context of a return of a university-owned  
10:53:15 3 patent, invention, but it was the shorthand we used.

10:53:20 4 Q. Do you recall more specifically what Section 1B  
10:53:25 5 specified?

10:53:26 6 A. It specifies, I believe, that if an inventor can  
10:53:30 7 demonstrate that an invention was made without use of  
10:53:35 8 university facilities, resources, personnel, or funds, then  
10:53:43 9 they can ask to own the invention themselves. And I think  
10:53:48 10 we specifically say that use of university computers or  
10:53:52 11 libraries is not considered to constitute substantial use of  
10:53:58 12 university facilities.

10:54:00 13 Q. So why did you say that it's probably inaccurate to  
10:54:04 14 use Section 1B in the context of the return of a  
10:54:09 15 university-owned patent?

10:54:09 16 A. Well, this was a patent that had been made with  
10:54:12 17 substantial use of university facilities, resources,  
10:54:16 18 personnel, and funds. But now we were deciding to return it  
10:54:20 19 to Professor Schubert.

10:54:22 20 So it -- strictly speaking, wasn't -- didn't  
10:54:27 21 fall under the Section 1B of the patent policy, but that was  
10:54:32 22 a shorthand that we used, because I think we did get  
10:54:37 23 inventors who submitted something and said, hey, I think I  
10:54:42 24 should own this because for this reason or that reason or  
10:54:47 25 the other reason.

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- 10:54:48 1 Q. And do you see the actual e-mail says, "return to  
10:54:53 2 Fred for 10K"?
- 10:54:55 3 A. Yep.
- 10:54:55 4 Q. Do you understand that he is recommending to return  
10:54:58 5 the '475 Patent to Professor Schubert for \$10,000?
- 10:55:01 6 A. I'm sorry.
- 10:55:02 7 Yeah, I see that.
- 10:55:05 8 Q. So is it your understanding that by February 16th,  
10:55:11 9 2010, a decision had been made in the OTD to proceed with  
10:55:14 10 the return of the patent to Professor Schubert?
- 10:55:17 11 A. No, I think we had taken the decision to take it to  
10:55:21 12 the patent committee to seek their concurrence.
- 10:55:24 13 Q. Do you recognize this document, Dr. Stevens?
- 10:55:29 14 A. I do.
- 10:55:30 15 Q. And what is it?
- 10:55:31 16 A. It is my recommendation to the Charles River Campus  
10:55:34 17 Patent Committee that we return the '475 Patent to Professor  
10:55:40 18 Schubert.
- 10:55:40 19 Q. And is this a document that you would prepare in the  
10:55:42 20 ordinary course of your business at BU?
- 10:55:42 21 A. Yes, when we had a request for inventor ownership.
- 10:55:52 22 Q. Do you see the second paragraph of the memorandum  
10:56:00 23 starts, "a U.S. utility patent was issued 9/25/2001." Do  
10:56:02 24 you see that?
- 10:56:02 25 A. Yes.

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10:56:10 1 Q. Can you just take a moment to read that paragraph?

10:56:23 2 A. I see that.

10:56:24 3 Q. So this sentence, "the case is therefore currently  
10:56:29 4 abandoned at the Patent Office, but can be revived for a  
10:56:34 5 filing fee of \$2,500." Do you see that?

10:56:38 6 A. I do.

10:56:38 7 Q. This is referring to the fact that the '475 Patent  
10:56:41 8 had expired for the failure to pay the second maintenance  
10:56:44 9 fee; correct?

10:56:45 10 A. Correct.

10:56:46 11 Q. And then the sentence ends, "but can be revived for a  
10:56:50 12 filing fee of \$2,500." Do you see that?

10:56:54 13 A. Yes.

10:56:56 14 Q. Does that refresh your recollection as to whether or  
10:57:00 15 not at this point, by the time you left the OTD, you  
10:57:04 16 believed that the '475 Patent could be in good faith  
10:57:08 17 revived?

10:57:10 18 A. I think probably if I were writing this memo today I  
10:57:14 19 would probably have put the word "potentially" between "but"  
10:57:18 20 and "can."

10:57:20 21 Q. And was it still your understanding -- and that's  
10:57:24 22 because there's more that's required to revive the patent  
10:57:28 23 than just paying a fee, correct?

10:57:30 24 A. That's my understanding.

10:57:32 25 Q. And was it still your understanding at this point in

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10:57:33 1 time that BU would be returning an expired patent to  
10:57:38 2 Dr. Schubert?

10:57:38 3 A. That was my understanding, yes.

10:57:41 4 Q. I don't see anywhere in the memorandum where you  
10:57:45 5 explain that plan to the patent committee.

10:57:49 6 Did you not think it was important to specify  
10:57:52 7 that the patent would be transferred in an expired state?

10:57:55 8 A. Well, it says, "proposed terms." "BU would return  
10:58:01 9 the invention to the government funding agency, and the  
10:58:03 10 inventors would then seek to have title transferred to  
10:58:07 11 them." That's the first step. They get back a dead patent.

10:58:10 12 Q. Well, it doesn't say the patent is dead, right?

10:58:14 13 A. Yeah, it says the patent -- "the case is therefore  
10:58:18 14 currently abandoned at the Patent Office."

10:58:21 15 Q. Okay. But then you continue, "but they can be  
10:58:31 16 revived for a filing fee of \$2,500," right?

10:58:35 17 A. Right.

10:58:36 18 Q. The next bullet says an initial fee of \$10,000 paid  
10:58:39 19 by the inventors to BU to cover the fees at the Patent  
10:58:42 20 Office and part of the prior prosecution cost.

10:58:45 21 Do you see that?

10:58:45 22 A. I do.

10:58:46 23 Q. Okay. So the fees at the Patent Office are not  
10:58:49 24 referring to the prior prosecution costs, do you see? Do  
10:58:52 25 you agree with that?

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10:58:54 1 A. I mean, you incur Patent Office fees and lawyer's  
10:59:02 2 fees when you file for a patent, so there is a blend of both  
10:59:08 3 of those in there.

10:59:11 4 Plus as I said earlier, we would need to assign  
10:59:15 5 the patent to the inventors, and I presume there is a fee  
10:59:23 6 associated with that.

10:59:26 7 Q. Okay. So you wrote, "the fees at the Patent Office  
10:59:29 8 and part of the prior prosecution costs."

10:59:33 9 Do you see that?

10:59:33 10 A. Correct.

10:59:34 11 Q. And the way that language is written, that states  
10:59:37 12 that the fees at the Patent Office are separate from the  
10:59:41 13 prior prosecution costs, correct?

10:59:43 14 A. Right. And I said we would incur a fee to assign the  
10:59:46 15 patent from BU to the inventors.

10:59:52 16 Q. Okay. But this doesn't specify that the fee that  
10:59:56 17 you're talking about here is the assignment fee, and not the  
11:00:00 18 filing fee that you mention in the second paragraph, right?

11:00:02 19 A. No, it doesn't.

11:00:04 20 Q. In fact, I believe the assignment fee is not  
11:00:08 21 mentioned anywhere specifically in this memorandum, correct?

11:00:13 22 A. I don't recall seeing it explicitly stated.

11:00:17 23 Q. So the only -- when you write that "cover the fees at  
11:00:22 24 the Patent Office," the only Patent Office fee mentioned in  
11:00:26 25 this memorandum is the file fee to revive the patent;

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11:00:30 1

correct?

11:00:32 2

A. But there is an implicit statement that we're going

11:00:35 3

to assign it to them, so it's a fee for assignment.

11:00:38 4

Q. The only fee that you specifically informed the

11:00:40 5

patent committee of is the fee to revive the patent,

11:00:43 6

correct?

11:00:43 7

A. Right. And the implication that we are going to

11:00:47 8

assign it to the inventors.

11:00:52 9

Q. Okay. There's no statement of paying a fee in

11:00:54 10

connection with the assignment in this memorandum, is there?

11:01:00 11

A. I don't want to make Mr. Rader's objections for him,

11:01:07 12

but I think this is asked and answered. I think we have

11:01:09 13

been around this circle three times. I don't think we're

11:01:12 14

going to get any further.

11:01:14 15

Q. You can answer the question.

11:01:15 16

A. No, there is an implied statement that there will be

11:01:19 17

an assignment fee.

11:01:22 18

Q. Do you see the last -- if you flip to the next page,

11:01:25 19

the last heading in this memorandum is "recommendation"?

11:01:30 20

A. Yes.

11:01:32 21

Q. Can you take a moment to read that section of the

11:01:42 22

memorandum?

11:01:43 23

A. (Witness reviewing document.)

11:01:52 24

Yes. I see that.

11:01:52 25

Q. Okay. And in the first -- what is your understanding

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11:02:03 1 of what you meant in the first sentence of that  
11:02:06 2 recommendation?

11:02:07 3 A. Well, we're saying that we didn't think this was  
11:02:15 4 likely to be licensed and generate significant revenues  
11:02:19 5 before it expired, but now here's an opportunity to recover  
11:02:24 6 at least a portion of our prior patent costs.

11:02:28 7 Q. And so your understanding, am I correct, of the  
11:02:35 8 phrase, "didn't engine rate significant revenue" is that you  
11:02:41 9 take that to mean something that the patent was not likely  
11:02:45 10 to do?

11:02:45 11 A. Correct.

11:02:47 12 Q. If you go to the next sentence, it is true, right,  
11:02:50 13 that BU got a better financial deal for the return of the  
11:02:55 14 '475 Patent than it typically did?

11:02:56 15 A. It was generally not our practice to ask for money up  
11:02:59 16 front.

11:03:00 17 Q. So you have testified a number of times that you  
11:03:03 18 don't remember discussing the revival of the '475 Patent  
11:03:06 19 with Professor Schubert, so I'm trying to determine what  
11:03:08 20 you're basing your recollection on that the plan was for  
11:03:13 21 Professor Schubert to revive the '475 patent?

11:03:16 22 A. I think we -- I thought Sean and I had agreed that we  
11:03:20 23 were happy to give Professor Schubert back the dead patent,  
11:03:24 24 and that he would revive it, and it was generally our policy  
11:03:30 25 when we did that to allow the inventor to use the same

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11:03:34 1 patent counsel that the university had used if they so  
11:03:38 2 desired.

11:03:40 3 Q. And do you recognize this document, Dr. Stevens?

11:03:43 4 A. I do. It's the minutes of the February 22nd, patent  
11:03:47 5 committee meeting.

11:03:49 6 Q. And when is the last time you've seen this document?

11:03:53 7 A. Earlier this week.

11:03:55 8 Q. And before then?

11:03:58 9 A. Probably Monday, February 22nd, 2010.

11:04:03 10 Q. And if you go to the second page, do you see that you  
11:04:07 11 signed this document?

11:04:09 12 A. I do.

11:04:11 13 Q. Does that mean that you prepared these meeting  
11:04:14 14 minutes?

11:04:14 15 A. Yes.

11:04:15 16 Q. And was that one of your regular job responsibilities  
11:04:18 17 at OTD?

11:04:20 18 A. Yes.

11:04:21 19 Q. So do you see in the top also in attendance there is  
11:04:24 20 a list of names of employees of the OTD that we've discussed  
11:04:31 21 earlier today. And then if you look at Item Number 3,  
11:04:32 22 "request for ownership of inventions." Do you see that?

11:04:42 23 A. Yes.

11:04:42 24 Q. And do you understand this to be referring to the  
11:04:45 25 request by Professor Schubert to return the '475 Patent to

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11:04:48 1 him?

11:04:49 2 A. Yes.

11:04:49 3 Q. So would Janine Anderson have had the authority to  
11:04:53 4 decide that BU should file the revival petition?

11:04:57 5 A. I would say under my administration she would have  
11:05:01 6 required instruction to do that. I cannot speak for after I  
11:05:05 7 left.

11:05:06 8 Q. And under your administration, Sean Lee would have  
11:05:12 9 been someone that could have given her that instruction?

11:05:16 10 A. Yes.

11:05:18 11 Q. Was Jon Jensen someone who could have given her that  
11:05:22 12 instruction under your administration?

11:05:25 13 A. Probably not. He was a licensing assistant at that  
11:05:28 14 point, although fairly soon thereafter he got a promotion  
11:05:32 15 from Mr. Nijhawan.

11:05:35 16 Q. You were physically located in the OTD's office as of  
11:05:40 17 April 2010, correct?

11:05:41 18 A. Correct.

11:05:42 19 Q. And you expect that Mr. Nijhawan would have had the  
11:05:45 20 authority to instruct Ms. Anderson to file the petition,  
11:05:48 21 correct?

11:05:48 22 A. Absolutely.

11:05:50 23 Q. Do you ever recall anyone at BU expressing concern  
11:05:54 24 over whether BU could legitimately file a revival petition  
11:05:58 25 for the '475 Patent?

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11:06:02 1 A. I don't recall a conversation to that effect.

11:06:05 2 Q. As you sit here today, do you have any understanding  
11:06:07 3 of whether or not BU's delay in paying the maintenance fee  
11:06:12 4 was intentional or unintentional?

11:06:14 5 A. I think I previously testified that I am conversant  
11:06:20 6 with the normal and customary meanings of those words, but  
11:06:27 7 not as they are used in practice before the Patent Office.

11:06:33 8 Q. That's still true that as of today, you have no  
11:06:39 9 further understanding of whether or not the delay was  
11:06:42 10 unintentional, correct?

11:06:43 11 A. That is correct. I have no further opinion.

11:06:47 12 Q. Are you aware of whether the '475 Patent was  
11:06:50 13 eventually returned to Professor Schubert?

11:06:53 14 A. I've seen documents in preparation for this  
11:06:57 15 deposition. I think it was several months later.

11:07:01 16 Q. But other than your preparation for this deposition,  
11:07:05 17 you had no knowledge of when the return actually was  
11:07:08 18 completed?

11:07:09 19 A. No.

11:07:12 20 Q. Dr. Stevens, do you have an understanding of what the  
11:07:14 21 lawsuit that you're here testifying as part of today is  
11:07:18 22 about?

11:07:18 23 A. I have read the complaint and countercomplaint.

11:07:22 24 Q. And do you have any other knowledge of what the case  
11:07:25 25 is about other than what's contained in those documents?

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- 11:07:30 1 A. No.
- 11:07:33 2 Q. When did you first read the complaint?
- 11:07:37 3 A. Yesterday.
- 11:07:40 4 Q. When did you first review the counterclaims?
- 11:07:44 5 A. Yesterday.
- 11:07:45 6 Q. When did you find out that Professor Schubert had
- 11:07:48 7 filed this lawsuit?
- 11:07:51 8 A. I think when Mr. Rader contacted me.
- 11:07:56 9 Q. And do you recall --
- 11:07:58 10 A. I had been aware of previous litigious activity on
- 11:08:04 11 the part of Dr. Schubert in connection with Osram.
- 11:08:09 12 Q. When did you become aware of the Osram litigation?
- 11:08:16 13 A. It turned out Crystal Talley had alerted me in 2013.
- 11:08:29 14 I was -- I had forgotten that, but counsel on a case where I
- 11:08:34 15 was working as an expert brought it to my attention.
- 11:08:43 16 Q. And do you recall whether or not you ever read the
- 11:08:47 17 complaint filed in the Osram litigation?
- 11:08:48 18 A. I have not.
- 11:08:49 19 Q. Have you ever read the counterclaims that Osram filed
- 11:08:53 20 in its litigation?
- 11:08:54 21 A. I have not.
- 11:08:55 22 Q. But otherwise, you had no knowledge of the Cree
- 11:08:58 23 lawsuit, is that correct?
- 11:09:00 24 A. Correct.
- 11:09:01 25 Q. Are you aware one way or the other of whether

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11:09:04 1 Professor Schubert ever informed the OTD of his attempts to  
11:09:08 2 license the '475 Patent?

11:09:14 3 A. I have read annual reports he submitted to BU in  
11:09:18 4 connection with the return of the '475 Patent to him.

11:09:24 5 Q. And did you read those reports in connection with  
11:09:26 6 preparing for your testimony today, or during your time at  
11:09:29 7 OTD?

11:09:31 8 A. In preparation for my testimony.

11:09:34 9 Q. So at your time at the OTD, you had no knowledge of  
11:09:38 10 any communications sent to BU about his licensing  
11:09:45 11 activities, is that right?

11:09:46 12 A. Correct.

11:09:48 13 Q. And is it fair to say that after you left the OTD in  
11:09:55 14 February of 2010, if Professor Schubert had contacted BU  
11:10:00 15 about his decisions to file these lawsuits, you wouldn't  
11:10:04 16 have been aware of them?

11:10:06 17 A. That is correct.

11:10:08 18 Q. I'm putting in the chat what will be Exhibit 20 to  
11:10:13 19 your deposition, which is a document dated July 27th, 2020,  
11:10:20 20 and it is a subpoena to testify at a deposition addressed to  
11:10:22 21 you.

11:10:22 22 Do you see that?

11:10:30 23 A. I do.

11:10:41 24 Q. Have you every reviewed this document before?

11:10:43 25 A. I have.

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11:10:43 1 Q. When was the first time you saw this document?

11:10:45 2 A. I don't know. I have a folder of materials which has  
11:10:49 3 two subpoenas in it, and I believe I was sent this updated  
11:10:54 4 subpoena earlier this week.

11:10:57 5 Q. And if you scroll down to exhibit -- or attachment B  
11:11:01 6 which is going to be on Page Number 26 of the PDF. Let me  
11:11:13 7 know when you're there?

11:11:15 8 A. I have attachment B on page 26.

11:11:18 9 Q. If you go then to the next page, do you see there's a  
11:11:22 10 document, "defendant Lumileds LLC's amended answer,  
11:11:26 11 counterclaims and demand for jury trial." Do you see that?

11:11:29 12 A. I do.

11:11:30 13 Q. And can you take a moment to look through it if you  
11:11:33 14 need it, but are these the counterclaims that you testified  
11:11:37 15 that you looked through yesterday?

11:11:38 16 A. I believe they were.

11:11:39 17 Q. Dr. Stevens, what did you do to prepare for your  
11:11:43 18 deposition today?

11:11:44 19 A. I had several conversations with Mr. Rader and  
11:11:52 20 Ms. Talley, and reviewed various documents.

11:11:54 21 Q. Do you recall how many conversations you had with  
11:11:58 22 Mr. Rader and Ms. Talley?

11:12:00 23 A. The conversations were simultaneous. Ms. Talley was  
11:12:04 24 not on all of the conversations. And I would say there was  
11:12:10 25 probably four or maybe five.

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11:12:12 1 Q. Do you recall when those conversations took place?

11:12:16 2 A. One was earlier this week, and then they were in  
11:12:22 3 previous weeks, maybe the week before.

11:12:28 4 Q. How long was the conversation you had earlier this  
11:12:33 5 week?

11:12:33 6 A. I think it was less than an hour.

11:12:41 7 Q. How much time in total would you say you spent in  
11:12:45 8 conversations preparing for your deposition today?

11:12:47 9 A. I don't know. Unfortunately I'm not being paid for  
11:12:51 10 this, so I haven't kept track.

11:12:52 11 Q. And was anyone present for any of the conversations  
11:12:55 12 other than Mr. Rader and Ms. Talley?

11:13:00 13 A. Yeah. Susmita, and I forget her last name.  
11:13:06 14 Mr. Rader can fill that in. And I believe it was Jennifer  
11:13:10 15 Pasquarelli in BU's OGC was on some of the calls.

11:13:14 16 Q. You mentioned you reviewed some documents to prepare  
11:13:17 17 to testify today. Did any of the documents that you  
11:13:20 18 reviewed refresh your recollection as to the scope of your  
11:13:24 19 testimony or anticipated testimony?

11:13:30 20 A. Yeah. The bunch of documents I hadn't seen in  
11:13:32 21 11 years on what was at the time a minor matter.

11:13:41 22 Q. What is your understanding of the nature of the  
11:13:42 23 allegations of inequitable conduct?

11:13:46 24 A. I have read them in there. I got accused of fraud on  
11:13:50 25 the Patent Office, and that is absolutely not the case.

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11:13:56 1 Q. Why do you believe it's not the case?

11:14:00 2 A. Because I took no action with the Patent Office on  
11:14:03 3 this matter. It was my intention to return a dead patent to  
11:14:07 4 Professor Schubert, and for him to make the case for  
11:14:12 5 revival. I had nothing to do with that. I had nothing to  
11:14:15 6 do whatsoever with the actions that were taken. I can't see  
11:14:20 7 why I have been accused in this matter.

11:14:22 8 Q. So is it your understanding that you had no impact  
11:14:26 9 whatsoever on the decision to file a petition to revive the  
11:14:34 10 '475 Patent?

11:14:34 11 A. Absolutely. I've made that clear throughout today.

11:14:42 12 Q. Are you aware of anyone at BU coming to the  
11:14:45 13 conclusion that the '475 Patent could be in good faith  
11:14:49 14 revived?

11:14:50 15 A. I have no knowledge. I'm sorry. I have no knowledge  
11:14:52 16 of that.

11:14:53 17 Q. And are you aware one way or the other whether anyone  
11:14:58 18 at BU ever took steps to determine whether or not BU's delay  
11:15:02 19 in paying the maintenance fee was, in fact, unintentional?

11:15:02 20 A. Please repeat the question.

11:15:02 21 Q. Are you aware one way or the other whether anyone at  
11:15:12 22 BU ever took any steps to determine whether or not BU's  
11:15:12 23 delay in paying the maintenance fee was, in fact,  
11:15:12 24 unintentional?

11:15:12 25 A. No.

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11:15:20 1 Q. Could you just take a moment to read paragraph number  
11:15:24 2 299.

11:15:25 3 A. "On information and belief, Dr. Lee, Ms. Anderson,  
11:15:30 4 Dr. Stevens and Mr. Nijhawan each knowingly and deliberately  
11:15:36 5 participated in BU's revival of the '475 Patent on the basis  
11:15:39 6 of the late payment of the fee on April 22, 2010, was  
11:15:42 7 unintentional. However, they each knew the delay in paying  
11:15:46 8 the maintenance fee was intentional."

11:15:47 9 I had absolutely no wrong in that decision, and  
11:15:51 10 I deeply resent that being in here in a publicly available  
11:15:55 11 document. Dr. Lee, Ms. Anderson, Mr. Nijhawan, they were  
11:16:00 12 around when that took place. They may or may not have  
11:16:04 13 known. I absolutely was not involved, and I deeply resent  
11:16:07 14 my name being linked in the same sentence with them  
11:16:10 15 throughout this document on these.

11:16:13 16 Q. Do you recall in these e-mails that Sean Lee informed  
11:16:17 17 Professor Schubert that your reaction was that something  
11:16:21 18 could be worked out probably to revive the '475 Patent. Do  
11:16:28 19 you remember that?

11:16:28 20 A. I read that.

11:16:29 21 Q. Okay. So would it surprise you if Dr. Schubert  
11:16:32 22 relied on your reaction in deciding that -- for informing  
11:16:38 23 his own belief that whether the '475 Patent could be  
11:16:42 24 revived?

11:16:42 25 A. I think he would have been ill advised to do that.

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11:16:47 1 He should have taken opinion from counsel. We would have  
11:16:50 2 allowed him to use Matt Connors. It was always our practice  
11:16:54 3 to allow faculty to continue to use the law firm or the  
11:16:59 4 lawyer who had prosecuted the case on behalf of the  
11:17:04 5 University.

11:17:05 6 Q. The question was whether -- the question that  
11:17:08 7 required clarification was whether or not the patent could  
11:17:11 8 be revived, not whether it could be transferred, correct?

11:17:15 9 A. That was a critical issue. I mean, a dead patent  
11:17:19 10 would be no use to Professor Schubert. It's only useful  
11:17:23 11 transferred to him if it could be revived.

11:17:26 12 Q. Earlier you testified that you became aware of the  
11:17:29 13 Osram inequitable conduct allegations through the attorney  
11:17:33 14 you were working on in this matter. Do you recall --

11:17:36 15 A. No, I did not. My testimony was by an attorney for  
11:17:41 16 whom I was working as an expert.

11:17:44 17 Q. Do you recall when you became aware of the Osram  
11:17:49 18 inequitable conduct allegations?

11:17:51 19 A. I think it was two or three or four years ago, I  
11:17:52 20 forget which.

11:17:58 21 Q. In late 2009, early 2010, when the events that you've  
11:18:02 22 been testifying about today happened, was there a patent  
11:18:08 23 lawyer on staff of OTD at the time?

11:18:12 24 A. No.

11:18:14 25 Q. But you had outside patent counsel, is that right?

Ashley Stevens - video

11:18:19 1 A. Correct.

11:18:19 2 Q. And during that time frame, who would make the

11:18:23 3 decision whether a delay in payment was unintentional or a

11:18:28 4 patent could be revived?

11:18:31 5 A. Counsel.

11:18:33 6 Q. Outside counsel?

11:18:36 7 A. Outside counsel.

11:18:41 8 Q. So to the best of your recollection, outside counsel

11:18:44 9 had not made any such decision by the time you left the OTD

11:18:50 10 on February 22nd, 2010. Is that correct?

11:18:52 11 A. That's my understanding.

11:18:54 12 (End of videotape testimony.)

11:18:57 13 THE COURT: All right.

11:18:59 14 MR. MOLANO: Your Honor, defendant's next

11:19:01 15 witness is --

11:19:02 16 THE COURT: Do you have any exhibits you want to  
11:19:04 17 add?

11:19:05 18 MS. DESAI: Yes, Your Honor. In light of  
11:19:09 19 Dr. Ashley Stevens' testimony we move to admit the following  
11:19:12 20 exhibits. This is in the order they were presented during  
11:19:14 21 the deposition. JTX 24, JTX 27, JTX 9, JTX 17, JTX 23, JTX  
11:19:22 22 24, JTX 10, JTX 29, JTX 19, JTX 31, JTX 15, and DTX 35, DTX  
11:19:42 23 36, and DTX 116.

11:19:44 24 THE COURT: Any objection?

11:19:48 25 MR. BOLLINGER: No objection, Your Honor.

Vinit Nijhawan - video

11:19:50 1 THE COURT: All right. Those will be admitted.  
11:19:52 2 We're going to take a fifteen-minute break. We'll come back  
11:19:55 3 at 11:35.

11:37:45 4 (A brief recess was taken.)

11:37:45 5 THE COURT: All right. Please be seated. Next.

11:37:49 6 MR. MOLANO: Your Honor, defendant calls Vinit  
11:37:52 7 Nijhawan, managing director of Boston University.

11:37:55 8 THE COURT: Okay.

11:37:59 9 (Deposition testimony of Vinit Nijhawan:)

11:38:12 10 Q. Who are you currently employed by?

11:38:14 11 A. MassVentures.

11:38:16 12 Q. And what is your current job title?

11:38:19 13 A. Managing director.

11:38:20 14 Q. And it says that you joined Boston University in  
11:38:23 15 January 2008. Is that right?

11:38:25 16 A. As an MBA lecturer.

11:38:28 17 Q. Okay. And if you'll scroll back to that first page  
11:38:32 18 of the document, in the first full paragraph you write, you  
11:38:37 19 "began teaching entrepreneurship at Boston University and  
11:38:42 20 subsequently led the Office of Technology Development (OTD)  
11:38:45 21 from 2010 to 2016."

11:38:47 22 Is that fair?

11:38:48 23 A. Yes.

11:38:48 24 Q. And what was your title in 2010 when you started  
11:38:52 25 working for OTD?

Vinit Nijhawan - video

- 11:38:54 1 A. Managing director.
- 11:38:55 2 Q. What were your responsibilities in that role?
- 11:38:58 3 A. The Office of Technology Development is -- reports to
- 11:39:04 4 the vice-president of research at Boston University, and I
- 11:39:09 5 was leading that office.
- 11:39:12 6 Q. Okay. And who held that title before you?
- 11:39:15 7 A. I don't know if it was the same title, but Ashley
- 11:39:19 8 Stevens was the prior head of OTD.
- 11:39:24 9 Q. Okay. Are you currently employed by BU in any way?
- 11:39:27 10 A. As an adjunct lecturer, yes.
- 11:39:32 11 Q. And when did Dr. Stevens leave OTD?
- 11:39:35 12 A. December 31st, 2019, I believe.
- 11:39:37 13 Q. Can you just back up and tell me a little bit about
- 11:39:40 14 what the role of the OTD is at BU?
- 11:39:45 15 A. Okay. I mean, it's like any other technology
- 11:39:50 16 licensing office at any one of the, you know, 200 plus
- 11:39:56 17 research universities in the U.S. First and foremost, it's
- 11:40:03 18 an organization that services faculty, and especially
- 11:40:06 19 faculty who are intended -- or interested in inventing, you
- 11:40:12 20 know, or filing patents based on their research. And as
- 11:40:18 21 part of that service we do patenting, we do licensing, we do
- 11:40:32 22 -- you know, we spin out companies who then license the IP.
- 11:40:36 23 Basically what every other technology transfer office does.
- 11:40:40 24 Q. What he is your experience with patent prosecution?
- 11:40:43 25 A. My expense with patent prosecution. Well, I mean, at

Vinit Nijhawan - video

11:40:48 1 OTD we hired outside counsel who would interview, you know,  
11:40:54 2 faculty members to help write claims and file patent  
11:41:01 3 applications.

11:41:02 4 Q. And what does BU do with the patents that are in its  
11:41:05 5 portfolio?

11:41:06 6 A. When I was managing director of OTD, you know, my  
11:41:10 7 responsibility was to try to license those patents and to  
11:41:13 8 get them commercialized basically. That's the business we  
11:41:19 9 were in.

11:41:19 10 Q. How big was OTD when you were managing director?

11:41:23 11 A. 14 FTE equivalents, including me.

11:41:29 12 Q. Now, during your time at BU, do you recall meeting  
11:41:33 13 with Fred Schubert ever?

11:41:35 14 A. No.

11:41:36 15 Q. Do you recall the names of anybody else who was  
11:41:39 16 involved in handling the '475 Patent at BU?

11:41:43 17 A. As I prepared for this deposition and in this  
11:41:46 18 conversation, I was told that Sean Lee was the case manager,  
11:41:50 19 and Ashley Stevens was involved as the previous head of OTD.

11:41:52 20 Q. So what do you recall about the factual history of  
11:42:02 21 the '475 Patent?

11:42:04 22 A. Again, you know, in preparing for this deposition,  
11:42:07 23 you know, I was reminded that BU asked the inventors if they  
11:42:12 24 wanted us to continue to maintain the patent, they came back  
11:42:21 25 and said they didn't have -- that they didn't want to, and I

Vinit Nijhawan - video

11:42:26 1 think we didn't pay the maintenance fee. That's what I saw  
11:42:33 2 from the documents that were provided to me.

11:42:38 3 Q. Okay. And what is your recollection of what occurred  
11:42:41 4 with this patent after the maintenance fees were not paid?

11:42:46 5 A. Again, I don't recollect anything by memory. But  
11:42:50 6 from the documents that were presented to me, Professor  
11:42:54 7 Schubert came back to us, to BU, and asked if the patent  
11:43:01 8 could be licensed to him.

11:43:11 9 Q. When you joined OTD in 2010, was it your  
11:43:15 10 understanding at that time that BU had already approached  
11:43:19 11 Dr. Schubert about returning the invention?

11:43:21 12 A. I don't remember.

11:43:24 13 Q. Do you recall ever being informed of the status of  
11:43:27 14 the '475 Patent when you joined the OTD?

11:43:31 15 A. I don't.

11:43:35 16 Q. Okay. Can you tell me generally what the process was  
11:43:38 17 for determining whether a patent could be licensed?

11:43:44 18 A. Well, I think there was a process to ensure that all  
11:43:51 19 the inventors were on board with licensing to whoever we  
11:43:56 20 were trying to license to.

11:43:52 21 You know, remember, if you're licensing to  
11:44:02 22 somebody, there's somebody on the other side probably with  
11:44:08 23 their own counsel that is going to look at the status of the  
11:44:12 24 patent, you know, its ownership, title, who it's been  
11:44:17 25 assigned to. If it's government-funded research, there are

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11:44:22 1 some restrictions to licensing the patent based on the  
11:44:27 2 Bayh-Doh1 Act.

11:44:30 3 These are the things that I remember, but there  
11:44:32 4 could be more steps that I don't remember.

11:44:36 5 Q. Okay. I am dropping a document into the chat that  
11:44:40 6 I'll ask the court reporter to mark as Exhibit 4.

11:44:52 7 Why don't you take a moment to just page through  
11:44:56 8 it.

11:45:01 9 A. Okay.

11:45:04 10 Q. Just let me know when you're done. Have you had a  
11:45:08 11 chance to finish reading it?

11:45:11 12 A. I'm still reading it.

11:45:13 13 Q. Okay.

11:45:14 14 A. (Witness reviewing document.)

11:45:17 15 Okay. I've read it.

11:45:19 16 Q. Do you recognize this document?

11:45:20 17 A. Not until you just showed it to me.

11:45:23 18 Q. And your name is in the top left corner, correct?

11:45:27 19 A. Yes.

11:45:29 20 Q. And you signed this letter?

11:45:31 21 A. Yes, it looks like that's my signature.

11:45:33 22 Q. Do you have any reason to believe that this is not a  
11:45:35 23 letter you would have sent in the ordinary course of  
11:45:37 24 business?

11:45:40 25 A. No.

Vinit Nijhawan - video

11:45:40 1 Q. Do you have any reason to doubt that the information  
11:45:43 2 in this letter is not accurate?

11:45:45 3 A. No.

11:45:46 4 Q. Do you recall what the status of the '475 Patent was  
11:45:50 5 as of the date that you sent this letter?

11:45:53 6 A. No, I don't recall.

11:45:55 7 Q. Do you recall if the patent was alive and enforceable  
11:45:58 8 as of the date of this letter?

11:46:01 9 A. I don't recall, other than the material that was  
11:46:03 10 provided to me in prep for the deposition.

