

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABB, INC.
Petitioner

v.

ROY-G-BIV CORPORATION
Patent Owner

Case IPR2013-00062
Case IPR2013-00282
Patent 6,516,236 B1

Before THOMAS L. GIANNETTI, BRYAN F. MOORE, and JENNIFER S. BISK, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On January 3, 2014, a telephone conference call was held between respective counsel for the parties and Judges Giannetti, Moore, and Bisk. The conference call was initiated by the Board in response to communications received from the parties following the Board's Order of December 31, 2013 (Paper 63).

The following issues were discussed and resolved:

1. The Board requested the parties to avoid directing further telephonic and email communications to the Board that present the parties' positions on various issues and request action by the Board, without prior authorization. These communications are contrary to the Board's rules. Furthermore, such communications fall outside of the Board's electronic filing system, and therefore are not part of the public record. For these reasons, unless otherwise authorized by the Board, all further emails and telephonic communications with the Board in these and related proceedings (IPR2013-00063, IPR2013-00074, IPR2013-00286, IPR2014-00122) should be limited to requesting conferences, but may be accompanied by a short (i.e., one sentence) explanation of the reason for the conference.

2. In the December 31, 2013 Order, Patent Owner's motion to exclude certain evidence (Paper 59) was dismissed as untimely. Petitioner and Patent Owner have stipulated to an extension of the due date for such motions, and Patent Owner will file a notice of such stipulation, as required under the Board's joinder decision of August 9, 2013 in IPR2013- 00282 (Paper 15). Upon filing of the notice, the Board will reinstate this motion.

3. The December 31, 2013 Order expunged as unauthorized Patent Owner's motion for observations on cross-examination of certain testimony presented in Petitioner's reply. Upon reconsideration, Patent Owner is granted leave to file

such a motion. The Board observed that the motion for observations expunged by the December 31 Order (Paper 61) contained improper argument that should be avoided in the new submission.

4. The December 31 Order denied Patent Owner's request for authorization to file a response to Petitioner's Reply, limited to the issue of whether certain references are antedated by prior conception and diligence (Paper 44). The Board has reviewed Petitioner's Reply, and on reconsideration, has determined that a brief written response from the Patent Owner directed to this issue would be helpful.

5. Patent Owner requested a change in the date of the final oral argument due to a scheduling conflict on the part of one of its counsel. That counsel is neither Lead nor Back-up Counsel, and the scheduling conflict arose after the date for final argument was set. Furthermore, the hearing date (January 23, 2014) was set in April 2013 to give the parties ample notice. Under the circumstances, the Board declines to change the original hearing date.

In view of the foregoing, it is, therefore:

ORDERED that unless otherwise requested by the Board, all further telephonic and email communications from the parties to the Board in these proceedings shall be limited to requests for a conference with the Board;

FURTHER ORDERED that such communications may include a brief (i.e., one sentence) explanation of why the conference is being requested, but no argument or other presentation of the parties' positions on the issue is permitted unless requested by the Board;

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FURTHER ORDERED that conditioned on Patent Owner filing an appropriate notice of stipulation within five days of the entry of this Order, Patent Owner's Motion to Exclude (Paper 59) will be deemed timely and reinstated, and Petitioner shall have two weeks from the entry date of this Order to file an opposition;

FURTHER ORDERED that Patent Owner is authorized to file a reply limited to the issues raised at pages 1-8 in Petitioner's Reply (Paper 44) concerning the Patent Owner's attempt to antedate Gertz and Morrow by showing prior conception and diligence;

FURTHER ORDERED that this reply is limited to five pages maximum, and must be filed within one week of the entry date of this Order;

FURTHER ORDERED that Patent Owner is granted leave to file a Motion For Observations on Cross-Examination of certain witnesses referred to in Petitioner's Reply, and such motion is due within one week of the entry date of this Order;

FURTHER ORDERED that Petitioner shall have one week from filing of that Motion For Observations to file its responses to such observations, and the parties are directed to the Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012), for guidance in preparing their submissions, particularly the statement that "[t]he Board may refuse entry of excessively long or argumentative observations (or responses)"; and

FURTHER ORDERED that Patent Owner's request to reset the date for the final oral argument is denied.

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