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

ABB'S OPPOSITION TO PATENT OWNER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION

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I. INTRODUCTION

Prior to the Trial Argument, RGB did not obtain testimony or introduce documents involving Marc McClung ("Late Submission"), even those it possessed for years. '062 Trial, Paper 76, 25:1-6. ABB could not provide McClung's recent testimony due to the terms of the Litigation PO. (Auvil Decl., ¶ 42). Moreover, consideration of the Late Submission without contrary evidence showing that McClung is an unnamed co-inventor unfairly prejudices ABB.

II. LEGAL STANDARDS

Under Rule 123(b), the proponent "must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice."

The "interests-of-justice" standard is higher than "good cause." 77 Fed. Reg. 48622. Misunderstanding of the law on corroboration does not qualify as "good cause." *Hahn v. Wong,* 892 F.2d 1028, 1034 (Fed. Cir. 1989); *see also Huston v. Ladner,* 973 F.2d 1564 (Fed. Circ. 1992) (stating that "attorney negligence" is not "good cause" and affirming that "good cause" requires proof that late submitted declaration could not have been obtained and presented earlier).

"The testimony of someone who is not a witness in this trial and who has not testified or been subject to cross-examination in the context of this trial is of insufficient value to warrant its late submission." *Illumina, Inc. v Columbia Univ.,*

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IPR2013-00011, Paper 87 at 5 (denying late submission); *see also* Paper 125 at 3.

III. DISCUSSION

A. RGB Was Not Reasonably Diligent In Seeking Evidence

The Board ordered RGB to show that it could not have reasonably obtained (at an earlier time) the evidence proffered in the Late Submission. However, RGB essentially concedes its failure to obtain any testimony from Marc McClung between April 18, 2013 ('062 Institution Decision) and March 2014 (deposition of McClung by ABB), even though McClung has been known and readily available to RGB throughout 2013. Ex. 2019, 14:23 – 15:1:

> JUDGE GIANNETTI: So you've been aware of this Compumotor thing for some time. Is that right?
> MR. MEYER: We have been aware of the Compumotor issue...yes.

First, McClung was identified as being relevant to the validity of the claims as least as early as April 15, 2013 in ABB's First Amended Answer and Counterclaims, Litigation Dkt. 138. (Auvil Decl., ¶ 3-8, 39-41; *also* '062 Trial, Ex. 1025, submitted May 2013 ("McClung brought up several key suggestions that were integrated…")). ABB asserted that McClung is an unnamed inventor on at least the '236 and '557 Patents based upon documents bearing RGB's production numbers in the Litigation. (*Id.*) RGB insisted that these documents were confidential under the Litigation Protective Order (*Id.*), preventing ABB from bringing this issue to the Board as the undersigned does not have access to these

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