

<p style="text-align: center;">Page 1</p> <p>1 UNITED STATES PATENT AND TRADEMARK OFFICE  2 -----  3 BEFORE THE PATENT TRIAL AND APPEAL BOARD  4 -----  5 TERREMARK NORTH AMERICA, LLC,  6 VERIZON BUSINESS NETWORK SERVICES, INC.,  7 and VERIZON SERVICES CORP.,  8 Petitioners,  9 v.  10 JOAO CONTROL &amp; MONITORING SYSTEMS, LLC  11 Patent Owner  12 -----  13 Case IPR2015-01466  14 U.S. Patent No. 6,542,077</p> <p style="text-align: center;">DEPOSITION OF  VAL DIEULIIS, Ph.D.</p> <p style="text-align: center;">Taken June 3, 2016  Commencing at 9:00 a.m.</p> <p>25 REPORTED BY: SHEILA D. FEARING</p>	<p style="text-align: right;">Page 3</p> <p>1 On Behalf of the Patent Owner:  2 Raymond A. Joao, Esquire  3 Joao Control &amp; Monitoring Systems, LLC  4 122 Bellevue Place  5 Yonkers, New York 10703  6 914-969-2992  7 rayjoao@optonline.net  8  9 Also Present via telephone:  10 Steven W. Ritcheson  11 Rene Vazquez  12  13  14  15 Note: The original transcript will be delivered to  16 Frank C. Cimino, Jr., Esquire, pursuant to the  17 applicable Rules of Civil Procedure.  18  19  20  21  22  23  24  25</p>
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<p style="text-align: center;">Page 2</p> <p>1 Deposition of VAL DIEULIIS, Ph.D., taken on  2 the 3rd day of June, 2016, commencing at 9:00 a.m.  3 at Paradigm Reporting &amp; Captioning, 24 East Fourth  4 Street, Suite 110, St. Paul, Minnesota, before  5 Sheila D. Fearing, RPR, CRR, and Notary Public of  6 and for the State of Minnesota.</p> <p style="text-align: center;">* * * * *</p> <p style="text-align: center;">APPEARANCES</p> <p>12 On Behalf of the Petitioners:  13 Frank C. Cimino, Jr., Esquire  14 Venable, LLP  15 575 7th Street, N.W.  16 Washington, DC 20004  17 202-344-4569  18 fccimino@Venable.com  19  20  21  22  23  24  25 (Appearances continued on the next page.)</p>	<p style="text-align: right;">Page 4</p> <p style="text-align: center;">I N D E X</p> <p>2 WITNESS: VAL DIEULIIS, Ph.D.  3  4  5 EXAMINATION:  6 By Mr. Cimino: 5, 137  7 By Mr. Joao: 134  8  9  10 EXHIBITS:  11 JCMS - EXHIBIT 2012 - Declaration of  12 Dr. Val DiEuliis 17  13 PETITIONERS' EXHIBIT 1001 - '077 patent 18  14 PETITIONERS' EXHIBIT 1005 - '916 patent 17  15  16  17  18  19  20  21  22  23  24  25</p>
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P R O C E E D I N G S

VAL DIEULIIS, Ph.D.,

duly sworn, was examined and testified as follows:

EXAMINATION

BY MR. CIMINO:

Q. Good morning.

A. Good morning.

Q. Can you please state your full name for the record?

A. Val DiEuliis.

Q. Good morning, Dr. DiEuliis. You've been deposed before, it looks like, from your CV?

A. Yes.

Q. You understand how the deposition works?

A. Yes.

Q. Is there any reason that you can think of that you can't give full and fair testimony here this morning?

A. No, there is not. Although, I will state the obvious from a visual point of view, I'm on supplemental oxygen, which doesn't affect my ability to provide accurate testimony, but it could affect my timing if I run out of oxygen in these tanks. And I would have to get a refill, for example. I'm good

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for probably four hours.

Q. Sure. If there comes a point where you think that is affecting you, just let me know and we'll stop and do whatever you need to do.

A. It will just be if it gets low. Then I'll need to ask for a break.

Q. Okay. Can you give me a brief description of your educational background?

A. Yes. I received a bachelor of science degree in electrical engineering from the University of Notre Dame; master of science, Ph.D. in electrical engineering from the University of Illinois Urbana-Champaign.

