

Volume: I  
Pages: 1 To 108  
Exhibits: See Index

UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE  
THE PATENT TRIAL AND APPEAL BOARD  
DOCKET NO. 337722-000230

APPLE INC., )  
)  
)  
Petitioner, )  
)  
vs. )  
)  
BILLJCO LLC, )  
Patent Owner IPR2022-00131 )  
Respondent. )  
)  
)

DEPOSITION OF THOMAS F. LAPORTA,  
PH.D., a witness called on behalf of the  
Respondent, taken pursuant to the rules of the  
Patent and Appeals Board, before Susan E.  
DiFraia, Certified Shorthand Reporter and  
Notary Public in and for the Commonwealth of  
Massachusetts, at the offices of DLA Piper,  
LLP, 33 Arch Street, Boston, Massachusetts, on  
Friday, July 29, 2022, commencing at 8:30 a.m.

**MAGNA** 

1 APPEARANCES:

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13 Attorney for the Respondent.

14 \*\*\*\*\*

1 EXAMINATIONS

2 Witness Page  
3 THOMAS F. LAPORTA, PH.D.  
4 DIRECT EXAMINATION BY MR. KUO 5

6 EXHIBITS

7 Exhibit Description Page  
8 1 Declaration w/ CV 7  
9 Attached  
10 2 Apple Exhibit 1001/US 37  
11 Patent 8639267  
12 3 Apple Exhibit 1004/US 71  
13 Patent Application  
14 Publication No.  
15 20050096044 (Haberman)  
16 APP\_BJCO\_00014621-14626 76  
17 4 Apple Exhibit 1005 US 99  
18 patent Application  
19 Publication No.  
20 20020159401 (Boger)  
21 6 Apple Exhibit 1006 100  
22 US Patent Application  
23 Publication No.  
24 20020132614 (Vanluijt)  
25

1 PROCEEDINGS

2 THE VIDEOGRAPHER: We're now on the  
3 record. Apple, Inc., versus BillJCo Patent  
4 Owner 2022-00131, Petition for Inter-parties  
5 Review of US Patent 8639267; challenging  
6 claims, 1, 5, 13, 20, 21, 29, 30, 34, 42 and 49  
7 Under 35 USC312 and 37CFR 42.104.

8 The court reporter today is Susan  
9 DiFraia. My name is Chris Coughlin. I'm the  
10 videographer for Magna Legal Services.

11 Will counsel please identify themselves  
12 and who they represent.

13 MR. KUO: Joe Kuo on behalf of Patent  
14 Owner BillJCo.

15 MR. LANDRY: Brian Landry on behalf of  
16 Patent Owner BillJCo.

17 MS. MANNING: Ellen Manning.

18 MS. BIFANO: Larissa Bifano on behalf of  
19 Petitioner Apple, Inc., and with me is  
20 Joseph Wolfe.

21 THE VIDEOGRAPHER: Will the court  
22 reporter please swear in the witness.

23 THE COURT REPORTER: Sir, would you  
24

1 please raise your right hand.  
2 THOMAS F. LAPORTA, PH.D.  
3 a witness called for examination by counsel for  
4 the Respondent, having been satisfactorily  
5 identified by the production of his driver's  
6 license and being first duly sworn by the  
7 Notary Public, was examined and testified as  
8 follows:

9 DIRECT EXAMINATION

10 BY MR. KUO:

11 Q. Good morning, Dr. LaPorta. My name is Joe Kuo.  
12 We met a few minutes ago. I'm counsel for the  
13 Patent Owner in this case BillJCo, and we're  
14 here today regarding your declaration that was  
15 submitted in the IPR related to US Patent  
16 8639267. I'll just refer to that as the 267  
17 Patent, is that okay?

