

# Exhibit 1

**ABB v ROY-G-BIV  
TRIAL IPR2013-00062  
ABB - EXHIBIT 1026**

April 26, 2013

The Honorable Leonard Davis  
U.S. District Court for the Eastern District of Texas  
211 W. Ferguson, Third Floor  
Tyler, TX 75702

Re: *ROY-G-BIV Corp. v. ABB, Ltd. et al.*, Civil Action No. 6:11-cv-00622-00624-LED

Dear Chief Judge Davis:

In accordance with the November 27, 2012 Docket Control Order (Doc. 97) in this case, Plaintiff RGB opposes Defendants' request to file a motion for summary judgment of indefiniteness. Defendants' requested motion is a "not even arguably meritorious" motion that will "waste[] clients' money and the Court's limited resources." Standing Order Regarding Letter Briefs at 2. Accordingly, RGB respectfully requests that it not be required to expend resources addressing Defendants' proposed motion.

**First**, as set forth below, Defendants' arguments as to "primitive operations" / "non-primitive operations" and "application program" are dead on arrival. The meanings of those terms are clear and any alleged play in those clear meanings does not come close to meeting the "insolubly ambiguous" standard. **Second**, Defendants' supposed confusion over the meaning of these terms is feigned. Indeed, in their invalidity contentions, Defendants had no trouble alleging that the asserted prior art references teach those limitations. Further, the Defendants also asserted in interrogatory responses that their accused products lack "primitive" and "non-primitive" operations, reflecting their understanding of those terms. **Third**, the PTO's decisions—including original prosecutions, *inter partes* reexaminations, and recent *inter partes* reviews—soundly rebut Defendants' contention. Indeed, just last week, the Patent Trial and Appeal Board ("PTAB") rejected ABB's "vagueness" argument as to "primitive operations."

## I. Applicable Legal Standards for Indefiniteness

Defendants' description of the legal standards for indefiniteness conspicuously omits any mention of the presumption of validity, the clear and convincing standard of proof, or the "exacting standard" with which indefiniteness defenses are evaluated. Specifically, to prove indefiniteness, "[a]n accused infringer must . . . demonstrate by **clear and convincing evidence** that one of ordinary skill in the art could not discern the boundaries of the claim." *Haemonetics Corp. v. Baxter Healthcare Corp.*, 607 F.3d 776, 783 (Fed. Cir. 2010). This is "an exacting standard" (*id.*) through which the Federal Circuit grants "respect to the statutory presumption of validity" and "protect[s] the inventive contribution of patentees, even when the drafting of their patents has been less than ideal." *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347-1348 (Fed. Cir. 2005).

"Only claims 'not amenable to construction' or 'insolubly ambiguous' are indefinite." *Halliburton Energy Servs. v. M-I LLC*, 514 F.3d 1244, 1250 (Fed. Cir. 2008). "Absolute clarity . . . is not necessary." *Source Search Techs., LLC v. LendingTree, LLC*, 588 F.3d 1063, 1076 (Fed. Cir. 2009). Thus, the mere fact that some "play remains in [a] construction is not enough

to render the patent indefinite.” *Accentra, Inc. v. Staples, Inc.*, 2013 U.S. App. LEXIS 225 (Fed. Cir. Jan. 4, 2013). “[C]lose questions of indefiniteness in litigation involving issued patents are properly resolved in favor of the patentee.” *Bancorp Servs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372 (Fed. Cir. 2004).

## II. Defendants’ Arguments Fail On the Merits

### A. “Primitive” and “Non-Primitive” Operations Are Not Indefinite

#### 1. The Mistake in the Appendix Is Apparent

Defendants correctly identify a mistake in the March 15, 1995 Appendices to the RGB Patents. Specifically, the inventors erroneously interchanged “MovRel” and “MovAbs.” They categorize “MovRel” as a non-primitive operation and “MovAbs” as a primitive operation, when the opposite is actually true. But the inventors realized their mistake, which they corrected in their May 30, 1995 patent filing. Accordingly, there is no doubt that the RGB Patents correctly classify “MovRel” as a “primitive operation.”

