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1
2 UNITED STATES PATENT TRIAL AND APPEAL BOARD
3
4 BEFORE THE PATENT TRIAL AND APPEAL BOARD
5
6
7 WEBASTO ROOF SYSTEMS, INC.
8 Petitioner
9 v.
10 UUSI, LLC
11 Patent Owner
12
13
14 Case IPR2014-00648
15 Patent 8,217,612
16
17 Case IPR2014-00650
18 Patent 7,579,802
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5 DEPOSITION OF
6 HAMID A. TOLIYAT, Ph.D.
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10 December 10, 2014
11 10:17 a.m.
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14 Goodwin Procter, LLP
15 Exchange Place
16 Boston, Massachusetts
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23 Kristin M. Kelley, RPR, CRR
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1 I N D E X
2 DEPONENT: PAGE
3 HAMID A. TOLIYAT, Ph.D.
4 Examination by Mr. Falcoff 6, 208
5 Examination by Mr. Sanders 196
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8 E X H I B I T S
9 No. Description PAGE
10 2 UUSI, LLC
11 5 Exhibit 2003
12 8
13 9
14 10 WEBASTO ROOF SYSTEMS,
15 11 INC.
16 12 Petitioner
17 13 V.
18 14 UUSI, LLC
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9 E X H I B I T S
10
11 No. Description PAGE
12 2 '612 Declaration of Toliyat 5
13 5 '802 Declaration of Toliyat 5
14 8 4,870,333 Patent 5
15 9 4,468,596 Patent 5
16 10 German DE 40 00 730 A 1 Patent 5
17 11 UK Patent GB 2 026 723 A 5
18 12 5,218,282 Patent 5
19 13 4,831,509 Patent 5
20 14 Amazon.com printout 45
21 15 Two page article 45
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1 HAMID A. TOLIYAT, Ph.D.
2 DECEMBER 10, 2014
3 PROCEEDINGS
4
5 HAMID A. TOLIYAT, Ph.D., a
6 witness called for examination by counsel
7 for the Patent Owner, was examined and
8 testified as follows:
9
10 ('612 Declaration of Toliyat marked
11 Toliyat 2 for Identification.)
12 ('802 Declaration of Toliyat marked
13 Toliyat 5 for Identification.)
14 (4,870,333 Patent marked Toliyat 8
15 for Identification.)
16 (4,468,596 Patent marked Toliyat 9
17 for Identification.)
18 (German DE 40 00 730 A 1 Patent
19 marked Toliyat 10 for Identification.)
20 (UK Patent GB 2 026 723 A marked
21 Toliyat 11 for Identification.)
22 (5,218,282 Patent marked Toliyat 12
23 for Identification.)
24 (4,831,509 Patent marked Toliyat 13

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1 for Identification.)
2 EXAMINATION
3 BY MR. FALCOFF:
4 Q. I'm Monte Falcoff. I'm representing the
5 patent owner, UUSI. Can you please state
6 your full name for the record.
7 A. Hamid Toliyat.
8 Q. Your birth date and home address, please?
9 A. 4/26/57, 803 Prestwick Court,
10 P-R-E-S-T-W-I-C-K, Court, College Station,
11 Texas, 77845.
12 Q. Thank you. Great. My job is to ask
13 questions and your job is to answer them
14 today.
15 A. Okay.
16 Q. The attorneys in the room may object to my
17 questions, but please answer them anyway
18 unless they're attorney-client privileged.
19 You must answer all questions
20 truthfully under the penalty of perjury and
21 you must orally answer all questions with a
22 "yes", "no", or explanation. "Uh-huh" and
23 shrugs cannot be picked up by the court
24 reporter and probably not by me on the

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1 telephone.
2 I'll do my best to make questions
3 clear. If you don't understand a question,
4 please let me know and I'll rephrase or
5 repeat the question.
6 If you answer my question, I'll
7 presume that you understand it.
8 Do you understand these instructions?
9 A. Sure.
10 Q. This deposition, just for the record, is for
11 two of the US Patent Office Inter Partes
12 Review proceedings filed by Webasto against
13 UUSI. They are IPR 2014-00650 and US Patent
14 number IPR 2014-00648 for patent 8,217,612.
15 Are you represented by an attorney
16 today at this deposition?
17 A. No, I'm not. I don't have a personal
18 attorney. Is that the question?
19 Q. That's correct.
20 MR. SANDERS: I'm here though,
21 Monte, still confirming, and I'll be
22 representing Dr. Toliyat today on behalf of
23 my client, Webasto.
24 MR. FALCOFF: Okay. So you are

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1 acting as the attorney for Dr. Toliyat for
2 this deposition?
3 MR. SANDERS: Correct, for this
4 deposition.
5 Q. Dr. Toliyat, have you ever been deposed
6 before?
7 A. Yes, I have.
8 Q. And how many times? An approximation is
9 good enough.
10 A. Okay. Maybe four or five times.
11 Q. Okay. And, of those, how many were patent
12 lawsuits?
13 A. I think they were all patent lawsuits.
14 Q. Have you ever testified at trial?
15 A. Yes, I have.
16 Q. Were any of those patent lawsuits?
17 A. Yes, it was, at ITC.
18 Q. Okay. And have you ever, in any of the
19 depositions or trial testimony, have you
20 ever represented the patent owner?
21 A. I might but I don't recall. I'm not very
22 clear. I don't have my resume in front of
23 me, the detailed resume.
24 Q. Okay.