18 A. Yes, that is.

19 Q. Before we get into it, I'm just going to ask a  
20 couple of preliminary questions to set the  
21 stage.

22 You've been deposed before, is that  
23 correct?

24 A. Yes, I have.



1 Q. So as you know, I'm just going to ask you some  
2 questions and unless you're instructed not to  
3 answer, I'd like a response to the best of your  
4 ability. If you don't understand a question  
5 I've asked just ask me to clarify and if you  
6 could explain what you don't understand about  
7 the question, I'll do my best to clear it up.  
8 We will take breaks as we go along. I try to  
9 take one every hour or so but if you need one  
10 before that just let me know, it's not a big  
11 deal.

12 Gee, usually I have a lot more to say  
13 because it's remote, but since it's actually in  
14 person it takes a way a lot of the preliminary  
15 stuff. So let's get going.

16 So Dr. LaPorta, let me hand to you  
17 what's been marked as Exhibit 1. And this  
18 document -- I'm sorry. This document has been  
19 marked as LaPorta 1, and it is in the record  
20 already as Exhibit 1002 and is a document  
21 titled Declaration of Thomas LaPorta Ph.D.,  
22 regarding listed claims of the US -- of the 267  
23 patent.  
24

1 (Document marked as LaPorta  
2 Exhibit 1 for identification)

3 Q. Is this a document you prepared?

4 A. It looks like it, yes.

5 Q. Your CV is attached at the end of the document,  
6 towards the end of the document, and in your CV  
7 you set forth your education. Is there  
8 anything you need to add to that or is that  
9 fully -- does that fully describe your  
10 educational background?

11 A. That describes it.

12 Q. And then your work experience is all set forth  
13 in your CV. Do you have anything to add there?

14 A. No. That looks like everything.

15 Q. And I didn't notice this before so I apologize  
16 for it, but there is highlighting in the CV  
17 that -- that's stuff that I highlighted and  
18 it -- actually only in this copy just so the  
19 record reflects that the original isn't in that  
20 highlighting. If you want I can substitute it  
21 but --

22 MS. BIFANO: It's okay.

23 Q. Okay. So as far as work experience, do you  
24 have anything to add to what's in the CV?

1 A. There may be some papers and things like that,  
2 that I've done since I've submitted this but  
3 not in terms of positions.

4 Q. How about cases that you've worked on, are  
5 there any additional cases since you submitted  
6 this CV?

7 A. No, this is complete.

8 Q. All right. If you could turn to Page 7 of your  
9 declaration?

10 A. Okay.

11 Q. In Paragraph 22 you state that you have no  
12 financial interest in the petitioner which is  
13 Apple, so you've worked on behalf of Apple  
14 previously, correct?

15 A. Yes, I have.

16 Q. How many times?

17 A. I'd have to look at the --

18 Q. Sure, go ahead.

19 A. The CV. I think you had them highlighted and I  
20 think it's three, so I'll check it.

21 Q. My mistake. Came in handy.

22 A. So to my knowledge it's those three. I don't  
23 see any others.

24 Q. Okay. So those three cases and then you're

1 working on multiple IPRs on behalf of Apple  
2 with respect to BillJCo's patent, correct?

3 A. Yes.

4 Q. How many of the IPRs are you working on?

5 A. I'm working on three.

6 Q. All right. All right. Did you have any  
7 involvement -- I'm sorry. Strike that. Are  
8 you aware that Apple and BillJCo are currently  
9 involved in district court litigation?

