blacr@foster.com

Registration No.: 40514

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

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Trial No.: IPR2013-00062

U.S. Patent No. 6,516,236B1

MOTION CONTROL SYSTEMS

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# PATENT OWNER ROY-G-BIV CORPORATION'S

# **PRELIMINARY RESPONSE UNDER 37 CFR § 42.107**

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## I. Introduction

Patent Owner ROY-G-BIV Corporation (hereafter "Patent Owner") hereby respectfully submits this Preliminary Response to the Petition seeking *Inter Partes* review in this matter. This filing is timely under 35 U.S.C. § 313 and 37 C.F.R. § 42.107, as it is being filed within three months of the November 27, 2012 mailing date of the Notice granting the Petition a filing date.

A trial should not be instituted in this matter as none of the references relied upon in the Petition, whether considered alone or in combination, gives rise to a reasonable likelihood of Petitioner prevailing with respect to any claim of U.S. Patent No. 6,516,236 (the '236 patent).

## II. Summary of Patent Owner's Argument

"The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged . . . ." 35 U.S.C. § 314(a). As discussed below, each proposed anticipation rejection is deficient for failing to set forth each and every feature arranged as recited by the respective claims of the '236 Patent. The secondary references do not teach the missing features, and thus fail to establish a *prima facie* case of obviousness. Further, the

plethora of cursory obviousness rejections proposed in the Petition fail to identify specific portions of the evidence that support the obviousness challenges and lack articulated reasoning with a rational underpinning to support a legal conclusion of obviousness. Thus, they fail to comply with Patent Office Rules and Supreme Court precedent. *See* 37 C.F.R. § 42.104(b)(5); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Each '236 Patent claim recites directly or by dependency two limitations that are not taught by the primary or secondary references in the Petition: (1) "a primitive operation the implementation of which is required to operate motion control devices and cannot be simulated using other motion control operations"; and (2) "a core set of core driver functions, where each core driver function is associated with one of the primitive operations." The '236 Patent provides an express definition for "primitive operations": "Primitive operations are operations that are necessary for motion control and cannot be simulated using a combination of other motion control operations." '236 Patent at 7:28-31. The broadest reasonable interpretation of these terms is dictated by Patent Owner's lexicography.

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