

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 IPR2013-00063
Case IPR2013-00074¹

Before THOMAS L. GIANNETTI, JENNIFER S. BISK, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

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

¹ The parties are not authorized to use this unofficial caption.

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IPR2013-00074

On March 21, 2014, a telephone conference call was held between respective counsel for the parties and Judges Giannetti, Bisk, and Plenzler. The conference call was initiated by the Board in response to a communication received from the Patent Owner's counsel. A court reporter was present on the call. Patent Owner will file the transcript as an exhibit.

Patent Owner seeks authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(b). The supplemental information consists of a deposition transcript and related exhibits. Patent Owner is seeking to antedate certain prior art by showing prior conception and diligence. Patent Owner asserts that these materials provide independent corroboration of conception. Petitioner opposes on the ground that the information sought to be filed could have been obtained earlier. Petitioner also asserts that it will be prejudiced by the late submission of this information.

After hearing argument, the panel ordered the following:

1. Patent Owner shall have until noon Eastern Time on Monday, March 24, 2014, to file a motion to submit supplemental information.
2. The motion is limited to five pages and must address the requirements for late submission of supplemental information under 37 C.F.R. § 42.123(b), including the timing of the submission and why it is in the interests of justice to grant the motion at this late stage.
3. The motion must be accompanied by an affidavit or declaration of counsel setting forth the reasons why the information could not reasonably have been obtained earlier.

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4. Patent Owner is ordered to submit the deposition transcript and exhibits along with the motion. The exhibits may be filed later if they are not available to be filed with the transcript.

5. Patent Owner may submit with the materials observations conforming with the guidance in the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012), not to exceed three pages in length.

6. Petitioner may file an opposition to the motion (not to exceed five pages) and response to the observations (not to exceed three pages). These are due no later than noon Eastern Time on Wednesday, March 27, 2014.

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