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|---|---|
| <p style="text-align: right;">Page 9</p> <p>1 A. Sorry.</p> <p>2 Q. Okay. So, to the best of your recollection,</p> <p>3 you were representing the person defending</p> <p>4 the lawsuit or challenging the patent?</p> <p>5 A. Yes.</p> <p>6 Q. Have you ever worked on a US Patent Office</p> <p>7 Inter Partes Review before?</p> <p>8 A. Yes, I have.</p> <p>9 Q. And for what company?</p> <p>10 A. I'm not sure if I can disclose it or not.</p> <p>11 Q. Let me ask you the next question. Have you</p> <p>12 submitted an expert declaration in that</p> <p>13 matter?</p> <p>14 A. Correct. Yes, I have.</p> <p>15 Q. You have?</p> <p>16 A. Yes.</p> <p>17 Q. Was it on behalf of the patent owner or the</p> <p>18 petitioner challenging the patent?</p> <p>19 A. It was on behalf of the petitioner.</p> <p>20 Q. Have you had your deposition taken in that</p> <p>21 Inter Partes Review proceeding?</p> <p>22 A. Yes, yes, I have.</p> <p>23 Q. I note that you've been a named inventor on</p> <p>24 some patents, is that correct?</p> | <p style="text-align: right;">Page 11</p> <p>1 Lamm. Duhome, D-U-H-A-M-E, or '282 patent</p> <p>2 for US Patent number 5,218,282. I may use</p> <p>3 Bernard, B-E-R-N-A-R-D, or Great Britain</p> <p>4 '723 patent for UK patent number 2 026 723.</p> <p>5 I may interchangeably refer to the patent</p> <p>6 owner as UUSI or it's d/b/a name of Nartron.</p> <p>7 I may refer to Webasto, which is the</p> <p>8 petitioner who filed the present IPR for</p> <p>9 expert declarations.</p> <p>10 Are those clear to you?</p> <p>11 A. Yes.</p> <p>12 Q. And, again, if you don't recall, just ask.</p> <p>13 A. Sure.</p> <p>14 Q. With regard to your preparation for this</p> <p>15 deposition, how much time did you spend</p> <p>16 preparing for this deposition today</p> <p>17 approximately?</p> <p>18 A. I would say probably somewhere in the range</p> <p>19 of -- I have a list, of course, but I</p> <p>20 haven't put them together as such. I would</p> <p>21 say --</p> <p>22 Q. Just estimate then.</p> <p>23 A. Yeah. Probably between somewhere in the</p> <p>24 range of 20 to 40 hours or 50 hours past</p> |
| <p style="text-align: right;">Page 10</p> <p>1 A. That's correct.</p> <p>2 Q. Did any of these patent applications or</p> <p>3 patents disclose window lift systems or</p> <p>4 roofless systems in automobiles?</p> <p>5 A. No.</p> <p>6 Q. Now, throughout this deposition I'm going to</p> <p>7 use certain acronyms or abbreviations. I</p> <p>8 just want to make sure you and I are talking</p> <p>9 apples to apples, so let me review the list.</p> <p>10 I may use IPR standing for Inter</p> <p>11 Partes Review.</p> <p>12 A. Okay.</p> <p>13 Q. I may use '802 patent for US Patent number</p> <p>14 7,579,802. I may use '612 patent as an</p> <p>15 abbreviation for US Patent number 8,217,612.</p> <p>16 I may use Itoh, I-T-O-H, or '333 patent for</p> <p>17 US Patent number 4,870,333. I may use</p> <p>18 Kinzl, K-I-N-Z-L, or '596 patent for US</p> <p>19 Patent number 4,468,596. I may use Jones or</p> <p>20 '509 patent for US Patent number 4,831,509.</p> <p>21 I may use Lamm, L-A-M-M, or German 730</p> <p>22 patent for German patent number 40 00 730</p> <p>23 A1, and that would include its English</p> <p>24 language translation when I'm referring to</p> | <p style="text-align: right;">Page 12</p> <p>1 couple of weeks, and then a couple of days</p> <p>2 in here.</p> <p>3 Q. How did you prepare? What did you look at?</p> <p>4 A. I looked at the references, I mean the</p> <p>5 patents, of course, the '802 and '612</p> <p>6 patents. I also looked at the references,</p> <p>7 my declarations on the '802 and '612. And I</p> <p>8 glanced through the exhibits and so on and</p> <p>9 so forth.</p> <p>10 Q. Okay. Did you look at anybody's deposition</p> <p>11 testimony?</p> <p>12 A. I did glance at the deposition testimony of</p> <p>13 Dr. McCauley.</p> <p>14 Q. Sorry. Say that again.</p> <p>15 A. Dr. McCauley or Dr. McCalley.</p> <p>16 Q. Okay. Did you meet with anybody besides the</p> <p>17 Webasto attorneys in preparation for the</p> <p>18 deposition?</p> <p>19 A. No.</p> <p>20 Q. What is your current employment?</p> <p>21 A. I'm a professor, a Raytheon professor at</p> <p>22 Texas A&M University.</p> <p>23 Q. Okay. What subject do you teach there?</p> <p>24 A. I teach electric machine design, electric</p> |