Q. After graduating did you start as an engineer?

A. After I graduated from Notre Dame I was drafted into the Army. I spent two years in the Army and I was an electrical engineer -- my job was as an electrical engineer in the Army. I did two years there. Then I went back to graduate school.

Q. You finished graduate school when?

A. 1978.

Q. After that what did you do?

A. I moved here. Worked for 3M Company.

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Q. What were your responsibilities at 3M?

A. I was a research specialist and started out in their research labs.

Q. Doing what type of work?

A. My first work was developing optical disk technology and digital audio technology.

Q. Did there come a time you left 3M?

A. There did, yes.

Q. When was that and where to?

A. I left 3M and went into my own consulting practice.

Q. How many years were you at 3M?

A. Five -- between five and six years.

Q. You started your consulting company when?

A. When, did you say?

Q. Yes.

A. 1984. Probably started in 1983.

Q. Since 1983 have you worked for any other companies as an engineer?

A. I've worked as an engineer all the time in my consulting projects.

Q. Right. Have you worked for a company as an employee?

A. No, I have not.

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Q. So as an employee, five to six years of experience with 3M, that would summarize your engineering background working directly for companies?

A. For companies, yes, as an employee for companies.

Q. Sure. You're consulting. You also work for companies; just you were a subcontractor?

A. That's correct, I'm a contractor and I'm contracted to do the engineering work.

Q. And you've been doing that since 1983?

A. Yes.

Q. When did you start doing legal work?

A. I first was contacted about legal work around, I think, near the end of 2003. It was really engineering work, but it was litigation support for patent cases. Still engineering work, as near as I can tell.

