Filed on behalf of Roy-G-Biv Corporation

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UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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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

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**PATENT OWNER'S REPLY BRIEF IN SUPPORT OF MOTION TO
EXCLUDE EVIDENCE**

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RGB timely submits this reply in support of its motion to exclude arguments and evidence raised for the first time in ABB's Reply, and in opposition to ABB's Opposition to Motion to Exclude Evidence, filed January 21, 2014 ("Opp."). The rule is clear: if the Petition did not "specify where each element of the claim is found" in the prior art and identify "specific portions of the evidence that support the challenge," the improperly submitted material should be excluded. *See* 37 C.F.R. 42.104(b)(4)-(5).

At the January 23 Hearing, ABB conceded that its Petition did not mention Stewart's "cycle" function, and that it was raised for the first time in its Reply.[1] The Petition (and Institution Decision) relied on Stewart solely for device drivers. Stewart cannot now be the basis for the other critical limitations of component functions, core and extended driver functions, or component code. It would be highly prejudicial to consider this new theory, and it should be excluded.

ABB does not dispute that the portion of its Petition that was adopted by the Institution Decision is the legal outer boundary of this IPR: "[t]he petition must specify where each element of the claim is found in the prior art *patents or printed publications* relied upon," and must identify "specific portions of the evidence that

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[1] The Trial Transcript is not currently available for citation; RGB will provide any necessary cites when it is made available.

support the challenge." *See* 37 C.F.R. 42.104(b)(4)-(5) (emphasis added). ABB's

Reply and Declarations improperly attempt to expand the scope of this IPR by

adding new alleged grounds and evidence of un-patentability, including factual

evidence of the Onika system beyond what is described in the Gertz reference, but

allegedly implemented in practice such as at Sandia labs, which is well beyond

what a person of ordinary skill in the art ("POSITA") would know from the

publications relied upon in the Petition.

A motion seeking to exclude belatedly disclosed or irrelevant evidence and

arguments addresses admissibility, not the sufficiency or credibility of evidence.

See, *e.g.*, *Yorkey v. Diab*, 2011 WL 9558436, at *15 (Bd. Pat. App. & Interf. Jan.

18, 2011) (granting motion brought to exclude improper reply evidence, noting a

party "may not re-write its initial motion in the name of a reply"); *see also Ex*

Parte Tourapis & Boyce, Application USAN 11/631,449, 2013 WL 3323638, at *1

(PTAB, Feb. 7, 2013).[2] First, ABB admits that "Gertz's control tasks,

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[2] ABB wrongly claims the Board declared a bright-line rule against motions to

exclude new evidence raised in a reply brief in *Avaya, Inc. v. Network-1 Security*

Solutions, Inc., IPR2013-00071, Paper 75, Dec. 2, 2013. In *Avaya*, the Board only

stated that Avaya did not need to file a motion to strike in that case, because the

Board would consider excluding the evidence when it prepared its final written

configurations and actions, as well as their connections (i.e., associations) within

Onika" were not identified in the Petition as meeting various claim limitations,

including driver functions, component functions, and component code. (Opp. at, p.

4.) These issues were raised for the first time on Reply, leaving RGB with no

opportunity to substantively respond and/or obtain expert testimony. This is the

essence of "sandbagging," and these untimely arguments should be excluded. *See,*

e.g., Roth v. Loos & Co., No. C 08–02156 VRW, 2009 WL 2525484, at *3 (N.D.

Cal. Aug. 17, 2009). ABB's Petition was required to specify all portions from

Stewart upon which it was relying, regardless of the matters that RGB raised in

Response, and ABB offers no authority to the contrary. *See* 37C.F.R. 42.104(b)(4)-

(5).

Second, ABB alleges in its Petition that "Control Tasks" in Gertz are "driver

functions" and Configurations are "extended driver functions." Petition, p. 21. In a

dramatic shift of its position, ABB now relies on Dr. P. to argue that "cycle

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decision. In fact, the Board expressly permitted motions to exclude: "Avaya and

Patent Owner each may file a single motion to exclude … identify[ing] specifically

each piece of evidence sought to be excluded." *id.* p.4. Also, contrary to ABB's

inexplicable denial, RGB timely objected to ABB's improper Reply Evidence. See

Motion to Exclude at 1, Ex. 2015

function" within a port based object is "an extended driver function." Ex. 2014 at 125:19-22. ABB cannot shift gears on Reply (and the Hearing) without substantially prejudicing RGB. Had ABB disclosed Dr. P.'s opinion in its Petition, RGB would have argued at least that the cycle function is not a driver function because it does not meet other claim limitations such as '236 claims 2-6 and 10, and/or obtained expert testimony refuting ABB's position. [Motion to Exclude at 2-4.]

Third, ABB admitted in its Opposition (Opp. at 8-11) and at the Hearing that its experts are offering *facts* of their personal knowledge and background of the alleged operation of Onika and a demonstration of such a system at Sandia Labs. But this proceeding is based upon what the alleged Gertz, Stewart and Morrow *publications* teach to a POSITA, not upon alleged prior systems or demonstrations, which are well beyond what a POSITA would know. There is no dispute that ABB's experts relied upon references other than the publications cited in ABB's Petition, including their own (unpublished and uncited) knowledge and experience, and *five* new publications not cited in the Petition. (Opp. at p. 9.) This refusal to confine their testimony to the issues before the Board infects ABB's experts' entire analysis, and their attempts to "broaden" standard definitions are fatal to ABB's case. ABB's approach is wholly improper, inapplicable to a POSITA, outside the scope of this IPR proceeding, and should be excluded.

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