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1 machine control, advanced control of
2 electric machinery, and I do teach also
3 motion control, DSP-based motion control.
4 It's a course that I developed, which I have
5 a textbook. In fact, it's the only textbook
6 which went out of print in the field of
7 DSP-based motor control.
8 Q. Okay. And do you have any other current
9 employment besides your professorship?
10 A. No. I do, once in a while, consulting on
11 technical matters related to design of
12 electric machines control, power converters.
13 Q. Okay. How long have you been an employee of
14 Texas A&M?
15 A. 20 years, for the past 20 years.
16 Q. And you're a full professor right now?
17 A. Yes, I am. I'm a Raytheon professor.
18 Q. Now, I see from your CV attached to your
19 expert declarations that you previously
20 worked for the Electro-Motive Division of
21 General Motors Corporation, is that correct?
22 A. That's correct, yes.
23 Q. How long did you work for them?
24 A. Well, this was when I was doing my Ph.D. at

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1 UW Madison. I worked on a project, a funded
2 project, which my advisor back then had with
3 GMC EMD. I don't know what their name is
4 these days but back then it was called
5 Electro-Motive Division. It was a few
6 months. I don't recall exactly. This was
7 like 20 some years ago.
8 Q. January to May of 1991 sound correct?
9 A. Yes, yes.
10 Q. Why was it such a short period of time?
11 A. Because the project it was -- I finished my
12 dissertation so my advisor asked me to help
13 with this project before graduation. I
14 graduated in May and I left Wisconsin, so I
15 submitted a final report and then left,
16 finished and graduated. It was on the
17 locomotive traction system back then.
18 Q. So like a train locomotive?
19 A. Correct, correct.
20 Q. So were you actually a direct employee for
21 Electro-Motive Division at General Motors at
22 that time?
23 A. No.
24 Q. So who did you get your paycheck through?

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1 A. Well, I was getting the paycheck from the
2 University of Wisconsin. That's how usually
3 what the university system is. The
4 companies pay the university, the university
5 pays the students or employee or faculty or
6 whatever.
7 Q. In January through May of 1991 you were
8 actually an employee of the University of
9 Wisconsin, is that correct?
10 A. Absolutely. Absolutely.
11 Q. And what products did you work on for the
12 Electro-Motive division of General Motors?
13 A. It was the main generator on the locomotive.
14 I was working on a new type of generator.
15 It's a diesel large generator and there's a
16 big locomotive so I was working on that
17 system, design of that generator and its
18 control.
19 Q. Were you actually working on the design of
20 the generator or just the winding machine
21 that would wind the wire of the generator?
22 A. No, the generator. It was a new design.
23 Q. What was the horsepower of that generator?
24 A. That's a very good question.

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1 Q. Approximately?
2 A. I would say about a thousand horsepower.
3 Q. One thousand?
4 A. About, yeah, somewhere in that range.
5 Q. Was that a diesel driven generator?
6 A. Correct. It was a diesel driven.
7 Q. And what was the -- so the electromagnetic
8 rotor portion of that Electro-Motive
9 Division of General Motors device was acting
10 as a generator, not as a motor, correct?
11 A. That's correct. It was -- the generator was
12 fitting -- there were two type of
13 generators. Sorry. Two type of locomotive.
14 I can't recall the number but it was a two
15 axle or three axle, if I recall correctly,
16 with the traction motor on the axle. So
17 this generator, it was fitting this track
18 generator, this traction motor.
19 Back then the technology was the
20 traction motors were DC so GMC EMD at the
21 time, they were looking at using
22 AC-induction motor in place of DC. So the
23 question, of course, back then was if there
24 is a way to reduce the size of the



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