

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 RESPONSE TO PATENT OWNER'S MOTION FOR
OBSERVATIONS ON EXAMINATION OF MARC MCCLUNG**

I. MR. MCCLUNG IS A WITNESS IN CONCURRENT LITIGATION

In Ex. 2021, on page 216, lines 19-21, Mr. McClung testified that he did not “have a dog in this fight.” On page 143, line 24 to page 144, line 1, he testified that he was not represented by counsel at the deposition. On page 167, lines 1-2, he testified that he has “no legal background.” On page 106, line 24 – page 107, line 3, he testified: “...for the second [WOSA/XMC] draft, uh, I was asked to...review the specification, uh, work with Dave, provide feedback...” This testimony is relevant to his role in the litigation and to his expertise on legal issues.

II. WOSA/XMC & THE PATENTS INCLUDE MR. MCCLUNG’S IDEAS

In Ex. 2021, on page 71, line 17 – page 72, line 3, Mr. McClung was asked: “...again these are sort of these core functions that Compumotor Parker came up with as part of this exercise of this distilling down the...400, 6000 [Series Controller] functions...to sort of a core [set]?” He responded: “That's correct.” In Ex. 2021, on page 122, line 6 – 124, line 4, the following exchange occurred:

[Q] So again, if you look, uh, at Exhibit 4 [i.e., first draft XMC spec] under this 3.8.1 I see a heading called Actions...., and underneath it looks like a "MoveAbs" so probably move absolute? [A] Right. Right. [Q] "Jog" and then "Stop." Do you see those three? [A] That's correct, hm-m. [Q] So here again "Need kill" a VI from the Motion Toolbox that Compumotor had developed, right? [A] Hm-m. Yes. [Q] This is Compumotor feedback on Mr. Brown's specification of we need to add a kill? [A] ...Yeah, so -- so at that

time, uh, yeah, we were -- probably had that mindset, yeah, this -- this core functionality. We were probably comparing, you --you know, the -- the Motion Toolbox Guide against, you know, the [XMC] specification....And, uh, and it's pretty obvious we were. Especially when you get into my -- my feedback in -- in draft -- for [XMC] draft 2. It's almost like verbatim. [Q] Verbatim from the Motion Toolbox? [A] Yeah. Yeah, because it's basically the -- the titles.

In Ex. 2021, on page 133, line 20 -- page 135, line 19, Mr. McClung was asked about email he sent Dave Brown which included the statements:

Will the here [sic] driver administrator allow the user to select more than one motion-control device? ... We have a few customers who use several of our products in one application.

Mr. McClung responded, in part, as follows:

So I was probably thinking back to, you know, my systems experience, you know, how would you -- I was just trying to imagine how would you do this with the motion, the XMC component...

In Ex. 2021, on page 142, lines 13 -- 20, Mr. McClung explained an email he sent to Dave Brown:

For example, in the, um -- Compucam, for example, will typically generate these, uh -- generate a program, and, uh, which can be downloaded -- uh, would generate a 6000 program, which would be downloaded to the unit using -- using motion Architect. Um, and so that's program code generation, you know...

In Ex. 2021, on page 120, line 16 to page 121, line 19, Mr. McClung testified regarding feedback that was provided to RGB by Compumotor:

...someone who's not a software developer...they see GetPosition, but they don't see...they might be confused, like, well, whi -- which position is that... exactly.... so that is providing feedback. I think, uh, I mentioned earlier, you know...one of my goals was to...provide advice to get an API with functionality that -- that is clear and unambiguous...I think that was probably an effort at that time. You know, let's...clarify some of these things, you know, we're --we're not, uh...you know, our experience are usually for a servo, a controller... there would be two kinds of position that -- that you would want to query...So someone saw that and said, well, you know, that's vague. You know, I -- I want -- it -- it would be better to do it this way.

This testimony is relevant to conception of claims at issue, whether Mr. McClung is an inventor thereof, whether he is capable of providing evidence independent of the inventors, and whether ABB would be prejudiced by the Late Submission.

Dated: March 26, 2014

Respectfully submitted,

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Certificate of Service in Compliance With 37 C.F.R. § 42.6(e)(4)

The undersigned certifies that a complete copy of *ABB's Response to Patent Owner's Motion for Observations on Examination of Marc McClung* was served on counsel of record for the '236 Patent Owner:

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via **EXPRESS MAIL**, on March 26, 2014.

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