11:46:04 11 Q. Okay. And did that material refresh your  
11:46:14 12 recollection about the status of the patent on the date that  
11:46:16 13 you sent this letter?

11:46:19 14 A. I don't -- you asked me to put my notes away, so I  
11:46:24 15 don't have my notes in front of me, but I don't know if the  
11:46:28 16 petition to the U.S. Patent Office was granted by the time  
11:46:32 17 this letter was written, but I assume it was.

11:46:35 18 Q. Okay. Do you recall as of the time you joined in  
11:46:39 19 2010 whether you had any knowledge about BU's decision not  
11:46:44 20 to pay maintenance fees on the patent?

11:46:51 21 A. In the transition from Ashley to me, it's possible we  
11:46:55 22 had that discussion prior to the patent committee meeting,  
11:46:58 23 but I don't recall.

11:47:01 24 Q. Okay. Do you have any understanding of why BU  
11:47:04 25 submitted this petition to accept unintentionally delayed

Vinit Nijhawan - video

11:47:08 1 payment of maintenance fee in an expired patent?

11:47:10 2 A. Again, from the documents that were presented to me  
11:47:14 3 in preparation for this deposition, I understand that  
11:47:17 4 Dr. Schubert requested the patent either be licensed to him  
11:47:24 5 or transferred to him, and I don't recall which one of the  
11:47:30 6 two.

11:47:30 7 Q. Okay. So in order for the patent to be returned to  
11:47:33 8 the inventor, it had to first be revived?

11:47:37 9 A. According to the documents I read, yes.

11:47:42 10 Q. Okay. I'm putting you in a time machine and taking  
11:47:45 11 you back to 2010, let's say April 23, 2010. Was it your  
11:47:52 12 understanding on that date that before returning an  
11:47:56 13 invention to an inventor, the patent on the invention needed  
11:48:02 14 to be revived?

11:48:04 15 A. This is one of the agendas of the patent committee  
11:48:08 16 meeting, so I would speculate that yes, it would be my  
11:48:12 17 understanding after the patent committee meeting.

11:48:16 18 Q. And sorry, what was your understanding?

11:48:20 19 A. That in order to return the patent to the inventor,  
11:48:23 20 it would have to be revived.

11:48:28 21 Q. Okay. And was your understanding formed or shaped by  
11:48:32 22 that patent committee meeting?

11:48:34 23 A. I don't remember.

11:48:35 24 Q. Do you have any other sources for that understanding  
11:48:38 25 other than that patent committee meeting?

Vinit Nijhawan - video

11:48:43 1 A. I don't remember.

11:48:45 2 Q. In February 2010, there was a patent committee  
11:48:49 3 meeting that you attended, and that was your -- it was  
11:48:53 4 possibly your first introduction to the '475 Patent. Is  
11:48:57 5 that fair?

11:48:57 6 A. Yes, that's fair.

11:48:58 7 Q. Who is Matthew E. Connors?

11:49:01 8 A. I, frankly, didn't know until I was prepping for this  
11:49:06 9 deposition. I gather he was our outside counsel.

11:49:09 10 Q. Okay. As of 2010, did you have an understanding of  
11:49:14 11 who was outside counsel for the OTD?

11:49:25 12 A. We had many outside counsel for patent prosecution.  
11:49:28 13 And I don't remember Matthew Connors, but, you know, once I  
11:49:33 14 read the documents his name came up.

11:49:35 15 Q. Okay. But seeing his name did not remind you of any  
11:49:39 16 conversations or discussions with him?

11:49:41 17 A. No. There weren't -- we had other patent prosecution  
11:49:46 18 counsel that were more prolific in the work they did for us.  
11:49:52 19 I don't remember this firm.

11:49:56 20 Q. Okay. Who would have authorized Matthew Connors to  
11:50:02 21 file this petition from your office?

11:50:02 22 A. I don't know who it was delegated to, but ultimately  
11:50:09 23 the responsibility laid on me.

11:50:12 24 Q. And can you read that statement, the text under the  
11:50:14 25 word "statement" into the record?

Vinit Nijhawan - video

11:50:16 1 A. "The undersigned certifies that the delay in payment  
11:50:20 2 of the maintenance fee to this patent was unintentional."

11:50:24 3 Q. Okay. Do you recall any discussions in the patent  
11:50:29 4 committee or at BU generally about whether to file this  
11:50:32 5 petition?

11:50:33 6 A. I don't recall.

11:50:35 7 Q. And what was BU's basis for certifying that the delay  
11:50:39 8 in the payment of maintenance fees was unintentional?

11:50:45 9 A. I don't recall what we were thinking.

11:50:50 10 Q. Okay. You were managing director at this time,  
11:50:54 11 right, at the time of the submission of this letter?

11:50:58 12 A. Yes.

11:51:00 13 Q. The statement that you just read into the record  
11:51:04 14 that's under the heading statement.

11:51:06 15 A. Well, I mean, the petition was filed by our outside  
11:51:10 16 counsel, so I mean, that's the type of thing we leave to  
11:51:14 17 outside counsel.

11:51:18 18 Q. Okay. So again, responsibility would have fallen to  
11:51:21 19 you, not Ashley Stevens if this petition was to be filed?

11:51:24 20 A. The responsibility would have fell with Boston  
11:51:28 21 University.

11:51:30 22 Q. You mentioned to me that Ashley Stevens spoke with  
11:51:34 23 outside counsel about the process for reviving the patent;  
11:51:38 24 correct?

11:51:42 25 A. I don't know the nature of the conversation that

Vinit Nijhawan - video

11:51:40 1 Ashley Stevens had with outside counsel.

11:51:43 2 Q. Okay. I'm not asking that, to be clear. That's

11:51:47 3 privileged. What I'm asking is, did anybody other than

11:51:50 4 Ashley Stevens investigate whether revival of the patent was  
11:51:55 5 available?

11:51:57 6 A. I don't recall, but, you know, that's the type of  
11:52:02 7 thing we generally leave to outside counsel.

11:52:05 8 Q. At the time that the petition was filed, did you have  
11:52:09 9 any understanding of whether BU's delay in payment was truly  
11:52:13 10 unintentional?

11:52:14 11 A. We left this kind of thing to outside counsel, and  
11:52:19 12 you know, basically followed them.

11:52:22 13 Q. Did you take any steps to understand what it meant  
11:52:26 14 for a delay to be unintentional?

11:52:33 15 A. From what I've read, Ashley Stevens went to outside  
11:52:40 16 counsel, based on that we brought it to the patent  
11:52:44 17 committee, and it got approved.

11:52:49 18 Q. Okay. Other than having the '475 Patent revived, can  
11:52:52 19 you recall any other instances of having patents revived  
11:52:57 20 during your time at OTD?

11:53:00 21 A. No, I can't.

11:53:03 22 (End of videotape testimony.)

11:53:07 23 MS. DESAI: Your Honor, in light of the  
11:53:11 24 testimony from Mr. Nijhawan, we move to admit JTX 34 to the  
11:53:14 25 record.

Michael Pratt - video

11:53:14 1 THE COURT: Any objection?

11:53:16 2 MR. BOLLINGER: No objection, Your Honor.

11:53:18 3 THE COURT: It's admitted.

11:53:20 4 What's next.

11:53:22 5 MR. MOLANO: Your Honor, defendant calls Michael

11:53:24 6 Pratt, managing director of BU.

11:53:26 7 (Deposition testimony of Michael Pratt:)

11:53:31 8 Q. Can you please state your name for the record?

11:53:33 9 A. Michael John Pratt.

11:53:37 10 Q. Mr. Pratt, what is your current business address?

11:53:41 11 A. 53 Bay State Road, Boston, Mass 02215.

11:53:50 12 Q. And is that an address associated with Boston

11:53:55 13 University?

11:53:55 14 A. Yes, it is.

11:53:57 15 Q. So Mr. Pratt, am I right that your -- your current

11:54:01 16 employer is Boston University?

11:54:02 17 A. Yes.

11:54:04 18 Q. And what is your -- your current title at Boston

11:54:08 19 University?

11:54:08 20 A. Managing director technology development.

11:54:14 21 Q. Okay. And technology development, did -- did that

11:54:19 22 used to be called or referred to as the "OTD"?

11:54:25 23 A. Yeah. Why don't -- why don't I just put the

11:54:29 24 explanation on the record so that we don't have to go

11:54:32 25 through a series of questions. Is that okay?

Michael Pratt - video

11:54:34 1 Q. That would be great.

11:54:35 2 A. Boston University from a marketing standpoint, asked  
11:54:39 3 us not to formally refer to it as the Office of Technology  
11:54:42 4 Development which is colloquially known as OTD. So its  
11:54:47 5 official title is managing director technology development.  
11:54:51 6 Although, it's the technology development office, but,  
11:54:55 7 informally around BU and as we refer to it do today,  
11:55:00 8 referring to it as OTD is -- is -- is convenient and  
11:55:04 9 efficient.

11:55:05 10 Q. And how long have you been the managing director of  
11:55:08 11 technology development?

11:55:12 12 A. I became the interim managing director in August of  
11:55:17 13 2015. I -- I don't know a precise day for you, but  
11:55:23 14 August 20, 0015, and then that became a permanent director I  
11:55:28 15 think it was May of 2017.

11:55:32 16 Q. Okay. And prior to becoming interim managing  
11:55:35 17 director, did you -- were you working in the OTD?

11:55:38 18 A. Yes. Well --

11:55:41 19 Q. Okay.

11:55:42 20 A. -- let me explain just some name things just to get  
11:55:46 21 it on the record again, so we're clear.

11:55:50 22 Q. Sure.

11:55:52 23 A. I started at Boston University in May of 2000. When  
11:55:56 24 I started at Boston University, I was hired into an office  
11:55:59 25 called the Office of Technology Transfer. The general

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11:56:01 1 responsibility of Office of Technology Transfer has to do  
11:56:04 2 with patent, you know, and licensing. That's similar to the  
11:56:08 3 Office of Technology Development in function, patents,  
11:56:12 4 licensing. But from 2000 until today is -- you know, there  
11:56:17 5 are a couple of transition us where there were name changes,  
11:56:21 6 but all of my time at Boston University, I've worked for  
11:56:25 7 this function at Boston University that was first called  
11:56:27 8 Office of Technology Transfer, and then later called Office  
11:56:33 9 of Technology Development. I've always worked for the same  
11:56:36 10 unit at Boston University from May of 2000 until today.

11:56:39 1 Q. And then what are your -- your current  
11:56:42 2 responsibilities as the managing director of OTD?

11:56:49 3 A. Okay. So we've maintained a similar structure to  
11:56:52 4 what Vinit had talked about with the three groups. So my  
11:56:58 5 current responsibility is across all three of those groups.  
11:57:01 6 So there are still people we refer to as business  
11:57:04 7 development people; they report directly to me. There is no  
11:57:08 8 middle management, if you will, there is no layer in  
11:57:11 9 between. So those people report directly to me. And then  
11:57:14 10 we have the intellectual property licensing group that has  
11:57:17 11 the -- there's a boss of that group, Ken Zwicker, he's  
11:57:22 12 patent attorney who manages those people, he reports to me.  
11:57:23 13 And then we have the finance and operation, there's two  
11:57:24 14 people in that group that manage the money coming in and  
11:57:32 15 out. So those three groups report to me and I manage those

Michael Pratt - video

11:57:39 1 three functions.

11:57:39 2 Q. And just while you're doing that, for the record, I  
11:57:42 3 will read in that Exhibit 1 is a document entitled  
11:57:46 4 "defendant Lumileds, LLC's notice of 30(b)(6) deposition of  
11:57:50 5 counterclaim defendant Boston University topic numbers 1  
11:57:54 6 through 28."

11:57:55 7 And so do you understand that you're here today  
11:57:58 8 to testify on behalf of Boston University?

11:58:02 9 A. Yes.

11:58:03 10 Q. Meaning that you're -- you're not here to testify  
11:58:06 11 just to your own personal knowledge, but to the knowledge  
11:58:10 12 that Boston University possesses on the subject matter of  
11:58:13 13 this deposition notice?

11:58:14 14 A. I'm happy to answer questions on behalf of Boston  
11:58:18 15 University. I understand that, through the questioning, you  
11:58:21 16 -- perhaps you might ask a few questions that have to do  
11:58:23 17 with my knowledge since I have worked here. But I guess  
11:58:27 18 we'll just take them a question at a time. Right? And if  
11:58:30 19 you could be clear when you're using the term you if you  
11:58:32 20 mean Boston University or if you mean me personally, that  
11:58:34 21 would also be appreciated so I can answer clearly.

11:58:38 22 Q. And do you understand that you're here today to  
11:58:42 23 testify to -- to Boston University's knowledge concerning  
11:58:44 24 topics 1 and 2 and then all of the topics beginning on  
11:58:52 25 page 6, topic number 5 through 28?

Michael Pratt - video

11:58:59 1

A. Yes.

11:59:03 2

Q. And who at BU during that time frame would have had responsibility for directing outside counsel's activities with respect to the Patent Office?

11:59:07 3

11:59:14 4

11:59:16 5

A. So directing -- let's see. Janine was our primary conduit for communications. So, if there was a decision made in the office to file a patent application, normal course of business, Janine was the one who, you know, put the -- put the instruction together and sent it off. The -- the administrative function of sending it off.

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For making a decision relative to a case, it depends on the decision. A lot of times they were discussed as a group or -- or in a group decision -- someone was requesting something, discuss it with the group, a decision is made, Janine gets the instructions, it goes off. So it probably would depend on the type of decision and who was involved with the discussion. There was no real absolute one way decisions were made relative to the cases.

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Q. Okay. So with respect to case number 98-11, who -- who might have been involved in the group who would make the decisions other than Sean Lee?

12:00:22 20

12:00:27 21

12:00:30 22

A. So it's again just kind of clarify the time frame so we're talking about the same thing so that I can narrow it down a little bit. So --

12:00:34 23

12:00:37 24

12:00:40 25

Q. Yeah, it's the same 2005 to 2010 time frame.

Michael Pratt - video

12:00:45 1 A. Yeah, it's ten. Thank you. So I might have been  
12:00:48 2 involved with some historical information, that's possible.  
12:00:51 3 Ashley obviously had some historical information as well.  
12:00:55 4 There was Sean Lee.

12:00:56 5 You may recall from seeing through some of the  
12:00:58 6 documentation that another person had joined the office, Jon  
12:01:03 7 Jensen, I think he joined us in 2006. And Jon Jensen was  
12:01:07 8 working with Sean Lee in managing the physical sciences  
12:01:12 9 portfolio during that 2005 to 2010 time frame. So besides  
12:01:17 10 the inventor himself, the inventor, obviously or inventors,  
12:01:21 11 you know, depending on the matter, within the office, I -- I  
12:01:26 12 think you had listed some out in some of your documents.  
12:01:29 13 You know, Ashley, Sean, John, Janine, perhaps myself if  
12:01:34 14 something tied back to something I was involved with, the  
12:01:36 15 inventors. Obviously you -- you questions had Vinit about  
12:01:42 16 his transition time. So if we are including all of 2010,  
12:01:46 17 you know, Vinit was employed in 2010.

12:01:50 18 Q. And you mentioned that BU relies on outside counsel  
12:01:53 19 for these types of matters with the Patent Office, is that  
12:01:57 20 correct?

12:01:57 21 A. Yeah. Any filings -- any practice before the Patent  
12:02:00 22 Office is done by outside counsel.

12:02:05 23 Q. Okay. So then is it fair to say that in this  
12:02:09 24 instance relating to the '475 Patent, BU would have relied  
12:02:13 25 on counsel's interpretation of whether or not the -- there

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12:02:18 1 was a -- any intentional delay in paying the maintenance fee  
12:02:22 2 for the '475 Patent?

12:02:24 3 A. Yeah. So there -- there's a lot in that statement,  
12:02:32 4 that term that I think some of your colleagues used in some  
12:02:35 5 of the depositions. So first I think you have to  
12:02:38 6 distinguish between the paying or not paying of the  
12:02:42 7 maintenance fee in September 25th, 2009, right? Clearly the  
12:02:47 8 records show that BU was aware that the maintenance fee was  
12:02:49 9 due. We reached out to Professor Schubert to see if he was  
12:02:53 10 interested in it. He said no. That information was  
12:02:56 11 communicated to Janine via e-mail.

12:02:59 12 You know, the -- had we known -- had Fred -- had  
12:03:05 13 Fred said yes, I'm interested in this, we would have paid  
12:03:08 14 the fee. Right? But clearly the fee, the facts show the  
12:03:11 15 fee was not paid. Sean was aware of the deadline. Janine  
12:03:15 16 was aware of the deadline. So I got to figure -- I got to  
12:03:19 17 figure that that -- that failure to pay that maintenance fee  
12:03:22 18 was known. It's hard to say that it was intentional or not,  
12:03:25 19 because the lack of an action. Right? The lack of  
12:03:29 20 something, it's a little tricky for me to find something  
12:03:32 21 that's a lack of an action. Nobody says oh, I'm not going  
12:03:36 22 to breathe today, right? You know, so I didn't find  
12:03:40 23 anything that say I'm not going to do this today, but I have  
12:03:44 24 to believe looking at the record that that decision, that  
12:03:47 25 decision not the pay that maintenance fee on September 25th

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12:03:49 1 was intentional by my layman's understanding of by design.

12:03:55 2 Okay?

12:03:56 3 Q. Okay.

12:03:56 4 A. So when you get into the different time period, you  
12:03:59 5 get into the time period from September 25th to April 22nd,  
12:04:03 6 okay, then when I think of that word intentional, I think of  
12:04:06 7 the word by design. First after you will, this is all  
12:04:10 8 outside counsel. Because outside counsel is filing that  
12:04:13 9 thing for us. But I can tell you that from my own personal  
12:04:16 10 opinion nothing that happened between that date of  
12:04:18 11 September 25th to April 22nd was by design, because it was  
12:04:21 12 an abnormal circumstance, and all sorts of things were going  
12:04:25 13 on between the transition of the office and all that kind of  
12:04:28 14 stuff. So I think when you're using the word intentional,  
12:04:32 15 let's be clear, I think that decision, or nondecision,  
12:04:36 16 whatever you want to call it, it appears from the record  
12:04:38 17 that it was intentional, but this delay issue in, this issue  
12:04:42 18 that I think you're trying to get at, you know, anything --  
12:04:46 19 any interpretation of the word intentional, I got to rely  
12:04:49 20 upon outside counsel for that when they filed that form on  
12:04:53 21 April 25th and Connors made that decision of filing that.

12:04:55 22 Q. Okay. So then it's -- so BU using -- you know, BU's  
12:05:00 23 understanding of the term made an intentional decision not  
12:05:02 24 to pay the maintenance fee on September 25th, 2009; is that  
12:05:05 25 right?

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12:05:22 1 A. What I'm saying is I have nothing in the record that  
12:05:25 2 someone documented and said I made this intentional  
12:05:28 3 decision. Alls I have is that communication with Sean Lee  
12:05:31 4 and Professor Schubert and then his record forwarding that  
12:05:35 5 communication to Janine. So it answer as though they knew  
12:05:38 6 about the deadline and it's obvious from the facts that the  
12:05:40 7 payment was made. So I mean, I got to figure -- in -- in  
12:05:45 8 the expert spirit of just moving things forward, I got to  
12:05:48 9 figure based upon the record that there was some  
12:05:50 10 intentionality there. There was -- it was, it was, it was  
12:05:54 11 known. But that's the best I can do. I don't have  
12:05:56 12 something direct that supports it.

12:05:59 13 Q. Okay. And then -- when we look at the period then  
12:06:03 14 from September 25th, 2009, through April 22nd, 2010, as the  
12:06:09 15 university witness, is it your position that BU relied on  
12:06:12 16 outside counsel to determine whether or not that delay  
12:06:16 17 qualified as unintentional per Patent Office procedures?

12:06:25 18 A. Yeah. I think my position on that time period is  
12:06:28 19 that BU did absolutely nothing wrong. They -- they had  
12:06:32 20 interest from a -- from an inventor who came back to us in  
12:06:36 21 December and said, hey, I want this thing. You got Ashley  
12:06:39 22 talking to outside counsel to kind of find out if it's  
12:06:43 23 possible. Outside couple files on this -- this petition to  
12:06:47 24 the Patent Office on April 22nd. There's a whole set of  
12:06:51 25 activities that happened in that time frame as you saw from

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12:06:55 1 the record. And again, it's my -- my opinion that none of  
12:06:59 2 that was by design. But for the formal filing to the  
12:07:03 3 office, in any -- any formal interaction with the Patent  
12:07:07 4 Office that required some sort of technical understanding of  
12:07:10 5 this word "intentional" or not was -- was -- was done by  
12:07:14 6 outside counsel.

12:07:15 7 Q. Just looking only at, you know, the -- the filing  
12:07:18 8 with the Patent Office concerning whether or not the delay  
12:07:24 9 was unintentional, your position that BU relied on outside  
12:07:29 10 counsel to determine whether or not the delay was  
12:07:32 11 intentional or not for purposes of the PTO's procedures?

12:07:38 12 A. No, that's not my position. My -- my position is  
12:07:41 13 that Matt Connors filed that form with the Patent Office.  
12:07:44 14 It was Matt Connors that made the decision to file that  
12:07:47 15 particular petition. We use outside counsel to make filings  
12:07:51 16 with the Patent Office. That's what -- that's what their  
12:07:55 17 job is, that's the service we hire them for. So BU hired  
12:08:00 18 now, Matt Connors, right, as our counsel. Matt Connors took  
12:08:05 19 the action to file that form with the Patent Office. My  
12:08:08 20 understanding through Ashley's deposition is that Matt  
12:08:11 21 Connors was aware of the facts, he had a discussion with  
12:08:14 22 Ashley, and, you know, it was done. It was done on  
12:08:20 23 April 23rd. It was done by Matt Connors. That's what I  
12:08:23 24 know.

12:08:23 25 Q. So did -- did Matt Connors have the authority to

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12:08:27 1 decide to file that petition on his own?

12:08:30 2 A. As you probably know, we are the client and there's  
12:08:35 3 outside counsel; right? So they are providing a service for  
12:08:38 4 us. I -- I would think, in most normal instances, counsel  
12:08:43 5 is following some sort of instruction or direct on the  
12:08:49 6 general concept from -- from its client.

12:08:52 7 Now, how they go about it and what they decide  
12:08:54 8 to do and how they execute on that, that would be up to  
12:08:57 9 counsel. So, yeah, there was obviously some interaction  
12:09:00 10 with Ashley and Matt Connors that we know of in early  
12:09:04 11 December. I could not find anything in the record where  
12:09:07 12 there were further communications or contact with Matt  
12:09:10 13 Connors. There were some letters he was copied on, I think,  
12:09:14 14 as we went through the return process in that -- the patent  
12:09:17 15 committee stuff with the -- there were some letters there he  
12:09:21 16 was copied on. But alls I have is that Matt Connors filed  
12:09:24 17 it on April 22nd. There was an e-mail from Jon Jensen, I  
12:09:28 18 mean, I know he didn't come up much, but Fred was reaching  
12:09:31 19 out to find out the status, Professor Schubert, excuse me,  
12:09:34 20 and there was an e-mail that I saw, one of these BU things  
12:09:38 21 from Jon replying back to Fred. It was funny because it was  
12:09:41 22 after the April 23rd date and Jon as a response to Fred was  
12:09:44 23 hi, Fred, it's in process, the lawyers are working on it.  
12:09:48 24 Right. So those are the two points I have. I have after  
12:09:51 25 the fact, clearly Jon wasn't aware that it was already

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12:09:58 1 filed, but he said the lawyers are working on it. And I  
12:10:00 2 have Ashley talking to Matt Connors in that early December  
12:10:03 3 time frame. Those are my -- those are my two touch points  
12:10:07 4 on what the report supports.

12:10:09 5 Q. BU was not, did not find a licensee for the '475  
12:10:15 6 Patent, is that correct?

12:10:15 7 A. Correct.

12:10:16 8 Q. And BU was not able to -- to generate revenue from  
12:10:21 9 the '475 Patent; is that also correct?

12:10:23 10 A. Well, some revenue was generated through Fred's  
12:10:27 11 efforts after it was returned to him, but prior to -- let's  
12:10:30 12 -- let's just say prior to that decision not the pay the  
12:10:33 13 maintenance fee, September 25th, 2009, to my knowledge,  
12:10:37 14 there was no commercial activity, no licenses, no revenue  
12:10:42 15 generated. I couldn't anything in the records that sport  
12:10:46 16 had that, and I don't have any personal memory of any  
12:10:48 17 activities related to that case.

12:10:51 18 Q. And did BU receive any licensing interest from an  
12:10:58 19 outside entity related to the '475 Patent?

12:11:02 20 A. Not that I recall or -- or -- or -- or that I saw  
12:11:05 21 going through the record. If there is something -- you  
12:11:08 22 know, if you could bring it up, if you found anything, I  
12:11:12 23 didn't see anything. It's possible or conceivable that  
12:11:14 24 there were some you know, contact that I'm not aware of --  
12:11:18 25 you know that happened at that time -- that does happen from

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12:11:21 1 time to time.

12:11:23 2 But I didn't -- I don't recall looking -- from  
12:11:26 3 seeing from the record or from my own memory if there -- if  
12:11:30 4 there was a specific interest beyond that attempt to start a  
12:11:34 5 company early on.

12:11:35 6 Q. And why -- why did BU approach Professor Schubert in  
12:11:40 7 September 2009 with an offer to return the '475 Patent to  
12:11:43 8 him?

12:11:43 9 A. There was a maintenance fee due to September 25th.  
12:11:47 10 University appeared, from Sean's e-mail, took a decision  
12:11:50 11 that it was not going to pay the maintenance fee, and asked  
12:11:53 12 Fred that -- you know, if he wanted to -- to maintain the  
12:11:56 13 case to reach out to him as a courtesy as we do, you know,  
12:12:00 14 most of the time with inventors, if there was a desire to  
12:12:03 15 maintain the case.

12:12:05 16 Q. And why was BU not going to pay the maintenance fee  
12:12:08 17 due on September 25th?

12:12:10 18 A. Yeah, so the -- the only thing I can really go off of  
12:12:14 19 there is -- is Sean's e-mail or communication with Professor  
12:12:18 20 Schubert where he indicated that, you know, as you do all  
12:12:22 21 the time, you try to do cost-cutting measures. You look at  
12:12:25 22 your portfolio, and if there's no licensing interest, you  
12:12:30 23 may say, you know, Sean, we won't go forward with this one  
12:12:34 24 because there is no interest.

12:12:35 25 Q. This will be Exhibit 4 to your deposition. For the

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12:12:38 1 record it's a document produced in this case, with a Bates  
12:12:40 2 number EFS 0006680. And is this the e-mail that you just  
12:12:50 3 mentioned from Sean Lee that your knowledge of the -- the  
12:12:55 4 return was based on?  
12:12:56 5 A. I'm reading it.  
12:13:07 6 Q. Sure.  
12:13:15 7 A. Yeah, I probably -- I probably have to be more  
12:13:18 8 specific. When I responded earlier, maybe I recall this or  
12:13:22 9 something else I saw that -- that talked a little more about  
12:13:25 10 licensing interest. Just this one doesn't seem to talk  
12:13:28 11 about a lack of interest. This seems to inform Fred that we  
12:13:32 12 were not going to pay the fee, if he's interested in doing  
12:13:35 13 it, but it doesn't seem to describe whether or not there is  
12:13:38 14 a licensing interest or not. So this is to communicate to  
12:13:42 15 Fred that we are not going to pay it, but doesn't really get  
12:13:45 16 into the decision of why the university is not going to pay  
12:13:47 17 it.  
12:13:47 18 Q. And do you see -- so this is an e-mail -- this is an  
12:13:52 19 e-mail that Sean Lee would have sent in the ordinary course  
12:13:52 20 of his business at BU; correct?  
12:13:52 21 A. Yes.  
12:13:52 22 Q. And would you agree with me that if the OTD wanted to  
12:14:02 23 continue to have the opportunity to generate revenue from a  
12:14:02 24 patent, it would decide to pay the maintenance fees for that  
12:14:12 25 patent?

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12:14:12 1 A. Yeah. Like in this case, if we had known that Fred  
12:14:15 2 was interested in the patent at that time, we probably would  
12:14:18 3 have paid the maintenance fee. If Fred -- if Fred -- if  
12:14:22 4 Fred's response, which is later in this e-mail, if Fred's  
12:14:26 5 response was oh, no, I would a like to talk to you about  
12:14:29 6 that, more likely than not we would have paid that  
12:14:33 7 maintenance fee.

12:14:34 8 Q. In the 2009 to 2010 time frame, did the OTD have an  
12:14:38 9 understanding that it had a duty to be honest with the  
12:14:41 10 Patent Office?

12:14:41 11 A. Yeah. As I just said, BU has a general policy. You  
12:14:45 12 know, it wants its employees to be honest. I think  
12:14:49 13 everybody understood that, that working in the office, your  
12:14:52 14 job is to do fair deals for the university, to be honest, to  
12:14:57 15 -- to be honest.

12:14:59 16 As it relates to practicing before the Patent  
12:15:04 17 Office, in any responsibilities of attorneys to practice or  
12:15:08 18 patent agents or whatever to practice before the patent  
12:15:13 19 office, we relied on upon them to do -- to do all those  
12:15:16 20 filings. So all your I know entire actions with the patent  
12:15:18 21 was through them.

12:15:19 22 Q. Did anyone at the BU review a draft of this petition  
12:15:23 23 before Mr. Connors submitted it?

12:15:24 24 A. Not that I'm aware of.

12:15:26 25 Q. And what -- what did you do to try to find that out?

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12:15:31 1 A. I just went through all the materials, probably the  
12:15:36 2 same materials you have.

12:15:37 3 Q. Okay. And any of your conversation with Dr. Stevens,  
12:15:41 4 did you ask him whether he had seen this petition prior to  
12:15:45 5 it being filed?

12:15:46 6 A. No, I didn't.

12:15:47 7 Q. And did -- in your conversation with Sean Lee, did  
12:15:50 8 you ask him whether he had seen this petition before it had  
12:15:52 9 been filed?

12:15:53 10 A. No, and just for convenience, for my conversation  
12:15:57 11 with Sean or Janine, and Vinit, I didn't ask them if they  
12:16:03 12 had seen this before it was filed.

12:16:04 13 Q. Who at BU directed Mr. Connors to file this petition?

12:16:08 14 A. There is nothing I could find in the record that  
12:16:12 15 definitively says who instructed them. We know he had  
12:16:16 16 communication with Ashley in December. He filed it on the  
12:16:20 17 22nd. That's all I have.

12:16:22 18 Q. So you've said a few times that it might have been a  
12:16:26 19 group of individuals -- who made the decision to have  
12:16:29 20 Mr. Connors file this petition. Who are the people who  
12:16:33 21 would have comprised that group?

12:16:37 22 A. Well, I think even in your original documents of  
12:16:41 23 depositions and all that stuff, I think you listed out those  
12:16:45 24 people, but I'll list them out again. The people who worked  
12:16:49 25 in the office at that time who would have perhaps touched

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12:16:50 1 this case in some way, were predominantly Sean Lee up until  
12:16:55 2 that transition to Jon Jensen. Ashley was we saw from the  
12:16:59 3 record had some interactions related to it. Janine. Jon  
12:17:04 4 Jensen, obviously Fred Schubert -- didn't work for BU, but  
12:17:08 5 Fred Schubert, that would be the primary group of people.

12:17:15 6 Q. And beyond the fact that Mr. Connors filed the  
12:17:18 7 petition, is BU aware of Mr. Connors -- of the basis, the  
12:17:22 8 factual basis on which the -- the petition certified that  
12:17:26 9 the delay in payment was unintentional?

12:17:34 10 A. You know, as I've said, we -- we rely upon outside  
12:17:38 11 counsel for these matters, so, you know, there was a  
12:17:41 12 maintenance fee due to September 25th. Come -- building up  
12:17:44 13 to that maintenance fee, Professor Schubert was asked if he  
12:17:48 14 had interest in the patent. He said no.

12:17:50 15 After that time -- you know, if we had known at  
12:17:54 16 the time that he was interested we probably would have paid  
12:17:57 17 it. After that time, he came back to us in December and he  
12:18:00 18 said he was interested.

12:18:00 19 There was -- there was some discussions, some  
12:18:03 20 with outside counsel, to talk about that. Per this last  
12:18:07 21 discussion, we see that -- that Ashley testified that he --  
12:18:10 22 that he saw there was a potential pathway forward.

12:18:14 23 And we know that the petition was filed on -- on  
12:18:17 24 April 22nd. Those are the -- those are the -- those are the  
12:18:20 25 key facts around the petition itself. Of course, there was

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12:18:24 1 lots of motion and action going on in the office at the  
12:18:27 2 time, as has been testified by Ashley and others, about the  
12:18:31 3 transition from Ashley to Vinit, the return of the patent,  
12:18:34 4 communicating with Dean Stocker. So there -- there were a  
12:18:38 5 lot of activities, but the -- the core backbone of the stuff  
12:18:41 6 around the revival is -- is just those fact.

12:18:45 7 Q. So Mr. Connors as we saw signed the petition that  
12:18:48 8 certifies that the delay was unintentional, correct?

12:18:50 9 A. Yes.

12:18:51 10 Q. And so my question is whether BU is aware of the  
12:18:54 11 basis on which Mr. Connors made that certification?

12:18:59 12 A. The information that I know is that Ashley Stevens  
12:19:03 13 had some communications with attorney Connors in this  
12:19:06 14 December time frame, and that the -- Mr. Connors filed the  
12:19:10 15 petition on -- on April 22nd. That -- those are the facts  
12:19:14 16 that I know.

12:19:17 17 Q. All right. And you said -- I think you said some  
12:19:21 18 communications, but your understanding is that there was one  
12:19:24 19 conversation between Dr. Stevens and Mr. Connors in  
12:19:27 20 December; correct?

