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EXHIBIT

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IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS
Civil Action No. 04-CV-10339-GAO

----- X
L3 COMMUNICATIONS SECURITY AND DETECTION SYSTEMS
CORPORATION DELAWARE,
Plaintiff,
v.
AMERICAN SCIENCE AND ENGINEERING, INC.,
Defendant.

----- X
DEPOSITION OF SAMUEL J. PETUCHOWSKI, PhD, ESQ.

Tuesday, March 22, 2005

3:51 p.m.

WOLF GREENFIELD & SACKS, P.C.
600 Atlantic Avenue, 23rd Floor
Boston, Massachusetts

Reporter: Marianne R. Wharram, CSR/RPR

A P P E A R A N C E S

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16:41:01 1 product?

16:41:05 2 MR. BELT: Are you asking for a legal
16:41:07 3 opinion now as opposed to facts?

16:41:10 4 MR. ABRAHAMSEN: I'm trying to inquire
16:41:11 5 into his state of mind when he considered this.
16:41:14 6 I'm trying to find out why --

16:41:16 7 MR. BELT: Are you asking about at the
16:41:18 8 time he considered the contract?

16:41:19 9 Q. (BY MR. ABRAHAMSEN) At the time you
16:41:20 10 considered the contract, as you said you did --

16:41:22 11 A. Mm-hmm.

16:41:23 12 Q. -- was it your understanding that an
16:41:26 13 invention had to have been reduced to practice as
16:41:30 14 of the critical date?

16:41:31 15 A. No. No.

16:41:32 16 Q. What was your understanding of the state of
16:41:34 17 the law when you considered whether this in fact
16:41:38 18 represents a precritical date offer for sale?

16:41:42 19 A. Pfaff v. Wells.

16:41:45 20 Q. Okay.

16:41:47 21 A. Ready for patenting.

16:41:48 22 Q. Okay. And did you consider whether the
16:41:51 23 invention was ready for patenting as of the
16:41:54 24 critical date?

16:41:58 1 MR. BELT: What invention are we
16:42:00 2 talking about?

16:42:02 3 MR. ABRAHAMSEN: The Mobile Cargosearch
16:42:03 4 invention.

16:42:04 5 MR. BELT: Well, you know, each claim
16:42:06 6 states its own invention; each patent has many
16:42:09 7 claims, et cetera.

16:42:10 8 Q. (BY MR. ABRAHAMSEN) Did you consider
16:42:11 9 whether any Mobile Cargosearch invention was ready
16:42:14 10 for patenting as of the critical date?

16:42:17 11 A. Yes.

16:42:18 12 Q. And what did you decide?

16:42:29 13 A. I decided that it was not.

16:42:31 14 Q. And why was it not?

16:42:42 15 A. Because in February 1995, no one knew
16:42:52 16 whether it would work as claimed.

16:42:57 17 Q. And you think it's a requirement for the on
16:43:00 18 sale bar test that as of the critical date, someone
16:43:03 19 has to know whether it will work?

16:43:10 20 A. These are questions that --

16:43:13 21 Q. I'm trying to figure out your understanding
16:43:15 22 of the law that enabled you to reach this
16:43:17 23 conclusion. Was it your understanding, when you
16:43:20 24 considered whether this in fact represents a

16:57:53 1 couldn't build it, though?

16:57:58 2 A. It was built by AS&E ultimately.

16:58:23 3 Q. Now, it's your testimony that the first
16:58:25 4 time you considered whether either the proposal or
16:58:27 5 a contract that took place prior to the critical
16:58:32 6 date may have been a prior art offer for sale was
16:58:36 7 in connection with the reissue application; is that
16:58:40 8 accurate?

16:58:44 9 A. No, I didn't say that.

16:58:45 10 Q. When was the first time you considered
16:58:47 11 whether the proposal or the contract that occurred
16:58:52 12 prior to the critical date was an offer for sale
16:59:01 13 that would be prior art?

16:59:10 14 A. A patent attorney will consider all the --
16:59:17 15 all the circumstances. I mean, I was aware of the
16:59:19 16 fact that AS&E was being paid to develop this
16:59:29 17 device.

16:59:31 18 Q. And --

16:59:32 19 A. So there can't be a characterization that
16:59:36 20 that wasn't considered.

16:59:38 21 Q. Were you aware that --

16:59:40 22 A. You asked me when I first saw this
16:59:43 23 contract, and I said that that was relatively
16:59:46 24 recently.

16:59:46 1 Q. Fair enough. When was AS&E -- when were
16:59:50 2 you first aware that AS&E was being paid to build
16:59:54 3 the device?

17:00:04 4 A. I knew when I first began work on it that
17:00:10 5 some government agency was having AS&E develop a
17:00:18 6 mobile back scatter capability. I knew that from
17:00:23 7 the outset.

17:00:24 8 Q. And you were aware that the vehicle that
17:00:26 9 provided that funding was in place prior to the
17:00:29 10 critical date, correct?

17:00:31 11 MR. BELT: Objection. That
17:00:32 12 mischaracterizes his testimony.

17:00:38 13 A. I did not know contract particulars.