Q. How much time is devoted currently to litigation work versus engineering consulting for companies?

A. Probably the lion's share, 90 percent or so.

Q. 90 percent is litigation?

A. Yes.

Page 9	<p>1 Q. How long has that been the case?</p> <p>2 A. Probably since -- I don't remember the</p> <p>3 exact percentages. Some years less than others</p> <p>4 for litigation, but probably since I started</p> <p>5 doing this kind of work.</p> <p>6 Q. And the 10 percent -- like currently,</p> <p>7 what is the 10 percent that you're doing that's</p> <p>8 not litigation related?</p> <p>9 A. I do some website development and I do</p> <p>10 -- occasionally I've done a project in the last</p> <p>11 year or two for analyzing a component in a</p> <p>12 product. It can be a variety of things. It</p> <p>13 can be analyzing a product for replacing chips.</p> <p>14 I have projects outlined in my CV which we can</p> <p>15 go over.</p> <p>16 Q. What companies are you currently</p> <p>17 consulting for?</p> <p>18 A. Right now, none.</p> <p>19 Q. How about in 2016?</p> <p>20 A. In 2016? This is 2016.</p> <p>21 Q. Currently none, but have there been any</p> <p>22 in 2016?</p> <p>23 A. No. As a matter of fact, I've been</p> <p>24 dialing my practice back because of my health</p> <p>25 issue until I get this resolved.</p>	Page 11	<p>1 A. I would have to go back.</p> <p>2 Q. Nothing comes to mind?</p> <p>3 A. Yeah.</p> <p>4 Q. How did you first become associated with</p> <p>5 this IPR?</p> <p>6 A. I was -- I received a phone call or</p> <p>7 maybe an email.</p> <p>8 Q. Do you know when?</p> <p>9 A. Sometime around mid March.</p> <p>10 Q. Do you know from whom?</p> <p>11 A. Mr. Joao.</p> <p>12 Q. Have you worked with Mr. Joao before?</p> <p>13 A. I have worked on cases for his company,</p> <p>14 yes.</p> <p>15 Q. Which cases?</p> <p>16 A. I probably can't remember for sure, but</p> <p>17 I know one was Protect America. There's one</p> <p>18 with the City of Yonkers.</p> <p>19 Q. Any others?</p> <p>20 A. I think so. I would have to refresh my</p> <p>21 memory with my CV.</p> <p>22 Q. How many do you think in total?</p> <p>23 A. Maybe five or six.</p> <p>24 Q. And you're paid hourly for each of</p> <p>25 those?</p>
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Page 10	<p>1 Q. Any company consulting in 2015 that you</p> <p>2 recall?</p> <p>3 A. I think so. Come to think of it I have</p> <p>4 done some consulting in 2016, also.</p> <p>5 Q. Who was that for?</p> <p>6 A. A company called Vestel.</p> <p>7 Q. What do they do?</p> <p>8 A. They are -- it's a Turkish company. It</p> <p>9 is one of these mega companies that do just</p> <p>10 about everything. And among other things, they</p> <p>11 sell and manufacture TVs and DVD players.</p> <p>12 Q. What were you doing for them?</p> <p>13 A. I was working with them on licensing</p> <p>14 issues that they're having in Germany.</p> <p>15 Q. Patents?</p> <p>16 A. Yes, for DVD technology.</p> <p>17 Q. So not necessarily litigation related</p> <p>18 but legal support work?</p> <p>19 A. I don't know. If it's legal, it's</p> <p>20 legal. You're the lawyer. But it's not</p> <p>21 regarding litigations that I know of.</p> <p>22 Q. They weren't designing products or</p> <p>23 improving products?</p> <p>24 A. That's correct.</p> <p>25 Q. How about in 2015?</p>	Page 12	<p>1 A. Yes.</p> <p>2 Q. Do you know approximately how much</p> <p>3 you've been paid by Mr. Joao in connection with</p> <p>4 these cases and IPRs?</p> <p>5 A. Approximately -- over the past five</p> <p>6 years, approximately \$140,000 over five years.</p> <p>7 Q. All the patents you worked on relate to</p> <p>8 the same general subject matter, remote</p> <p>9 monitoring and controlling of a premise or</p> <p>10 vehicle?</p> <p>11 A. The cases I've been involved in, yes,</p> <p>12 have been for the same patent family that this</p> <p>13 IPR is related to in that sense in having a</p> <p>14 patent in the family.</p> <p>15 Q. Do you recall how you first met Mr. Joao</p> <p>16 or any one of his litigation team?</p> <p>17 A. When I first ever met one?</p> <p>18 Q. Yes.</p> <p>19 A. Or any one of his litigation team you're</p> <p>20 saying? Yes, I do. I think I do.</p> <p>21 Q. How you first got involved with any of</p> <p>22 these cases.</p> <p>23 A. You're referring specifically for a case</p> <p>24 that Mr. Joao was involved in?</p> <p>25 Q. Yes.</p>