The MovRel and MovAbs operations are well known to persons skilled in the art, who would not be confused by RGB’s initial mistake. The “MovRel” operation instructs a motion control device to move some distance “relative” to its current position and without regard to its absolute position in the coordinate system. This simple move command is analogous to instructing a person to move five feet to their right. The person need not know his or her current position—*e.g.*, a longitude and latitude—to comply with the instruction. Because “MovRel” is necessary for motion control and cannot be simulated using other motion control operations, it is a primitive operation.

In contrast, the “MovAbs” operation instructs a motion control device to move to an absolute position in the coordinate system. The analogous instruction is for a person to move to a particular latitude and longitude. To comply, a person must first determine his or her current position in latitude and longitude, and then determine an appropriate “MovRel” to reach the desired absolute position. Thus, a “MovAbs” operation can be simulated by a “Get Position” operation followed by an appropriate “MovRel” operation. Because “MovAbs” can be simulated by these two other motion control operations, it is non-primitive. *See* ‘236 Patent, col. 7:27-39.

The relationship between “MovRel” and “MovAbs” operations is well known in the field of motion control. Although the March 15, 1995 Appendices accidentally interchanged the two operations, the mistake was corrected in the original patent filing two months later. No person of skill in the art could possibly be confused.

#### 2. The “Primitive Operations” “Move Relative” and “Get Position” Cannot Be Simulated by Other Motion Control Operations

Defendants incorrectly contend that “[b]y defining ‘SetAcceleration’ and ‘SetVelocity’ as motion control operations, RGB admits that MOVE RELATIVE is not a primitive operation because it can be simulated using the combination of acceleration and velocity components.” Ltr. at 4. Defendants are demonstrably wrong; even a cursory examination of RGB’s Appendices shows that not all motion control operations cause movement. For example, motion

control operations can relate to, among other things: “**Configuration**” (e.g., “Initialize”); “**Querying Attributes**” (e.g., “GetAcceleration” and “GetVelocity” and “GetPosition”); “**Setting Attributes**” (e.g., SetAcceleration and SetVelocity); and “**Actions**” (e.g., MovAbs). See Appendix B § 4.2.8. “Configuration,” “Querying Attributes,” and “Setting Attributes” are other motion control operations that do not cause movement. For example, the “Setting Attributes” motion control operations simply set parameters that will apply if and when “Actions” are initiated. “SetAcceleration” and “SetVelocity” will determine the acceleration and velocity if and when a MOVE RELATIVE operation is initiated. But, unlike MOVE RELATIVE, “SetAcceleration” and “SetVelocity” never initiate movement themselves. Accordingly, while “SetAcceleration” and “SetVelocity” are motion control operations, they cannot be used to simulate MOVE RELATIVE. Defendants’ contrary argument makes no sense. The PTAB agrees; just last week the PTAB stated that it was “not persuaded by” ABB’s argument that “‘move relative’ could be emulated using ‘constituent operations.’” ‘236 IPR Decision at 8.

Defendants’ related argument about “GET POSITION” is equally frivolous. Defendants argue that GET POSITION is not primitive because it “*can* be emulated using a combination of **operations.**” Ltr. at 4 (emphasis added). According to Defendants, “GET POSITION also requires constituent operations, including: (1) sending a query; (2) receiving position data in response to that query; and (3) reading the received position data.” *Id.* Again, Defendants are wrong; they misread the claim limitation.