17:00:42 14 Q. (BY MR. ABRAHAMSEN) Did you know there was
17:00:44 15 some vehicle for providing money prior to the
17:00:48 16 critical date, in place prior to the critical date?

17:00:57 17 A. Um, I don't recall.

17:00:59 18 Q. What would you need to review to refresh
17:01:02 19 your recollection on that?

17:01:03 20 A. If I would have known, it would have been
17:01:19 21 because of discussions. I don't recall there being
17:01:30 22 a document that I was ever aware of.

17:01:33 23 Q. Discussions with whom?

17:01:47 24 A. I remember having a discussion -- telephone

17:06:49 1 be provided?

17:06:54 2 A. I -- I don't remember thinking about it.

17:07:02 3 Q. Would you be surprised if there was not a
17:07:04 4 deliverable to be provided?

17:07:13 5 MR. BELT: To the government, you mean?

17:07:15 6 Q. (BY MR. ABRAHAMSEN) To the government.

17:07:21 7 A. I know plenty of examples where the
17:07:26 8 contractor retains the prototype.

17:07:28 9 Q. Okay. Now, at the time you prepared the
17:07:32 10 non-provisional patent application that led to the
17:07:35 11 '683 patent and subsequently prosecuted that
17:07:38 12 application and the whole series of applications
17:07:40 13 here, beginning at the time you prepared the
17:07:43 14 provisional application, you were aware that AS&E
17:07:47 15 had a vehicle in place with the United States
17:07:51 16 government providing it funding to at least build a
17:07:56 17 prototype Mobile Cargosearch system, right?

17:08:01 18 A. Yes.

17:08:01 19 Q. Now, at that time, did you inquire with
17:08:05 20 anyone to satisfy yourself that that event was not
17:08:08 21 an invalidating offer for sale?

17:08:14 22 A. I don't recall inquiring.

17:08:16 23 Q. You don't recall asking anybody? You don't
17:08:19 24 recall any conversations with Mr. Sunstein?

17:08:22 1 A. No.

17:08:31 2 Q. Do you wish you had investigated that
17:08:34 3 further at this point?

17:08:35 4 MR. BELT: Objection.

17:08:51 5 A. I had a complete understanding at the time
17:09:01 6 that they were in the process of developing a
17:09:10 7 product and that they were providing progress
17:09:22 8 reports.

17:09:25 9 Q. (BY MR. ABRAHAMSEN) Okay. Do you wish you
17:09:36 10 had inquired further?

17:09:40 11 A. No.

17:09:48 12 Q. Had you learned that there was a contract
17:09:51 13 in place prior to the critical date, would you have
17:09:54 14 inquired further?

17:09:57 15 MR. BELT: Objection. Calls for
17:09:59 16 speculation. Hypothetical.

17:10:24 17 A. I knew that the client only learned that
17:10:34 18 the product worked not long, months before the
17:10:46 19 provisional application was filed. Therefore, that
17:10:52 20 was not an issue.

17:10:56 21 Q. (BY MR. ABRAHAMSEN) So in your view, the
17:11:00 22 client would have to know a product works before
17:11:03 23 there could be a potential on sale bar?

17:11:06 24 MR. BELT: We've gone over that ground

17:15:20 1 (Witness gesturing.)

17:15:22 2 Q. And in your view, because a product hadn't
17:15:25 3 been built yet, there could be no on sale bar?

17:15:28 4 A. No. No. That's a mischaracterization.

17:15:32 5 Q. So what is the reason it's readily
17:15:35 6 considered?

17:15:49 7 A. Because there was neither reduction to
17:15:52 8 practice before the critical date nor drawings that
17:15:57 9 were sufficiently specific to enable a person
17:16:01 10 skilled in the art to practice the invention.

17:16:05 11 Q. Prior to the critical date, there weren't
17:16:08 12 drawings specifically specific to enable one of
17:16:10 13 ordinary skill in the art to practice the
17:16:13 14 invention? You reached that conclusion without
17:16:15 15 even considering the issue? I'm confused. How
17:16:20 16 much consideration did you give that question?

17:16:27 17 A. I considered it that there's no, um --
17:16:42 18 there's no documentation that I'm aware of of the
17:16:44 19 consideration.

17:16:50 20 Q. And you considered it when after Pfaff v.
17:16:55 21 Wells?

17:16:55 22 A. It's -- it's something that was going on in
17:17:02 23 our minds, since we were very closely involved with
17:17:07 24 the work of this client, understanding the -- the

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IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS
CIVIL ACTION NO. 04-CV-10339-GAO

- - - - - X
L3 Communications Security and Detection
Systems Corporation Delaware, **BROMBERG & SUNSTEIN LLP**
RECEIVED
Plaintiff, **APR 07 2005**

v.

American Science and Engineering, Inc.,
Defendant.

- - - - - X

CONTINUED DEPOSITION OF
SAMUEL J. PETUCHOWSKI, PhD, ESQUIRE
Wednesday, March 23, 2005
9:10 a.m.