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Page 13	<p>1 A. Okay. I'm trying to think when I</p> <p>2 actually first met someone. I met</p> <p>3 Mr. Ritcheson in Texas. I believe that's the</p> <p>4 first time I met someone for one of these</p> <p>5 cases.</p> <p>6 Q. Did you know Mr. Joao or Mr. Ritcheson</p> <p>7 or anyone else from the litigation team prior</p> <p>8 to being involved with any of these</p> <p>9 litigations?</p> <p>10 A. No.</p> <p>11 Q. Do you have any idea how they came to</p> <p>12 find you?</p> <p>13 A. I can't speak to that. I don't know.</p> <p>14 Q. You don't know if it was from a service</p> <p>15 or from a website?</p> <p>16 A. It couldn't be for a service. I know I</p> <p>17 had done other work for a firm that has been</p> <p>18 involved with them, with Mr. Joao. Perhaps</p> <p>19 that was the connection, but I don't know. I'm</p> <p>20 speculating.</p> <p>21 Q. Have you testified on behalf of Mr. Joao</p> <p>22 or any of his companies before?</p> <p>23 A. No.</p> <p>24 Q. Have you given depositions?</p> <p>25 A. No, not for Mr. Joao or JCMS.</p>	Page 15	<p>1 patent.</p> <p>2 Q. And the patent was valid?</p> <p>3 A. The validity was not argued at the</p> <p>4 trial.</p> <p>5 Q. So the trial was just about</p> <p>6 infringement?</p> <p>7 A. Yes.</p> <p>8 Q. Did you testify as to infringement</p> <p>9 issues?</p> <p>10 A. Yes.</p> <p>11 Q. And applied claim constructions?</p> <p>12 A. Yes.</p> <p>13 Q. Same thing in the Convolv case, were</p> <p>14 you the infringement expert?</p> <p>15 A. Yes.</p> <p>16 Q. And you applied claim constructions?</p> <p>17 A. Yes.</p> <p>18 Q. Have you ever been involved in a case</p> <p>19 where your testimony was excluded for any</p> <p>20 reason by the judge or the administrating body?</p> <p>21 A. Yes. Partial exclusion, yes.</p> <p>22 Q. What was that?</p> <p>23 A. That was Taser v. Karbon. Did you ask</p> <p>24 for the venue or not?</p> <p>25 Q. The venue would be helpful, sure.</p>
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Page 14	<p>1 Q. You testified at trial one time?</p> <p>2 A. Jury trials?</p> <p>3 Q. Yes.</p> <p>4 A. Twice.</p> <p>5 Q. What were those cases?</p> <p>6 A. The first jury trial case was Convolv</p> <p>7 v. Dell, et al. The second case is Uniloc v.</p> <p>8 Activision at -- actually, the actual trial was</p> <p>9 Uniloc, U-N-I-L-O-C, v. EA, Electronic Arts.</p> <p>10 Q. And the Uniloc case, were you on the</p> <p>11 plaintiff's side or defendant's side?</p> <p>12 A. Plaintiff.</p> <p>13 Q. And the Convolv case, plaintiff's side</p> <p>14 or defendant's side?</p> <p>15 A. Plaintiff.</p> <p>16 Q. Do you know what the jury verdict was in</p> <p>17 the Convolv case?</p> <p>18 A. Yes.</p> <p>19 Q. What was it?</p> <p>20 A. It was -- the jury found that the patent</p> <p>21 was valid; that the defendants infringed and</p> <p>22 that the infringement was willful.</p> <p>23 Q. How about the Uniloc case?</p> <p>24 A. In the Uniloc case the jury found that</p> <p>25 the patent -- or the defendant infringed the</p>	Page 16	<p>1 A. Delaware.</p> <p>2 Q. You were an expert on what?</p> <p>3 A. I was an expert on how the taser gun</p> <p>4 electronic design and -- or the Karbon Arms</p> <p>5 gun -- these are about stun guns -- and also</p> <p>6 the firmware and software that was in the</p> <p>7 products.</p> <p>8 Q. Did you handle the infringement issues</p> <p>9 or were you supposed to?</p> <p>10 A. I was working on behalf of the</p> <p>11 defendants, but, yes, I did handle them.</p> <p>12 Q. You were working on behalf of the</p> <p>13 defendants to provide information about how the</p> <p>14 accused product worked?</p> <p>15 A. Yes.</p> <p>16 Q. Were you also rendering opinions as to</p> <p>17 noninfringement?</p> <p>18 A. Yes.</p> <p>19 Q. Was it those opinions that got excluded?</p> <p>20 A. No, not completely. The partial</p> <p>21 exclusion was concerning a couple of</p> <p>22 limitations in the asserted claims that the</p> <p>23 judge felt were -- this is a Daubert</p> <p>24 proceeding. The judge thought that I might be</p> <p>25 testifying about electrophysiology. Something</p>
