

Filed on behalf of ABB, Inc.

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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 (Joined with IPR2013-00282)

Patent 6,516,236 B1

CORRECTED DECLARATION OF STEVEN M. AUVIL

**ABB v ROY-G-BIV
TRIAL IPR2013-00062
TRIAL IPR2013-00282
ABB CORRECTED
EXHIBIT 1142**

I, STEVEN M. AUVIL, hereby declare and state as follows:

1. I am lead counsel for petitioner ABB Inc. in the related district court proceeding, *ROY-G-BIV Corporation v. ABB Inc., MEADWESTVACO TEXAS, LP AND MEADWESTVACO CORPORATION*, Case No. 6:11-cv-00622 (E.D. Tex., filed November 15, 2011).

2. I make this declaration in support of petitioner ABB Inc.'s opposition to patent owner ROY-G-BIV ("RGB")'s motion to submit supplemental evidence. I am familiar with the facts set forth in this declaration.

3. Based on documents produced by RGB in the co-pending litigation with ABB and marked confidential or highly confidential under the litigation protective order ("Litigation PO"), ABB learned that RGB had worked with Compumotor to develop the XMC specification in 1994. Compumotor is a division of Parker-Hannifin, and so ABB served a subpoena on Parker-Hannifin to obtain documents relating to that work. On March 1, 2013, Parker Hannifin produced documents in response to a subpoena served in the litigation, and these documents were marked as confidential under the Litigation PO. On information and belief, RGB's counsel asked Parker Hannifin to produce the documents marked confidential or highly confidential under the Litigation PO, thereby restricting use of and access to the documents and information contained therein. On further information and belief, RGB's counsel contended that Parker-Hannifin

and Compumotor were still bound by a confidentiality agreement entered into with RGB in 1994.

4. On March 13, 2013, I sent RGB's counsel Richard Meyer a letter stating that ABB believed that RGB's counsel requested that Parker Hannifin designate the documents as confidential. A true and correct, redacted copy of this letter is attached as Appendix A. Appendices attached hereto have been highlighted for emphasis.

5. Also in this letter, I stated that the confidentiality designation was improper as it related to the Parker Hannifin documents ("PH Documents"). I further stated that the confidentiality designation was improper, related to other documents produced by RGB involving communication between RGB and Compumotor taking place in the 90's ("RGB Documents").

6. Also in this letter, I requested that the PH Documents and RGB Documents be de-designated as confidential under the Litigation PO, because they did not properly fall into a protectable category.

7. In a letter dated April 15, 2013, RGB litigation counsel Patrick Lafferty responded, refusing to de-designate the requested documents. A true and correct, redacted copy of this letter is attached as Appendix B.

8. Also in the letter, RGB took the position that Parker Hannifin was the correct party to contact in order to request de-designation of the PH Documents.

9. On April 15, 2013, ABB filed its First Amended Answer and Counterclaims, Dkt. No. 138 in the Litigation. ABB identified Marc McClung as being an unnamed co-inventor based, at least in part on, the PH Documents and RGB Documents discussing Mr. McClung's contributions. RGB moved to dismiss the counterclaim of unenforceability, and the Court recently denied that motion. Dkt. No. 279 in the Litigation.

10. On April 26, 2013, I sent a letter to RGB counsel Richard Meyer, requesting that RGB agree that the parties expand the Litigation PO to include the inter partes review ("IPR") proceedings. The proposal would have allowed parties to use in the IPR proceedings any relevant confidential business information ("CBI") produced in the district court litigation. A true and correct copy of this letter is attached as Appendix C.

11. On May 3, 2013, RGB counsel Richard Meyer replied by email and rejected the proposal. A true and correct copy of an email thread ending on July 23, 2013 is attached as Appendix D.

12. On July 19, 2013, I sent Richard Meyer an email stating that Dave Brown's IPR declaration for the '557 patent necessarily made relevant documents produced by RGB in the district court proceeding designated as confidential. I proposed that the parties agree to expand the scope of the Litigation PO to make discovery produced in the district court available in the IPR proceedings. A true

and correct copy of this email is found in Appendix D.

13. On July 23, 2013, Richard Meyer responded via email and rejected this proposal. A true and correct copy of this email is found in Appendix D.

14. On September 10, 2013, I sent RGB's litigation counsel, Richard Meyer, a letter, again requesting de-designation of the RGB Documents. In this letter I specified several examples of documents that were improperly designated as confidential. A true and correct, redacted copy of this letter is attached as Appendix E.

15. On September 23, 2013, I sent a letter to Richard Meyer, noting that RGB submitted to the Patent Trial and Appeal Board ("PTAB") documents designated as confidential under the Litigation PO, in order to establish a priority date over the references at issue. A true and correct, redacted copy of this letter is attached as Appendix F.

16. Also in the September 23 letter, I specifically identified numerous documents designated as confidential under the Litigation PO that should have been produced in the IPR proceeding as they show inconsistent positions taken by RGB.

17. In the September 23 letter I also noted RGB's improper interpretation of their duty to provide routine discovery under Rule 42.51(b)(iii) during an IPR proceeding.

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