12:19:29 21 A. Yes. Thank you. Correct.

12:19:29 22 Q. And you are not aware of any other information that  
12:19:32 23 was provided to Mr. Connors prior to him filing the petition  
12:19:35 24 on April 22nd, 2010, concerning the -- the circumstances of  
12:19:38 25 the delay; correct? Other than the conversation that he had

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12:19:43 1 with Dr. Stevens in December.

12:19:44 2 A. So I know -- I know that Attorney Connors was copied  
12:19:47 3 on some documentation regarding the return of the invention  
12:19:51 4 or -- or the process for returning the invention to  
12:19:56 5 Professor Schubert. There's a letter -- a letter he was  
12:20:01 6 copied on, I think, that's in the records.

12:20:09 7 Q. And Mr. Pratt, let me know when you've had a chance  
12:20:12 8 to open up that document.

12:20:14 9 A. Okay. It's a letter, Bates -- the BU number ends  
12:20:23 10 424, and it's a letter to Fred from Vinit Nijhawan.

12:20:30 11 Q. And is this the letter you were referring to that you  
12:20:33 12 saw that Mr. Connors was copied?

12:20:36 13 A. Yeah, it's this one. Was there -- was there another  
12:20:40 14 one? This must be the one, I guess, because it's dated  
12:20:44 15 July 16th. I thought -- yeah. Yeah. He is copied on this  
12:20:48 16 than would. This is definitely one I was thinking of.

12:20:51 17 Q. So is it then by February 22nd, BU had reached the  
12:20:56 18 conclusion that Dr. Stocker was not interested in  
12:21:00 19 reacquiring -- reacquiring the '475 Patent; is that correct?

12:21:05 20 A. No, that's -- that's actually not correct. E-mails  
12:21:09 21 -- if you look -- if you look at Dean Stocker's LinkedIn  
12:21:13 22 profile which is -- which handy, handy tool, you'll see that  
12:21:17 23 he stopped working at Thermal Fisher Scientific. And if you  
12:21:21 24 look at the e-mails that we sent to Dean Stocker, and I done  
12:21:25 25 this in preparation for deposition, the e-mails went to his

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12:21:29 1 Thermal Fisher account. So the high probability he didn't  
12:21:32 2 work for Therma Fisher when he got the e-mail. We sent  
12:21:35 3 those e-mails off, there was no response from Dean Stocker.  
12:21:38 4 There was no response, so therefore, there was still this  
12:21:41 5 opening, this gap. In fact, what I learned from his profile  
12:21:46 6 is he went off to become a volunteer in Malawi for like four  
12:21:51 7 years so he was a little out of communication, that  
12:21:54 8 transition happened a little later. But in any case we got  
12:21:56 9 no response from the e-mails and that's what the record  
12:21:59 10 shows. So we really didn't know where --

12:22:01 11 Q. Okay.

12:22:01 12 A. -- Dr. Stocker went.

12:22:03 13 Q. So I'm not asking about Dr. Stocker's LinkedIn  
12:22:07 14 profile or anything else that may have been going on, I'm  
12:22:10 15 asking about the representations that were made in this  
12:22:13 16 memorandum to the patent committee.

12:22:15 17 And if you read the -- it says, "the same  
12:22:18 18 proposal was made to Dr. Stocker on January 20th, 2010, the  
12:22:21 19 statement that should we not hear from him by February 8th,  
12:22:24 20 2010, we would assume he is not interested in the proposal.  
12:22:27 21 Dr. Stocker has not responded, therefore we assume he is not  
12:22:30 22 interested in the above proposed terms." Do you see that?

12:22:32 23 A. I do.

12:22:36 24 Q. So then it's correct to say that the recommendation  
12:22:38 25 to the patent committee was that Dr. Stocker was not

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12:22:42 1 interested in reacquiring the '475 Patent; correct?

12:22:45 2 A. The recommendation was to inform the committee that  
12:22:48 3 we were making this assumption.

12:22:51 4 Q. Okay. And the -- the ultimate recommendation made to  
12:22:54 5 the committee on February 22nd, 2010, was to return to  
12:22:58 6 patent to Professor Schubert alone; correct?

12:23:01 7 A. Well, we informed the committee -- given this  
12:23:05 8 recommendation, we informed the committee that there was  
12:23:08 9 still this assumption hanging out there. And --

12:23:12 10 Q. Well, let's look at --

12:23:14 11 A. What you saw is a follow-up is that because it was  
12:23:18 12 unresolved, we sent a certified letter to Dean Stocker to  
12:23:21 13 try to really get this nailed down. And once we understood  
12:23:24 14 that the certified letter was -- was opened up and at least  
12:23:27 15 somebody saw it so we knew the communication got through,  
12:23:31 16 then we -- we really felt more comfortable that Dean Stocker  
12:23:35 17 had been fairly informed of -- of this -- this action. So I  
12:23:39 18 think that -- I think that's the complete -- the complete  
12:23:43 19 record of it.

12:23:44 20 Q. So on February 22nd, 2010, Dr. Stevens recommended to  
12:23:48 21 the patent committee that the '475 Patent be returned to  
12:23:52 22 Dr. Schubert; correct?

12:23:52 23 A. Yes.

12:23:55 24 Q. Even though Dr. Stocker had not responded to the  
12:23:58 25 e-mails, correct?

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12:24:00 1 A. Well, the -- as I said, the facts that were reported  
12:24:04 2 to the committee is that there was an outstanding  
12:24:07 3 assumption. There was an action taken afterwards to try to  
12:24:10 4 close that loop a little bit by sending a certified letter  
12:24:14 5 so we could be ensured that this e-mail we were sending,  
12:24:17 6 evidently to a false e-mail address, we wanted to do more  
12:24:21 7 than that. We wanted to make sure he was well informed. So  
12:24:25 8 a certified letter was sent out. I don't know if that was  
12:24:28 9 the result of the conversation at the committee or advice  
12:24:31 10 from other people, but that was an action that was taken  
12:24:34 11 prior to continuing with the return process. Somebody  
12:24:41 12 decided if somebody wanted to really make sure that Dean  
12:24:44 13 Stocker was aware of all this.

12:24:45 14 Q. So my question was only about the recommendation made  
12:24:48 15 in this letter. The February 22nd, 2010 letter does not say  
12:24:53 16 anything about making further attempts to contact  
12:24:56 17 Dr. Stocker; correct?

12:24:57 18 A. It just talks about an assumption.

12:25:00 19 Q. Yeah. And my question is whether or not BU made any  
12:25:03 20 efforts to have the petition filed any time earlier than  
12:25:06 21 after that patent committee meeting on February 22nd, 2010?

12:25:12 22 A. Yeah, you know, I -- I'd like to give you the best  
12:25:15 23 answer I possibly can which is, you know, Ashley had spoken  
12:25:22 24 with counsel back in December, you know, showed him the  
12:25:25 25 relevant facts. Clearly, there's a whole bunch of activity

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12:25:30 1 about this return to Fred Schubert with the patent committee  
12:25:34 2 meeting, the writing to Dean Stocker, kind of getting all  
12:25:37 3 those ducks in a row.

12:25:39 4 There's possibly probably some caution, although  
12:25:42 5 I have nothing in the record, about reporting to the  
12:25:45 6 government and our government obligations, so I don't know.  
12:25:48 7 There's nothing in record that says it, but there could have  
12:25:51 8 been effort. Clearly there were efforts all around the  
12:25:54 9 patent. There was a lot of activity there. There were  
12:25:57 10 transitions of people in the office. There was a lot going  
12:26:00 11 on, and I -- the petition was filed on April 22nd. As far  
12:26:03 12 as I know, it was -- it was accepted, and that was the end  
12:26:06 13 of the story.

12:26:07 14 Q. As you sit here today, you are not aware of any  
12:26:10 15 reason why BU could not have filed the petition on  
12:26:13 16 February 23rd, 2010, for example, correct?

12:26:14 17 A. Okay. So I -- I could just restate the -- what I do  
12:26:17 18 know. I do know that Matt Connors filed the petition on  
12:26:20 19 April 22nd. I do know that Ashley Stevens had conversations  
12:26:23 20 and revealed all the -- all the -- all the details or some  
12:26:26 21 of the details to -- to Matt Connors back in December.  
12:26:29 22 That's -- that's what I know.

12:26:30 23 Q. And my question is not for, you know, an exhaustive  
12:26:33 24 list of the facts, you know, I'm asking a specific question  
12:26:36 25 of whether or not you are aware of any reason why BU could

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12:26:51 1 not have filed the petition to revive the '475 Patent on  
12:26:56 2 February 23rd, 2010. Yes or no?

12:26:58 3 A. Any -- any information related to that of whether we  
12:27:02 4 could or we could not, because as with action with the  
12:27:06 5 Patent Office, I rely on outside counsel for that. I don't  
12:27:09 6 have any facts that I can report to you about e-mails or  
12:27:12 7 discussions or efforts, because I could not find any one way  
12:27:15 8 or the other. So I don't know if there were some or if  
12:27:17 9 there weren't some. I just know the facts that I reported  
12:27:21 10 to you.

12:27:21 11 Q. Okay. And what did you do? Did you take any steps  
12:27:25 12 to prepare for your deposition today to find out whether BU  
12:27:28 13 took any steps to file the -- the revival petition at some  
12:27:32 14 point prior to April 22nd, 2010?

12:27:36 15 A. Well, I read through the materials of Ashley Stevens  
12:27:40 16 and Vinit Nijhawan. I also had conversations with them.  
12:27:44 17 They -- they don't have any more information than what's --  
12:27:48 18 what's in those testimonies, those depositions that -- that  
12:27:53 19 you have as well.

12:27:54 20 Q. So you referred a few times to some additional  
12:27:57 21 attempts to contact Dean Stocker. Do you recall that?

12:28:00 22 A. Yes.

12:28:01 23 Q. And these attempts were made after February 22nd,  
12:28:04 24 2010?

12:28:05 25 A. We can pull up the document and take a look at it. I

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12:28:09 1 don't -- don't -- probably but we can take a look at it. Do  
12:28:14 2 you have the -- do you have the letter there?

12:28:16 3 Q. Well, with this -- so you remember the patent  
12:28:19 4 committee meeting was on February 22nd, 2010; correct?

12:28:22 5 A. I do.

12:28:22 6 Q. And then you testified that additional efforts were  
12:28:24 7 made to contact Dr. Stocker following that meeting?

12:28:27 8 A. Yeah. I think a certified letter was sent to him.  
12:28:31 9 Correct.

12:28:32 10 Q. Okay. And at any point following February 22nd,  
12:28:36 11 2010, did Dr. Schubert indicate that there was -- that he  
12:28:41 12 might no longer be interested in the '475 Patent?

12:28:43 13 A. Not that I'm aware of.

12:28:45 14 Q. And ultimately Dean Stocker confirmed that he was not  
12:28:49 15 interested in having the '475 Patent confirmed to him -- or  
12:28:53 16 return returned to him, correct?

12:28:54 17 A. If I recall correctly, I think we have evidence that  
12:28:57 18 the certified letter was received. I'm not sure that we had  
12:29:01 19 an explicit confirmation from Dean Stocker.

12:29:04 20 Q. And that is what was recommended in the February 22nd  
12:29:07 21 2010 memorandum to the patent committee, correct?

12:29:10 22 A. Well, it didn't -- the committee recommendation is a  
12:29:14 23 very high level item. It doesn't get into the  
12:29:18 24 technicalities of how assignments are done and  
12:29:21 25 peculiarities. If there's a change in facts, something

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12:29:24 1 would go back to the committee. This isn't the -- the  
12:29:28 2 committees' rulings are not cast in stone. If there's a  
12:29:33 3 change in facts, something might come back to the committee.  
12:29:36 4 It's a discussion.

12:29:38 5 Q. Okay. Do --

12:29:39 6 A. So there was a recommendation, they approved the  
12:29:43 7 recommendation, there was some follow-up to that. Yeah,  
12:29:45 8 there could have been lots of different possibilities that  
12:29:48 9 happened after that committee meeting that might have  
12:29:50 10 changed the actions. But this is -- we know -- there is no  
12:29:51 11 since in debating that. We know the facts. The facts were  
12:29:51 12 that Boston University assigned the patent to Professor  
12:30:00 13 Schubert.

12:30:00 14 Q. And you see in the second paragraph, he says, as  
12:30:04 15 "we've been shifting responsibilities and portfolios in the  
12:30:08 16 office, my esteemed and extremely able colleague, Jon Jensen  
12:30:11 17 copied here is handling the return of the invention to you.  
12:30:14 18 Jon is briefed on status and next steps needed and will be  
12:30:17 19 getting in touch with you." Do you see that?

12:30:20 20 A. Yes.

12:30:20 21 Q. So you referred a few times in your testimony today  
12:30:23 22 to changes happening in the office. Is it your  
12:30:25 23 understanding that those changes are being -- are what's  
12:30:28 24 being referred to in this e-mail?

12:30:30 25 A. Yeah. Shifting responsibilities, people -- the

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12:30:33 1 reorganization of the office, yes.

12:30:35 2 Q. And was the shift in responsibilities and  
12:30:38 3 reorganization of the office that was occurring at this  
12:30:40 4 time?

12:30:41 5 A. So, as Vinit had testified, and I testified earlier,  
12:30:45 6 Vinit as an award best managing director created three  
12:30:51 7 operating units where before there weren't those three  
12:30:53 8 operating units. It was a business development group,  
12:30:57 9 intellectual property and licensing group and the operations  
12:30:59 10 group. And both Sean and Jon were part of this business  
12:31:03 11 development group.

12:31:03 12 Under Ashley's management prior to  
12:31:08 13 February 2010, I believe the reporting structure was Sean  
12:31:11 14 reported to Ashley. And I think Jon might have officially  
12:31:16 15 report -- reported to Ashley, as far as the university was  
12:31:20 16 concerned, but certainly reported to Sean with regard to  
12:31:24 17 portfolio responsibilities, was -- was junior to Sean. And  
12:31:28 18 as part of the reorganization right during this time frame,  
12:31:32 19 Jon then started to assume responsibility for some of the  
12:31:35 20 portfolio and Sean for -- for -- that was kind of like a  
12:31:40 21 division of the portfolio, where some people take some cases  
12:31:42 22 and some people would take other cases. So Jon -- I guess  
12:31:42 23 you could say Jon was promoted to what we used to call --  
12:31:52 24 what we still call people director of business development.  
12:31:52 25 So in the old regime he was referred to as a licensing

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12:31:58 1 assistant Sean was a licensing associate. The licensing  
12:32:02 2 associates we sort of changed that name to the director of  
12:32:05 3 business development. So Jon become Sean's peer if --  
12:32:09 4 that's probably a way to think about it in the  
12:32:11 5 organizational structure. And both of them at this time --  
12:32:13 6 because Ashley was gone now, in this new structure would  
12:32:17 7 have reported to me in that title I mentioned earlier in  
12:32:20 8 deposition, when I became what they called executive  
12:32:23 9 director of business development.

12:32:24 10 So right around that -- that February time after  
12:32:27 11 that patent committee, when Ashley testified that he was  
12:32:31 12 done with the office, these changes started to take place  
12:32:34 13 inside of OTD.

12:32:37 14 Q. Okay. So did the shift in responsibilities, did it  
12:32:40 15 impact the OTD's ability to effectively perform its  
12:32:45 16 function?

12:32:45 17 A. Well, I mean, that's a great question. There was a  
12:32:50 18 huge change going on. It's like a seismic shift going on  
12:32:55 19 where Ashley who had run the office since the mid '90s was  
12:32:59 20 -- was -- was stepping down and Vinit was coming onboard  
12:33:02 21 with a brand-new vision. So everything was up in the air.  
12:33:05 22 And we were restructuring around these different -- you  
12:33:09 23 know, these different fields of responsibility, like  
12:33:12 24 business development versus the intellectual property and  
12:33:15 25 licensing. So I know we were a small office of just, you

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12:33:17 1 know, a dozen or so people but when you make a big  
12:33:20 2 organizational change like that it disrupts everything. I  
12:33:23 3 mean, they had us looking at new databases, mapping out our  
12:33:26 4 work flows, shifting our responsibilities a little bit. So  
12:33:29 5 yeah, this was, like a super busy time, and it disrupted all  
12:33:35 6 of our operations. In fact, I even look at those patent  
12:33:38 7 committee meetings, because there was some discussion about  
12:33:40 8 when the next patent committee meeting was. Vinit was --  
12:33:45 9 they canceled the main one because there was -- the next one  
12:33:49 10 they had was August of 2020. So yeah, this is was a huge  
12:33:54 11 disruption, it was a busy time in our lives, there was a lot  
12:33:57 12 going on.

12:33:59 13 Q. Are you aware of whether other than in this lawsuit,  
12:34:03 14 BU or its employees have ever been accused of committing  
12:34:09 15 inequitable conduct in front of the U.S. Patent Office?

12:34:12 16 A. Not that I recall. No, I'm not aware of -- of  
12:34:16 17 anything of that nature.

12:34:18 18 Q. And does -- does BU believe that it committed  
12:34:23 19 inequitable conduct?

12:34:24 20 A. In my opinion, I don't think we did, no.

12:34:27 21 Q. Okay. Is that -- is that your personal opinion or is  
12:34:32 22 it the -- the position of Boston University?

12:34:34 23 A. Yeah, I think I'm speaking on behalf of BU in this  
12:34:38 24 case as the managing director of the tech transfer office.  
12:34:42 25 I -- it -- this -- I don't think we did anything wrong.

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12:34:46 1 Q. And what is your basis for believing that Boston  
12:34:49 2 University did not commit inequitable conduct?

12:34:52 3 A. Well, the facts are pretty straightforward. I mean,  
12:34:55 4 we -- we had a maintenance fee coming up. We reached out to  
12:34:58 5 the inventor to see if he was interested in it, he said no.  
12:35:02 6 If -- if he had said yes at that time, we probably would  
12:35:06 7 have paid the fee. And we -- the fee wasn't paid. Then in  
12:35:10 8 December or shortly thereafter, he evidently changed his  
12:35:13 9 mind or some -- there was a change in facts. He reached out  
12:35:17 10 to us and said he wanted it back. A person at BU had a  
12:35:20 11 discussion with outside counsel, provided the facts to  
12:35:23 12 outside counsel. A petition was filed. A petition was  
12:35:26 13 granted. That was it. It's that simple.

12:35:30 14 Q. So it's your understanding that -- so you said that  
12:35:35 15 there's -- in December, Professor Schubert evidently changed  
12:35:40 16 his mind or there was a change in facts.

12:35:45 17 Did -- what -- what change in facts are you --  
12:35:50 18 are you referring to?

12:35:55 19 A. Well, in September, Professor Schubert wrote to us  
12:35:58 20 and said he wasn't interested. In December -- these are  
12:36:02 21 both 2009 -- he wrote and he said he wanted to talk about  
12:36:05 22 it. He subsequently expressed his interest in the patent.

12:36:08 23 Q. Okay. And did Professor Schubert ever inform BU why  
12:36:12 24 he changed his mind on his interest in the patent?

12:36:15 25 A. No.

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12:36:16 1 Q. Okay. So Mr. Pratt, did BU ever attempt to inform  
12:36:19 2 the Patent Office of the -- of the reasons why it did not  
12:36:23 3 timely pay the second maintenance fee for the '475 Patent?

12:36:26 4 A. My only information is that Mr. Connors filed a  
12:36:33 5 petition on April 22nd.

12:36:35 6 Q. And we saw in the petition, if you recall, there was  
12:36:38 7 a statement certifying that the delay was unintentional.

12:36:42 8 Correct?

12:36:43 9 A. That's.

12:36:45 10 Q. Do you remember that?

12:36:45 11 A. That's what the petition says, yes.

12:36:47 12 Q. And do you recall whether after that petition was  
12:36:49 13 filed, BU ever considered providing more information to the  
12:36:54 14 patent office concerning the circumstances of the delay?

12:36:56 15 A. I'm not aware of any information or further  
12:36:59 16 communications on the matter.

12:37:02 17 Q. How much money is Professor Schubert -- how much  
12:37:06 18 money has BU received from Professor Schubert relating to  
12:37:09 19 the '475 Patent?

12:37:10 20 A. I think we provided a check that we received in  
12:37:15 21 May 20, 2019. And I'm sorry, I'm not going to quote the  
12:37:18 22 exact amount, but it's approximately \$395,000. And I think  
12:37:23 23 part of this past patent cost that was due was kind of  
12:37:24 24 wrapped into that payment. So I -- I think it -- it was  
12:37:31 25 wrapped in that. I forget. I have to look at that, but

Michael Pratt - video

12:37:35 1 suffice it to say, it's about \$395,000.

12:37:39 2 Q. So as far as you're -- as far as you're aware, that  
12:37:43 3 check constitutes the total sum that Professor Schubert has  
12:37:46 4 to date paid BU for the '475 Patent?

12:37:50 5 A. Minus these -- these upfront amounts that --

12:37:53 6 Q. Does BU expect to receive any additional revenue from  
12:37:57 7 -- from Professor Schubert relating to the '475 Patent?

12:38:00 8 A. It's possible.

12:38:02 9 Q. Okay. Possible from -- from this lawsuit against  
12:38:05 10 Lumileds?

12:38:06 11 A. Yeah.

12:38:08 12 Q. Okay. I put a document through the chat. That will  
12:38:11 13 be Exhibit 22 to your deposition. And for the record, it's  
12:38:14 14 a document produced in the case with Bates number BU 001354.  
12:38:23 15 Mr. Pratt, let me know when you have opened that document?

12:38:26 16 A. I have an opened -- it's an e-mail from me to Ken  
12:38:30 17 Lutchen and Tom Bifano.

12:38:32 18 Q. Who are the two individuals to whom you sent this  
12:38:35 19 e-mail?

12:38:36 20 A. So one is Kent, Kenneth Lutchen. He's the Dean of  
12:38:40 21 our School of Engineering. And the other is Thomas Bifano  
12:38:42 22 who is a faculty, might be in engineering, but his primary  
12:38:44 23 role is director of the Photonics Center. And then I copied  
12:38:51 24 Kristy Talley who is in our office of general counsel, and  
12:38:54 25 Gloria Waters who is my boss and the vice-president of

Michael Pratt - video

12:39:00 1

research.

12:39:01 2

Q. Okay. Now, do you see that in this e-mail you -- you

12:39:10 3

write that Professor Schubert want to visit BU and deliver a

12:39:14 4

check for about \$400,000 for this -- for his settlements?

12:39:18 5

A. Yes.

12:39:20 6

Q. And he asked about the possibility of a photo op and

12:39:24 7

maybe a short story celebrating the achievement. Do you see

12:39:27 8

that?

12:39:28 9

A. Yes.

12:39:28 10

Q. Do you recall Professor Schubert asking you about

12:39:31 11

these things?

12:39:32 12

A. Yes.

12:39:33 13

Q. And what do you recall about your conversation with

12:39:37 14

Mr. Schubert?

12:39:38 15

A. Well, almost exactly what it says here. He phoned

12:39:41 16

me, he made that request. And I said, "let me, you know,

12:39:46 17

just float it by a few people and see what they think." I

12:39:50 18

said, "I am certainly happy to meet with you when you come."

12:39:55 19

Q. And did Professor Schubert inform you why he wanted

12:39:52 20

to do this visit and photo op and story?

12:40:04 21

A. Okay. My recollection is that he said he wanted to

12:40:07 22

come and -- and celebrate his success of his settlements

12:40:12 23

with these companies, and he was proud to provide some money

12:40:16 24

back to the university. It was sort of a point of pride.

12:40:22 25

Q. Okay. This will be Exhibit 23 to your deposition.

Michael Pratt - video

12:40:26 1 And it's a document produced in this case that has Bates  
12:40:30 2 number BU 001356. And then does this e-mail refer to the  
12:40:37 3 lunch that you had suggested in the e-mail we just looked  
12:40:40 4 at?

12:40:40 5 A. Yes.

12:40:42 6 Q. Okay. So Professor Schubert did come to BU and had a  
12:40:46 7 lunch with you and Dean Stocker and Thomas Bifano; is that  
12:40:53 8 correct?

12:40:53 9 A. That is correct.

12:40:54 10 Q. Okay. And do you see this e-mail Professor Schubert,  
12:40:58 11 he handed over the \$395,000 check at that lunch; is that  
12:41:04 12 correct?

12:41:04 13 A. He did, yes.

12:41:07 14 Q. Okay. And you see he where is, "a couple of  
12:41:11 15 photographs are attached"?

12:41:12 16 A. Yes.

12:41:13 17 Q. The next document should be through momentarily.  
12:41:17 18 It's going to be Exhibit 24. And it has Bates number BU  
12:41:22 19 001356A.

12:41:22 20 And Mr. Pratt, let me know when you have it  
12:41:22 21 open?

12:41:32 22 A. I have open before me, looks like two -- two  
12:41:32 23 photographs.

12:41:32 24 Q. Okay. And are these the photographs that were  
12:41:42 25 attached to the e-mail we just looked at?

Michael Pratt - video

12:41:43 1

A. Yes.

12:41:45 2

Q. Okay. And are these photographs from the lunch that

12:41:47 3

we -- that were referenced in that e-mail?

12:41:51 4

A. Yes.

12:41:52 5

Q. And I see -- I see you in -- in the photos, but can

12:41:57 6

you just identify, from left to right, who those individuals

12:42:00 7

are?

12:42:00 8

A. Sure. The gentleman with the beard on the far left

12:42:03 9

is Dean Stocker. And the taller gentleman with the glasses

12:42:07 10

to his right is -- is Professor Schubert. And to his right,

12:42:11 11

the gentleman next to me is Professor Bifano. And that's

12:42:16 12

myself.

12:42:18 13

Q. Okay. And am I correct in understanding the piece of

12:42:25 14

paper that Professor Schubert and Thomas Bifano are holding,

12:42:29 15

is that the \$395,000 check?

12:42:31 16

A. It is.

12:42:32 17

Q. Okay. I'm going to put another document into the

12:42:35 18

chat. This will be Exhibit 25 to your deposition.

12:42:49 19

This is a document produced Bates number BU

12:42:52 20

001566.

12:42:58 21

Do you recognize this document?

12:42:59 22

A. Yes, that's the check that we were holding.

12:43:05 23

Q. So the -- the picture shown in Exhibit 25 is an image

12:43:10 24

of a check that Professor Schubert gave to BU to pay per his

12:43:16 25

agreement with BU; is that correct?

Michael Pratt - video

12:43:18 1 A. Correct.

12:43:19 2 Q. So that will be the next exhibit to your deposition,

12:43:25 3 Mr. Pratt. And it's a document with the Bates number BU

12:43:29 4 001567 through 69. And just can you please let me know when

12:43:33 5 you've had a chance to open that?

12:43:35 6 A. Yes. I have a three-page document. And the -- well

12:43:38 7 the first -- the first page ends in 1567 for the BU number.

12:43:44 8 And it's the -- we just talked about this earlier today.

12:43:48 9 This is the interaction I had with Sean Lee over the

12:43:52 10 LinkedIn.

12:43:54 11 Q. And if you could please go down to the second page of

12:44:00 12 the document, and the last message there on the bottom of

12:44:05 13 that page that you sent to Sean Lee at 8:24 a.m.?

12:44:12 14 A. Yes.

12:44:13 15 Q. Do you see that about one, two, three, four lines

12:44:17 16 down, you write "the BU lawyer, his name is Mike Rader from

12:44:22 17 the law firm of Wolf Greenfield. Would like to speak to you

12:44:25 18 about those e-mails"?

12:44:27 19 A. Yes.

12:44:28 20 Q. Do you know whether or not Mr. Rader has ever spoken

12:44:32 21 to Sean Lee about this lawsuit?

12:44:34 22 A. Yes. Mike Rader did have a conversation with Sean

12:44:38 23 Lee about the lawsuit.

12:44:42 24 Q. Okay. Were you present for that conversation?

12:44:43 25 A. No.

Michael Pratt - video

12:44:44 1 Q. When was that conversation?

12:44:47 2 A. Oh, so I got the phone number. What's the date of

12:44:52 3 this? What is this? Sorry. June 18th, I think, right?

12:44:58 4 June -- so that LinkedIn conversation I had with Sean was on

12:45:03 5 June 18th --

12:45:04 6 Q. Uh-huh --

12:45:06 7 A. -- of 2020, so it was some time after that.

12:45:11 8 Q. Do you know was it before or after you had your

12:45:14 9 conversation with Sean Lee in preparation for the

12:45:16 10 deposition?

12:45:16 11 A. It was before.

12:45:17 12 Q. And did -- when you spoke to Sean Lee, did you

12:45:21 13 discuss at all the conversation that he had with Mr. Rader?

12:45:24 14 A. No, he mentioned that he had the conversation, but

12:45:27 15 mentioned he didn't really have anything to share, no real

12:45:31 16 recollections or anything.

12:45:32 17 Q. So it was Sean Lee who informed you that he had the

12:45:35 18 conversation with Mr. Rader?

12:45:37 19 A. No, I -- I learned about that from -- from counsel.

12:45:42 20 (End of testimony.)

12:45:42 21 THE COURT: All right.

12:45:42 22 MS. DESAI: Your Honor, based on the testimony

12:45:42 23 from Michael Pratt we moved to admit the following documents

12:45:52 24 in the order that they were played during the deposition.

12:45:52 25 DTX 88. JTX 11. JTX 14. DTX 75. DTX 77. DTX 78. DTX

Michael Pratt - video

12:46:11 1

76. And DTX 89.

12:46:14 2

THE COURT: Any objections?

12:46:20 3

MR. BOLLINGER: Your Honor, we don't object to

12:46:24 4

any of the exhibits coming in.

12:46:26 5

THE COURT: All right. They're admitted.

12:46:28 6

(The above exhibits were admitted into

12:46:31 7

evidence.)

12:46:31 8

THE COURT: Is the only thing we have left is

12:46:33 9

Mr. Connors' video.

12:46:36 10

MR. MOLANO: Yes, Your Honor. For an hour and

12:46:38 11

fifteen.

12:46:40 12

THE COURT: All right. How about we -- let's

12:46:42 13

take our lunch break and then we'll hear that. Let's take

12:46:44 14

an hour. We'll come back at 1:45.

12:46:52 15

(A luncheon recess was taken.)

13:33:22 16

THE COURT: Please be seated. Okay. Next.

13:49:04 17

MR. BOLLINGER: Your Honor, can I raise a

13:49:09 18

procedural issue going forward. My understanding is we have

13:49:12 19

one last witness for the defendant in this case, about an

13:49:16 20

hour and 15 minutes. And then we have Professor Schubert

13:49:20 21

who is going to testify. I don't think it's going to be

13:49:23 22

more than maybe an hour, I'm not sure how long cross is

13:49:26 23

going to be. We're going to respectfully request that we

13:49:30 24

start openings tomorrow morning instead of late this

13:49:34 25

afternoon.

Michael Pratt - video

13:49:34 1 MR. MOLANO: I believe he means closings.

13:49:36 2 MR. BOLLINGER: I'm sorry, closings.

13:49:40 3 MR. MOLANO: Your Honor, we would be amenable to

13:49:42 4 that.

13:49:43 5 THE COURT: How about we do this. How about --

13:49:46 6 so it's going to be Dr. Schubert and that's it, there is no

13:49:49 7 rebuttal or anything?

13:49:51 8 MR. MOLANO: There will be a cross of

13:49:53 9 Dr. Schubert.

13:49:54 10 THE COURT: I meant after Dr. Schubert gets off

13:49:56 11 the stand. Why don't we do this. Let's start, I hate to do

13:50:00 12 this if it's going to be -- if it's going to keep you guys

13:50:07 13 in town later, but how about we start them in the afternoon

13:50:11 14 rather than at 8:30 in the morning.

13:50:13 15 MR. BOLLINGER: I was planning on being here

13:50:15 16 anyway.

13:50:16 17 THE COURT: Because I only have from 8:30 to

13:50:19 18 10:30 and then it's a hard cutoff and I rather if we started

13:50:23 19 at 2:15, then whatever time you have left you can use.

13:50:27 20 MR. MOLANO: That would be good.

13:50:31 21 THE COURT: Let's do that.

13:50:32 22 MR. MOLANO: One more procedural point, Your

13:50:33 23 Honor. After we're done with our case in chief with the

13:50:36 24 last witness, we have a different trial team that will be

13:50:39 25 coming in.

Matthew Connors - video

13:50:39 1

THE COURT: That's fine.

13:50:40 2

MR. MOLANO: Will it be okay --

13:50:41 3

THE COURT: I didn't mean to suggest that you

13:50:44 4

had to have four people here at all times, just four at a

13:50:47 5

time.

13:50:48 6

MR. MOLANO: Thank you.

13:50:50 7

THE COURT: Mr. Connors.

13:50:53 8

MR. MOLANO: Yes, Your Honor, the defendant

13:50:54 9

calls Matthew Connors.

13:50:56 10

(Deposition testimony of Matthew Connors:)

13:51:02 11

Q. Good morning, Mr. Connors. Can you please state your

13:51:04 12

name for the record?

13:51:05 13

A. Matthew Edward Connors.

13:51:07 14

Q. And I understand you live in Massachusetts?

13:51:11 15

A. I do.

13:51:12 16

Q. What town do you live in?

13:51:13 17

A. Hingham.

13:51:15 18

Q. Did you understand that today you're here testifying

13:51:17 19

in response to two subpoenas?

13:51:22 20

A. Yes.

13:51:23 21

Q. And that there's one subpoena to you individually and

13:51:28 22

one subpoena issued to your law firm?

13:51:32 23

A. Yes.

13:51:32 24

Q. And just so I get it right during the deposition, can

13:51:36 25

you pronounce the name of your law firm for me?

Matthew Connors - video

13:51:39 1 A. Sure. Gesmer Updegrove LLP.

