Filed on behalf of Roy-G-Biv Corporation

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABB, INC.
Petitioner

v.

ROY-G-BIV CORPORATION
Patent Owner

Trial No.: IPR2013-00062
(pursuant to Joinder with IPR2013-00282)
U.S. Patent No. 6,516,236B1

PATENT OWNER'S SURREPLY ON ANTEDATE ISSUE

In its Reply, Petitioner ABB, Inc. ("ABB") fails to meet its burden of proving that both Gertz and Morrow are prior art, which alone resolves the IPR.

As to corroboration, ABB applies the "impossible standard of 'independence' on corroborative evidence" that was rejected in *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1346–47 (Fed. Cir. 2013). The law does "not require that every point ... be corroborated by evidence having a source totally independent of the witness." Whether testimony is sufficiently corroborated is evaluated under the "rule of reason." *Id.* Reliable evidence of corroboration "comes in the form of records made contemporaneously with the inventive process. Circumstantial evidence of an independent nature may also corroborate." *Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1327 (Fed. Cir. 2004) (internal citation omitted). Every corroboration case "must be decided on its own facts with a view to deciding whether the evidence as a whole is persuasive." *Id.*

The Brown Declaration and its contemporaneous exhibits clearly demonstrate conception of all claims[1] no later than July 24, 1994, well before publication of both Gertz and Morrow. (Brown Decl., Ex. 2010, ¶¶6, 8, 10, 12.) Two key

[1] Contrary to ABB's Reply, RGB addressed claims 5-7 of the '236 Patent. Dependent claims 5-7 are necessarily addressed in the antedating testimony and evidence provided regarding the independent claims.

corroborating documents indisputably existed and were filed in the PTO years prior to ABB's claim of Gertz and Morrow as alleged prior art:

1. Priority Application Appendix A, filed May 30, 1995, containing an excerpt from the third draft of the XMC Motion Control Reference. The third draft references an April 15, 1994 first draft and a July 1, 1994 second draft.[2]

2. Mr. Brown's *XMC Motion Control Component 93-94 History*, filed November 6, 2008, which references an NDA between Compumotor and RGB dated May 19, 1994."[3]

These documents in turn reveal three other corroborating documents:

1. The NDA between ROY-G-BIV and Compumotor, dated May 19, 1994.[4]

2. First Draft of the XMC Motion Control Reference, dated April 15, 1994.[5]

3. Second draft of the XMC Motion Control Reference (divided into two

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[2] ABB Ex. 1024.

[3] ABB Ex. 1025

[4] Referenced by: (1) p. 1 of Mr. Brown's *XMC Motion Control Component 93-94 History*, attached by ABB as Ex. 1025; (2) p.1 of Ex. 2010-1; (3) p.1 of Ex. 2010-2.

[5] Referenced by: (1) p. 1 of Appendix A of Priority Application No. 08/454,736, May 30, 1995, filed by ABB as Ex. 1024; (2) Ex. 2010-1; (3) Ex. 2010-2.

separate specifications in the second draft), dated July 1 and July 15, 1994.[6] The second drafts reference the April 15, 1994 first draft. Both state "[t]his document is provided for discussion purposes only in strict confidence and subject to the non-disclosure agreement executed between ROY-G-BIV Corporation and Compumotor, a division of Parker Hannifan, dated May 19, 1994."

These numerous corroborating documents satisfy the rule of reason. ABB's suggestion that Mr. Brown foresaw both this litigation and the need to antedate Gertz and Morrow, and fabricated multiple documents which cross-referenced *other* fabricated documents bearing the same dates is unreasonable conjecture.

As to diligence, the basic inquiry is "whether, on all of the evidence, there was reasonable continuing activity to reduce the invention to practice. There is no rule requiring a specific kind of activity in determining whether the applicant was reasonably diligent in proceeding toward ... reduction to practice." *Brown v. Barbacid*, 436 F.3d 1376, 1382 (Fed. Cir. 2006). Evidence made contemporaneously "provides the most reliable proof that the inventor's testimony has been corroborated." *Id.* at 1350-51. "Circumstantial evidence about the inventive process, alone, may also corroborate." *Sandt Tech., Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344, 1351 (Fed. Cir. 2001).

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[6] Exs. 2010-1 & 2010-2 & referenced in Appdx. A, p.1, Ex. 1024

The Brown Declaration includes detailed time logs and a summary of the work performed towards actually reducing to practice and constructively reducing to practice the claimed invention during each work week from November 20, 1994 through May 30, 1995. (Brown Decl., Ex. 2010, ¶¶6, 7, 8, 20, 21). During these six months, Mr. Brown worked approximately 1,453 hours, 1,049 of which were spent on work related to the XMC project. (*Id*. ¶20). This equates to over 40 hours per week dedicated to work on the invention. The weekly summary of major activities on the XMC Project and the time logs show substantial and continuous activity towards reduction to practice (without any significant gaps). Moreover, the 1995 XMC Project Log, which Mr. Brown had forgotten about when preparing his declaration, supports this analysis. Although prepared for a different purpose, it shows over 800 hours of work on developing the XMC invention over a shorter time period. (*See* ABB Ex. 1128.) Mr. Brown testified that this document was very consistent with the analysis in his declarations. (*See* Ex. 1129, p. 199:10-18).

The exhibits to Mr. Brown's Declaration and to ABB's 2nd Petition for IPR corroborate Mr. Brown's diligence. Third party documentation (such as the Compumotor NDA here) and PTO filings have been held to constitute corroboration of diligence. *See, e.g.*, *Brown v. Barbacid*, 436 F.3d at 1376; *In re Jolley*, 308 F.3d 1317, 1328 (Fed. Cir. 2002).

ABB merely nit-picks in arguing that Mr. Brown's intensive work somehow

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