10 A. I read that in, I believe, the Patent Board's  
11 discussion, so I'm aware of it.

12 Q. Were you aware of it prior to reading the  
13 Patent Board discussion?

14 A. I may have been. I don't remember if I was  
15 told it or not but I assume they were.

16 Q. Why did you assume that?

17 A. Because usually when these things happen  
18 there's something else going on.

19 Q. So I take it from your answer that you were not  
20 involved at all in the district court  
21 litigation?

22 A. No.

23 Q. How far back does your work for Apple go?

24 A. I don't understand the question.

1 Q. How far back in time, like, when was the first  
 2 case you worked on for Apple?  
 3 A. Excuse me. I'll look here.  
 4 Q. Sure.  
 5 A. So according to my CV it was 2014. I may have  
 6 in one of the cases where I was just a  
 7 consultant that wasn't testifying, I don't  
 8 remember, but I have a vague recollection one  
 9 of them may have involved Apple also but I  
 10 don't remember when that was. So I'll say  
 11 2014.  
 12 Q. Okay.  
 13 A. That's the best I can remember.  
 14 Q. Other than the one consulting job that you  
 15 can't remember the exact date of and the list  
 16 of litigation have you done any other work for  
 17 Apple?  
 18 A. No.  
 19 Q. Who are you compensated by? Are you  
 20 compensated by Apple directly or through the  
 21 attorneys?  
 22 A. So I submit my invoices to the attorneys.  
 23 Q. And how are you paid? And what I mean by that  
 24 because that's a little vague, are you paid in

1 dollars or are you paid -- is there any part of  
 2 payment that might be in the form of a stock  
 3 option?  
 4 A. It's just a check for cash.  
 5 Q. Okay. Approximately how much have you made  
 6 both in consulting as well as expert --  
 7 testifying as an expert witness for -- on  
 8 behalf of Apple?  
 9 A. I don't know the time frame you're talking  
 10 about.  
 11 Q. In total?  
 12 A. I have no idea.  
 13 Q. Can you give me an estimate?  
 14 A. Maybe a thousand maybe. It's pure speculation.  
 15 I don't -- I have no real memory of these  
 16 cases. The closest one was, I guess, 2019 when  
 17 some of these were eight years old, five years  
 18 old. I don't remember.  
 19 Q. With respect to your declaration in this case  
 20 will you give me an estimate how much time you  
 21 spent preparing -- preparing the declaration  
 22 and that question includes reading the Patent,  
 23 reading the prior art, etc?  
 24 A. So I don't remember exactly but I would

1 estimate in the 50-to-75-hour range.  
 2 Q. 50 to 75 hours. And you charge how much per  
 3 hour?  
 4 A. I charge 550 an hour.  
 5 Q. Do you own stock in Apple?  
 6 A. To my knowledge, I don't own stock in Apple.  
 7 Q. You own mutual funds that -- you own mutual  
 8 funds, correct?  
 9 A. I have an investment company that buys me  
 10 whatever, and I don't look at it very closely  
 11 so I don't know.  
 12 Q. Okay. But you -- you don't have any control  
 13 over Apple?  
 14 A. No, I have no control over Apple.  
 15 Q. Nor do I. It would be nice though.  
 16 Can you tell me -- let's say over the  
 17 last five years approximately what percentage  
 18 of your work -- I'm sorry. What percentage of  
 19 your commission is from expert witness either  
 20 consulting or testifying as compared to your  
 21 work as a professor?  
 22 A. Can you just repeat that question.  
 23 Q. Sure. So you -- your regular job is as a  
 24 professor, correct?

1 A. That is correct, a school director and a  
 2 professor.  
 3 Q. So what I want to get an idea of is the  
 4 percentage of your commission over the last  
 5 five years from consulting and expert witness  
 6 work as compared to your work for Penn State.  
 7 A. I would say probably ten percent or less.  
 8 Q. Is for expert witness work?  
 9 A. Yes.  
 10 Q. Okay. Let's go to Paragraph 33 of your  
 11 declaration?  
 12 A. I'm there.  
 13 Q. Okay. So paragraph 33 you set forth a summary  
 14 of the 267 Patent, correct?  
 15 A. That is correct.  
 16 Q. And you say it's location based services for  
 17 mobile data processing systems, right?  
 18 A. That's correct.  
 19 Q. Prior to your work in this case, what  
 20 experience did you have in this particular  
 21 field?  
 22 A. So a large body of my research work both at  
 23 Bell Labs and at Penn State has been on mobile  
 24 systems including mobile computing.