13:51:46 2 Q. Just for the record I'm going to introduce the  
13:51:50 3 deposition subpoenas as exhibits. Mr. Connors, do you see  
13:51:53 4 on your screen now the subpoena that was issued to you  
13:51:57 5 individually in this action?

13:52:00 6 A. It looks like the subpoena that was served to me, at  
13:52:06 7 least the first page.

13:52:07 8 Q. And if I scroll through, that is -- the rest of the  
13:52:11 9 subpoena is there? So we're going to mark this subpoena to  
13:52:21 10 you individually as Exhibit 1 to today's deposition.

13:52:28 11 And do you understand, Mr. Connors, that in  
13:52:33 12 response to this subpoena you're here to testify to the  
13:52:38 13 extent of your personal knowledge?

13:52:40 14 A. Yes.

13:52:42 15 Q. I'm now going to introduce the second subpoena. Are  
13:52:46 16 you able to see that document, Mr. Connors?

13:52:58 17 A. Yes.

13:53:01 18 Q. So we're going to mark as Exhibit 2 to today's  
13:53:05 19 deposition, this is the subpoena to testify at a deposition  
13:53:09 20 to Gesmer Updegrove.

13:53:14 21 And Mr. Connors, have you reviewed this subpoena  
13:53:17 22 before today?

13:53:18 23 A. Yes.

13:53:20 24 Q. And if I scroll down, you see that there are a series  
13:53:22 25 of topics here?

Matthew Connors - video

13:53:28 1

A. I see that.

13:53:29 2

Q. And you understand that in response to this subpoena

13:53:33 3

you are here to testify to your firm's knowledge regarding

13:53:36 4

these noticed topics; is that correct?

13:53:39 5

A. Yes.

13:53:41 6

Q. And if I scroll up to the definitions here on page 1,

13:53:50 7

do you see there's a definition of you, your and the firm,

13:53:55 8

that is Item Number 4 on this page?

13:53:59 9

A. Yes.

13:54:00 10

Q. And do you see that that definition covers not just

13:54:04 11

your current firm, Gesmer Updegrave, but your former firm

13:54:11 12

Gauthier & Connors that merged with Gesmer & Updegrave, and

13:54:16 13

then your former firm of Samuels, Gauthier & Stevens. Do

13:54:20 14

you see that?

13:54:20 15

A. Yes.

13:54:20 16

Q. Are you prepared to testify on behalf of those

13:54:24 17

entities today?

13:54:25 18

A. Yes.

13:54:25 19

Q. Mr. Connors, to start out, can you just briefly run

13:54:30 20

through your educational history, college, and law school,

13:54:38 21

where you went when you graduated?

13:54:40 22

A. Sure. I have an under graduate bachelor of arts

13:54:44 23

degree from Stoneham College, 1984. It was part of a 3/2

13:54:50 24

engineering program with the University of Notre Dame, and

13:54:54 25

finished a bachelor of science in electrical engineering at

Matthew Connors - video

13:54:58 1 Notre Dame in 1985.

13:55:00 2 I -- after graduating from -- you just want  
13:55:07 3 education?

13:55:09 4 Q. Start with education, and then we'll go past that  
13:55:13 5 into your employment history.

13:55:14 6 A. Okay. From there I went to Catholic University  
13:55:19 7 School of Law, graduated 1990, Washington D.C.

13:55:25 8 Q. After you graduated law school, how did you begin  
13:55:29 9 your legal career?

13:55:30 10 A. I moved to Boston and started as an associate with  
13:55:37 11 Fish & Richardson in Boston.

13:55:43 12 Q. And how long were you at Fish & Richardson?

13:55:49 13 A. One year.

13:55:50 14 Q. Where did you go after Fish & Richardson?

13:55:54 15 A. I went to Samuals Gauthier & Stevens in Boston.

13:55:59 16 Q. And for how many years were you at that firm?

13:56:02 17 A. Well, it transformed by name over several years until  
13:56:06 18 we merged with Gesmer Updegrave in 2011.

13:56:12 19 Q. And in 2011 Gauthier & Connors merged with Gesmer  
13:56:19 20 Updegrave?

13:56:20 21 A. Correct.

13:56:23 22 Q. So since 1991, you have not actually taken a new job  
13:56:28 23 switching law firms, correct? It's all been different  
13:56:33 24 iterations of the same firm and practice?

13:56:35 25 A. More or less, yes.

Matthew Connors - video

13:56:38 1 Q. And at one point in your career you were a patent  
13:56:44 2 examiner; correct?

13:56:45 3 A. I was.

13:56:46 4 Q. What years were you an examiner?

13:56:51 5 A. 1986 through 1988.

13:56:56 6 Q. And did your training to become a patent examiner  
13:57:00 7 require you to become familiar with the Patent Office's  
13:57:03 8 rules and procedures?

13:57:04 9 A. It did.

13:57:06 10 Q. And did that include becoming familiar with the MPEP?

13:57:11 11 A. Yes, it did.

13:57:12 12 Q. And so at the time you were an examiner, you would  
13:57:16 13 have been familiar with the versions of the MPEP that were  
13:57:20 14 in effect during that time, correct?

13:57:22 15 A. I believe I would have been.

13:57:24 16 Q. And is the same true for the federal regulations that  
13:57:32 17 govern PTO procedure?

13:57:34 18 A. As a patent examiner, hard to tell. Some of them,  
13:57:41 19 yes.

13:57:42 20 Q. So you agree that, for example, Title 37 of the Code  
13:57:48 21 of Federal Regulations includes regulations governing the  
13:57:52 22 Patent Office procedure; correct?

13:57:52 23 A. Yes.

13:57:52 24 Q. And at the time you were an examiner, were you  
13:57:52 25 required to be familiar with Title 37 of the CFR?

Matthew Connors - video

- 13:58:03 1 A. Familiar with Title 37, yes.
- 13:58:10 2 Q. And when you were an examiner, did your work focus on
- 13:58:14 3 a specific technology area?
- 13:58:17 4 A. It did.
- 13:58:17 5 Q. What was the technology area?
- 13:58:20 6 A. Telephony.
- 13:58:27 7 Q. That's it? Telephony was the -- your subject matter?
- 13:58:34 8 A. That was the group I was in.
- 13:58:39 9 Q. Now, when you went into private practice, has your
- 13:58:43 10 practice focused on patent prosecution matters throughout
- 13:58:46 11 your career?
- 13:58:48 12 A. Yes.
- 13:58:53 13 Q. Has that been the sole focus of your private
- 13:58:56 14 practice?
- 13:58:56 15 A. Not the sole focus.
- 13:58:58 16 Q. If you had to put a percentage on it, what would you
- 13:59:02 17 say is the percentage of your practice you've devoted to
- 13:59:08 18 patent prosecution?
- 13:59:09 19 A. Likely over 90 percent.
- 13:59:12 20 Q. And so in your private practice, you've remained
- 13:59:16 21 familiar with the MPEP as it's been revised over time?
- 13:59:21 22 A. Over time.
- 13:59:23 23 Q. You remain familiar with the MPEP today?
- 13:59:28 24 A. When needed.
- 13:59:32 25 Q. How often would you say you go back and refresh your

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- 13:59:35 1 knowledge as to the contents of the MPEP?
- 13:59:40 2 A. Hard to say generally. My practice is to use the
- 13:59:43 3 MPEP when issues require that it be used.
- 13:59:47 4 Q. But would you agree that you consult the MPEP
- 13:59:54 5 regularly as part of your patent practice?
- 13:59:57 6 A. It's part of my practice.
- 14:00:00 7 Q. And how about Title 37 of the CFR, have you remained
- 14:00:07 8 up-to-date on changes in those regulations?
- 14:00:10 9 A. When the changes are made, I believe I am.
- 14:00:16 10 Q. So is it fair to say that in the 2009 to 2010 time
- 14:00:22 11 frame you would have been familiar with the operative
- 14:00:25 12 version of the MPEP?
- 14:00:29 13 A. I believe I would be, yes.
- 14:00:33 14 Q. And in the 2009-2010 time frame, you would have been
- 14:00:37 15 familiar with the operative version of Title 37 of the CFR?
- 14:00:43 16 A. Yes.
- 14:00:44 17 Q. In the course of your career in private practice, how
- 14:00:48 18 much work have you done for Boston University?
- 14:00:52 19 A. It was more -- it's hard to say. We did work in the
- 14:01:00 20 '90s and early 2000s.
- 14:01:12 21 Q. Could you approximate how many years Boston
- 14:01:15 22 University was a client of yours?
- 14:01:18 23 A. I would say it started in the mid '90s.
- 14:01:23 24 Q. And went through the early 2000s?
- 14:01:32 25 A. The bulk of the work was in that span.

Matthew Connors - video

14:01:36 1 Q. Have you continued to do any work for BU since then?

14:01:41 2 A. I don't recall specifically doing much for BU since  
14:01:48 3 then.

14:01:49 4 Q. And were you the only attorney at your firm doing  
14:01:52 5 work for BU, or were there others involved as well?

14:01:56 6 A. It was a client that I managed, and there were other  
14:02:01 7 attorneys that did work on BU cases.

14:02:05 8 Q. So then is it accurate to say that you're not doing  
14:02:09 9 any work for BU today?

14:02:11 10 A. I'm not actively doing work for BU today.

14:02:14 11 Q. And other than the allegations raised by Osram and  
14:02:19 12 Lumileds, is it then correct that you have not ever been  
14:02:24 13 accused of inequitable conduct in your career?

14:02:27 14 A. That's correct.

14:02:28 15 Q. So Exhibit 3 is a document with the title "petition  
14:02:32 16 to accept unintentionally delayed payment of maintenance fee  
14:02:37 17 in an expired patent (37 CFR 1.378 NC)." Do you see that  
14:02:45 18 Mr. Connors?

14:02:46 19 A. I do.

14:02:46 20 Q. And would you agree with me that it's important that  
14:02:49 21 the individual who submits a revival petition ensures that  
14:02:52 22 that certification is, in fact, true, correct?

14:02:52 23 A. As a practitioner I have to have the belief that it  
14:03:01 24 is true.

14:03:04 25 Q. It has to be a reasonable belief, correct?

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- 14:03:06 1 A. It has to be a reasonable belief.
- 14:03:10 2 Q. And there's a -- as a practitioner, you owe a duty of
- 14:03:17 3 candor, that is the source of that requirement, is that
- 14:03:22 4 correct?
- 14:03:22 5 A. Yes.
- 14:03:23 6 Q. Okay. And would you agree with me that the Patent
- 14:03:26 7 Office counts on practitioners complying with the duty of
- 14:03:30 8 candor to ensure a reasonable belief that submitted
- 14:03:35 9 statements of unintentional delay are true?
- 14:03:40 10 A. Yes.
- 14:03:42 11 Q. And you would agree with me that a revival petition
- 14:03:46 12 cannot be filed in good faith if the delay was intentional,
- 14:03:51 13 correct?
- 14:03:51 14 A. It can't be filed by me if I do not have a belief
- 14:03:56 15 that the patent was not unintentionally abandoned.
- 14:04:02 16 Q. I think there may have been a double negative mixed
- 14:04:11 17 up in there. Just to be clear, you as the patent
- 14:04:16 18 practitioner could not file a revival petition if you do not
- 14:04:21 19 have a reasonable belief that the patent was unintentionally
- 14:04:26 20 abandoned, correct?
- 14:04:29 21 A. Correct.
- 14:04:32 22 Q. And would you agree with me that a patent owner who
- 14:04:40 23 deliberately decides to not timely pay the maintenance fee
- 14:04:44 24 cannot avail itself of a revival petition?
- 14:04:47 25 A. Deliberately?

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14:04:51 1 If a patent owner intentionally abandons a  
14:05:00 2 patent, they cannot revive the patent.

14:05:02 3 Q. So you would agree with me, then, that if a patentee  
14:05:06 4 decides that it does not want to keep the patent alive and,  
14:05:10 5 therefore, decides not to pay the maintenance fee, that  
14:05:14 6 patent owner cannot appropriately file a revival petition,  
14:05:18 7 is that correct?

14:05:19 8 A. If it was truly intentional to abandon the patent,  
14:05:25 9 then the patent owner cannot revive the patent.

14:05:30 10 Q. What is it your understanding of what it means for a  
14:05:33 11 delay to be unintentional?

14:05:36 12 A. Unintentional would mean not on purpose, perhaps a  
14:05:40 13 mistake involved, misunderstanding, miscommunication, that  
14:05:43 14 leads to a non-purposed action that leads to the patent  
14:05:53 15 going abandoned.

14:05:56 16 Q. You mean things like forgetting the deadline,  
14:06:01 17 forgetting to submit the form to pay?

14:06:05 18 A. It could mean many, many things; not docketing  
14:06:12 19 issues, talking about the wrong patent, communication  
14:06:20 20 amongst people within the decision chain. That's easier --  
14:06:28 21 go ahead.

14:06:31 22 Q. An unintentional delay would not include a situation  
14:06:38 23 where the patentee deliberately decides to not make the  
14:06:45 24 payment and memorializes its intent not to do so in advance  
14:06:48 25 of the deadline; correct?

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14:06:49 1 A. This is a very -- hypothetically, yes.

14:06:54 2 Q. Can you think of any situations in which a patent  
14:06:58 3 owner's deliberate decision to not timely pay the  
14:07:01 4 maintenance fee would constitute an unintentional delay?

14:07:06 5 A. I became aware of that Network Signatures case where  
14:07:11 6 there was apparently a deliberate abandonment, and the  
14:07:17 7 revival afterward. Hypothetically I could envision  
14:07:32 8 communication errors within a patentee -- it depends if the  
14:07:36 9 patentee is one person in the decision chain or multiple  
14:07:40 10 people in the decision chain, so I'm not sure I follow your  
14:07:43 11 logic there.

14:07:47 12 Q. So Mr. Connors, you mentioned the *Network Signatures*  
14:07:51 13 case. Do you recall when you became aware of that case?

14:07:54 14 A. Before this matter.

14:07:56 15 Q. Do you recall approximately what year you became  
14:08:07 16 aware of the case?

14:08:08 17 A. I believe it was a 2013 case.

14:08:12 18 Q. Do you recall how you became aware of the *Network*  
14:08:17 19 *Signatures* case?

14:08:19 20 A. I think that would be privileged communication.

14:08:24 21 Q. And you mentioned your understanding of the *Network*  
14:08:30 22 *Signatures* case is that a deliberate delay was found to be  
14:08:35 23 unintentional, is that correct?

14:08:36 24 A. That's vaguely my recollection.

14:08:38 25 Q. Are you aware of any other instances which a

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14:08:45 1 deliberate delay was found to be unintentional?

14:08:49 2 A. I don't recall.

14:08:52 3 Q. And the understanding you have of what it means for a  
14:08:58 4 delay to be unintentional and intentional, did you have that  
14:09:03 5 same understanding in 2009?

14:09:06 6 A. I believe I did.

14:09:08 7 Q. And we've been talking about whether or not the delay  
14:09:15 8 is unintentional. You would agree that the entire period of  
14:09:21 9 delay needs to be unintentional for a revival petition to be  
14:09:26 10 available to a patent owner, is that correct?

14:09:29 11 A. That is correct.

14:09:29 12 Q. If a patent owner learns of an unintentional delay in  
14:09:34 13 paying a maintenance fee and then waits a year to file the  
14:09:39 14 revival petition, would you consider the entire delay to be  
14:09:42 15 unintentional?

14:09:43 16 A. My practice would suggest that that might not be  
14:09:48 17 unintentional.

14:09:52 18 Q. Might not be, or would not be?

14:09:56 19 A. Likely would not be.

14:10:00 20 Q. And, for example, if the patentee waited three  
14:10:05 21 months, would you consider that to be an unintentional  
14:10:10 22 delay?

14:10:10 23 A. I don't have specific knowledge of whether three  
14:10:20 24 months is a magic number. I had a have to do little  
14:10:25 25 research.

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14:10:26 1 Q. Do you recall whether you interfaced with Fred  
14:10:28 2 Schubert?

14:10:29 3 A. I likely did, but I don't specifically recall  
14:10:32 4 conversing with Mr. Schubert, quite frankly.

14:10:36 5 Q. Do you recall who Janine Anderson is?

14:10:39 6 A. Yes.

14:10:40 7 Q. Who is Janine Anderson?

14:10:42 8 A. Janine, I believe, was a licensing officer in the BU  
14:10:48 9 technology transfer office.

14:10:51 10 Q. How about, do you remember a BU employee named Ashley  
14:10:54 11 Stevens?

14:10:57 12 A. I do know Ashley Stevens.

14:10:59 13 Q. And what do you know about Mr. Stevens?

14:11:02 14 A. As I recall, he was the head of OTD, perhaps manager.

14:11:09 15 Q. Do you recall whether or not you interfaced with him  
14:11:15 16 during the preparation and prosecution of the '475 Patent?

14:11:20 17 A. I don't recall.

14:11:21 18 Q. Do you recall how you became aware of Mr. Stevens?

14:11:30 19 A. How I became aware of him?

14:11:35 20 Q. Do you recall whether it was in connection with the  
14:11:40 21 '475 Patent application or in some other context?

14:11:43 22 A. I think it was long before this '475 Patent that I  
14:11:47 23 became aware of Ashley Stevens being the head of the OTD.

14:11:53 24 Q. And do you recall how frequently you communicated  
14:12:00 25 with Mr. Stevens?

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- 14:12:04 1 A. Rarely.
- 14:12:07 2 Q. How about Ms. Anderson?
- 14:12:09 3 A. I communicated with Ms. Anderson.
- 14:12:19 4 Q. Was Ms. Anderson your primary day-to-day contact for  
14:12:27 5 your patent prosecution work at BU?
- 14:12:30 6 A. Yes, I believe she was.
- 14:12:32 7 Q. As part of your practice, do you independently track  
14:12:38 8 maintenance fee deadlines for patents you've prosecuted?
- 14:12:41 9 A. Our general practice is to track maintenance fees  
14:12:46 10 unless a client tells us that they are paying their own  
14:12:52 11 maintenance fees.
- 14:12:56 12 Q. And do you recall whether that was your practice in  
14:12:59 13 2005?
- 14:13:01 14 A. I can't specifically recall if it was 2005.
- 14:13:06 15 Q. Do you recall ever having a different practice with  
14:13:08 16 respect to tracking maintenance fee deadlines?
- 14:13:12 17 A. I don't recall a different practice.
- 14:13:15 18 Q. Do you recall whether or not that was your practice  
14:13:17 19 in 2009?
- 14:13:19 20 A. I can't specifically recall.
- 14:13:22 21 Q. So in your general practice you track the maintenance  
14:13:35 22 fees, and what else do you do to ensure that they're paid?
- 14:13:42 23 A. Our general practice is once a patent is issued to  
14:13:52 24 docket, all maintenance fees and report the issued patent to  
14:13:56 25 the client with the three maintenance fees that are due for

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14:14:02 1 the life of that patent.

14:14:09 2 Q. In your general practice, do you generally provide  
14:14:13 3 your clients with follow-up reports as the deadline for each  
14:14:19 4 individual maintenance fee approaches?

14:14:21 5 A. Our general practice is to provide reminders to  
14:14:25 6 clients relating to any deadline in our docket.

14:14:30 7 Q. So following the payment of the first maintenance fee  
14:14:33 8 on the '475 Patent in 2005, do you recall when the next --  
14:14:39 9 when was the next time you had any involvement with the '475  
14:14:45 10 Patent?

14:14:45 11 A. I think that involves privileged client  
14:14:54 12 communications.

14:14:57 13 Q. Okay. So my question was whether you just recall  
14:15:04 14 when you had the involvement. So can you answer whether or  
14:15:09 15 not you recall your next involvement, without revealing what  
14:15:13 16 the involvement was?

14:15:14 17 A. Because of this matter I've been refreshed as to when  
14:15:21 18 my next involvement in the patent was.

14:15:25 19 Q. And when was that next involvement?

14:15:28 20 A. I believe it was reviving the patent.

14:15:35 21 Q. And do you recall the date of that next involvement?

14:15:41 22 A. I don't specifically recall a date.

14:15:44 23 Q. Do you recall the year?

14:15:46 24 A. 2010.

14:15:52 25 Q. Do you recall that for the '475 Patent, the

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14:15:57 1 seven-and-a-half year deadline without the grace period was  
14:16:00 2 in March 2009?

14:16:03 3 A. I don't recall that.

14:16:05 4 Q. And it's your understanding that you didn't have any  
14:16:15 5 communications with BU until 2010?

14:16:22 6 A. That's my understanding.

14:16:24 7 Q. And you're aware that BU did not pay the second  
14:16:36 8 maintenance fee in March of 2009?

14:16:41 9 A. Apparently they did not.

14:16:45 10 Q. I guess, as of March 2009, you didn't know one way or  
14:16:49 11 the other whether BU paid the maintenance fee?

14:16:51 12 A. No, I did not. I don't recall.

14:16:54 13 Q. So it's your understanding that you did not have any  
14:16:57 14 communications with BU leading up to the September 25th,  
14:17:05 15 2009, deadline?

14:17:06 16 A. I don't recall specifically in that time frame.

14:17:10 17 Q. And at some point you became aware that BU did not  
14:17:13 18 pay the fee on September 25th, 2009, is that right?

14:17:17 19 A. Yes.

14:17:18 20 Q. When did you become aware that BU did not pay the fee  
14:17:22 21 on September 25th, 2009?

14:17:22 22 A. I don't specifically remember what date that was.

14:17:22 23 Q. How did you become aware that BU did not pay the  
14:17:32 24 maintenance fee on September 25th, 2009?

14:17:32 25 A. Yeah, I can. I believe we received a notice of

Matthew Connors - video

- 14:17:41 1       **abandonment from the Patent Office.**
- 14:17:44 2       Q.       **And do you recall when you received that notice?**
- 14:17:49 3       A.       **I don't recall specifically.**
- 14:17:52 4       Q.       **And your recollection is that's the first**
- 14:17:56 5       **notification you received that BU did not timely pay the**
- 14:18:00 6       **maintenance fee?**
- 14:18:02 7       A.       **That's my recollection.**
- 14:18:03 8       Q.       **Have you ever become aware of the reason why BU did**
- 14:18:16 9       **not timely pay the second maintenance fee?**
- 14:18:20 10       A.       **I have no knowledge of that.**
- 14:18:24 11       Q.       **For the record, Exhibit 7 is a document produced in**
- 14:18:28 12       **this case bearing the Bates range EFS 0000232 through 234.**
- 14:18:40 13       A.       **I have it open.**
- 14:18:41 14       Q.       **Mr. Connors, do you recognize this document?**
- 14:18:45 15       A.       **Looks like it's a petition to accept an**
- 14:18:50 16       **unintentionally delayed maintenance fee.**
- 14:18:57 17       Q.       **Okay. And do you see on the first page near the top**
- 14:19:01 18       **left corner the patent number is identified as 6,294,475?**
- 14:19:09 19       A.       **Yes.**
- 14:19:10 20       Q.       **And if you go to the second page, do you see that**
- 14:19:14 21       **this document is signed by Matthew E. Connors on April 22nd,**
- 14:19:22 22       **2010?**
- 14:19:22 23       A.       **I see an electrical E signature, yes.**
- 14:19:26 24       Q.       **Do you understand this to be the revival petition**
- 14:19:29 25       **that you submitted to the PTO in connection with the '475**

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14:19:34 1

**Patent?**

14:19:34 2

A. It likely is. I'm not sure. It looks like it.

14:19:41 3

Q. You have no reason to think it's anything else, do you?

14:19:48 4

A. I have no reason to think it's anything else.

14:19:51 6

Q. Do you recall whether or not the Patent Office granted this petition?

14:19:53 7

A. I believe the Patent Office granted the petition.

14:19:55 8

14:20:00 9

Q. And do you recall that they granted it on the same day, also on April 22nd, 2010?

14:20:03 10

14:20:06 11

A. I believe that is standard Patent Office procedure.

14:20:11 12

Q. I'd like to turn back to Exhibit 7, which is the revival petition for the '475 Patent. Can you please let me know when you have that pulled up?

14:20:15 13

14:20:20 14

A. Which one is it?

14:20:24 15

14:20:31 16

Q. It's the file name Exhibit EFS-232.

14:20:35 17

A. I've got it. Yes.

14:20:39 18

Q. Okay. Now, do you see in the middle of the first page there's a box labeled "statement"? Do you see that?

14:20:44 19

A. Yes.

14:20:50 20

14:20:51 21

Q. And do you see that that includes the same certification that the delay in payment of the maintenance fee was unintentional that we discussed earlier?

14:20:54 22

14:20:58 23

A. Yes.

14:21:01 24

14:21:02 25

Q. And it refers to the undersigned certifies that the

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14:21:06 1 delay in payment was unintentional. And you're the  
14:21:09 2 undersigned with respect to this revival petition, correct?

14:21:13 3 A. Correct.

14:21:14 4 Q. So you certified to the PTO that the delay in payment  
14:21:18 5 of the maintenance fee for the '475 Patent was  
14:21:23 6 unintentional. Right?

14:21:24 7 A. Certified that my belief was that the delay in  
14:21:28 8 payment was unintentional.

14:21:31 9 Q. As we discussed earlier, you're required to have a  
14:21:36 10 reasonable belief that the delay in payment was  
14:21:39 11 unintentional, correct?

14:21:41 12 A. Correct.

14:21:43 13 Q. And you agree that if you did not have a reasonable  
14:21:46 14 basis for believing that the entire delay was unintentional,  
14:21:51 15 you could not appropriately file this revival petition,  
14:21:54 16 correct?

14:21:57 17 A. Correct.

14:21:59 18 Q. And that applies for the entire delay period,  
14:22:02 19 correct?

14:22:02 20 A. Correct.

14:22:05 21 Q. So is it your testimony that you did have a  
14:22:08 22 reasonable basis for believing that the entire delay period  
14:22:12 23 from September 25th, 2009, through April 22nd, 2010 was  
14:22:25 24 unintentional at the time you submitted this petition?

14:22:27 25 A. That is my general practice.

Matthew Connors - video

14:22:30 1 Q. Do you recall whether or not it's true with respect  
14:22:32 2 to the petition for the '475 Patent specifically?

14:22:41 3 A. Specifically, no.

14:22:44 4 Q. So as you sit here today, you can't recall whether or  
14:22:47 5 not you had a reasonable basis for certifying to the Patent  
14:22:51 6 Office that the entire delay period of September 25th, 2009,  
14:22:54 7 through April 22nd, 2010, was unintentional, is that  
14:22:59 8 correct?

14:22:59 9 A. I would not have filed that petition for this or any  
14:23:02 10 other matter if I did not have a reasonable belief that it  
14:23:06 11 was unintentionally abandoned for the entire period of time.

14:23:12 12 Q. Do you recall what facts informed your reasonable  
14:23:17 13 belief that the entire delay period was unintentional?

14:23:22 14 A. I do not specifically recall.

14:23:24 15 Q. Do you recall whether or not you took any steps  
14:23:27 16 before filing the revival petition to verify that BU's  
14:23:34 17 entire delay in paying the maintenance fee was  
14:23:37 18 unintentional?

14:23:38 19 A. I do not recall specifically.

14:23:42 20 MR. MOLANO: Your Honor, I want to alert the  
14:23:50 21 Court that there is a fifteen second buzzing noise that will  
14:23:52 22 be coming up, and I have alerted counsel to it, in about a  
14:23:56 23 minute.

14:23:52 24 THE COURT: Thank you.

14:23:58 25 (Deposition testimony continues:)

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14:24:02 1 Q. What generally do you recall about what you did to  
14:24:05 2 obtain a reasonable belief that the delay was unintentional?

14:24:13 3 A. Generally my practice is to have an understanding  
14:24:17 4 that I have a reasonable belief that the case went abandoned  
14:24:22 5 unintentionally.

14:24:27 6 Q. And as your general practice, what steps would you  
14:24:31 7 typically take to find that out?

14:24:34 8 A. That's a very open-ended question. Depends on the  
14:24:40 9 client, depends on the case, depends on the facts.

14:24:44 10 Q. And do you recall as a general matter what steps you  
14:24:47 11 took in this particular case?

14:24:54 12 A. I don't recall specifically the steps.

14:24:57 13 Q. So do you recall one way or the other whether or not  
14:25:10 14 you requested any information from Boston University about  
14:25:13 15 the circumstances of the delay?

14:25:17 16 A. I don't recall.

14:25:20 17 Q. Okay. Do you recall one way or the other whether or  
14:25:24 18 not Boston University provided you with any information  
14:25:27 19 about the circumstances of the delay?

14:25:32 20 A. Without going into client communications, I don't  
14:25:37 21 specifically recall.

14:25:38 22 Q. So Mr. Connors, you said a few times that you don't  
14:25:42 23 specifically recall what steps you took to verify that the  
14:25:45 24 delay in the maintenance fee payment was unintentional.  
14:25:50 25 Even if you can't recite the specific steps that you took,

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14:25:53 1 can you generally recall the investigation that you  
14:25:55 2 performed to verify your certification to the Patent Office?

14:26:01 3 A. I don't recall.

14:26:03 4 Q. You can't recall a single thing you did to verify  
14:26:09 5 that the entire seven-month delay in paying the maintenance  
14:26:14 6 fee was unintentional?

14:26:16 7 A. I don't recall.

14:26:17 8 Q. You've been either a patent examiner or a  
14:26:20 9 practitioner for over thirty years, correct?

14:26:23 10 A. That's correct.

14:26:24 11 Q. And this is the only time you've been accused of  
14:26:29 12 inequitable conduct, correct?

14:26:31 13 A. Correct.

14:26:32 14 Q. And would you agree with me that an accusation of  
14:26:36 15 inequitable conduct is a serious allegation?

14:26:38 16 A. It can be, yes.

14:26:41 17 Q. And do you recall -- well, do you take the allegation  
14:26:44 18 against you seriously?

14:26:46 19 A. I do not.

14:26:49 20 Q. Why not?

14:26:52 21 A. I do not believe I committed inequitable conduct.

14:26:58 22 Q. Why don't you believe that you committed inequitable  
14:27:03 23 conduct?

14:27:03 24 A. I don't believe I committed inequitable conduct.

14:27:05 25 It's just a belief that I have.

Matthew Connors - video

14:27:09 1 Q. What facts is that belief based on?

14:27:13 2 A. My general practice would be to have an understanding  
14:27:16 3 that the case went to abandonment unintentionally. I have  
14:27:23 4 nothing else to offer. That's my belief.

14:27:29 5 Q. Your belief is not based on a single fact that's  
14:27:34 6 specific to the '475 Patent, is that correct?

14:27:37 7 A. That's correct.

14:27:38 8 Q. And as you sit here today, you can't recall a single  
14:27:43 9 step you took to verify whether or not the delay in paying  
14:27:47 10 the maintenance fee for the '475 Patent was unintentional,  
14:27:52 11 correct?

14:27:52 12 A. I don't specifically recall the steps. My general  
14:27:56 13 practice, as I said before, is to communicate with the  
14:28:00 14 client to gather a reasonable belief that the abandonment  
14:28:06 15 was unintentional.

14:28:08 16 Q. But you don't recall one way or the other whether you  
14:28:12 17 did so in this case?

14:28:14 18 A. My general practice would be to do that.

14:28:17 19 Q. I understand that's your general practice. I'm  
14:28:20 20 asking for this case in particular, do you remember whether  
14:28:24 21 or not you did that?

14:28:25 22 A. I don't recall.

14:28:28 23 Q. When you learned of the inequitable conduct  
14:28:32 24 allegations against you in 2013, did you take any steps to  
14:28:42 25 understand whether or not the delay was, in fact,

Matthew Connors - video

14:28:43 1 unintentional?

14:28:46 2 A. I did not.

14:28:49 3 Q. Okay. I'd like to go back to Exhibit 6, which is --  
14:28:54 4 has a file name exhibit BU-268.

14:29:03 5 A. I have it.

14:29:07 6 Q. And at this time I'd like you to look at the first  
14:29:10 7 page of the document which ends in Bates number 268. Do you  
14:29:14 8 see that?

14:29:14 9 A. Yes.

14:29:15 10 Q. Okay. And do you see at the top of this, there's an  
14:29:19 11 e-mail thread, and the second e-mail down there's an e-mail  
14:29:24 12 between Fred Schubert and Sean Lee dated September 2nd,  
14:29:29 13 2009. Do you see that?

14:29:31 14 A. I do.

14:29:32 15 Q. And do you see that that's replying to an earlier  
14:29:35 16 e-mail from the same date from Sean Lee to Professor  
14:29:40 17 Schubert.

14:29:40 18 Do you see that?

14:29:42 19 A. Yeah, it's kind of a jumbled mess. Yes.

14:29:42 20 Q. Do you recall whether or not you've ever seen these  
14:29:52 21 e-mails before?

14:29:52 22 A. I don't recall ever seeing this e-mail before.

14:29:52 23 Q. Okay. So if you scroll -- if you go to the middle,  
14:30:02 24 the second paragraph of the e-mail from Sean Lee to  
14:30:05 25 Professor Schubert, starts "Your invention from 1998."

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14:30:12 1 Do you see that?

14:30:12 2 A. I do.

14:30:12 3 Q. Do you see he's referring here to the '475 Patent?

14:30:15 4 A. Yes.

14:30:19 5 Q. And do you see Mr. Lee states, "we have paid the  
14:30:23 6 first maintenance fee but as part of our effort to reduce  
14:30:26 7 our portfolio we are planning on not paying the second fee  
14:30:29 8 of \$1,300 due September 25th, 2009.

14:30:32 9 Do you see that?

14:30:33 10 A. I do.

14:30:34 11 Q. Have you ever seen that statement before?

14:30:35 12 A. I have not.

14:30:37 13 Q. Okay. At the time you filed the petition, were you  
14:30:40 14 aware one way or the other of Boston University's effort to  
14:30:45 15 reduce its patent portfolio?

