

Filed on behalf of Roy-G-Biv Corporation

By: Richard T. Black
Foster Pepper PLLC
1111 Third Avenue, Suite 3400
Seattle, Washington 98101-3299
Tel: (206) 447-6251
Fax: (206) 749-2062
Email: BlacR@foster.com
Registration No.: 40514

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

**DECLARATION BY RICHARD T. BLACK
IN SUPPORT OF PATENT OWNER'S
MOTION TO SUBMIT SUPPLEMENTAL EVIDENCE**

1. My name is Richard T. Black. I have personal knowledge of the facts contained in this Declaration, am of legal age, and am otherwise competent to testify.

2. I am lead counsel for Patent Owner in this proceeding, Roy-G-Biv Corporation. Both of my backup counsel also represent Plaintiff Roy-G-Biv Corporation (RGB) in the co-pending District Court Litigation, *Roy-G-Biv Corporation v. ABB, Inc., et al.* Case No. 6:11-cv-00622, (E.D. Tex.) (the Litigation), in which RGB alleges infringement of the same RGB patents at issue in IPR2013-00062, 00063, and 00074, *i.e.*, U.S. Patent Nos. 6,516,236; 6,513,058; and 8,073,557 (Patents-in-Suit).

3. Upon information and belief, ABB subpoenaed Parker-Hannifin Corporation (Parker) for documents from Compumotor on or about February 8, 2013 (*See* ABB Subpoena to Parker-Hannifin, Exhibit 2020-1). Upon information and belief, Parker produced responsive documents to ABB and RGB on or about March 8, 2013. Upon information and belief, prior to this time, RGB produced numerous documents to ABB concerning RGB's dealings with Compumotor in the 1994 timeframe. Upon information and belief, some but not all the Parker produced documents were previously produced to ABB by RGB. Upon information and belief, on or about April 15, 2013, ABB filed under seal and served on RGB its First Amended Answer, Affirmative Defenses, and

Counterclaims alleging, *inter alia*, that the Patents-in-Suit incorporate ideas conceived by Compumotor, including Marc McClung.

4. Upon information and belief, on or about September 18, 2013, ABB served Supplemental Initial Disclosures disclosing Stuart Goodnick and Marc McClung, both Compumotor employees during the relevant time period, as persons having knowledge of relevant facts concerning the conception of the subject matter disclosed in the Patents in Suit and knowledge concerning the design, development, manufacture, operation, marketing and/or sales of one or more prior art Parker systems, including Motion Toolbox and Motion Architect. (See ABB's First Supplemental Initial Disclosures, See Exhibit 2020-2.) *Id.* at p. 5.

5. On or about January 23, 2014 at the Trial in the proceedings IPR2013-00062 and IPR2013-00074, Mr. McLeod, lead counsel for ABB, asserted with regard to the July 24, 1994 Design Specification and Analysis Specification that RGB attached as Exhibit 2010-1 and 2, that there was, "no evidence that they were communicated to another person at a specific date and a specific form with specific information in them." (See Oral Hearing Transcript in IPR2013-00062, Paper 76, page 16:25-17:2). He also stated with respect to the "need for independent third-party corroboration" that "[t]hey have none. They've admitted they have none. It's simply not there." *Id.* at page 68, 13-18. The above Design Specification exhibit was also introduced at Mr. McClung's deposition as Exhibit 5 and was referred to

therein as the 2nd RGB Spec. (*See* Exhibit 2020-5). At the February 27, 2014 Trial in IPR2013-00063, it became apparent that the Board might view as necessary evidence of completely independent, third party corroboration of RGB's conception evidence.

6. ABB noticed Marc McClung's Deposition on or about February 28, 2014, the day after the IPR final hearing in IPR2013-00063. ABB took his deposition on or about March 14, 2014 (*See* Notice of Deposition, Exhibit 2020-3), after RGB had cancelled claims in proposed IPR2013-00122 and it had therefore been terminated by the Board.

7. At his deposition, Mr. McClung testified that ABB and certain Compumotor employees had been working together regarding the co-pending litigation for some time. (Ex. 2021, McClung Transcript at 204:20-207:1)

8. ABB counsel took both direct and redirect examination of this witness at his deposition on a variety of topics, including independent corroboration of RGB's conception evidence. Upon information and belief, ABB has had access to the RGB-produced Compumotor documents and the Parker-produced Compumotor documents and elicited much of the corroborating testimony itself. After RGB's counsel asked questions of Mr. McClung, ABB's counsel asked questions on re-direct of McClung and had the opportunity during its re-direct to ask further

questions on proof of corroboration. (Exhibit 2021, McClung Transcript at 214:3-218:25.)

9. Upon information and belief, RGB attempted to expedite delivery, but the final deposition transcript of Mr. McClung's deposition was not available until March 21, 2014. (See Mark McClung Transcript, Exhibit 2021). On that same day, RGB sought a conference call with the Board.

10. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Executed this 24th day of March, 2014 at Seattle, Washington.



Richard T. Black