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Page 17	<p>1 I completely -- the judge, if I were, I would</p> <p>2 be excluded from testifying that way. The</p> <p>3 judge noted that he didn't really know where</p> <p>4 the line was and would find out at trial where</p> <p>5 the actual exclusion, if there were any, would</p> <p>6 occur.</p> <p>7 Q. There was no proposed testimony that was</p> <p>8 actually excluded because you didn't actually</p> <p>9 take the stand in that case?</p> <p>10 A. That's correct.</p> <p>11 Q. Were any of your expert reports struck?</p> <p>12 A. No.</p> <p>13 Q. Any other exclusions or partial</p> <p>14 exclusions you can think of?</p> <p>15 A. Not that I would know of. If there were</p> <p>16 motions of limine, I wasn't involved in that.</p> <p>17 I'm sure there's a lot of things going on that</p> <p>18 I don't know.</p> <p>19 Q. Let me hand you what's been marked</p> <p>20 previously as 2012. It's the declaration of</p> <p>21 Dr. Val DiEuliis. I'll also hand you what's</p> <p>22 been previously marked as Exhibit 1005, the</p> <p>23 patent to French, subject to the IPR.</p> <p>24 Dr. DiEuliis, can you take a look at</p> <p>25 both these documents for a second and confirm</p>	Page 19	<p>1 haven't studied any of the asserted claims. So</p> <p>2 I don't even know what claims are asserted. I</p> <p>3 couldn't tell you off the top of my head for</p> <p>4 sure.</p> <p>5 Q. Turn to paragraph 15 in your report,</p> <p>6 page 9 of 12 in Exhibit 2012.</p> <p>7 A. Yes.</p> <p>8 Q. What is paragraph 15?</p> <p>9 A. Paragraph 15 is the information that I</p> <p>10 relied upon.</p> <p>11 Q. And the '077 patent is one of the few</p> <p>12 things that you relied on to prepare your</p> <p>13 declaration?</p> <p>14 A. Yes, that's correct.</p> <p>15 Q. So what did you review of the '077</p> <p>16 patent to come to your opinion?</p> <p>17 A. If I can point you back to paragraph 4</p> <p>18 on page 3, I noticed -- I note that: "I have</p> <p>19 studied the French reference and the '077</p> <p>20 Patent, and I am qualified to opine on them</p> <p>21 based on my education, (a Ph.D. in electrical</p> <p>22 engineering) and experience (Exhibit 2016.)" I</p> <p>23 looked at the '077 patent in order to get the</p> <p>24 primary written description to get the sense of</p> <p>25 technologies that are in the patent and so</p>
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Page 18	<p>1 that you're familiar with them?</p> <p>2 A. Sure. Yes.</p> <p>3 Q. What are they?</p> <p>4 A. Exhibit 2012 is my declaration in this</p> <p>5 IPR. The other exhibit 1005 is the French</p> <p>6 patent.</p> <p>7 Q. That's the prior art patent that the</p> <p>8 Petitioners in the IPR believe anticipates the</p> <p>9 challenged claims in the '077 patent?</p> <p>10 A. I believe that's how it's being used in</p> <p>11 this IPR, yes.</p> <p>12 Q. You disagree. And I believe the</p> <p>13 independent claim is claim 22 of the '077</p> <p>14 patent. I can give you a copy of that if you</p> <p>15 want.</p> <p>16 MR. JOAO: Objection. Foundation.</p> <p>17 A. I'll take a copy, but I haven't really</p> <p>18 looked at the claim. There's nothing in my</p> <p>19 declaration.</p> <p>20 BY MR. CIMINO:</p> <p>21 Q. This is the '077 patent has been</p> <p>22 previously marked as Exhibit 1001.</p> <p>23 You say you haven't looked at the '077</p> <p>24 patent?</p> <p>25 A. I have looked at the '077 patent, but I</p>	Page 20	<p>1 forth. That's it. I didn't analyze the</p> <p>2 claims. I didn't study the claims.</p> <p>3 Q. Why not?</p> <p>4 A. I was not asked to do so.</p> <p>5 Q. So you didn't perform a claim</p> <p>6 construction?</p> <p>7 A. Correct.</p> <p>8 Q. You didn't look at the file history?</p> <p>9 A. No, I don't think I did.</p> <p>10 Q. If you looked at the file history it</p> <p>11 would be listed in paragraph 15?</p> <p>12 A. Yes.</p> <p>13 Q. You didn't look --</p> <p>14 A. It should be listed. You never know.</p> <p>15 Sometimes these things get missed. But I</p> <p>16 normally would put that in, yes.</p> <p>17 Q. Does that suggest to you that you did</p> <p>18 not look at the file history?</p> <p>19 A. I think my memory also suggests that. I</p> <p>20 don't think I -- I wasn't asked to do any of</p> <p>21 that.</p> <p>22 Q. Do you have a background in construing</p> <p>23 claims or do you leave that for the lawyers?</p> <p>24 A. No. Well, first of all, it's, I think,</p> <p>25 two pronged because claim construction, as I</p>
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