1 Q. And what is the timeframe for the work that you  
 2 just described at Bell Labs?  
 3 A. Probably 1994 through current.  
 4 Q. Through current. You're still working for Bell  
 5 Labs?  
 6 A. No. No. My work at Penn State has continued  
 7 in this area.  
 8 Q. Oh, I'm sorry.  
 9 Can you describe in more detail the type  
 10 of work you had at Bell Labs with respect to  
 11 the mobile computing systems?  
 12 A. Sure. Let me look at my resume so I don't --  
 13 Q. Sure.  
 14 A. Okay. So I started looking at broadband  
 15 wireless mobile communications in the 1994  
 16 timeframe.  
 17 Q. What do you mean by "broadband"?  
 18 A. So this was using the standards based on what  
 19 they call broadband ISDN. So ATM-based  
 20 systems.  
 21 Q. Do the acronyms a little slower.  
 22 A. Okay. Broadband ISDN.  
 23 Q. ISDN?  
 24 A. Yes. So those were the standards and they were

1 based on something called ATM, which was  
 2 asycronus transfer mode. And we were looking  
 3 at how to do wireless multimedia for Bell Labs  
 4 in around the 1994 timeframe.  
 5 Q. So by multimedia, you mean video streaming?  
 6 A. Could be video, audio, images, conferencing,  
 7 things like that, yes.  
 8 Q. So that's what you started -- what else -- how  
 9 had that work developed?  
 10 A. Okay. So that work continued a long time and  
 11 became part of several products that Lucent  
 12 Technologies sold, and that work then expanded  
 13 to do more than what we call cold processing to  
 14 do things like location management,  
 15 authentication, interworking between different  
 16 types of systems. So that was one vein of work  
 17 I did.  
 18 Q. Was any of this work that you had for Bell  
 19 Labs, had any of this ended up being patented?  
 20 A. Quite a bit of it ended up being patented.  
 21 Q. And I think in your CV you have a list of your  
 22 patents. Do you know which ones relate to what  
 23 you just described?  
 24 A. I can try to highlight it from the titles.

1 (Pause)  
 2 A. So I would say -- I don't know how you want me  
 3 to reference them on my CV. I can just give  
 4 you the patent numbers.  
 5 Q. You have numbers with the patents.  
 6 A. So I would say 330, 337.  
 7 Q. Okay.  
 8 A. 338, 339, 341, 342. And these were based on  
 9 the systems patented in 320, 321, 322 and 323.  
 10 Q. And just so the record is clear you're looking  
 11 at Page 37 of your CV; is that correct?  
 12 A. Yes, and one more. 326.  
 13 Q. Okay. Can you explain to me, you know, why you  
 14 consider those to be the same field of work as  
 15 the 267 patent?  
 16 A. They dealt with how to control and manage the  
 17 mobility and communicated with wireless devices  
 18 that had sort of advanced services, if you  
 19 will, not just telephone services.  
 20 Q. What do you mean by "advanced services"?  
 21 A. Again, not just voice services, data services.  
 22 I also -- that was one vein of work I did. I  
 23 also did more work related to what I would  
 24 consider the field.

1 Q. What's the other work?  
 2 A. So we had work on mobile processing, so mobile  
 3 data processing. And that work I would break  
 4 it into at least three sections; we worked on  
 5 mobility management or packet data networks,  
 6 wireless packet data networks; we worked on  
 7 systems that had what we call "thin clients,"  
 8 so these were mobile systems that relied on  
 9 servers in the network to help execute services  
 10 and applications. And then we worked on  
 11 advanced messaging, mobile messaging services.  
 12 Q. What is "mobility management"?  
 13 A. So that's tracking the location of mobile  
 14 devices and users and then locating them more  
 15 precisely when communication was supposed to  
 16 take place and authenticating.  
 17 Q. The last part of your sentence, you said  
 18 something about accessing when location is  
 19 supposed to take place. I'm sorry?  
 20 A. Yes. So there's tracking the location of a  
 21 device and/or a user to a certain granularity,  
 22 and then when someone wants to communicate with  
 23 that person or device finding them precisely to  
 24 deliver the communications, so there's an



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