14:30:48 16 A. I don't recall them having such a procedure.

14:30:52 17 Q. At the time you filed the revival petition in April  
14:30:56 18 of 2010, were you aware that Boston University had informed  
14:31:00 19 Dr. Schubert on September 2nd, 2009, that it was planning on  
14:31:02 20 not paying the second fee of \$1,300 due September 25th,  
14:31:12 21 2009?

14:31:12 22 A. I don't recall.

14:31:14 23 Q. So as best you can recall, the steps you took to  
14:31:18 24 verify that the delay was unintentional did not uncover this  
14:31:23 25 statement from Sean Lee to Dr. Schubert, is that correct?

Matthew Connors - video

14:31:26 1 A. It must be. I never saw that e-mail.

14:31:38 2 Q. And why do you say it must be, that you never saw the  
14:31:42 3 e-mail?

14:31:43 4 A. It's the answer to your question.

14:31:48 5 Q. But you said it must be that I never saw the e-mail,  
14:31:56 6 so my question is why did you say that must be the case?

14:32:03 7 A. Well, I don't recall ever seeing that e-mail, so that  
14:32:08 8 must be the case.

14:32:10 9 Q. And do you see in the next paragraph of the e-mail  
14:32:13 10 Sean Lee writes to Professor Schubert, "if you are  
14:32:17 11 interested in having the invention returned to you, we can  
14:32:20 12 return it back to the original federal funding agency and  
14:32:24 13 you can petition them to have it assigned to you."

14:32:27 14 Do you see that?

14:32:28 15 A. I do.

14:32:30 16 Q. So at the time you filed the revival petition, were  
14:32:35 17 you aware that Boston University had offered to return the  
14:32:39 18 '475 Patent to Dr. Schubert?

14:32:42 19 A. I don't recall this scenario.

14:32:45 20 Q. If you look at the response e-mail from Professor  
14:32:48 21 Schubert to Sean Lee, where he says, "I would not be  
14:32:52 22 interested," do you see that?

14:32:55 23 A. At the beginning of the e-mail, yes.

14:32:57 24 Q. Is it also the case that you can't recall one way or  
14:33:01 25 the other whether you knew at the time you filed the revival

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14:33:04 1 petition that Professor Schubert had rejected BU's offer to  
14:33:08 2 return the patent to him?

14:33:11 3 A. I have no recollection of that.

14:33:14 4 Q. I'm going to show you another document. I'm  
14:33:19 5 introducing what will be Exhibit 9 to your deposition. And  
14:33:23 6 for the record, it is a document produced in this case  
14:33:26 7 bearing the Bates range -- the Bates number BU 001145.

14:33:32 8 Have you ever seen this document before?

14:33:35 9 A. I don't recall ever seeing this document before.

14:33:39 10 Q. Okay. Do you recognize it as an entry from Boston  
14:33:44 11 University's patent database?

14:33:46 12 A. I do not recognize that. I don't know.

14:33:50 13 Q. So you're not familiar with Boston University's  
14:33:54 14 patent database?

14:33:55 15 A. No, I am not.

14:33:56 16 Q. And do you see next to the row for the second  
14:34:00 17 maintenance there is a highlighted section that says, "do  
14:34:04 18 not pay per Sean Lee. Fred Schubert agreed. USP  
14:34:12 19 6,294,745"?

14:34:13 20 A. I see it.

14:34:14 21 Q. Do you see that?

14:34:14 22 A. Yes.

14:34:15 23 Q. Were you aware of this database entry at the time you  
14:34:18 24 filed the revival petition?

14:34:21 25 A. I was not, obviously. I never saw this document

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14:34:23 1

**before.**

14:34:23 2

Q. If Sean Lee was the case manager for the '475 Patent,

14:34:27 3

**you'd have no recollection of that?**

14:34:28 4

A. I have no recollection of that.

14:34:31 5

Q. I'm going to show you another document, which will be

14:34:35 6

**Exhibit 10. And Exhibit 10, for the record, is a document**

14:34:41 7

**that was produced in this case bearing the Bates number BU**

14:34:48 8

**000451.**

14:34:51 9

Is this a document that you recognize?

14:34:57 10

A. It is not.

14:34:58 11

Q. If you could look at the first paragraph of the

14:35:01 12

**letter, it says, "Boston University decided not to pay the**

14:35:05 13

**second year U.S. maintenance due September 25, 2009, for the**

14:35:12 14

**above-referenced patent."**

14:35:16 15

Do you see that?

14:35:17 16

A. I do.

14:35:17 17

Q. Do you see in the subject heading of the e-mail there

14:35:21 18

**is a line for U.S. patent number 6294475?**

14:35:25 19

A. Yes, I do.

14:35:27 20

Q. And do you see the letter then continues, the "this

14:35:31 21

**decision was made due to lack of commercial interest in the**

14:35:34 22

**invention." Do you see that?**

14:35:36 23

A. I do.

14:35:37 24

Q. So at the time you filed the revival petition for the

14:35:41 25

**'475 Patent, were you aware of this letter?**

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14:35:43 1 A. I don't believe I was.

14:35:45 2 Q. Were you aware that Boston University decided not to  
14:35:49 3 pay the maintenance fee on September 25th, 2009, due to lack  
14:35:54 4 of commercial interest in the invention?

14:35:57 5 A. I do not believe I was aware.

14:36:00 6 Q. So you don't believe that the investigation you  
14:36:03 7 performed to verify your certification to the Patent Office  
14:36:06 8 uncovered this fact?

14:36:09 9 A. I don't believe I was aware of that document.

14:36:14 10 Q. How about of Boston University's decision not to pay  
14:36:19 11 the maintenance fee due to a lack of commercial interest in  
14:36:22 12 the invention?

14:36:23 13 A. I do not believe I was aware of that.

14:36:25 14 Q. As a general practice, if you become aware that a  
14:36:29 15 client had decided not to pay a maintenance fee due to a  
14:36:32 16 lack of commercial interest in the invention, would you  
14:36:34 17 perform some additional investigation to uncover the  
14:36:37 18 circumstances of the delay?

14:36:40 19 A. Hypothetically, I probably would.

14:36:42 20 Q. If at the time you filed the revival petition for the  
14:36:48 21 '475 Patent you were aware of the November 27th, 2009,  
14:36:52 22 letter, and the statement that BU decided not to pay the  
14:36:58 23 maintenance fee due to lack of commercial interest in the  
14:37:00 24 invention, you would perform -- you would need to know some  
14:37:03 25 additional facts before you could certify to the Patent

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14:37:06 1 Office that the delay was unintentional, correct?

14:37:09 2 A. I might need additional facts.

14:37:11 3 Q. So at the time you filed the revival petition, do you  
14:37:15 4 recall a single fact about your understanding of BU's  
14:37:19 5 reasoning for not timely paying the maintenance fee?

14:37:23 6 A. I do not recall.

14:37:26 7 Q. Do you agree that under the duty of candor you had an  
14:37:37 8 obligation to try to find those facts out?

14:37:40 9 A. My practice is to have a belief that the client  
14:37:50 10 understood that the case was unintentionally abandoned for  
14:37:56 11 the entire period of time.

14:37:59 12 Q. In addition to that being your practice, it's also a  
14:38:02 13 PTO requirement, correct?

14:38:05 14 A. I believe it is.

14:38:07 15 Q. When did you become aware that Professor Schubert  
14:38:10 16 wanted to acquire the '475 Patent from BU?

14:38:15 17 A. I believe that's privileged communication.

14:38:19 18 Q. I'm not asking for the manner in which you learned  
14:38:23 19 the information. I'm just asking for a date.

14:38:26 20 A. I don't recall the date.

14:38:27 21 Q. And Exhibit 13 is a document produced in this case  
14:38:30 22 bearing the Bates number BU 000447 through 448.

14:38:40 23 Mr. Connors, just let me know when you have had a chance to  
14:38:44 24 open that up and take a look at it?

14:38:47 25 A. Okay.

Matthew Connors - video

- 14:38:48 1 Q. Have you seen this document before?
- 14:38:52 2 A. I don't recall seeing this document before.
- 14:38:57 3 Q. Okay. Do you see that it is a memorandum from Ashley
- 14:39:03 4 Stevens, who you have identified earlier as the head of the
- 14:39:06 5 OTD department at BU, to the Charles River Campus Patent
- 14:39:12 6 Committee, dated February 22nd, 2010?
- 14:39:15 7 A. Yes.
- 14:39:16 8 Q. And do you have an understanding of what the Charles
- 14:39:20 9 River Campus Patent Committee is?
- 14:39:21 10 A. I do not.
- 14:39:22 11 Q. And do you see in the subject line it's again
- 14:39:26 12 referring to the case number BU 98-11 to Professor Fred
- 14:39:31 13 Schubert? Do you see that?
- 14:39:34 14 A. Yes.
- 14:39:35 15 Q. And so do you understand that this memorandum is
- 14:39:40 16 referring to the '475 Patent?
- 14:39:42 17 A. Yes.
- 14:39:45 18 Q. Do you see in the second paragraph there's the second
- 14:39:50 19 sentence starts "OTD paid the first maintenance fee in 2005,
- 14:39:52 20 but after Professor Schubert's move to RPI from BU, did not
- 14:40:00 21 pay the second fee of \$1,010 due on September 25, 2009 after
- 14:40:02 22 consulting with Professor Schubert."
- 14:40:12 23 Do you see that?
- 14:40:12 24 A. Yes.
- 14:40:14 25 Q. At the time you filed the revival petition in April

Matthew Connors - video

14:40:16 1 of 2010, were you aware that BU had consulted with Professor  
14:40:21 2 Schubert about whether or not to pay the second maintenance  
14:40:25 3 fee?

14:40:25 4 A. I was not aware.

14:40:27 5 Q. As a general practice, if you became aware prior to  
14:40:32 6 filing your revival petition that the inventor and the  
14:40:39 7 patent owner had consulted about whether to file a fee, you  
14:40:43 8 would want to understand the circumstances of that  
14:40:46 9 consultation, correct?

14:40:48 10 A. I would want to understand the consultation.

14:40:53 11 Q. So the last few documents we've looked at discussing  
14:40:56 12 the payment of the maintenance fee, BU's decision not to pay  
14:41:00 13 the maintenance fee, does any of this refresh your  
14:41:05 14 recollection as to the knowledge you had as of April 22nd,  
14:41:13 15 2010?

14:41:14 16 A. It does not refresh my recollection.

14:41:20 17 Q. And does any of this information refresh your  
14:41:23 18 recollection as to the steps you took to investigate the  
14:41:27 19 underlying facts prior to filing the revival petition?

14:41:32 20 A. It does not.

14:41:34 21 Q. And as you sit here today, do you have -- do you now  
14:41:38 22 have an understanding of whether or not BU deliberately  
14:41:42 23 decided not to pay the second maintenance fee for the '475  
14:41:46 24 Patent by the September 25th, 2009, deadline?

14:41:50 25 A. Other than what you've just showed me, no.

Matthew Connors - video

14:41:57 1 Q. Based on what I just showed you, do you think you  
14:42:02 2 have enough information to make that determination, or would  
14:42:04 3 you need additional understanding of the facts?  
14:42:07 4 A. I would need additional information.  
14:42:10 5 Q. So if at the time you filed the revival petition you  
14:42:13 6 had the information that I've just showed you available to  
14:42:17 7 you, you would not pay based on that information, be able to  
14:42:21 8 certify to the Patent Office that the delay in paying the  
14:42:24 9 maintenance fee was unintentional, correct?  
14:42:25 10 A. I'd have to do further investigation.  
14:42:29 11 Q. Fourth factual investigation?  
14:42:31 12 A. Is there another kind?  
14:42:35 13 Q. Would you also do any legal research or confer Patent  
14:42:41 14 Office guidance and procedures?  
14:42:43 15 A. Yes.  
14:42:45 16 Q. So you'd want a further understanding of the facts,  
14:42:48 17 and you'd consult legal sources?  
14:42:51 18 A. Yes.  
14:42:52 19 Q. Do you recall whether or not you consulted any of  
14:42:54 20 those sources prior to filing the revival petition for the  
14:42:58 21 '475 Patent?  
14:42:58 22 A. I don't recall.  
14:43:00 23 Q. The first document is Exhibit Number 14, which is a  
14:43:04 24 document that was produced in this case bearing Bates number  
14:43:12 25 EFS 000006582. And Exhibit 15 is a document that was

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14:43:20 1 produced in this case bearing the Bates number EFS 00006583  
14:43:31 2 through 85.

14:43:33 3 Mr. Connors, if you just pull those documents  
14:43:37 4 up, and once you've had a moment, let me know if you  
14:43:42 5 recognize them?

14:43:44 6 A. I have them up.

14:43:46 7 Q. Okay. Do you recognize Exhibits 14 and 15?

14:43:51 8 A. 14, I don't recognize 14. 15. I see what it is. I  
14:44:05 9 don't have recollection of this document.

14:44:07 10 Q. Okay. Looking at Exhibit 14, do you see this is an  
14:44:10 11 e-mail from Janine Anderson, and that you are copied on it?

14:44:15 12 A. I do see that.

14:44:21 13 Q. And the date of the e-mail, the June 18th, 2010, do  
14:44:26 14 you see that?

14:44:26 15 A. I see that.

14:44:27 16 Q. Do you have any reason to doubt that you received  
14:44:29 17 this e-mail on June 18th of 2010?

14:44:32 18 A. I don't have any recollection one way or the other.

14:44:35 19 Q. Do you see that there's an attachment listed in the  
14:44:39 20 attachment fields of the e-mail?

14:44:42 21 A. Yes.

14:44:43 22 Q. Then if you go to the next document, Exhibit 15, do  
14:44:50 23 you see on the last page of the document you are listed as  
14:44:52 24 being cc'd on this document in both e-mail and mail?

14:45:02 25 A. Yes.

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14:45:02 1 Q. Do you remember receiving this document?

14:45:05 2 A. I do not remember receiving it.

14:45:08 3 Q. So you also don't remember whether or not you've read

14:45:11 4 this document?

14:45:12 5 A. I don't recall reading this document.

14:45:15 6 Q. Okay. Do you have any reason to doubt that you

14:45:17 7 received the letter that is Exhibit 15?

14:45:20 8 A. I don't have any reason to doubt. I just don't

14:45:24 9 recall.

14:45:31 10 Q. Do you see that this letter is from Vinit Nijhawan to

14:45:42 11 Professor Schubert?

14:45:42 12 A. I see Vinit Nijhawan signed the letter, yes.

14:45:50 13 Q. And so do you understand this letter to be

14:45:54 14 Mr. Nijhawan informing Fred Schubert that the '475 Patent

14:45:57 15 will be returned to him at some point in the future?

14:46:00 16 A. I didn't read the entire letter. I don't know what

14:46:07 17 the letter is saying. You'd have to ask the writer of the

14:46:11 18 letter, I think.

14:46:14 19 Q. Okay. Do you see in the second paragraph it starts,

14:46:17 20 "the invention will be returned solely to you." And then it

14:46:20 21 continues. "Oh April 5, 2010, we sent a certified mail,

14:46:22 22 return receipt requested letter to Dean Stocker notifying

14:46:23 23 him that Boston University is no longer supporting the

14:46:31 24 patent costs for this invention and asking if he was

14:46:34 25 interested in having the invention returned to him."

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14:46:36 1

Do you see that?

14:46:37 2

A. Yes, I do.

14:46:39 3

Q. Is it your understanding that this letter is

14:46:42 4

informing Professor Schubert that the '475 Patent will be

14:46:46 5

returned to him at some point in the future?

14:46:55 6

A. I would be speculating I guess that's what it means.

14:46:59 7

Q. And the letter continues to state that Boston

14:47:01 8

University is no longer supporting the patent costs for the

14:47:05 9

'475 Patent.

14:47:05 10

Do you see that?

14:47:06 11

A. I see that.

14:47:09 12

Q. Okay. And you received this memorandum within three

14:47:15 13

months of the date that you filed the revival petition with

14:47:18 14

the PTO, correct?

14:47:20 15

A. I don't recall receiving this.

14:47:25 16

Q. You did see that you were copied on both the letter

14:47:34 17

and the e-mail --

14:47:35 18

A. Yes.

14:47:37 19

Q. -- after the letter, correct?

14:47:40 20

A. Yes.

14:47:43 21

Q. And you don't doubt that you actually received it,

14:47:46 22

correct?

14:47:48 23

A. I don't recall receiving it.

14:47:52 24

Q. Sure.

14:47:54 25

So in your general practice, if you receive

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14:47:58 1 correspondence relating to a patent application or patent  
14:48:02 2 that you prosecuted, is it your practice to read the letter?

14:48:08 3 A. My general practice would be to read correspondence  
14:48:13 4 regarding a patent that I prosecuted.

14:48:17 5 Q. So is it your understanding, then, that you would  
14:48:24 6 have reviewed this letter when you received it?

14:48:31 7 A. My practice would be to read it if received.

14:48:35 8 Q. So, do you see the letter in the second paragraph  
14:48:39 9 states that "Boston University is no longer supporting the  
14:48:42 10 patent costs for this invention," which is referring to the  
14:48:44 11 '475 Patent. Do you see that?

14:48:49 12 A. Yes.

14:48:50 13 Q. And you had received this letter either in June or  
14:48:53 14 July of 2010, correct?

14:48:56 15 A. Purportedly I received it. I don't recall receiving  
14:49:01 16 this letter.

14:49:03 17 Q. Okay. And so the time June or July of 2010, we're  
14:49:09 18 talking two to three months after you filed the revival  
14:49:12 19 petition for the '475 Patent, correct?

14:49:15 20 A. I believe that is correct.

14:49:17 21 Q. And after receiving this letter within three months  
14:49:20 22 of filing the revival petition which states that BU had  
14:49:24 23 decided not to support the patent costs for the '475 Patent,  
14:49:27 24 you didn't provide any additional information to the Patent  
14:49:30 25 Office concerning BU's delay in paying the maintenance fee,

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14:49:37 1

correct?

14:49:38 2

A. I don't recall receiving this letter.

14:49:40 3

Q. In your practice you say you filed, what, a handful of revival petitions, I believe you said, correct?

14:49:44 4

14:49:47 5

A. That sounds right.

14:49:49 6

Q. Okay. So if three months after you filed one of

14:49:52 7

those petitions you were informed that your clients had

14:49:56 8

deliberately decided not to pay the maintenance fee, you

14:50:06 9

would have a duty to update your disclosure to the Patent

14:50:11 10

Office, correct?

14:50:12 11

A. I guess it's a practice, if I was informed that a

14:50:17 12

client intentionally abandoned the patent after the revival

14:50:24 13

within three months, I would have submitted that information

14:50:30 14

to the Patent Office.

14:50:38 15

Q. And you would agree that not only would you have done

14:50:41 16

that, but PTO guidelines and procedures would require you to

14:50:45 17

do that, correct?

14:50:46 18

A. Yes.

14:50:47 19

Q. In general, not talking about this letter

14:50:50 20

specifically, but if you as a patent practitioner make a

14:50:52 21

representation to the Patent Office that you later find out

14:50:58 22

is incorrect, you have a duty to correct your representation

14:51:00 23

with the Patent Office, correct?

14:51:02 24

A. I believe that is correct.

14:51:10 25

Q. So I believe you said earlier that you also learned

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14:51:15 1 of Osram's inequitable conduct allegations against you in  
14:51:20 2 2013, is that right?

14:51:24 3 A. Yes.

14:51:25 4 Q. And are you aware that Lumileds had also filed  
14:51:30 5 inequitable conduct allegations against you and BU in 2013?

14:51:40 6 A. I don't recall that.

14:51:44 7 Q. So when you learned that Osram had asserted  
14:51:58 8 inequitable conduct allegations against you, did you review  
14:52:00 9 the allegations?

14:52:01 10 A. I recall reviewing the complaint.

14:52:19 11 Q. So you've been at this point a patent practitioner  
14:52:23 12 for over twenty years, you're accused of inequitable conduct  
14:52:26 13 for the first time, and you don't recall whether you were  
14:52:29 14 interested in learning about the allegations?

14:52:33 15 A. I have specific memory issues with respect to  
14:52:36 16 October 2013.

14:52:39 17 Q. What are those memory issues?

14:52:41 18 A. My wife fell ill of leukemia and passed away during  
14:52:51 19 October of 2013.

14:52:53 20 Q. Do you know which entity has currently pending  
14:52:56 21 allegations of inequitable conduct against you?

14:52:59 22 A. I do not.

14:53:01 23 Q. What's your understanding of how the *Network*  
14:53:04 24 *Signatures* case relates to the allegations against you?

14:53:07 25 A. My understanding is that a patent went abandoned for

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14:53:13 1 failure to pay a maintenance fee timely, the lack of payment  
14:53:20 2 was intentional, and that upon a lower court decision found  
14:53:30 3 the patent invalid, but the CAFC found -- reversed that  
14:53:37 4 holding.

14:53:38 5 Q. Okay. And you're aware that the *Network Signatures*  
14:53:42 6 case was decided in 2013, right?

14:53:47 7 A. I believe that's correct.

14:53:49 8 Q. How about petitions to revive an abandoned  
14:53:52 9 application, how many of those have you filed or submitted  
14:53:56 10 in your career?

14:53:57 11 A. Several.

14:53:59 12 Q. "Several" meaning a handful or something different?

14:54:04 13 A. Something different.

14:54:05 14 Q. Approximately how many?

14:54:07 15 A. More than ten.

14:54:09 16 Q. More than fifty?

14:54:19 17 A. That's hard to say. I don't recall.

14:54:26 18 Q. Do you recall whether or not any of those petitions  
14:54:28 19 have ever been denied?

14:54:30 20 A. I don't recall. I don't recall a petition being  
14:54:43 21 denied.

14:54:44 22 Q. Do you recall what the search terms were?

14:54:47 23 A. I recall some of them.

14:54:49 24 Q. Which ones do you recall?

14:54:52 25 A. Schubert, Stocker, file numbers, patent number,

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14:54:57 1 variations of the patent number, variations of the serial  
14:55:04 2 number, Janine Anderson, Ashley Stevens, Dan Ladow. And  
14:55:23 3 after that, I'm not sure.

14:55:28 4 Q. Who is Dan Ladow?

14:55:33 5 A. Dan Ladow, I believe, is an attorney representing  
14:55:40 6 Schubert.

14:55:40 7 Q. Have you had any communications with Mr. Ladow?

14:55:46 8 A. Have I ever had communications with Mr. Ladow?

14:55:53 9 Q. Yes.

14:55:54 10 A. Yes.

14:55:55 11 Q. Have those communications related to Professor  
14:55:58 12 Schubert's lawsuits asserting the '475 Patent?

14:56:02 13 A. That may be privileged communications.

14:56:09 14 Q. So Mr. Ladow is affiliated with the Troutman Sanders  
14:56:17 15 firm, is that correct?

14:56:18 16 A. I believe that's correct.

14:56:19 17 Q. Does Troutman Sanders represent you with respect to  
14:56:23 18 this matter?

14:56:24 19 A. They do not.

14:56:25 20 Q. When did you have the communications with Mr. Ladow?

14:56:30 21 A. 2013.

14:56:32 22 Q. Was anyone else present for those communications?

14:56:37 23 A. It depends on what you mean by "present."

14:56:42 24 Q. So you had communications in 2013 with Mr. Ladow,  
14:56:52 25 correct?

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14:56:55 1

A. Yes.

14:56:56 2

Q. Were those telephonic communications, written

14:57:02 3

communications, in person communications, what do you

14:57:05 4

remember?

14:57:05 5

A. Telephonic and e-mail.

14:57:08 6

Q. And in your phone conversations with Mr. Ladow, was

14:57:12 7

anyone else a participant in the conversation?

14:57:16 8

A. I believe so.

14:57:17 9

Q. Do you recall who else was involved in the

14:57:20 10

conversation?

14:57:21 11

A. Yes.

14:57:22 12

Q. Who?

14:57:24 13

A. My partner, Bill Hilton.

14:57:29 14

Q. Anyone else? Was there anyone else that you can

14:57:32 15

recall?

14:57:32 16

A. Not that I recall.

14:57:34 17

Q. What do you recall about the substance of those

14:57:38 18

conversations?

14:57:43 19

MR. BOLLINGER: I'm going to object to this and maintain a community of interest privilege.

14:57:52 21

MR. TIMBERS: I would join in that.

14:57:52 22

MR. APGAR: You're claiming community of interest between Mr. Connors and Professor Schubert as of 2013?

14:58:02 3

14:58:02 4

MR. BOLLINGER: Yes.

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14:58:09 1 MR. APGAR: What's your basis for that? Is  
14:58:11 2 there a written agreement?

14:58:13 3 MR. BOLLINGER: I don't know. In any event, I'm  
14:58:16 4 going to have to investigate it further. I wasn't there, I  
14:58:19 5 wasn't part of the conversation. Dan Ladow is no longer  
14:58:22 6 part of the firm. I don't really know the details.

14:58:28 7 MR. APGAR: So I mean, are you instructing him  
14:58:32 8 not to answer given that basis?

14:58:33 9 MR. BOLLINGER: I can't instruct him. I'm  
14:58:36 10 objecting to it and asserting the privilege.

14:58:40 11 MR. APGAR: Okay.

14:58:41 12 MR. BOLLINGER: If the witness may know whether  
14:58:43 13 there was legal advice or legal communications, I have no  
14:58:46 14 idea. I have no idea.

14:58:48 15 Q. So Mr. Connors, what do you recall about the  
14:58:50 16 substance of your communications with Mr. Ladow and  
14:58:53 17 Mr. Hilton?

14:58:56 18 MR. TIMBERS: I'm going to instruct him not to  
14:59:00 19 answer to the extent it relates to work he did for  
14:59:03 20 Mr. Schubert and BU. If you can answer otherwise, that's  
14:59:06 21 fine.

14:59:10 22 THE WITNESS: I'm not sure I can answer  
14:59:13 23 otherwise.

14:59:16 24 Q. So you're going to follow counsel's instruction?

14:59:20 25 A. Yes.

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- 14:59:34 1 Q. Do you recall any communications with Ladow other  
14:59:39 2 than the ones you had in 2013?
- 14:59:42 3 A. No.
- 14:59:44 4 Q. To keep a patent in force for its full term, how many  
14:59:48 5 maintenance fees need to be paid?
- 14:59:50 6 A. Three.
- 14:59:52 7 Q. And approximately how long after the patent issues do  
14:59:58 8 each of those three maintenance fees need to be paid? If  
15:00:07 9 you recall, approximately how long after a patent issues do  
15:00:10 10 each of those three maintenance fees need to be paid?
- 15:00:12 11 A. Three-and-a-half years. Is that what you mean?
- 15:00:15 12 Q. Yeah, like the first one, second one, and third one?
- 15:00:18 13 A. Three-and-a-half, seven-and-a-half,  
15:00:22 14 eleven-and-a-half.
- 15:00:23 15 Q. Okay. And with --
- 15:00:26 16 A. With six months' grace period.
- 15:00:29 17 Q. I'm not going to hold you to any specific numbers,  
15:00:33 18 but approximately how much are those fees? Are they the  
15:00:37 19 same or do they change over time?
- 15:00:39 20 A. They grade up with time.
- 15:00:42 21 Q. So if I understand correctly, the first maintenance  
15:00:46 22 fee is the cheapest one, the second one is more expensive  
15:00:49 23 and the third one is the most expensive?
- 15:00:52 24 A. That is correct.
- 15:00:54 25 Q. Mr. Connors, let me know if you're able to download

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15:00:57 1 Exhibit 20, which I just sent.

15:01:03 2 A. I have it up.

15:01:05 3 Q. Now, if you look at the first page of Exhibit 20,  
15:01:08 4 which is page 1239 of the 731 F.3d Federal Reporter, do you  
15:01:17 5 see that case caption that I've highlighted in yellow?

15:01:23 6 A. Yes.

15:01:25 7 Q. And this is a decision issued by the United States  
15:01:30 8 Court of Appeals for the Federal Circuit on September 24th,  
15:01:36 9 2013; is that right?

15:01:37 10 A. Yes.

15:01:39 11 Q. All right. And am I reading this right that Network  
15:01:46 12 Signatures, Inc. was the plaintiff in the underlying case?

15:01:48 13 A. Yes.

15:01:49 14 Q. So the *Network Signatures* case involved a situation  
15:01:52 15 in which a patent was abandoned due to lack of commercial  
15:01:55 16 interest, and then it was revived for unintentional delay in  
15:02:00 17 paying the maintenance fee after it was discovered that  
15:02:03 18 there was interest after all. Is that a fair summary?

15:02:08 19 A. I think that's a fair characterization.

15:02:11 20 Q. And on those facts, the Federal Circuit found no  
15:02:15 21 inequitable conduct, is that your understanding?

15:02:17 22 A. That is my understanding.

15:02:20 23 Q. And other than the Supreme Court, the Federal Circuit  
15:02:24 24 Court of Appeals is the highest authority on patent law  
15:02:27 25 issues in the United States. Is that your understanding?

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15:02:30 1 A. That is my understanding.

15:02:33 2 Q. So in light of the *Network Signatures*' decision we  
15:02:37 3 just talked about from the Federal Circuit, if a patent is  
15:02:40 4 deliberately abandoned due to a perceived lack of commercial  
15:02:44 5 interest, but subsequently it turns out that there is  
15:02:48 6 commercial interest, would you agree there can be a  
15:02:52 7 reasonable basis for a claim of unintentional delay in  
15:02:55 8 filing a revival petition?

15:02:56 9 A. I think it's reasonable to use that case for that  
15:02:59 10 fact scenario.

15:03:01 11 Q. In light of the *Network Signatures* case that we just  
15:03:04 12 discussed from the Federal Circuit, and given that  
15:03:07 13 Dr. Schubert here expressed interest in the '475 Patent  
15:03:11 14 after its abandonment, do you stand by your decision to file  
15:03:14 15 that revival petition in this case?

15:03:19 16 A. If using that case, I think I would.

15:03:23 17 Q. Now, I know all of this happened ten years ago. Do I  
15:03:27 18 understand correctly, just to summarize some of your  
15:03:30 19 testimony earlier today, that you do not recall the details  
15:03:33 20 of the investigation you performed before filing the revival  
15:03:37 21 petition for BU?

15:03:42 22 A. I believe I did say that. I do not recall.

15:03:46 23 Q. All right. So I just have a couple more questions,  
15:03:49 24 and I want to caution you that I'm not seeking any  
15:03:52 25 privileged information when I ask them. Do you understand

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15:03:58 1

that?

15:03:59 2

A. I have an understanding that that's your

15:04:06 3

understanding.

15:04:06 4

Q. Okay. So on a purely yes or no basis, do you recall

15:04:11 5

the substance of any discussions you had with BU personnel

15:04:15 6

before filing the revival petition about why the delay in

15:04:18 7

paying the maintenance fee was unintentional?

15:04:21 8

A. I don't recall.

15:04:23 9

Q. Am I correct in understanding from earlier today that

15:04:26 10

you believe in your ordinary practice you would have

15:04:29 11

discussed the revival petition with BU before you filed it?

15:04:33 12

A. Yes.

15:04:36 13

Q. But given that this happened ten years ago, if I

15:04:40 14

understand correctly, you simply cannot understand -- you

15:04:43 15

cannot remember the substance of any such discussion today?

15:04:46 16

A. I don't recall the discussion.

15:04:49 17

Q. Okay. Do you recall discussing with Mr. Rader that

15:04:53 18

in that case there was a two-week delay in the filing of the

15:04:56 19

maintenance fee?

15:05:00 20

A. I do recall that, yes.

15:05:03 21

Q. And you said that based on the *Network Signatures*

15:05:07 22

case that you think you would stand by your decision to file

15:05:10 23

the revival petition; is that correct?

15:05:13 24

A. That is correct.

15:05:16 25

Q. So putting the *Network Signatures* case aside, based

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15:05:19 1 on everything you've seen today, as you sit here today would  
15:05:27 2 you have proceeded in the exact same fashion as you did on  
15:05:31 3 the April 22nd, 2010 in your filing of the revival petition  
15:05:36 4 for the '475 Patent?

15:05:38 5 A. I'm not sure what I would have done. I'd have to  
15:05:42 6 review everything, including -- how can I put aside the  
15:05:45 7 signature case.

15:05:50 8 Q. So based on everything you have seen today --

15:05:53 9 A. Yes.

15:05:54 10 Q. -- as you sit here today based on facts as you  
15:05:56 11 understand them, would you have proceeded in the same  
15:05:59 12 fashion as you did when you filed the revival petition on  
15:06:03 13 April 22nd, 2010?

15:06:04 14 A. I might have done it a little different.

15:06:06 15 Q. What would you have done differently?

15:06:09 16 A. If I had an understanding that there wasn't  
15:06:13 17 intentional abandonment I would have discussed that, found  
15:06:21 18 out more facts as to whether it was intentionally abandoned.

15:06:25 19 Q. And the documents you have seen today indicate to you  
15:06:29 20 that there was an intentional decision to abandon the patent  
15:06:33 21 on September 25th, 2009?

15:06:37 22 A. I don't know that they specifically do that. I see a  
15:06:41 23 lot of comments from people. I don't know what their  
15:06:45 24 intentions are. You'd have to ask them.

15:06:49 25 Q. Okay. But you would agree that you would need to do

15:06:50 1 -- you would need to do some additional factual  
15:06:53 2 investigation based on materials you saw today to determine  
15:06:59 3 whether the delay truly was unessential correct?

15:07:04 4 A. Yes.

15:07:08 5 (End of videotape deposition.)

15:07:08 6 MS. DESAI: Your Honor, in light of Matthew  
15:07:11 7 Connors' testimony, we move to admit the following  
15:07:13 8 documents, JTX 2, JTX 12, JTX 33, and JTX 35.