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BROMBERG & SUNSTEIN LLP
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APR 07 2005

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19 Appearing for the Defendant

1 A No.

2 Q So while you were prosecuting the
3 nonprovisional patent applications, you also had
4 no reason to believe that the examiner's attention
5 had been drawn to the fact that Mobile CargoSearch
6 was proposed in January 1994; is that correct?

7 A The examiner had a copy of the proposal,
8 so that is not correct.

9 Q But did you understand that the examiner
10 had been made aware of -- that Mobile CargoSearch
11 was proposed in January 1994 when you were
12 prosecuting the nonprovisional patent
13 applications?

14 A Yes, the examiner had a copy of the
15 proposal.

16 Q But did you know that the examiner's
17 attention had been drawn to this sentence?

18 A Not to this sentence, no.

19 Q Did you have --

20 A That his attention had been -- I can't
21 answer what his attention was drawn to. I know
22 the documents that were before him.

23 Q When you were prosecuting the
24 nonprovisional patent applications, did you have

1 on.

2 Q Is the answer to the question yes or no,
3 Doctor?

4 A The answer is that I knew that this
5 document was before the examiner.

6 Q That wasn't my question. The question
7 is -- was: Did you believe during the prosecution
8 of the nonprovisional patent applications that the
9 examiner had been made aware that a proposal was
10 submitted to the U.S. Army before the critical
11 date of the applications?

12 A Yes.

13 Q You did know that?

14 A Absolutely. I don't know about the
15 specifics as to the Army. This does say Army, and
16 it -- I mean, it doesn't have the specific date
17 that you're talking about, but yeah.

18 Q So during the prosecution of the patent
19 application, you thought that the examiner had
20 been made aware that a proposal was submitted
21 before the critical date?

22 MR. WARD: Asked and answered.

23 Could you read the last full
24 question and answer back that precedes the

1 Q It's specific to this patent. During
2 the prosecution of this patent application.

3 A During the prosecution of this patent, I
4 knew that the examiner had before him the
5 provisional applications and the appendices
6 attached to it.

7 Q But did you think that the examiner had
8 been made aware that a proposal was submitted to
9 the U.S. Army prior to the critical date?

10 A Yes.

11 Q And what was the basis of that belief?

12 A The appendix to the provisional
13 application.

14 Q Any particular part, please identify it?

15 MR. WARD: Just to clarify the
16 question, are you asking for his memory of what
17 was in his mind while prosecuting the application,
18 or as he sits here today, does he believe that the
19 examiner was aware of the information?

20 MR. ABRAHAMSEN: During the
21 prosecution of the patent application, I'm asking
22 whether he was aware --

23 Q Or what -- what was the basis of you
24 being -- thinking that the examiner had been made

1 question.

2 MR. ABRAHAMSEN: For the record, the
3 witness is perusing the exhibit I believe looking
4 for a disclosure that he supposedly submitted to
5 the U.S. Army prior to the critical date.

6 A It says that Mobile CargoSearch was
7 proposed in January 1994.

8 Q And I think your testimony a little
9 while ago was that you were not aware of that
10 sentence at the time that you were prosecuting the
11 nonprovisional patent applications --

12 MR. WARD: Objection.

13 Q -- is that not correct?

14 A I don't recall having given it any
15 thought whatsoever.

16 Q But it was your belief during the
17 prosecution of the nonprovisional patent
18 applications that the examiner had been apprised
19 that a proposal was submitted to the United States
20 government prior to the critical date?

21 MR. WARD: Asked and answered.

22 A I knew that the examiner had before him
23 the appendices to the provisional application. I
24 don't remember having considered the details of

1 MR. WARD: Objection. Asked and
2 answered.

3 A The examiner knew everything that I
4 knew.

5 Q That's your belief?

6 THE STENOGRAPHER: I'm sorry?

7 MR. WARD: You have to say yes or
8 no, Sam.

9 A Yes. Yes.

10 Q You knew that a proposal was submitted
11 to the U.S. Army in January of 1994; is that
12 correct?

13 MR. WARD: Objection. That's a mis-
14 characterization of his testimony.

15 A I don't remember whether I was aware of
16 the date. I had seen the proposal.

17 Q Did you ever consider disclosing to the
18 patent examiner additional facts concerning the
19 proposal or the contract during the prosecution of
20 any of the nonprovisional patent applications?

21 A No.

22 MR. WARD: Objection as to form.

23 Q You did not consider that?

24 A Consider disclosing -- I -- no.

1 Q And which activities were part of the
2 contract?

3 A I think there we get into --

4 MR. WARD: I instruct the witness
5 not to answer.

6 Q I'm not asking for any -- what was
7 communicated to you by anybody. I just want to
8 know what your state of mind was.

9 what activities were part of the
10 contract irrespective of how you learned that
11 information?

12 A The development that led to what AS&E
13 refers to as truck one were considered to have
14 been conducted by AS&E in their performance under
15 the contract.

16 Q Is that the only thing that was under
17 the contract?

18 MR. WARD: Objection. Are you
19 asking for what his understanding of --

20 MR. ABRAHAMSEN: Of course.

21 MR. WARD: -- what was under the
22 contract or...

23 He's asking whether you knew -- are
24 you aware of anything else that was under the