15:07:20 9 THE COURT: Any objection?

15:07:22 10 MR. BOLLINGER: No objections, Your Honor.

15:07:24 11 THE COURT: All right. They're admitted.

15:07:26 12 (Above exhibits were admitted into evidence.)

15:07:28 13 THE COURT: Let's start with Dr. Schubert and we  
15:07:31 14 will take a break around 4 o'clock or so.

15:07:34 15 MR. MOLANO: Your Honor, may we have a brief  
15:07:36 16 recess to bring in counsel?

15:07:38 17 MR. BOLLINGER: Your Honor -- I didn't mean to  
15:07:41 18 interrupt.

15:07:43 19 THE COURT: Bring them in.

15:07:44 20 MR. BOLLINGER: I just, Your Honor,  
15:07:46 21 procedurally, I think this is the close of their case on  
15:07:48 22 their counterclaim.

15:07:51 23 THE COURT: Okay.

15:07:52 24 MR. BOLLINGER: And we would move under

15:07:53 25 Rule 52 --

15:07:54 1 THE COURT: Did you want to close your case?

15:07:56 2 MR. MOLANO: Your Honor, we also have  
15:07:58 3 affirmative -- we listed as a witness, Dr. Schubert.

15:08:01 4 THE COURT: So they are going to call  
15:08:02 5 Dr. Schubert.

15:08:03 6 MR. BOLLINGER: I don't think they are. They  
15:08:05 7 withdrew him.

15:08:07 8 MR. MOLANO: No, we called Dr. Schubert and put  
15:08:09 9 on a cross, so we decided to take our witness after theirs.

15:08:13 10 THE COURT: I don't care. I'm not going to  
15:08:15 11 grant any motion that you have anyway, so let's just not  
15:08:18 12 fight about it.

15:08:19 13 Bring in the other counsel and let's get  
15:08:22 14 Dr. Schubert on the stand.

15:08:25 15 MR. BOLLINGER: Thank you, Your Honor.

15:09:27 16 THE COURT: You're on the clock, so you have to  
15:09:33 17 do it quickly. You want to bring Dr. Schubert up so we  
15:09:48 18 don't waste time here.

15:09:57 19 MR. JOHNSON: Good afternoon, Your Honor.  
15:09:58 20 Defense is ready.

15:10:02 21 MR. BOLLINGER: I was going to introduce my  
15:10:04 22 colleague.

15:10:04 23 THE COURT: She looks like she's able to do it  
15:10:07 24 herself.

15:10:10 25 MS. HARIHAR: Thank you. Good afternoon. My

15:10:11 1 name is Katherine Harihar on behalf of plaintiff,  
15:10:14 2 Dr. Schubert. At this time the plaintiff would like to call  
15:10:19 3 Dr. Schubert to the stand.

15:10:20 4 THE COURT: All right. We'll swear him in and  
15:10:23 5 then I will let you put your appearances on the record.

15:10:26 6 COURT CLERK: Please raise your right hand.  
15:10:28 7 Please state and spell your full name for the record.

15:10:31 8 THE WITNESS: E. Fred Schubert. E, like Eric.  
15:10:35 9 F-R-E-D, S-C-H-U-B-E-R-T.

15:10:43 10 E. Fred Schubert, having been duly sworn, was  
15:10:58 11 examined and testified as follows:

15:10:58 12 THE COURT: Good afternoon.

15:11:01 13 All right. Who do we have here?

15:11:04 14 MR. JOHNSON: Edward Johnson for defendants.

15:11:07 15 MR. NESE: Good afternoon, Your Honor. Brian  
15:11:13 16 Nese for defendant.

15:11:14 17 MR. BUCCIGROSS: Good afternoon, Your Honor.

15:11:15 18 Graham Buccigross for defendants.

15:11:17 19 THE COURT: Nice to see a face with a voice.

15:11:22 20 MS. HARIHAR: My apologies, Your Honor. Is it  
15:11:24 21 okay if we hand up a notebook for the witness?

15:11:27 22 THE COURT: Sure. Give it to the someone with a  
15:11:32 23 mask on before you start walking around the courtroom,  
15:11:33 24 please.

15:11:34 25 MS. HARIHAR: My apologies.

Schubert - direct

15:11:37 1 THE COURT: That's okay.

15:11:49 2 Okay. Go ahead.

15:11:51 3 DIRECT EXAMINATION

15:11:52 4 MS. HARIHAR: Thank you very much.

15:11:53 5 BY MS. HARIHAR:

15:11:55 6 Q. Good afternoon, Dr. Schubert. Please state your name  
15:11:58 7 for the record.

15:11:59 8 A. E. Fred Schubert.

15:12:04 9 Q. Thank you.

15:12:05 10 And Dr. Schubert, by whom are you currently  
15:12:09 11 employed?

15:12:11 12 A. Rensselaer Polytechnic Institute, RPI, in Troy, New  
15:12:17 13 York.

15:12:17 14 Q. What is RPI, Dr. Schubert?

15:12:20 15 A. RPI is a private research university. It is also the  
15:12:28 16 oldest technological university in the English speaking  
15:12:32 17 world.

15:12:33 18 Q. Thank you.

15:12:34 19 And what is your current role at RPI?

15:12:37 20 A. I am an active tenured full professor in the  
15:12:44 21 Department of Electrical Computer and System Engineering.

15:12:50 22 Q. And have you held any additional positions at RPI?

15:12:54 23 A. Yes. In the past I have been a member of the Physics  
15:13:02 24 Department. In the past I have been the head of the Future  
15:13:09 25 Chip Constellation which is a small group of professors.

Schubert - direct

15:13:12 1 And in the past I have also been the director of a larger  
15:13:20 2 research center funded by the National Science Foundation.

15:13:27 3 And the name of the research center was Smart Lighting.

15:13:32 4 Q. Thank you for that Dr. Schubert. How long have you  
15:13:34 5 been at RPI?

15:13:37 6 A. Nineteen years.

15:13:40 7 Q. Thank you.

15:13:41 8 And if you could pull up JTX 8, please. If you  
15:13:50 9 could turn to JTX 8 in your binder, or also up here on the  
15:13:53 10 screen in front of you. Is JTX 8 a copy of your resume,  
15:14:00 11 Dr. Schubert -- I'm sorry, your CV?

15:14:03 12 A. Yes, it is.

15:14:05 13 Q. Thank you.

15:14:06 14 And we can see it here, but can you briefly  
15:14:09 15 describe your educational background, please?

15:14:11 16 A. Yes. I was educated in Germany and received my  
15:14:18 17 master and Ph.D. from the University of Stuttgart.

15:14:26 18 Q. In what field were your degrees?

15:14:29 19 A. All the degrees that I hold are in the field of  
15:14:32 20 electrical engineering.

15:14:38 21 Q. And after you got your Ph.D., Dr. Schubert, what was  
15:14:42 22 the next step in your career?

15:14:44 23 A. I joined Bell Laboratories which is the research and  
15:14:52 24 development laboratory of AT&T, the well-known  
15:15:02 25 telecommunications company.

Schubert - direct

- 15:15:02 1 Q. How long did you work in Bell Labs?
- 15:15:05 2 A. A total of ten years. Two years as a postdoctoral
- 15:15:12 3 employee, and eight years of a member of technical staff.
- 15:15:16 4 Q. What was the subject of your work at Bell Labs?
- 15:15:20 5 A. The subject of my work was microelectronic materials
- 15:15:29 6 and devices, fabrication technology to make devices, and
- 15:15:35 7 measurements on the devices.
- 15:15:41 8 Q. And does this include work on semiconductor materials
- 15:15:47 9 and devices?
- 15:15:48 10 A. Yes, semiconductor materials such as gallium nitrite.
- 15:15:53 11 Q. For how long have you done work involving
- 15:15:56 12 semiconductor materials and devices?
- 15:16:02 13 A. I joined AT&T in the 1980s, and so that work was done
- 15:16:11 14 over a period of more than thirty years.
- 15:16:15 15 Q. And just briefly, what does that work entail?
- 15:16:21 16 A. It entails the fabrication of devices, and that is
- 15:16:28 17 typically done in the form of semiconductor wafers. The
- 15:16:34 18 patterning of the wafers, the removing of materials, and the
- 15:16:39 19 addition of materials.
- 15:16:42 20 Q. Thank you, Dr. Schubert.
- 15:16:45 21 And what did you do after working at Bell Labs?
- 15:16:50 22 A. I joined academia.
- 15:16:52 23 Q. Where did you join?
- 15:16:54 24 A. I joined Boston University initially and later RPI.
- 15:17:02 25 Q. And when you -- what was your role at BU?

Schubert - direct

15:17:09 1 A. At Boston University I was a professor in the  
15:17:14 2 Electrical Computer and Systems Engineering Department.  
15:17:17 3 Q. For how long did you work at BU?  
15:17:21 4 A. For seven years.  
15:17:26 5 Q. And do you recall what years it was that you worked  
15:17:32 6 at BU?  
15:17:33 7 A. Yes. I joined BU in 1995, and my employment ended in  
15:17:42 8 2002.  
15:17:45 9 Q. What did you do after working at BU, Dr. Schubert?  
15:17:49 10 A. I joined my present employer, RPI.  
15:17:54 11 Q. In your current position?  
15:17:57 12 A. Yes.  
15:17:59 13 Q. Do you have any publications, Dr. Schubert?  
15:18:05 14 A. Yes. I have about 300 journal publications. I have  
15:18:16 15 about 38 U.S. patents, issued U.S. patents. And I have  
15:18:27 16 written four books. The fourth one came out in three  
15:18:35 17 editions and was translated in Russian, Japanese and Korean.  
15:18:42 18 Q. What was the subject matter of that book,  
15:18:45 19 Dr. Schubert?  
15:18:48 20 A. The subject matter of the book was light-emitting  
15:18:53 21 diodes.  
15:18:54 22 Q. Have you received any awards?  
15:18:57 23 A. Yes. I have been named as fellow of multiple  
15:19:05 24 professional societies. And being a fellow is a  
15:19:12 25 distinction, it's only afforded to a very small percentage

Schubert - direct

15:19:16 1 of a professional society. For example, one percent. And I  
15:19:22 2 have been named an elective fellow of the IEEE Institute of  
15:19:34 3 Electrical and Electronics Engineers; of the OSA, Optical  
15:19:39 4 Society of America; of the APS, American Physical Society;  
15:19:47 5 and SPIE, the Optical Engineering Society. I have also  
15:19:56 6 received some other awards.

15:19:59 7 Q. Thank you.

15:20:00 8 And have you also been a technical expert  
15:20:04 9 witness in court cases?

15:20:06 10 A. Yes.

15:20:08 11 Q. Can you briefly describe that experience for us?

15:20:12 12 A. Yes. The role of a technical expert is to assist the  
15:20:21 13 decisionmaker in explaining the technology at issue. I have  
15:20:26 14 been an expert witness for about more than twenty years.  
15:20:34 15 And in that capacity I have written reports, I have been  
15:20:41 16 deposed, and I have testified in various venues. For  
15:20:49 17 example, the International Trade Commission, the USPTO,  
15:21:01 18 United States District Courts, and the American Arbitration  
15:21:09 19 Association.

15:21:12 20 Q. And on what types of technologies have you served as  
15:21:15 21 an expert witness, Dr. Schubert?

15:21:18 22 A. Generally microelectronic devices and this includes  
15:21:22 23 light-emitting devices, this includes silicon integrated  
15:21:35 24 circuits. This includes materials and fabrication  
15:21:42 25 technologies used for these devices.

Schubert - direct

15:21:47 1 Q. Thank you for that background, Dr. Schubert.

15:21:50 2 Now, let's talk about the patent-in-suit, the

15:21:54 3 '475 Patent. Can you describe at a high level what the '475

15:21:59 4 Patent is directed to?

15:22:03 5 A. Yes. The '475 Patent is directed to the etching of

15:22:15 6 gallium nitrate thin films. Gallium nitrate thin films are

15:22:22 7 deposited on a substrate and it is of interest when

15:22:26 8 fabricating devices to add and to remove material from that

15:22:34 9 thin gallium nitrite layer. The removal of material is

15:22:39 10 typically performed by etching. And a conventional etching

15:22:47 11 technique is wet chemical etching where we have a liquid

15:22:52 12 that attacks, attacks the semiconductor material.

15:22:57 13 Prior to the '475 Patent, a number of groups

15:23:03 14 have tried to wet chemically etch by conventional techniques

15:23:09 15 the thin gallium nitrite film. And what they have found

15:23:14 16 consistently is that gallium nitrite cannot be etched by

15:23:21 17 conventional etching techniques.

15:23:22 18 And the gallium nitrite was found to be inert.

15:23:30 19 It was found to be impervious. The discovery that we made

15:23:37 20 and that is detailed in the '475 Patent is that it is only

15:23:42 21 the top plane of the gallium nitrite film, the top plane or

15:23:51 22 the C plane that is impervious. If we go to different

15:23:57 23 surfaces, different planes, for example, if we use the

15:24:01 24 bottom plane, it's sort of the top plane, the bottom plane

15:24:06 25 etches very rapidly. If we use other planes such as

Schubert - direct

15:24:11 1 sidewalls or side planes, the etching rate is also nonzero.  
15:24:19 2 So therefore, we have found that the prior understanding was  
15:24:26 3 misguided. The prior understanding was that gallium nitrite  
15:24:35 4 --

15:24:35 5 MR. JOHNSON: Your Honor, I understand  
15:24:36 6 Dr. Schubert is here as a fact witness today, not as an  
15:24:39 7 expert witness.

15:24:40 8 THE COURT: I was actually kind of curious. It  
15:24:42 9 doesn't seem like this is really focused on the issue in  
15:24:45 10 front of me. I appreciate getting some background, but I  
15:24:49 11 don't need to know this, so how about we get to --

15:24:57 12 MS. HARIHAR: It was meant to be a short  
15:24:58 13 introduction. Dr. Schubert is finishing up momentarily.

15:25:02 14 THE COURT: I think we can move on right now.

15:25:04 15 MS. HARIHAR: Sure. Thank you, Your Honor.

15:25:08 16 BY MS. HARIHAR:

15:25:09 17 Q. So Dr. Schubert, when was the research done that led  
15:25:12 18 to the '475 Patent?

15:25:15 19 A. 1997 and 1998.

15:25:20 20 Q. Did anyone assist you in this research?

15:25:23 21 A. Yes. I was assisted by my former graduate student,  
15:25:30 22 Dean Stocker, who is also an inventor on the '475 Patent.

15:25:35 23 Q. And are you and Dean Stocker the only co-inventors of  
15:25:40 24 the '475 Patent?

15:25:42 25 A. Yes, that is correct.

Schubert - direct

15:25:43 1 Q. Did you submit an inventor's disclosure to BU on your  
15:25:48 2 research regarding the '475 Patent?

15:25:52 3 A. Yes, we did.

15:25:54 4 Q. And did BU decide to proceed patenting of the  
15:26:08 5 invention?

15:26:09 6 A. Yes.

15:26:14 7 Q. And was a provisional application filed,  
15:26:17 8 Dr. Schubert?

15:26:18 9 A. Yes, a provisional patent application was filed in  
15:26:24 10 1998, and a regular patent application was filed in 1999.

15:26:33 11 Q. Thank you.

15:26:33 12 And what was your involvement in the patent  
15:26:36 13 application process?

15:26:38 14 A. I submitted the invention disclosure. I wrote a  
15:26:50 15 companion paper that explains in detail the technology. I  
15:26:56 16 responded to queries from the Boston University Office of  
15:27:09 17 Technology Transfer. And I worked with the technology  
15:27:14 18 transfer people on the patent application.

15:27:22 19 Q. And do you recall any specifics regarding the patent  
15:27:26 20 prosecution of the '475 Patent itself?

15:27:30 21 A. Yes. I recall that we, the two inventors, submitted  
15:27:32 22 the declaration under -- during the patent prosecution  
15:27:42 23 period.

15:27:44 24 Q. And did you personally file that declaration with the  
15:27:52 25 USPTO during prosecution of the '475 Patent?

Schubert - direct

15:28:00 1 A. No. I gave it back -- I don't have a clear  
15:28:07 2 recollection, but my regular contact with the Office of  
15:28:12 3 Technology Transfer, so I assume I gave it back to the  
15:28:14 4 Office of Technology Transfer.

15:28:17 5 Q. Have you ever personally filed anything with the  
15:28:20 6 USPTO?

15:28:23 7 A. I don't recall any personal filings with the USPTO.

15:28:28 8 Q. And do you recall who the attorney responsible for  
15:28:32 9 prosecuting the '475 Patent was?

15:28:36 10 A. I understand that it was Matt Connors.

15:28:41 11 Q. Have you ever spoken with Mr. Connors?

15:28:49 12 A. I don't remember having met him ever in person. I  
15:28:57 13 saw his face for the first time yesterday. I don't recall  
15:29:03 14 any conversation with him. I don't think I talked to him.

15:29:08 15 Q. And what is your typical role on prosecutions of  
15:29:22 16 inventions, Dr. Schubert?

15:29:24 17 A. I conveyed and explained the technology in the  
15:29:28 18 invention disclosure. I usually write a companion paper  
15:29:34 19 that is more detailed. I provide prior art to the  
15:29:42 20 prosecution efforts. I provide all information that I think  
15:29:48 21 is relevant. And I respond to questions that I receive.

15:29:58 22 Q. And did you understand at the time of prosecution of  
15:30:02 23 the '475 Patent that you were under a duty of candor to the  
15:30:07 24 Patent Office?

15:30:07 25 A. Yes, that is my understanding.

Schubert - direct

15:30:10 1 Q. And what is your understanding of what that means?

15:30:14 2 A. Providing all relevant information, not hold anything  
15:30:25 3 back, be forthcoming with information that relates to the  
15:30:31 4 patent application.

15:30:33 5 Q. And did you have a duty to share with the Patent  
15:30:37 6 Office other references in the art?

15:30:41 7 A. Yes, my understanding is that all relevant prior art  
15:30:50 8 must be submitted to my contact person and ultimately to the  
15:31:00 9 USPTO.

15:31:02 10 Q. At that time who would you have given any such  
15:31:06 11 references? As a general matter?

15:31:13 12 A. As a general matter my contact person, my general  
15:31:17 13 contact person at the University, so in this particular case  
15:31:23 14 I would assume that it would have been Janine Anderson.

15:31:28 15 Q. Have you ever been involved in prosecuting a patent  
15:31:32 16 application on your own, Dr. Schubert?

15:31:35 17 A. No, I don't recall any of the patents that bear my  
15:31:41 18 name as an inventor. None of these patents that bear my  
15:31:46 19 name as an inventor were submitted by myself or prosecuted  
15:31:52 20 by myself. I am not a patent agent. And I am not a patent  
15:31:57 21 attorney.

15:31:57 22 Q. And who typically retains the prosecution counsel to  
15:32:03 23 prosecute the patent application on which you have been an  
15:32:06 24 inventors?

15:32:10 25 A. When I was at industry in AT&T it was an in-house

Schubert - direct

15:32:16 1 counsel. In academia, the respected university I would  
15:32:21 2 assume hired a patent attorney.

15:32:25 3 Q. Thank you, Dr. Schubert. And do you recall on what  
15:32:28 4 date the '475 Patent issued?

15:32:31 5 A. Yes. September 25, 2001.

15:32:36 6 Q. And if you could please look at JTX 1 in your binder.  
15:32:47 7 We see on the first page of the patent that September 25th,  
15:32:52 8 2001, date. Dr. Schubert, between issuance of the patent in  
15:32:56 9 2001 and BU contacting you in 2009, did you have anything to  
15:33:03 10 do with the '475 Patent?

15:33:06 11 A. No, I don't recall any activity in that regard.

15:33:11 12 Q. And can you just remind us in what year it was that  
15:33:15 13 you left BU?

15:33:17 14 A. My employment ended in 2002.

15:33:24 15 Q. And we've heard a bit about why you got involved  
15:33:29 16 again with the Technology Transfer Office. Can you tell us  
15:33:33 17 in your own words with BU's return of the '475 Patent to  
15:33:38 18 you?

15:33:41 19 A. Yes. Based on the record, I understand that Sean Lee  
15:33:50 20 contacted me in early September of 2009, offering to '475  
15:34:02 21 Patent to me.

15:34:06 22 Q. And Dr. Schubert, can you please turn to JTX 17. And  
15:34:18 23 you can see it on the screen there, too, Dr. Schubert. Is  
15:34:22 24 this an e-mail from Dr. Sean Lee that you're referring to?

15:34:30 25 A. Yes.

Schubert - direct

15:34:31 1 Q. As a general matter, Dr. Schubert, do you  
15:34:35 2 specifically recall these events from 2009 and 2010?

15:34:44 3 A. I recall that Boston University offered the patent to  
15:34:48 4 me, but I don't specifically recall receiving this e-mail.  
15:34:55 5 I don't recall the specific events, but I generally recall  
15:34:59 6 that Boston University contacted me regarding the '475  
15:35:05 7 Patent.

15:35:05 8 Q. And you would agree that the documents appear to  
15:35:10 9 indicate what had occurred during this time period?

15:35:14 10 A. Yes.

15:35:18 11 Q. Do you recall interacting with Dr. Lee at this time  
15:35:21 12 or prior to this time?

15:35:27 13 A. I have not been in contact with Sean Lee prior to  
15:35:36 14 this interaction. I have not known his name prior to this  
15:35:41 15 interaction.

15:35:43 16 Q. And you mentioned Anderson earlier. Who do you  
15:35:48 17 recall working with in the BU tech transfer office?

15:35:52 18 A. Yes, I recall working with Janine Anderson, you  
15:36:01 19 already mentioned, and also with Ashley Stevens, and towards  
15:36:12 20 the end of my tenure with Michael Pratt.

15:36:23 21 Q. And did you know Ashley Stevens?

15:36:26 22 A. Yes. We met on several occasions.

15:36:32 23 Q. What was your understanding of Dr. Stevens' role at  
15:36:38 24 BU?

15:36:39 25 A. My understanding was that he is the head of the

Schubert - direct

15:36:48 1

Technology Transfer Office.

15:36:52 2

Q. Do you believe that Dr. Stevens reflected a competent

15:36:58 3

view on patent matters?

15:37:02 4

A. Yes.

15:37:05 5

Q. And what's that based on, Dr. Schubert?

15:37:11 6

A. I had interacted with him on multiple projects, and

15:37:21 7

there was never any hiccup, and things went smoothly. I

15:37:31 8

don't recall any problems.

15:37:34 9

Q. And what is your understanding of Ms. Anderson's role

15:37:41 10

at BU?

15:37:48 11

A. She had frequently served as the person to contact

15:37:56 12

for paperwork, for things that needed to be done, for

15:38:04 13

standards type of interactions, for papers to be signed that

15:38:12 14

regularly went through her.

15:38:15 15

Q. And what was your understanding of Mr. Pratt's role

15:38:19 16

at BU?

15:38:33 17

A. He was -- towards the end of my tenure, he became my

15:38:38 18

person of contact of the Technology Transfer Office, so I

15:38:44 19

had a number of discussions with him. I think we filed

15:38:48 20

additional invention disclosures towards the end of my

15:38:54 21

tenure, and I had communicated on those ones with Michael

15:39:02 22

Pratt.

15:39:07 23

Q. If we look back at JTX 17, Dr. Schubert, what's your

15:39:12 24

understanding of what's happening in this e-mail?

15:39:15 25

A. My understanding is that Boston University offered to

Schubert - direct

15:39:22 1 transfer ownership of the '475 Patent to me.

15:39:32 2 Q. Do you have an understanding of why BU reached out to  
15:39:36 3 you regarding the '475 Patent?

15:39:41 4 A. No, I don't know.

15:39:45 5 Q. Do you recall BU having any types of policies  
15:39:52 6 regarding inventors and patents?

15:40:01 7 A. Yes, I recall an IP quality or universities in  
15:40:05 8 general have typically intellectual property policies.

15:40:13 9 Q. Dr. Schubert, if you could please turn to JTX 13 in  
15:40:18 10 your binder. Is this -- and you can see it on the screen,  
15:40:24 11 Dr. Schubert. Is this BU's patent policy?

15:40:35 12 A. Yes.

15:40:38 13 Q. And if we go back to JTX 17, actually, and look at  
15:40:45 14 the second paragraph on page JTX 17.001, Dr. Schubert, it  
15:40:54 15 discusses maintenance fees for the '475 Patent. At that  
15:41:01 16 time do you recall having an understanding of what  
15:41:08 17 maintenance fees were?

15:41:10 18 A. Beyond just the word maintenance fees, I don't know.  
15:41:18 19 I have never been involved in the payment of maintenance  
15:41:26 20 fees or the management of maintenance fees, so maintenance  
15:41:32 21 fees was not something that I was active in or that I had an  
15:41:38 22 understanding in.

15:41:40 23 Q. And at the time of this e-mail on September 2nd,  
15:41:46 24 2009, did you own any patents at that time?

15:41:49 25 A. I did not, no.

Schubert - direct

15:41:51 1 Q. Do you currently own any patents?

15:41:54 2 A. Yes. I own the patents that have been returned to me  
15:41:59 3 by Boston University, and these are two patents.

15:42:03 4 Q. And that's the '475 Patent and one other patent,  
15:42:06 5 right, Dr. Schubert?

15:42:08 6 A. That is correct.

15:42:12 7 Q. And did you obtain both of those patents around the  
15:42:18 8 same time period from BU?

15:42:21 9 A. Yes.

15:42:25 10 Q. Did you respond to Dr. Lee's September 2nd e-mail,  
15:42:30 11 Dr. Schubert?

15:42:32 12 A. Yes. I responded on the same day.

15:42:39 13 Q. And if you could please turn to JTX 29 in your  
15:42:44 14 binder, Dr. Schubert, and we'll pull it up on the screen.  
15:42:52 15 Just to orient, if we look at the bottom of JTX 29.002  
15:42:58 16 through JTX 29.003, you see Dr. Lee's e-mail of September  
15:43:05 17 2nd. And right above that on page JTX 29.002, about three  
15:43:17 18 quarters of the way down, is that your response to Dr. Lee,  
15:43:23 19 to Dr. Lee's September 2nd e-mail, Dr. Schubert?

15:43:27 20 A. Yes, it is.

15:43:29 21 Q. And what was your response?

15:43:32 22 A. He asked me if I would be interested, and I responded  
15:43:37 23 thank you very much for the offer. Unfortunately I would  
15:43:42 24 not be interested.

15:43:44 25 Q. Dr. Schubert, why did you initially decline BU's

Schubert - direct

15:43:49 1

offer?

15:43:55 2

A. For me it was a time that was very busy. I had

15:44:01 3

administrative responsibilities and I had research and

15:44:05 4

teaching responsibilities. And at that time I would not

15:44:11 5

have been able to accept another activity. And for that

15:44:16 6

reason, I said I would not be able to accept ownership of

15:44:24 7

the '475 Patent.

15:44:30 8

Q. And after you declined Lee's offer in September 2009,

15:44:36 9

what did you do next, Dr. Schubert?

15:44:39 10

A. I understand that I contacted Dr. Sean Lee in

15:44:50 11

December of 2009, expressing my interest in accepting

15:45:00 12

ownership of the '475 Patent. So I understand that during

15:45:04 13

the period September 2009 to December 2009, I became more

15:45:19 14

available and had additional time. It was a change in my

15:45:27 15

activities. And I contacted him expressing interest in his

15:45:34 16

offer of September 2009.

15:45:43 17

Q. And so if we look back at JTX 29.002 about halfway

15:45:50 18

down, is this e-mail you're referring to where you contacted

15:45:55 19

Dr. Lee in December of 2009, Dr. Schubert?

15:46:02 20

A. Yes.

15:46:08 21

Q. At this time were you interested in obtaining the

15:46:12 22

'475 Patent?

15:46:15 23

A. Yes, I had thought about the '475 Patent during that

15:46:20 24

period, and I remember my interest growing, so I expressed

15:46:22 25

my interest in this e-mail.

Schubert - direct

15:46:36 1 Q. And was there -- do you recall anything specifically  
15:46:43 2 triggering your sending that December 2nd e-mail?

15:46:50 3 A. I don't recall anything specific, but I recall that I  
15:46:58 4 became aware of fabrication processes that are used in  
15:47:06 5 conjunction with LEDs where thin film of gallium nitrate are  
15:47:16 6 subjected to the same etching procedures that we disclosed  
15:47:20 7 in the '475 Patent.

15:47:25 8 Q. Thank you, Dr. Schubert.

15:47:26 9 And when you reached out to Dr. Lee on  
15:47:31 10 December 2nd, do you recall whether you knew about the '475  
15:47:36 11 Patent had expired?

15:47:40 12 A. I don't recall anything about that. Expiration is  
15:47:47 13 something from the legal domain. My interests are in the  
15:47:51 14 technical domain. And it may not have been -- it may not  
15:47:59 15 have registered that the patent had expired.

15:48:03 16 Q. And you may have mentioned this earlier,  
15:48:07 17 Dr. Schubert, but do you recall any conversations with  
15:48:09 18 Dr. Lee during this time period?

15:48:12 19 A. I do not specifically recall a telephone conversation  
15:48:17 20 or an in-person conversation with Dr. Sean Lee.

15:48:24 21 Q. What happened next, Dr. Schubert, after the  
15:48:28 22 December 2nd e-mail?

15:48:31 23 A. I received a response. And he initially said it  
15:48:39 24 would not be possible to return the patent to me. And I  
15:48:43 25 think there was an additional e-mail shortly thereafter

Schubert - direct

15:48:49 1 indicating that BU would be willing to return the '475

15:48:55 2 Patent to me.

15:48:57 3 Q. Thank you.

15:48:59 4 Dr. Schubert, if you could please turn to JTX 19  
15:49:03 5 in your binder, and we'll pull it up on the screen as well.

15:49:07 6 Is this the first e-mail that you're referring to,

15:49:10 7 Dr. Schubert?

15:49:14 8 A. Yes.

15:49:21 9 Q. Why did you respond to Dr. Lee's December 3rd e-mail?

15:49:31 10 A. I did not fully understand his e-mail. And also,  
15:49:37 11 generally I believe that a conversation, for example, a  
15:49:43 12 telephone conversation, can be more informative than an  
15:49:48 13 e-mail conversation.

15:49:52 14 Q. We'll come back to this a little bit later,  
15:49:55 15 Dr. Schubert. But what's your understanding of what  
15:49:58 16 happened after this December 3rd e-mail? I believe you  
15:50:02 17 mentioned earlier --

15:50:04 18 A. Based on the record I understand that Dr. Sean Lee  
15:50:08 19 sent me another e-mail indicating that the return of the  
15:50:15 20 '475 Patent to me would be possible.

15:50:18 21 Q. And if we could pull up JTX 18. If we look at JTX  
15:50:24 22 18.001, Dr. Schubert, about a third of the way down, do you  
15:50:29 23 see an e-mail from Dr. Lee on December 10th, 2009? Was this  
15:50:36 24 the e-mail you're referring to, Dr. Schubert?

15:50:39 25 A. Yes.

Schubert - direct

15:50:41 1 Q. Could you please read the first sentence of that  
15:50:43 2 e-mail out loud, Dr. Schubert?

15:50:47 3 A. Dr. Sean Lee says, "I was able to speak to Ashley,  
15:50:53 4 and his brief reaction was that we could probably work  
15:50:56 5 something out, though we need to discuss details."

15:51:11 6 Q. Did you understand what Dr. Lee was referring to?

15:51:18 7 A. My understanding was that it would be possible to  
15:51:20 8 return the '475 Patent to me. And that is what the e-mail  
15:51:27 9 indicates.

15:51:28 10 Q. And when Dr. Lee refers to Ashley here, who do you  
15:51:35 11 understand that to be?

15:51:36 12 A. Ashley Stevens, the head or the executive of the  
15:51:42 13 Technology Transfer Office.

15:51:44 14 Q. Do you specifically recall these e-mails that we're  
15:51:49 15 discussing now, Dr. Schubert?

15:51:50 16 A. I do not. I have reviewed them in preparation for  
15:51:56 17 deposition and trial, but I do not recall them from the --  
15:52:02 18 from my memory.

15:52:04 19 Q. And do you know how Dr. Lee thought it could be  
15:52:09 20 worked out?

15:52:12 21 A. No.

15:52:17 22 Q. Dr. Schubert, can you tell us what happened next  
15:52:23 23 after you got these two different e-mails from Dr. Lee in  
15:52:28 24 December of 2009?

15:52:29 25 A. I recall an in-person meeting in January 2010 at

Schubert - direct

15:52:35 1 Boston University.

15:52:49 2 Q. And do you recall the substance of any discussions  
15:52:59 3 that occurred during that meeting?

15:53:01 4 A. No, I'm sorry, I don't recall.

15:53:03 5 THE COURT: You don't recall anything that  
15:53:04 6 happened at that meeting? Do you remember that the '475  
15:53:07 7 Patent was discussed? I mean, nothing, really, nothing?

15:53:10 8 THE WITNESS: I remember the conference room.  
15:53:12 9 It was a relatively large conference room.

15:53:15 10 THE COURT: Do you remember who was there?

15:53:16 11 THE WITNESS: I remember Ashley Stevens was  
15:53:18 12 there. And I remember that I always have to listen to him  
15:53:24 13 very carefully because he's a fast speaker. But I do not  
15:53:30 14 recall --

15:53:30 15 THE COURT: Was it about your patent or was it  
15:53:32 16 about something else?

15:53:33 17 THE WITNESS: It certainly was about the patent.

15:53:35 18 THE COURT: Okay. But you don't remember  
15:53:37 19 anything? Was it about you getting the patent back? Was it  
15:53:40 20 about you paying money? I just am trying to understand, you  
15:53:42 21 don't do this very often. You had this meeting. You  
15:53:42 22 apparently for three months were thinking about getting this  
15:53:52 23 patent back because in December you changed your mind, so I  
15:53:52 24 just don't believe you can't remember anything. And it  
15:54:00 25 seems like we're just going down this I don't remember

Schubert - direct

15:54:02 1 anything that happened, and I think there is probably some  
15:54:06 2 stuff in there that you remember if you're asked to remember  
15:54:09 3 it. So think back on anything you remember about that  
15:54:14 4 meeting, can you tell us?

15:54:17 5 THE WITNESS: Certainly, Your Honor. I remember  
15:54:22 6 it was a large conference room. I remember Ashley Stevens  
15:54:28 7 was speaking with me. There may have been additional people  
15:54:32 8 in the room. And -- but I don't think they -- I don't  
15:54:39 9 remember anything about them. And based on the timing, we  
15:54:48 10 must have discussed the return of the '475 Patent to me.  
15:54:56 11 Beyond that --

15:54:58 12 THE COURT: Do you remember how long it was?  
15:55:01 13 Was it a morning? Did you have lunch? Did you have  
15:55:03 14 breakfast?

15:55:04 15 THE WITNESS: My recollection, I would assume it  
15:55:06 16 was like a thirty to forty-five-minute meeting. Maybe an  
15:55:10 17 hour. I would say it was less than one hour meeting, that  
15:55:15 18 would be my estimate. I don't recall really the meeting  
15:55:20 19 time how long it took. But I was in Boston. I don't know  
15:55:22 20 the reason why I was in Boston. I am occasionally in  
15:55:32 21 Boston. And certainly the discussion must have revolved  
15:55:32 22 around the return of the '475 Patent to me.

15:55:42 23 THE COURT: Thank you.

15:55:42 24 BY MS. HARIHAR:

15:55:52 25 Q. So Dr. Schubert, was the '475 Patent ultimately

Schubert - direct

- 15:55:53 1 assigned to you?
- 15:55:55 2 A. Yes.
- 15:55:56 3 Q. Do you recall when?
- 15:56:01 4 A. October 2010.
- 15:56:07 5 Q. And during that time before the assignment to you,
- 15:56:12 6 Dr. Schubert, the '475 Patent was revived by BU in April
- 15:56:15 7 2010. You understand that, right?
- 15:56:19 8 A. Yes, I do.
- 15:56:21 9 Q. Did you ask BU to petition to revive the patent?
- 15:56:27 10 A. No, I don't -- I did not.
- 15:56:35 11 Q. Were you ever responsible for reviving the '475
- 15:56:40 12 Patent?
- 15:56:40 13 A. No, I was not. I was responsible for getting,
- 15:56:48 14 obtaining the consent of two federal funding agencies. The
- 15:56:55 15 first one was the NSF, or National Science Foundation. And
- 15:57:00 16 the second was ONR, or Office of Naval Research. And it was
- 15:57:10 17 my responsibility to obtain the consents of these two
- 15:57:17 18 organizations. And that's another topic that may have been
- 15:57:21 19 discussed during the January meeting. But I don't recall.
- 15:57:24 20 Ultimately I approached these federal agencies and received
- 15:57:31 21 their consent for the return of the patent to me.
- 15:57:38 22 Q. Do you recall approximately how long it took to
- 15:57:41 23 obtain approval from the agencies?
- 15:57:46 24 A. My recollection is that it took several months.
- 15:57:51 25 Q. Did you participate in any way in working with

Schubert - direct

15:57:55 1 counsel or anyone else at BU in preparing the petition for  
15:57:59 2 revival?

15:58:02 3 A. No, I did not.

15:58:04 4 Q. Were you provided with the draft petition?

15:58:08 5 A. No.

15:58:11 6 THE COURT: Do you remember the date when you  
15:58:14 7 approached the federal agencies, was that before or after  
15:58:18 8 the patent was revived?

15:58:22 9 THE WITNESS: That I don't know.

15:58:23 10 THE COURT: Did you keep that correspondence?

15:58:25 11 Do we have that correspondence?

15:58:27 12 MS. HARIHAR: I believe that correspondence  
15:58:29 13 might be in JTX 10, Your Honor.

15:58:31 14 THE COURT: Can we figure out what the dates  
15:58:33 15 were?

15:58:36 16 MS. HARIHAR: Yes. And just from my own  
15:58:38 17 recollection, I believe it was after the revival that  
15:58:43 18 Dr. Schubert started contacting agencies. But we will  
15:58:50 19 definitely double-check and give you the cites, Your Honor.

15:59:02 20 Do you want me to proceed?

15:59:04 21 THE COURT: Yes.

15:59:12 22 BY MS. HARIHAR:

15:59:12 23 Q. Did you have any discussions with Mr. Connors at this  
15:59:16 24 time, Dr. Schubert?

15:59:17 25 A. At which time?

Schubert - direct

15:59:19 1 Q. During 2010 when the patent was in the process of  
15:59:23 2 being revived?

15:59:25 3 A. No, I don't recall any discussions with Mr. Connors.

15:59:29 4 Q. Did Mr. Connors represent you in the 2009-2010 time  
15:59:35 5 frame?

15:59:37 6 A. Legal representation? No.

15:59:42 7 Q. Is there any time since you left BU that you have  
15:59:48 8 been represented by Mr. Connors?

15:59:52 9 A. No.

15:59:54 10 Q. Did you ever receive a bill from Mr. Connors during  
15:59:58 11 this time?

16:00:00 12 A. No, I don't recall receiving any bills from him. I  
16:00:05 13 did receive invoices from Boston University.

16:00:10 14 Q. Did you agree to reimburse the USPTO to revive the  
16:00:18 15 patent?

16:00:19 16 A. Yes.

16:00:21 17 Q. And Dr. Schubert, if you could please --

16:00:25 18 THE COURT: How about before we go to the next  
16:00:27 19 exhibit we take a fifteen-minute break.

16:00:29 20 (A brief recess was taken.)

16:19:12 21 THE COURT: Thank you. Please be seated.

16:19:23 22 MS. HARIHAR: Thank you.

16:19:24 23 BY MS. HARIHAR:

16:19:25 24 Q. Dr. Schubert, if you could please turn to JTX 10 in  
16:19:29 25 your binder. Specifically if we could please look at JTX

Schubert - direct

16:19:33 1 10.07 -- I'm sorry, JTX 10.071. Dr. Schubert, do you  
16:19:42 2 recognize this letter that's on JTX 10.071 through 073?

16:19:55 3 A. Yes.

16:19:55 4 Q. What is this letter?

16:19:57 5 A. This letter is an agreement between Boston University  
16:20:02 6 and myself relating to the '475 Patent.

16:20:08 7 Q. And how much did you provide to BU in exchange for  
16:20:14 8 the '475 Patent?

16:20:15 9 A. My recollection is that this letter details a fee of  
16:20:24 10 \$10,000, and another fee of \$3,700, so a total of  
16:20:31 11 approximately \$14,000.

16:20:33 12 Q. And if we -- I think we can see that on JTX 0 -- JTX  
16:20:43 13 10072, right, Dr. Schubert?

16:20:46 14 A. Yes. In the first paragraph there is a fee of  
16:20:55 15 \$3,771. And in the following paragraph there is a  
16:21:01 16 reimbursement of \$10,000 to cover prosecution costs, or at  
16:21:12 17 least partially cover prosecution costs.

16:21:16 18 Q. And Dr. Schubert, when you were acquiring the '475  
16:21:21 19 Patent from BU, were you represented by counsel for this  
16:21:27 20 acquisition?

16:21:29 21 A. No, I was not.

16:21:32 22 Q. And did you believe there were issues with the patent  
16:21:37 23 when you acquired?

16:21:39 24 A. No, I did not believe that there are any issues, any  
16:21:42 25 difficulties with the patent.

Schubert - direct

16:21:46 1 Q. Thank you.

16:21:46 2 And while we're in this document and to address  
16:21:50 3 the Court's questions earlier, Dr. Schubert, if we could  
16:21:54 4 please look at JTX 10.077. And we see Dr. Schubert, and you  
16:22:11 5 have this in your binder. You can also see it on the  
16:22:15 6 screen. Do you recall these e-mails regarding contacting  
16:22:22 7 the agencies on returning the '475 Patent to you?

16:22:30 8 A. I recall that I contacted people at the National  
16:22:40 9 Science Foundation, NSF, and I also contacted people at the  
16:22:45 10 Office of Naval Research, ONR, asking for their consent for  
16:22:50 11 the return of the patent to me.

16:22:55 12 Q. And let's switch gears for a little bit,  
16:23:00 13 Dr. Schubert.

16:23:00 14 Do you recall an inter parte review being filed  
16:23:07 15 against the '475 Patent?

16:23:08 16 A. Yes, I do.

16:23:09 17 Q. By whom was that IPR filed?

16:23:13 18 A. The IPR was filed by the Osram Company.

16:23:18 19 Q. And Dr. Schubert, could you please turn to PTX 065 in  
16:23:20 20 your binder, and it's here on the screen. Is this Osram's  
16:23:31 21 petition for IPR filed against the '475 Patent?

16:23:32 22 A. Yes.

16:23:38 23 Q. Dr. Schubert, was the USPTO informed by Osram of  
16:23:42 24 facts regarding the expiration of the '475 Patent?

16:23:42 25 A. Yes.

Schubert - direct

16:23:50 1 Q. And if we could please look at PTX 065.014. The  
16:23:58 2 first full paragraph on this page. Dr. Schubert, is this  
16:24:02 3 where Osram informed the USPTO of those facts?

16:24:11 4 A. Yes.

16:24:14 5 Q. Did the USPTO take any action regarding Osram's  
16:24:20 6 allegations to your knowledge?

16:24:25 7 A. To my understanding, the USPTO did not take any  
16:24:31 8 action.

16:24:32 9 Q. Did anyone propose that you needed to do something  
16:24:36 10 further with the Patent Office regarding Osram's  
16:24:39 11 allegations?

16:24:45 12 A. No.

16:24:47 13 Q. If something needed to be done with the USPTO, who  
16:24:53 14 would do it?

16:24:58 15 A. At that time, 2013, I was represented by counsel, and  
16:25:03 16 so I would defer to counsel if anything had to be done with  
16:25:07 17 the USPTO.

16:25:10 18 Q. And let's switch gears again, Dr. Schubert. Do you  
16:25:16 19 recall reaching out to Dean Stocker during this process  
16:25:19 20 regarding the '475 Patent?

16:25:22 21 A. Yes, I do.

16:25:24 22 Q. Why did you contact Dr. Stocker?

16:25:27 23 A. Based on my understanding, there is no difference  
16:25:32 24 between inventors. So Dean Stocker and I, we both are  
16:25:35 25 inventors, and therefore the same rules or offers need to be

Schubert - direct

16:25:47 1       afforded to both inventors. And I understood that Boston  
16:25:55 2       University had tried to contact Dean Stocker and offer him  
16:25:59 3       the patent. And was not successful in contacting him.

16:26:08 4       Q.       So what -- I'm sorry, Dr. Schubert, continue.

16:26:12 5       A.       Yes.

16:26:12 6                       So I reached out to Dean Stocker and after some  
16:26:18 7       time identified his whereabouts. And he at that time was a  
16:26:26 8       Christian missionary in Africa. And I called after  
16:26:34 9       communicating by e-mail with him, I called him and just had  
16:26:39 10       a conversation with him, explained the situation with the  
16:26:47 11       '475 Patent, and asked if he would be interested.

16:26:52 12       Q.       And if we could look at JTX 36, please, Dr. Schubert.  
16:26:59 13       Is this some of that correspondence where you first  
16:27:04 14       contacted Dr. Stocker?

16:27:09 15       A.       Yes.

16:27:14 16       Q.       And do you recall if the patent had already been  
16:27:19 17       returned to you at this time?

16:27:22 18       A.       I understand that the patent was returned to me on  
16:27:27 19       October 20th, and so this was about a week before the patent  
16:27:32 20       had been returned to me.

16:27:37 21       Q.       Would you have still acquired the '475 Patent if  
16:27:42 22       Dr. Stocker wanted the patent, too?

16:27:47 23       A.       No.

16:27:52 24       Q.       Why not?

16:27:57 25       A.       If he had wanted to acquire the patent, I would have

Schubert - direct

16:27:53 1 let him acquire the patent. And I also thought about the  
16:28:02 2 possibility that the two of us jointly acquire the patent,  
16:28:07 3 but I would not have wanted it because it would have made  
16:28:12 4 things more complicated, so basically every decision would  
16:28:16 5 need to be coordinated with him, and I thought that this is  
16:28:21 6 too complicated.

16:28:22 7 Q. Did Dr. Stocker ultimately express interest in having  
16:28:26 8 the '475 Patent returned to him?

16:28:28 9 A. No, he did not. After I explained the situation to  
16:28:32 10 him, he said he has other priorities and would not be  
16:28:37 11 interested in assuming an ownership of the patent.

16:28:39 12 Q. If we could pull up JTX 37. Is this where  
16:28:49 13 Dr. Stocker indicated he's not interested, Dr. Schubert?

16:28:55 14 A. Yes.

16:28:58 15 Q. And Dr. Schubert, just very briefly, why did you want  
16:29:09 16 to acquire the '475 Patent?

16:29:14 17 A. In academia there are various activities, teaching,  
16:29:23 18 research, but one activity is also commercialization,  
16:29:27 19 getting an invention from the research laboratory into  
16:29:34 20 practice. And licensing an invention is part of the  
16:29:41 21 commercialization effort. And I thought it was generally an  
16:29:47 22 interesting activity to commercialize an invention, to make  
16:29:53 23 the invention be used by industry.

16:29:59 24 Q. Thank you, Dr. Schubert.

16:30:03 25 MS. HARIHAR: And I have no further questions.

Schubert - cross

16:30:05 1 But just at this time I did want to enter some exhibits that  
16:30:08 2 I believe have not previously been entered, if I may.

16:30:11 3 THE COURT: Okay.

16:30:13 4 MS. HARIHAR: That would be JTX 1, JTX 8, JTX  
16:30:18 5 13, JTX 18, JTX 36, JTX 37, and PTX 065.

16:30:33 6 THE COURT: Any objection?

16:30:36 7 MR. JOHNSON: None, Your Honor.

16:30:36 8 THE COURT: All right. They're admitted. Thank  
16:30:41 9 you.

16:30:41 10 Cross.

16:30:43 11 MR. JOHNSON: May I, Your Honor?

16:30:44 12 THE COURT: Absolutely.

16:30:44 13 CROSS-EXAMINATION

16:30:44 14 BY MR. JOHNSON:

16:30:45 15 Q. Good afternoon, Dr. Schubert. Ward Johnson here.

16:30:49 16 Nice to see you, sir.

16:30:51 17 A. Good afternoon.

16:30:51 18 THE COURT: Are you guys able to see each other?

16:30:56 19 MR. JOHNSON: I can see him, Your Honor. I can  
16:30:52 20 see the witness.

16:30:58 21 THE COURT: And Dr. Schubert, you can see?

16:30:58 22 THE WITNESS: Yes, I can, Your Honor.

16:31:02 23 BY MR. JOHNSON:

16:31:02 24 Q. Dr. Schubert, if you don't mind my asking, what does  
16:31:04 25 the E stand for?

Schubert - cross

16:31:07 1 A. My name given to me at birth is Erdmann,  
16:31:16 2 E-R-D-M-A-N-N. When I was naturalized as a U.S. citizen in  
16:31:22 3 the 1990s, the first name became Eric, E-R-I-C.

16:31:29 4 Q. Thank you, sir.

16:31:31 5 I've spent some time reading your impressive CV.  
16:31:37 6 I notice that you sure have spent a lot of time with lawyers  
16:31:41 7 over the past quarter century, haven't you?

16:31:45 8 A. I have served as an expert witness in patent cases  
16:31:50 9 and so I would say yes, an expert witness I have interacted  
16:31:58 10 with lawyers.

16:32:00 11 Q. Thank you, sir.

16:32:01 12 And in the interest of time because our time is  
16:32:03 13 so short, I ask that you answer yes or no questions with a  
16:32:06 14 yes or no, if you can. Do you understand me, sir?

16:32:11 15 A. Yes.

16:32:12 16 Q. Thank you, sir.

16:32:13 17 Pretty much all of your engagements as an expert  
16:32:18 18 witness have been in patent cases; isn't that right?

16:32:23 19 A. That's correct.

16:32:25 20 Q. And in addition to being an expert as I think you  
16:32:28 21 have kind of mentioned, you're also a co-inventor on more  
16:32:32 22 than thirty U.S. patents, thirty some U.S. patents, isn't  
16:32:35 23 that right, sir?

16:32:40 24 A. Yes, correct.

16:32:42 25 Q. And as I think you mentioned in direct, you testified

Schubert - cross

16:32:46 1 professionally at depositions, yes?

16:32:51 2 A. Yes.

16:32:52 3 Q. In district court?

16:32:56 4 A. Yes.

16:32:57 5 Q. Arbitration hearings?

16:33:00 6 A. One arbitration hearing.

16:33:02 7 Q. At the ITC?

16:33:05 8 A. Yes.

16:33:06 9 Q. And at the U.S. Patent Office?

16:33:09 10 A. One time at the U.S. Patent Office, correct.

16:33:12 11 Q. But you have testified as a whole as a professional

16:33:15 12 witness dozens and dozens of times, isn't that true, sir?

16:33:22 13 A. Dozens of times, yes.

16:33:24 14 Q. I think we counted twenty-six at least just based on

16:33:33 15 what we saw in your CV. Can we pull up your CV.

16:33:42 16 You've worked as an expert in patent cases for

16:33:46 17 more than twenty-five different law firms by my count. Does

16:33:49 18 that sound right to you?

16:33:52 19 A. I would need to check my CV, but it could be correct.

16:33:55 20 Q. I made that count. I have to say it was impressive,

16:34:00 21 it was a distinguished list of law firms. Big name ones,

16:34:02 22 Quinn Emanuel, Morrison & Forster, Finnegan Henderson,

16:34:12 23 Covington, Weil, Gotshal, DLA Piper, Perkins Coie, Sherman

16:34:18 24 Sterling, I recognize all those names, don't you, sir?

16:34:21 25 A. Yes, I do.

Schubert - cross

16:34:21 1 Q. And many of those law firms were repeat customers for  
16:34:24 2 you, taking you on two and three engagements, isn't that  
16:34:29 3 right?

16:34:31 4 A. There may be some law firms that engaged me  
16:34:36 5 repeatedly.

16:34:41 6 Q. That's what I noticed.

16:34:42 7 And you have written at least forty expert  
16:34:45 8 reports or declarations in the course of your engagements,  
16:34:50 9 isn't that right?

16:34:51 10 A. I haven't counted it, but it may be correct.

16:34:55 11 Q. And you have testified at a reexamination before the  
16:34:59 12 USPTO Board of Patent Appeals; isn't that correct?

16:35:04 13 A. Yes.

16:35:05 14 Q. And I notice that you said you also had been a  
16:35:09 15 witness for the Nichia Corporation, that's right, isn't it?

16:35:16 16 A. Yes.

16:35:18 17 Q. And Nichia is a LED lighting company like Cree and  
16:35:25 18 Lumileds, isn't it?

16:35:26 19 A. Yes, that is correct.

16:35:27 20 Q. And something else I noticed, at the same time that  
16:35:30 21 you were an expert witness on engagements for Nichia, you  
16:35:35 22 were also in discussions with them, you were talking to them  
16:35:37 23 about licensing the '475 Patent, the patent-in-suit here.  
16:35:42 24 That's correct, isn't it?

16:35:42 25 A. Nichia approached me and inquired about licensing the

Schubert - cross

16:35:52 1 '475 Patent, that's correct.

16:35:52 2 Q. Sir, I would ask that you answer my questions yes or  
16:35:56 3 no if you can. My question was were you talking to Nichia  
16:36:01 4 about licensing the '475 Patent at the same time that you  
16:36:04 5 were also retained by them as an expert witness?

16:36:10 6 A. Yes.

16:36:19 7 Q. Can we pull up JTX 17.

16:36:22 8 Now, on September 9th as I understand your  
16:36:25 9 testimony, both here and at deposition, Dr. Sean Lee of BU,  
16:36:32 10 he wrote you and he offered a way for you to have the '475  
16:36:36 11 Patent returned to you; correct?

16:36:41 12 A. Did you say September 2nd or did you say  
16:36:46 13 September 9th?

16:36:46 14 Q. I thought I said September 2nd, 2009. That's what I  
16:36:50 15 intended to say.

16:36:52 16 A. Yes. Dr. Sean Lee contacted me on September 2nd,  
16:36:56 17 2009.

16:36:56 18 Q. Thank you. Yes or no would just be great.

16:37:01 19 And Dr. Lee told you that Boston University was,  
16:37:06 20 "planning on not paying the second maintenance fee." Right?

16:37:24 21 A. Yes, that's what he wrote.

16:37:25 22 Q. And you responded very shortly thereafter, didn't  
16:37:29 23 you, sir?

16:37:34 24 A. Yes, I did.

16:37:35 25 Q. In fact, less than an hour after he wrote you, you

Schubert - cross

16:37:41 1 declined BU's offer, didn't you, sir?

16:37:45 2 A. Yes, that's correct.

16:37:47 3 Q. The words you used, specifically you wrote back and  
16:37:52 4 you told him you weren't interested.

16:37:57 5 A. Yes. He asked if I am interested, and I tell him I'm  
16:38:01 6 not interested.

16:38:02 7 Q. And you testified at your deposition at length and  
16:38:06 8 briefly here today, you testified that the reason that you  
16:38:09 9 rejected BU's offer was because you were too busy. Isn't  
16:38:14 10 that right?

16:38:18 11 A. That is my recollection. I had a number of projects  
16:38:21 12 going on, and for that reason I wasn't able to accept a new  
16:38:26 13 activity.

16:38:27 14 Q. Just a yes or no, sir. Thank you.

16:38:29 15 You know when you don't pay the maintenance fee  
16:38:32 16 on a patent that the patent expires, you know that, don't  
16:38:37 17 you, sir?

16:38:43 18 A. The patent maintenance fee goes out of my technical  
16:38:49 19 domain. I understand that this is more like an  
16:38:52 20 administrative thing, and such administrative things fall  
16:39:02 21 under administrative rules, and I am not very good at these  
16:39:07 22 administrative rules, or I'm not familiar with these -- all  
16:39:13 23 these rules. I am not a patent agent or I'm not a patent  
16:39:17 24 attorney.

16:39:22 25 Q. You have testified at a reexamination as an expert

Schubert - cross

16:39:30 1 before the USPTO Board of Patent Appeals, didn't you? I  
16:39:39 2 think you said that earlier.

16:39:41 3 A. Yes.

16:39:41 4 Q. And you also testified -- maybe we can bring your CV  
16:39:45 5 back up. You testified as an expert in a negligent patent  
16:39:49 6 filing case, didn't you, sir? The Kohler case. If you can  
16:40:10 7 pull that up, the Kohler case, MLB and Kohler. Do you see  
16:40:23 8 that, sir, you served as a technical witness on behalf of  
16:40:27 9 MLB and Kohler, defendant?

16:40:32 10 A. Yes, I see that.

16:40:33 11 Q. Negligence in conjunction with a patent application.  
16:40:36 12 I wrote one or more expert reports. Do you recall that?

16:40:41 13 A. Yes.

16:40:44 14 Q. And so your answer to my question about not knowing  
16:40:58 15 what happens, I mean, is that your answer? I asked you, I  
16:41:03 16 said, "Do you know, sir, that when you don't pay the  
16:41:06 17 maintenance fee on a patent, the patent expires?"

16:41:08 18 Is your answer to that question, "I don't know"?

16:41:12 19 A. Are you asking me about the present time, 2021, or  
16:41:16 20 are you asking me about my knowledge in 2009?

16:41:22 21 Q. Given what you have said about your memory, I won't  
16:41:25 22 do that now. Just sitting here today, do you know what  
16:41:28 23 happens when you don't pay the maintenance fee?

16:41:32 24 A. So if it's okay with you, I answer for the present  
16:41:35 25 time, 2021.

Schubert - cross

16:41:39 1

Q. Yes, sir.

16:41:40 2

A. And after I acquired the '475 Patent, I learned about

16:41:48 3

the responsibilities of a patent owner and according to my

16:41:53 4

recollection I paid twice a patent maintenance fee --

16:41:59 5

actually, more than twice, and therefore at the present time

16:42:03 6

I am familiar with the duty of a patent owner to pay patent

16:42:11 7

maintenance fees. But in 2009, I was not a patent owner,

16:42:16 8

and I was not familiar with the responsibilities that a

16:42:21 9

patent owner may have.

16:42:23 10

Q. Sir, respectfully, that's not at all what I asked

16:42:27 11

you. What I asked you was, as you sit here today, you know

16:42:30 12

when you don't pay the maintenance fee on a patent the

16:42:33 13

patent expires, you know that sir, don't you?

16:42:37 14

A. At the present time I know that.

16:42:40 15

Q. And you know that when a patented invention, when a

16:42:47 16

patented invention expires, it becomes freely available to

16:42:50 17

the public. You know that as you sit here today anyway,

16:42:54 18

don't you?

16:43:00 19

A. I was aware that patents -- or I am aware that if I

16:43:10 20

would not pay the patent maintenance fee, if I had not paid

16:43:20 21

the patent maintenance fee of the '475 Patent once I owned

16:43:27 22

it, that this would not be a good thing, the consequences

16:43:30 23

would result -- that there would be negative consequences if

16:43:37 24

I would not pay the fees. But I familiarized myself with

16:43:42 25

the duties of the patent owner and to the best of my ability

Schubert - cross

16:43:47 1 I met all duties of a patent owner.

16:43:52 2 MR. JOHNSON: Your Honor, pardon me, but may I  
16:43:55 3 have some help in instructing the witness to at least take a  
16:43:59 4 shot at answering the question yes or no? And you can let  
16:44:02 5 us know if you can't do that.

16:44:03 6 THE COURT: Dr. Schubert, usually what I ask the  
16:44:06 7 witnesses to do is to say yes and no if you can and if you  
16:44:10 8 need to give a brief explanation, so I'm not going to say  
16:44:13 9 yes or no stop, but you can say yes, if you can start with a  
16:44:18 10 yes or no so he knows which way you're going and then you  
16:44:21 11 can give a brief explanation.

16:44:23 12 MR. JOHNSON: Thank you, Your Honor.

16:44:26 13 THE WITNESS: Thank you, Your Honor.

16:44:28 14 BY MR. JOHNSON:

16:44:29 15 Q. Can we move forward a couple of months from the  
16:44:33 16 September 2nd e-mail exchange with you and Sean Lee of BU.  
16:44:38 17 On December 9th -- or excuse me, on December 2nd, 2009, you  
16:44:43 18 wrote back to Dr. Lee about BU's offer of the patent.  
16:44:47 19 Correct?

16:44:52 20 A. Yes, that is correct.

16:44:54 21 Q. And you wrote him because you went from being  
16:44:58 22 uninterested in the '475 Patent back in September to being  
16:45:02 23 interested in owning it in December; correct?

16:45:13 24 A. Yes.

16:45:13 25 Q. And you testified that suddenly you had more free

Schubert - cross

16:45:17 1 time to devote to a new project, correct?

16:45:22 2 A. No, I won't characterize it as suddenly, I would say  
16:45:26 3 that my availability changed over a year.

16:45:32 4 Q. Right. You've described 2009 as a year of change for  
16:45:37 5 you. Do you recall that?

16:45:40 6 A. That is correct. The year 2009 was a change. I had  
16:45:45 7 initially more administrative responsibilities and they  
16:45:49 8 decreased over the course of the year.

16:45:51 9 Q. Right. You also described 2009 as a year of  
16:45:54 10 transition; correct?

16:45:58 11 A. I think that's an appropriate word, yes.

16:46:02 12 Q. And that's because you were winding down some of your  
16:46:06 13 responsibilities from earlier in the year; correct?

16:46:10 14 A. Yes, that is correct.

16:46:12 15 Q. In particular, Dr. Schubert, one of the things you  
16:46:16 16 kept mentioning at your deposition that had kept you busy  
16:46:20 17 during 2009 was your work for the Smart Lighting Engineering  
16:46:24 18 Research Center at RPI; correct?

16:46:29 19 A. It kept me busy at the beginning of the year 2009,  
16:46:33 20 but not at the end of the year 2009.

16:46:36 21 Q. Right. Fair to say that by December of 2009 your  
16:46:39 22 work at the Smart Lighting Center was winding down?

16:46:43 23 A. Yes, that could be expressed that way.

16:46:47 24 Q. Thank you, sir. Let's pull that up, the first page.  
16:46:51 25 This is the CV exhibit that we had up earlier. JTX 8 I am

Schubert - cross

16:47:05 1

**informed.**

16:47:10 2

**So just to find it, the director and founder**

16:47:15 3

**director 2008 to 2009 entry. That's what we're talking**

16:47:20 4

**about, Dr. Schubert, isn't it? Do you see that, sir?**

16:47:29 5

**A. Yes, that is correct.**

16:47:30 6

**Q. And you founded the Smart Lighting Engineering**

16:47:36 7

**Research Center, it was your brain child; correct?**

16:47:40 8

**A. You know, I can't answer this question with a yes or**

16:47:47 9

**no, because engineering research center is a complex entity**

16:47:51 10

**and I would need to use a few more words to describe that.**

16:47:56 11

**Q. How about the words that are up there, would you**

16:47:58 12

**agree with those, you were the founding director?**

16:48:03 13

**A. Yes.**

16:48:04 14

**Q. Anything there you disagree with?**

16:48:11 15

**A. No, there is nothing I disagree with.**

16:48:14 16

**Q. And, you know, frankly speaking, no need to be modest**

16:48:20 17

**about it, you testified as such, the research center was**

16:48:24 18

**kind of a big deal both for you and for RPI, wasn't it?**

16:48:28 19

**A. Yes, it was a research center that had a funding of**

16:48:34 20

**up to \$40 million. And so it was not a small thing.**

16:48:41 21

**Q. And being director and the principal investigator,**

16:48:46 22

**that was a big job; right?**

16:48:50 23

**A. That is correct.**

16:48:51 24

**Q. You said fifty people involved, roughly? Twenty**

16:48:58 25

**faculty, thirty grad students, something like that,**

Schubert - cross

16:49:01 1 approximately?

16:49:05 2 A. The number that I recall is more like thirty to  
16:49:09 3 forty, but I wouldn't exclude fifty. Fifty is maybe on the  
16:49:14 4 high side. Twenty-five would be on the low side. So  
16:49:18 5 somewhere between twenty-five and fifty.

16:49:20 6 Q. And I think you were saying it was heavily funded by  
16:49:25 7 the government to the tune of tens of millions, specifically  
16:49:28 8 by the National Science Foundation; correct?

16:49:32 9 A. It was funded by the National Science Foundation and  
16:49:38 10 the maximum funding is approximately \$40 million over ten  
16:49:45 11 years.

16:49:45 12 Q. Right. But according to your CV, by December of  
16:49:50 13 2009, you no longer had responsibility at the center, did  
16:49:53 14 you?

16:50:01 15 A. The responsibilities wound down over a period of  
16:50:07 16 time. And it was like a continuous process.

16:50:10 17 Q. Right. But by 2009, you're saying it's over, is that  
16:50:14 18 right?

16:50:14 19 A. No. It was over in 2010. But it ended somewhere in  
16:50:20 20 2009. I didn't specify the months here. And I do not  
16:50:22 21 recall the exact months.

16:50:28 22 Q. Well, but in fact you resigned from the center,  
16:50:32 23 didn't you, sir?

16:50:35 24 A. At some point the center was directed by another  
16:50:39 25 person and I was no longer director, yes.

Schubert - cross

16:50:45 1 Q. Is it fair to say that you were forced to resign,  
16:50:48 2 sir?

16:50:49 3 A. No, I wouldn't say that's fair.

16:50:52 4 Q. Isn't it true, sir, that you resigned in the wake of  
16:50:57 5 allegations of fraud, of unethical conduct and of conflict  
16:51:01 6 of interest against you, isn't that true, sir?

16:51:07 7 A. I am currently not aware of any allegations of fraud  
16:51:12 8 in conjunction with that center. I do not know what this  
16:51:18 9 refers to.

16:51:19 10 Q. I'm talking -- I can show you to refresh your  
16:51:22 11 recollection, but you do recall filing, you and your wife  
16:51:26 12 filing some FOIA requests in 2011 that were directed toward  
16:51:31 13 the allegations of fraud, violations of law, misleading  
16:51:37 14 information to the NSF that you thought were directed  
16:51:40 15 against you. You recall making those FOIA filings, don't  
16:51:45 16 you, sir?

16:51:46 17 A. Yes, I do recall making Freedom of Information  
16:51:50 18 requests.

16:51:50 19 Q. Lots and lots, correct?

16:51:53 20 A. I don't recall the number.

16:51:54 21 Q. If I said 61 filed by you and your wife, 61  
16:51:58 22 individual requests on these topics, would that sound right  
16:52:02 23 to you?

16:52:03 24 A. I would not be able to confirm. I don't recall the  
16:52:07 25 number.

Schubert - cross

16:52:07 1 Q. But there were allegations that you gave false  
16:52:10 2 information to the National Science Foundation. Do you  
16:52:14 3 recall that?

16:52:16 4 A. I am not aware of allegations that I gave false  
16:52:21 5 information to the National Science Foundation. I have not  
16:52:28 6 given false information to the National Science Foundation.

16:52:32 7 Q. Do you recall a FOIA request specifically that asked  
16:52:36 8 for -- first of all, do you remember that the Office of  
16:52:42 9 Inspector General with the National Science Foundation  
16:52:43 10 conducted an investigation into the center?

16:52:47 11 A. Yes, I recall that. And I also recall the result.  
16:52:51 12 The result was that there was absolutely no misconduct on my  
16:52:56 13 part.

16:52:56 14 Q. Was it on your side or was it on RPI's side that  
16:53:02 15 there was no misconduct because they eliminated the conflict  
16:53:05 16 of interest by having you resign?

16:53:10 17 A. Can you say that again, the question, please?

16:53:18 18 MR. JOHNSON: Madam Court Reporter, can you read  
16:53:19 19 it back?

16:53:20 20 THE COURT: Mr., Mr. Court Reporter.

16:53:22 21 MR. JOHNSON: Pardon me.

16:53:32 22 (The reporter read back as instructed.)

16:53:32 23 A. I can only speak for myself. I did not commit  
16:53:42 24 misconduct in any way regarding the center, the Smart  
16:53:42 25 Lighting Engineering Research Center.

Schubert - cross

16:53:54 1 Q. But you left within two years of founding the center,  
16:53:57 2 correct?

16:54:00 3 A. As I said earlier, during the course of 2009, the  
16:54:05 4 responsibilities were handed over to another director. And  
16:54:10 5 they were handed over in an ordered way.

16:54:17 6 Q. Well, you had an FOIA request talking about a joint  
16:54:21 7 letter from the National Science Foundation and RPI that  
16:54:28 8 forced you to resign, do you recall that?

16:54:31 9 A. If you could refresh my memory.

16:54:36 10 MR. JOHNSON: Your Honor, we have just a very  
16:54:38 11 small refreshment binder for just such a circumstance. If  
16:54:42 12 we may hand that up.

16:54:44 13 THE COURT: Yes. I have asked that those things  
16:54:47 14 be given to the witness when he goes up so people don't have  
16:54:50 15 to walk around my courtroom, but okay.

16:54:52 16 MR. JOHNSON: We didn't know for sure that we  
16:54:55 17 would need it. We hadn't needed it up until now. It's very  
16:54:59 18 small.

16:54:59 19 THE COURT: It's the moving, I don't care how  
16:55:02 20 big the binder is, I just don't want people walking around  
16:55:05 21 if we don't need it.

16:55:07 22 MR. JOHNSON: I apologize. Understood.

16:55:10 23 MR. NESE: May I approach, Your Honor?

16:55:12 24 THE COURT: Give it to Mr. Buckson.

16:55:22 25 BY MR. JOHNSON:

Schubert - cross

16:55:29 1 Q. If you turn to -- it's the tab -- the 2011 FOIA tab.  
16:55:40 2 These were downloaded from the National Science Foundation  
16:55:45 3 website. This is their freedom of information log. Does  
16:55:51 4 this refresh your recollection, Dr. Schubert, with respect  
16:55:55 5 to some of the allegations that you thought were made  
16:55:59 6 against you?

16:56:05 7 A. I have not seen this document before. And I really  
16:56:12 8 don't know which allegations you are talking about. I don't  
16:56:17 9 think there were allegations made against me in terms of  
16:56:21 10 misconduct under the National Science Foundation center. I  
16:56:29 11 am absolutely not aware of any allegations of misconduct  
16:56:34 12 that I may have committed under the NSF Smart Lighting  
16:56:45 13 Engineering Center.

16:56:45 14 Q. Sir, these are your words or your wife's words, these  
16:56:50 15 are requests filed by you.

16:57:00 16 A. I'm looking at several pages, and I'm happy to look  
16:57:08 17 at the pages and look through them.

16:57:10 18 Q. Let me direct you for speed. I don't want to spend  
16:57:13 19 too much time on this. Let's go to page 7 of the log. Do  
16:57:20 20 you see there, Schubert E Fred, self, that refers to a  
16:57:27 21 request filed by you, sir. Does that refresh your  
16:57:30 22 recollection?

16:57:32 23 A. 2011, 188, is that what you're talking about?

16:57:42 24 Q. If you just look up at the blow up here on the  
16:57:48 25 screen, it might be easier. Sir, I won't be troubling you

Schubert - cross

16:58:04 1 with this, but you know, this is the reason that we're here  
16:58:06 2 today is because you became -- you said you became unbusy  
16:58:10 3 and were free to do a new project and this is why.

16:58:15 4 MS. HARIHAR: Objection, Your Honor. Does  
16:58:17 5 Mr. Johnson have a question?

16:58:18 6 THE COURT: I'm sorry, I couldn't understand  
16:58:20 7 you.

16:58:21 8 MS. HARIHAR: I'm sorry, I didn't know if  
16:58:22 9 Mr. Johnson had a question. It sounded like --

16:58:30 10 THE COURT: I suppose there was like an implied  
16:58:32 11 correct at the end of that.

16:58:35 12 MR. JOHNSON: Thank you, Your Honor, there was.  
16:58:37 13 I'll withdraw it.

16:58:38 14 Q. Dr. Schubert, does this refresh your recollection  
16:58:40 15 that this was one of the 61 FOIA requests that you filed  
16:58:45 16 regarding allegations of fraud, conflict of interest,  
16:58:48 17 misconduct, providing false information to the National  
16:58:54 18 Science Foundation, not revealing conflicts of interest  
16:58:57 19 about a company called Troy Research Corporation which you  
16:59:00 20 set up and ran out of your home and employ your son at?

16:59:02 21 MS. HARIHAR: Objection. Again, it sounds like  
16:59:10 22 Mr. Johnson is testifying.

16:59:12 23 THE COURT: I think he's asking a question.  
16:59:14 24 Overruled.

16:59:15 25 A. I'm happy to answer your question. The National

Schubert - cross

16:59:20 1 Science Foundation conducted an investigation and there was  
16:59:23 2 absolutely no wrongdoing on my side that the investigation  
16:59:27 3 revealed.

16:59:30 4 Q. However, you resigned amidst these allegations from  
16:59:35 5 the organization that you served as founding director and  
16:59:38 6 principal investigator of; correct?

16:59:42 7 A. I couldn't give you a yes or no answer. I would need  
16:59:46 8 to give a little bit longer explanation. And I'm happy to  
16:59:49 9 do that if you wish.

16:59:51 10 Q. That's not necessary now.

16:59:53 11 I would like to move that into evidence, Your  
16:59:57 12 Honor, as DDX 050. Sorry, excuse me, DDX 117.

17:00:01 13 THE COURT: Any objection?

17:00:10 14 MS. HARIHAR: I'm sorry, we haven't been  
17:00:13 15 provided I think with a copy.

17:00:17 16 MR. JOHNSON: It was purely to refresh the  
17:00:19 17 witness' recollection. It's public --

17:00:21 18 THE COURT: If it's being used solely for  
17:00:23 19 impeachment, it doesn't come in if it's not on the exhibit  
17:00:26 20 list. You can use it for impeachment, but it doesn't come  
17:00:28 21 in. If it's on the exhibit list and you want to admit it,  
17:00:30 22 then we can deal with that, but was this on the exhibit  
17:00:32 23 list?

17:00:34 24 MR. JOHNSON: No, Your Honor.

17:00:36 25 THE COURT: So it's not going to come in.

Schubert - cross

17:00:41 1 MR. JOHNSON: Very well, Your Honor. Thank you,  
17:00:42 2 Your Honor.

17:00:43 3 THE COURT: But I think you established what was  
17:00:44 4 in it.

17:00:45 5 MR. JOHNSON: Thank you, Your Honor.

17:00:47 6 BY MR. JOHNSON:

17:00:49 7 Q. Dr. Schubert, if we could return to your December 2nd  
17:00:53 8 e-mail to Dr. Lee, you e-mailed him and you told him that  
17:01:00 9 you wanted to talk about the '475 Patent; right?

17:01:03 10 A. Yes.

17:01:05 11 Q. Is it fair to say that by the time you wrote to  
17:01:08 12 Dr. Lee in December, you had gone from being uninterested to  
17:01:12 13 interested?

17:01:15 14 A. Yes.

17:01:20 15 Q. I'm referring now to JTX 28. I have been gently  
17:01:28 16 reminded to do so by my colleague.

17:01:45 17 A. I'm sorry. Is there a question pending?

17:01:48 18 MR. JOHNSON: I apologize. Mr. Court Reporter,  
17:01:51 19 would you mind reading back the question?

17:01:53 20 (Reporter read back as instructed.)

17:02:00 21 A. That is correct.

17:02:00 22 Q. In fact, on February 2nd, 2010, I'm talking about JTX  
17:02:17 23 10 now, you sent Dr. Lee an e-mail confirming that you were  
17:02:22 24 "interested to acquire ownership of the '475 Patent."  
17:02:27 25 Correct?

Schubert - cross

17:02:32 1 A. That is correct.

17:02:34 2 Q. Now that you were interested in the patent, you  
17:02:42 3 initiated a series of e-mails and phone calls with Dr. Lee,  
17:02:48 4 didn't you?

17:02:57 5 A. I am not sure if I would characterize it as series,  
17:03:01 6 but I certainly recall that I had written to Dr. Sean Lee  
17:03:07 7 and communicated with him as we see in the record.

17:03:14 8 Q. I think you acknowledged at your deposition, although  
17:03:18 9 I don't think you said you could remember them, that your  
17:03:20 10 e-mail exchanges reflected multiple phone calls. Isn't that  
17:03:24 11 right?

17:03:25 12 A. My e-mails may have mentioned multiple phone calls,  
17:03:29 13 but at this time I do not recall any phone calls that I had  
17:03:32 14 with Dr. Lee. I do not know if those phone calls occurred,  
17:03:37 15 but they are certainly mentioned in the e-mails.

17:03:39 16 Q. Dr. Schubert, isn't it true that after you got  
17:03:42 17 interested in the patent in December, after your time freed  
17:03:46 18 up, that you kind of began pestering Dr. Lee about the  
17:03:50 19 patent, didn't you?

17:03:52 20 A. No, I wouldn't characterize it that way.

17:03:55 21 Q. Well, do you remember that Dr. Lee found your phone  
17:03:59 22 calls strange and annoying?

17:04:00 23 A. I have no knowledge of that.

17:04:02 24 Q. Could you pull up DTX 89. Could you highlight the  
17:04:12 25 Fred Schubert was somehow strange and annoying on the phone.

Schubert - cross

17:04:20 1 And the final phrase there, this is from an instant message,  
17:04:24 2 although I can only assume it must have been an inventorship  
17:04:30 3 dispute. Can you highlight "somehow Fred Schubert was  
17:04:35 4 strange and annoying on the phone." And the concluding part  
17:04:41 5 of that. This is an instant message going back and forth at  
17:04:44 6 BU, this is what we're showing you, sir. "I can only assume  
17:04:48 7 it must have been an inventorship dispute." Does that  
17:04:53 8 refresh your recollection at all about your phone calls with  
17:04:57 9 Dr. Lee?

17:04:57 10 A. I have no idea what he means by inventorship dispute.  
17:05:03 11 Absolutely no idea. The inventor of the '475 Patent is Dean  
17:05:08 12 Stocker and myself. And there was never any dispute. I am  
17:05:14 13 not sure what he's talking about. So I don't understand  
17:05:17 14 what he's talking about.

17:05:19 15 Q. You arranged a call for Dr. Lee for 4:15 p.m. on  
17:05:24 16 December 3rd, 2009; correct? If you could pull up JTX 28.

17:05:58 17 A. What is the time that you mentioned?

17:06:01 18 Q. You arranged for a call for Dr. Lee for 4:15 p.m. on  
17:06:07 19 December 3rd, 2009. I'm referring to the language, "I will  
17:06:10 20 call you tomorrow, Thursday." And the follow-up messages  
17:06:12 21 that indicate the call would be at 4:15 p.m.

17:06:16 22 A. Here I just see 2:00 p.m.

17:06:19 23 Q. If you follow down, it's 4:15 p.m. But you recall  
17:06:22 24 that there was a follow-up call, no, sir?

17:06:25 25 A. I do not recall any phone calls from my memory.

Schubert - cross

- 17:06:32 1 Q. There was a calendar invite for that call, wasn't
- 17:06:35 2 there? JTX 29. Does that refresh your recollection?
- 17:07:03 3 A. I think the e-mails show that I wanted to call him at
- 17:07:07 4 4:15 p.m. That's correct.
- 17:07:09 5 Q. And at 5:09 p.m. on that same day, December 3rd, you
- 17:07:13 6 received an e-mail, correct, JTX 19. That's an e-mail from
- 17:07:19 7 Sean Lee again delivering the bad news? This was in your
- 17:07:29 8 direct testimony, sir. Do you recall that?
- 17:07:30 9 A. Yes, I see that.
- 17:07:32 10 Q. In that e-mail Dr. Lee said he had some bad news
- 17:07:36 11 about your desire to revive the abandoned '475 Patent;
- 17:07:41 12 correct?
- 17:07:44 13 A. Yes.
- 17:07:45 14 Q. And Dr. Lee told you there was no honest way for the
- 17:07:48 15 patent to be revived; right?
- 17:07:59 16 A. What he says is that it can't be revived because it
- 17:08:04 17 was intentionally abandoned.
- 17:08:05 18 Q. Right. In his e-mail Mr. Lee also said that he was
- 17:08:09 19 sorry because he knew it would be disappointing news for
- 17:08:13 20 you. True?
- 17:08:15 21 A. Yes, the last sentence says sorry for the
- 17:08:19 22 disappointing news.
- 17:08:20 23 Q. And you were, in fact, disappointed by that news,
- 17:08:23 24 weren't you?
- 17:08:25 25 A. I have no recollection of my reaction to this e-mail

Schubert - cross

17:08:27 1

in 2009.

17:08:29 2

Q. Dr. Lee explained the obstacle to the revival, didn't

17:08:34 3

he say that Boston University's patent manager, Janine "is a

17:08:44 4

notary and so is perhaps more honor bound than most to be

17:08:48 5

truthful to the Patent Office." You saw that language,

17:08:54 6

right?

17:08:55 7

A. I see that sentence, but I actually don't understand

17:08:59 8

what he's talking about and what he means by this.

17:09:02 9

Q. Sure. Let me ask you if you do understand, sir. I'm

17:09:05 10

not talking about technical legal requirements. You do

17:09:08 11

understand from Dr. Lee's e-mail that he was raising ethical

17:09:13 12

issues as well as legal ones, don't you?

17:09:16 13

A. By this particular sentence I do not know what he

17:09:19 14

means. Honestly I do not know what he means by this

17:09:22 15

sentence.

17:09:22 16

Q. Honor bound, truthful, telling the truth to the

17:09:25 17

Patent Office, do those don't raise any red flags for you?

17:09:31 18

A. I understand the words. And I understand that one

17:09:36 19

must be truthful to the USPTO.

17:09:42 20

Q. Sitting here today, Dr. Schubert, do you see issues

17:09:45 21

of ethics and integrity being presented to you by this

17:09:51 22

e-mail?

17:09:52 23

A. The way I understand this e-mail is that he said it

17:09:52 24

is not possible to return the patent to me. However,

17:10:02 25

shortly thereafter he sent me an e-mail saying it is

Schubert - cross

17:10:06 1

possible.

17:10:09 2

Q. Well, that's not exactly what he said, is it? What

17:10:14 3

did he say?

17:10:18 4

A. I would need to look at the original e-mail.

17:10:22 5

Q. Well, let's go back on December you e-mail Dr. Lee

17:10:26 6

again asking for a call, not in writing, but a call to

17:10:29 7

discuss the '475 Patent; right? That's JTX 18.

17:10:58 8

A. Yes, I say would there be a convenient time that I

17:11:03 9

could call you.

17:11:03 10

Q. And about a month later on January 12th, 2010, you

17:11:07 11

received a calendar invite from BU's OTD; right? This is

17:11:14 12

JTX 30.

17:11:43 13

A. Yes, I see an invitation for potentially a meeting on

17:11:49 14

January 15th from 3 o'clock to 4:30 p.m.

17:11:55 15

Q. And you attended that meeting, didn't you?

17:11:57 16

A. I think that's the meeting that I recall, yes.

17:12:00 17

Q. Right.

17:12:01 18

And it was described also in DTX 90, your

17:12:05 19

supplemental response to interrogatory number 1, and also

17:12:12 20

DTX 91, supplemental response to rog 3 where you were

17:12:25 21

remembering some of the people in that conference room and

17:12:28 22

who attended?

17:12:29 23

A. I remember that meeting, yes.

17:12:33 24

Q. And at this meeting in January, it took place during

17:12:36 25

the process of carrying out the return of the '475 Patent to

Schubert - cross

17:12:39 1

you; right?

17:12:41 2

A. I think that's generally right.

17:12:50 3

Q. Let's take a look if we can at DTX 91. Your second

17:12:59 4

rog response. You recognize this document, don't you?

17:13:07 5

A. Yes, I do.

17:13:08 6

Q. Right. And you understand that these are questions

17:13:12 7

directed to you, sir; right?

17:13:16 8

A. Yes, I do.

17:13:17 9

Q. To you personally. And you reviewed this document

17:13:21 10

for accuracy before it was submitted; correct?

17:13:29 11

A. Yes.

17:13:30 12

Q. In your interrogatory responses in discussing this

17:13:35 13

meeting, you state -- this is at page 8, "BU had apparently

17:13:41 14

been operating under the mistaken belief that Professor

17:13:44 15

Schubert had no interest in the patent."

17:13:47 16

That was your response, right?

17:14:07 17

A. Yes.

17:14:11 18

Q. And you reviewed this response you said before it was

17:14:14 19

submitted back to Lumileds?

17:14:19 20

A. Yes.

17:14:20 21

Q. And the response is true and correct as far as you're

17:14:24 22

concerned?

17:14:26 23

A. Yes.

17:14:28 24

Q. In your interrogatory responses, this is again at

17:14:32 25

page 8 on DTX 90, you also state Boston University thought

Schubert - cross

17:14:38 1 that "all that was needed to revive the patent was to pay  
17:14:42 2 the requisite fee."

17:14:45 3 Do you recall that?

17:15:02 4 A. Can I read the whole paragraph, is that okay?

17:15:05 5 Q. Of course.

17:15:08 6 A. (Witness reviewing document.)

17:15:46 7 The second sentence of this paragraph notes that  
17:15:48 8 Dr. Stevens noted that the '475 Patent had been abandoned at  
17:15:54 9 the Patent Office, but can be revived for a filing fee of  
17:16:00 10 \$2,500. And so yes, this indicates his view that a filing  
17:16:11 11 fee is necessary to revive the patent.

17:16:16 12 Q. Specifically what you say there, sir, on page 8, you  
17:16:21 13 say "all that was needed to revive the patent was to pay the  
17:16:25 14 requisite fee." You say that, don't you?

17:16:28 15 A. Yes.

17:16:31 16 Q. But you were aware that Sean Lee had e-mailed you and  
17:16:37 17 said the patent couldn't be revived because it was  
17:16:39 18 intentionally abandoned; correct?

17:16:42 19 A. He told me that the patent could be revived. Or did  
17:16:42 20 he say it couldn't be revived?

17:16:44 21 Q. Well, he said in the e-mail that even came up in your  
17:16:52 22 direct testimony, his response to you, and I'm not talking  
17:16:52 23 about the later work it out e-mail, I'm talking about the  
17:16:52 24 e-mail that your counsel only produced very late in this  
17:17:02 25 litigation, but the one where Sean e-mails you and said the

Schubert - cross

17:17:07 1 patent couldn't be revived because it was intentionally  
17:17:09 2 abandoned?

17:17:10 3 A. I can give you my understanding is that in an initial  
17:17:15 4 e-mail he said that it could not be revived. And in a  
17:17:19 5 subsequent e-mail, Dr. Sean Lee said that it could be  
17:17:22 6 revived. And so --

17:17:24 7 Q. He didn't say that, sir, did he? He said we can work  
17:17:27 8 something out. That was his language, wasn't it?

17:17:30 9 A. I think those were the words, but the way I  
17:17:33 10 understood this is that there is a possibility that the '475  
17:17:37 11 Patent can be revived.

17:17:39 12 Q. Dr. Schubert, over the years, and you know, there are  
17:17:43 13 many from the time of the revival of the patent through  
17:17:46 14 these three litigations, over the years you had an excellent  
17:17:50 15 working relationship with Boston University; correct?

17:17:54 16 A. That was my impression, yes.

17:17:58 17 Q. And you'd agree that from 2010 to 2019, you built a  
17:18:05 18 relationship of trust with Boston University; correct?

17:18:12 19 A. I think that I worked for Boston University for seven  
17:18:15 20 years. During those seven years I learned that Boston  
17:18:20 21 University is a great institution. Its rankings have  
17:18:24 22 improved significantly over the years and all my  
17:18:30 23 interactions with the Office of Technology Transfer were  
17:18:34 24 from my point of view were high quality good interaction.

17:18:42 25 Q. Respectfully, sir, I would ask that you give a try on

Schubert - cross

17:18:44 1 the yes and nos. Let me ask you again.

17:18:47 2 You would agree, wouldn't you, that from 2010  
17:18:50 3 through 2019, I'm talking about in the context of the '475  
17:18:55 4 Patent, from 2010 to 2019, you built a relationship of trust  
17:18:59 5 with Boston University; correct?

17:19:00 6 A. I couldn't say it this way because the relationship  
17:19:03 7 existed before, it was mostly built in the years 1995 to  
17:19:08 8 2002, that's when I met the people like Ashley Stevens,  
17:19:14 9 Janine Anderson, Michael Pratt, and the relationship  
17:19:20 10 continued, or reemerged in about 2009 to 2010, that's how I  
17:19:28 11 would express it.

17:19:28 12 Q. Let me show you how you expressed it not too long  
17:19:32 13 ago. DTX 74 at page 36. Can you highlight the language.  
17:19:42 14 Do you see it, sir, on there, this is a letter to -- or a  
17:19:47 15 note to BU, to Michael Pratt who you said was a close  
17:19:51 16 contact of yours there. Do you see that? I am referring  
17:19:57 17 you now to the language, "We trust each other and we have an  
17:20:00 18 excellent working relationship." Do you stand by that  
17:20:03 19 statement, sir, with respect to your feelings about BU at  
17:20:08 20 that time?

17:20:08 21 A. I would like to make a correction to your question.  
17:20:12 22 It is an e-mail directed to Ken Zwicker with Michael Pratt  
17:20:18 23 cc'd.

17:20:18 24 Q. And right you are. And thank you for that.

17:20:21 25 MR JOHNSON: And Mr. Court reporter, could I

Schubert - cross

17:20:23 1 have the question back.

17:20:24 2 (The reporter read back as instructed.)

17:20:57 3 Q. Understanding your correction that it's to Ken  
17:21:00 4 Zwicker, do you stand by your statement, sir?

17:21:06 5 A. I do.

17:21:07 6 Q. Now, a week after Dr. Lee's e-mail when he told you  
17:21:10 7 the patent had been intentionally abandoned, you got another  
17:21:14 8 e-mail from him; correct?

17:21:16 9 A. That's correct.

17:21:17 10 Q. This is JTX 31 and also DTX 31, evidently.

17:21:23 11 Now that e-mail was December 10th, 2009;  
17:21:31 12 correct?

17:21:33 13 A. Yes.

17:21:34 14 Q. And eventually you did, in fact, have a meeting with  
17:21:38 15 Dr. Lee to try and quote unquote, work things out on January  
17:21:42 16 18th, 2010; correct?

17:21:53 17 A. I recall one meeting with Ashley Stevens in the  
17:22:00 18 conference room. I do not recall a meeting with Dr. Sean  
17:22:04 19 Lee, but Dr. Sean Lee may have been present at that meeting,  
17:22:08 20 but the conversation that I had at that meeting was with  
17:22:14 21 Ashley Stevens.

17:22:15 22 Q. Right. But you were there to work things out; true?

17:22:21 23 A. I wouldn't put it this way. I would say that there  
17:22:27 24 was a meeting. I recall few details about the meeting, but  
17:22:33 25 I don't recall the substance of the discussion.

Schubert - cross

17:22:35 1

Q. Right.

17:22:36 2

A. I'm happy to talk about what I recall from the

17:22:39 3

meeting.

17:22:39 4

Q. Right. January 15th, looking at DTX 29, you had

17:22:43 5

another call with Dr. Lee; correct, to, "discuss revival and

17:22:49 6

return of the invention currently abandoned at the USPTO."

17:22:57 7

Do you recall that?

17:23:04 8

A. I think this refers to the same meeting. There is

17:23:09 9

not another meeting. So I don't agree with your suggestion

17:23:13 10

that this would be another meeting. There was -- according

17:23:17 11

to my recollection, there was one meeting in January of

17:23:23 12

2010, and that was an in-person meeting in the conference

17:23:27 13

room of the Tech Transfer Office. There was no other

17:23:34 14

meeting that I recall, and I don't think there was any other

17:23:37 15

meeting that I attended.

17:23:39 16

Q. But that meeting was in mid January, 2010; correct?

17:23:43 17

A. That is my understanding.

17:23:44 18

Q. Right. But the patent wasn't revived, whatever you

17:23:48 19

think of the revival, it wasn't revived until several months

17:23:52 20

after that, correct?

17:23:55 21

A. My understanding is that the act of revival was in

17:24:02 22

April 2010.

17:24:03 23

Q. Now, back in September 2009 when Dr. Lee first

17:24:07 24

offered you the patent, he told you you could petition the

17:24:10 25

National Science Foundation to have it assigned to you;

Schubert - cross

17:24:14 1 correct? Pull that back up, DTX 21. If you're interested  
17:24:21 2 in having, could you highlight that. Do you see that, sir?

17:24:30 3 A. My understanding is that there were two federal  
17:24:33 4 agencies involved. One of them was the ONR, the other one  
17:24:38 5 was the NSF. I contacted both agencies and ultimately they  
17:24:43 6 consented to the patent being returned to me.

17:24:48 7 Q. Right. And I think you testified to that on your  
17:24:52 8 direct examination today as well. And one of the  
17:24:56 9 organizations you approached was the office of -- or ONR,  
17:25:02 10 the Office of Naval Research. Have I got that right?

17:25:06 11 A. Yes.

17:25:07 12 Q. And that's because the research that made this  
17:25:10 13 patent, that made what you did possible was paid for by the  
17:25:14 14 federal government; correct?

17:25:17 15 A. In part paid by the federal government, that is  
17:25:21 16 correct.

17:25:21 17 Q. And isn't it true, sir, that to persuade the navy to  
17:25:26 18 release the patent to you, you told them that you had asked  
17:25:31 19 BU not to abandon the patent?

17:25:32 20 A. Yes.

17:25:38 21 Q. You told them that. But that's not quite true, is  
17:25:42 22 it? You never told them not to abandon the patent, you told  
17:25:46 23 them you weren't interested in the patent.

17:25:49 24 A. I told Boston University repeatedly after, and in  
17:25:52 25 December 2009 that I would be prepared to assume ownership

Schubert - cross

17:26:01 1 of the patent and would assume all responsibilities that go  
17:26:06 2 with the ownership of the patent.

17:26:09 3 Q. You testified earlier that the other inventor on the  
17:26:14 4 '475 Patent is Dr. Dean Stocker; correct? He was a graduate  
17:26:19 5 student of yours, Dr. Stocker?

17:26:21 6 A. Yes, Dr. Stocker was a graduate student of mine.

17:26:25 7 Q. And he's the other inventor?

17:26:28 8 A. That is correct.

17:26:29 9 Q. And he doesn't own any part of the '475 Patent today;  
17:26:35 10 right?

17:26:37 11 A. That is correct.

17:26:38 12 Q. And among other things, BU asked him and he said he  
17:26:42 13 wasn't interested; right? Or he didn't respond, I guess  
17:26:46 14 that was the case, wasn't it, he didn't respond to BU, did  
17:26:49 15 he?

17:26:50 16 A. With respect to BU, you would need to ask BU. But he  
17:26:53 17 told me on the telephone and by e-mail that he would not be  
17:26:58 18 interested in ownership of the '475 Patent.

17:27:00 19 Q. And you assume that answer is final?

17:27:04 20 A. Say that again.

17:27:05 21 Q. You assume that answer, his answer is a final answer?  
17:27:09 22 He's not changing his mind, he told you he wasn't  
17:27:13 23 interested, he's not changing his mind?

17:27:16 24 A. I have not heard otherwise.

17:27:17 25 Q. Right. On the other hand, you told BU that you

17:27:21 1 weren't interested and you did change your mind; correct?

17:27:26 2 A. Yes, over time I changed my mind in this regard.

17:27:33 3 Initially I said I would not be interested, but later I said

17:27:37 4 I would be interested in taking ownership of the '475

17:27:41 5 Patent.

17:27:43 6 Q. Shortly after the '475 Patent was acquired by you,

17:27:50 7 you filed three patent infringement lawsuits; correct?

17:28:02 8 A. I wouldn't say shortly. I think it was a time period

17:28:07 9 from October 2010 to July 2012, so it was between one and

17:28:14 10 two years later.

17:28:21 11 Q. So in 2012, you sued Philips; correct?

17:28:27 12 A. Correct.

17:28:28 13 Q. And you also sued Cree and Osram; correct?

17:28:34 14 A. Correct.

17:28:35 15 Q. In May of 2013, you settled with Cree; correct?

17:28:42 16 A. Correct.

17:28:43 17 Q. Now, I'm going to introduce some settlement

17:28:47 18 agreements.

17:28:48 19 MR. BOLLINGER: We got a -- go ahead,

17:28:52 20 confidential.

17:28:53 21 MR. JOHNSON: We have an open court to my

17:28:55 22 understanding, but I wanted to give you the opportunity.

17:28:58 23 MS. HARIHAR: Just to say on the record it's our

17:29:00 24 understanding, it's our understanding that the Osram

17:29:04 25 agreement was produced at a level of confidentiality,

17:29:09 1 in-house counsel only for seeing the agreement, but if  
17:29:12 2 you're letting --

17:29:18 3 MR. JOHNSON: I got to tell you I suspect they  
17:29:20 4 are watching on video and this is open to the public and  
17:29:23 5 there is an open phone line. I don't see the need for this  
17:29:27 6 --

17:29:27 7 THE COURT: Can we stop talking to each other in  
17:29:29 8 a courtroom. You're supposed to be making arguments to me.

17:29:33 9 MR. JOHNSON: I apologize, Your Honor.

17:29:34 10 THE COURT: Is there an objection to using this  
17:29:36 11 exhibit or not?

17:29:37 12 MS. HARIHAR: Yes.

17:29:38 13 THE COURT: Okay: And the objection is based on  
17:29:41 14 third-party confidentiality?

17:29:43 15 MS. HARIHAR: That's correct, Your Honor.

17:29:44 16 THE COURT: I guess my question to you is if --  
17:29:48 17 can you use this document with the witness without  
17:29:52 18 broadcasting it on to the screen, and just asking him  
17:29:57 19 questions so that the document is not being broadcast to the  
17:30:02 20 public, because I don't know how we're supposed to seal  
17:30:05 21 these proceedings.

17:30:06 22 MR. JOHNSON: Yes, Your Honor. And I might talk  
17:30:08 23 about amounts of money generally, but on an aggregated  
17:30:12 24 basis, if that would satisfy the plaintiff.

17:30:19 25 MS. HARIHAR: I guess it will depend on the

17:30:22 1 circumstances. That seems appropriate, but again, the  
17:30:28 2 terms, the actual terms of both agreements are highly  
17:30:31 3 confidential, outside counsel eyes only, and so to the  
17:30:35 4 extent --

17:30:36 5 THE COURT: You remember I said during pretrial  
17:30:38 6 conference that if anyone wanted to seal the courtroom, you  
17:30:42 7 have to give me notice. I don't have notice. So now we  
17:30:45 8 have to proceed in a way that we're doing it without  
17:30:48 9 disclosing a third-party's confidential information, but not  
17:30:52 10 sealing the courtroom. So I guess we can take this question  
17:30:57 11 by question and try it that way.

17:31:03 12 Let me just ask, though, how much longer do you  
17:31:06 13 think you're going to have, sir?

17:31:09 14 MR. JOHNSON: I beg your pardon, Your Honor?

17:31:11 15 THE COURT: How much longer?

17:31:12 16 MR. JOHNSON: I would say that about fifteen or  
17:31:16 17 twenty minutes, but we also have to introduce some exhibits.

17:31:18 18 THE COURT: All right. The problem I have is I  
17:31:21 19 had forgotten that I need to get on a Zoom call for a panel  
17:31:24 20 at 4:45. So how about we do this. How about we take a  
17:31:27 21 break now, you guys figure out what you're going to do and  
17:31:30 22 how we're going to deal with this third-party confidential  
17:31:33 23 information. And then how much time do you think you're  
17:31:36 24 going to need for rebuttal, or redirect?

17:31:42 25 MS. HARIHAR: It will be very brief, Your Honor.

17:31:48 1 THE COURT: How about if we then start tomorrow  
17:31:53 2 at 9:00, we'll finish up Dr. Schubert, we'll take a break  
17:31:56 3 and you can come back and do closing in the afternoon.

17:32:00 4 MR. BOLLINGER: We'll obviously go with the  
17:32:03 5 Court's convenience. That means we can't talk to him all  
17:32:07 6 night.

17:32:07 7 THE COURT: I know. I'm sorry. I don't know  
17:32:09 8 what I'm supposed to do.

17:32:10 9 MR. BOLLINGER: I guess you're right.

17:32:11 10 THE COURT: I can't force him to finish in  
17:32:14 11 fifteen minutes. I have to leave in fifteen minutes, and so  
17:32:17 12 you can speak to him, you just can't speak to him on  
17:32:20 13 anything on the substance of his testimony.

17:32:21 14 MR. BOLLINGER: Thank you, Your Honor.

17:32:23 15 THE COURT: We'll take a break and come back  
17:32:25 16 tomorrow at 9:00 o'clock.

17:32:28 17 MR. JOHNSON: Thank you, Your Honor.

18 (Court adjourned at 5:32 p.m.)

19

20 I hereby certify the foregoing is a true and  
21 accurate transcript from my stenographic notes in the proceeding.

22

23

/s/ Dale C. Hawkins  
Official Court Reporter  
U.S. District Court

24

25

26