As Defendants acknowledge, “primitive operations” are operations “which cannot be simulated using a combination of **other motion control operations.**” Ltr. at 3 (emphasis added). But tellingly, Defendants do not even attempt to explain how these alleged “constituent operations” qualify as “other motion control operations.” Indeed, the GET POSITION motion control operation in the RGB Patents involves “querying the system for the current position.” ‘236 Patent at col.16:43-45. Thus, the first alleged constituent operation is not an “**other** motion control operation”; rather, it is **the** GET POSITION motion control operation. Further, the last two allegedly “constituent operations” relate to what is done *after* GET POSITION is called. Again, the PTAB agrees with RGB. Last week, the PTAB rejected ABB’s argument that, because “motion control operations exist in the abstract,” they “can always be further decomposed into increasingly lower level constituent operations.” ‘236 IPR Decision at 7.

Defendants’ letter brief identifies only a handful “motion control operations.” But the Appendices disclose many, many more, including Initialize, Tune, GetErrorStatus, GetUnits, GoHome, GoZero, Reset, and ShutDown. Tellingly, Defendants have not even attempted to explain how any of the many exemplary “primitive operations” in the Appendices can be simulated from any of the “other motion control operations” disclosed in the Appendices. Their argument that GET POSITION and MOVE RELATIVE can be simulated from other motion control operation simply has no basis in fact.

### 3. The Patents Provide Adequate Guidance on Which Operations Are “Necessary for Motion Control”

Defendants next argue that the “patents fail to notify the public as how GET POSITION or MOVE RELATIVE are ‘necessary for motion control’” because “[t]urning a spindle does not require a MOVE RELATIVE operation.” Ltr. at 4. According to Defendants “[i]f an operation is only performed in certain motion control applications by certain devices, it cannot be fairly

described as ‘necessary for motion control.’” Ltr. at 3. Defendants’ argument is irreconcilable with the clear teaching in the specification, and their own actions. In addition, the PTAB’s recent IPR decision expressly found that “the ‘236 Patent clearly defines a primitive operation with an explicit definition—an operation necessary for motion control and cannot be simulated using a combination of other motion control operations. ‘236 IPR Decision at 8-9. The PTAB also found that the specification explains how to apply the definition. *Id.* Although “MovRel” may not be employed for “turning a spindle,” that application requires other operations like “MoveContinuous,” which cannot be simulated using other motion control operations. This is why “MoveContinuous” is denominated as a primitive operation in the RGB Appendices.

#### 4. Defendants’ Alleged Confusion Is Feigned & Inconsistent with the PTO IPR Decisions

Defendants’ prior admissions demonstrate that their confusion over these terms is feigned. First, Defendants’ Joint Invalidity Contentions (“DJICs”) reflect that they had no trouble whatsoever distinguishing between “primitive operations” and “non-primitive operations” and specifically identifying alleged examples of each in references that the Defendants assert are prior art. *See, e.g.*, DJICs, Ex. B2 at 5-6 (“Infi90 DCS function codes embody motion control operations. . . . Some of the function codes correspond to *primitive operations*. . . . Other function codes correspond to *non-primitive operations*.”) (emphasis added); *Id.*, Ex. N2 at 2 (“Sorensen discloses a set of motion control operations. . . . *Primitive operations include* measure\_pose (p. 174), move\_axis (p. 165), move\_to\_ele (p. 165), and set\_signal/set\_ext\_signal (p. 174), for example. *Non-primitive operations include* move\_joints (p. 165) and move\_rel\_ele (p. 166), and pulse\_sig (p. 174), for example. *Primitive and non-primitive operations are described in Appendix A, for example (using the data structures and definitions of Appendix C).*”).

Second, in their interrogatory responses Defendants deny that their accused products have “primitive operations” or “non-primitive operations,” further evidencing that they understand the meaning of those terms.

Third, as to “primitive” and “non-primitive” operations, Defendants’ Letter Brief candidly concedes that the supposed ambiguities in the meaning of primitive operations and non-primitive operations are “less obvious on the whole.” (Ltr. at 5). Indeed, in ABB’s recent IPR Petition, it did not even contend that “primitive operations” was insolubly ambiguous. As we discuss below, ABB asserted only that the term was “vague” and needed supplementation. The PTAB disagreed and readily construed the term. *See* Section III below.

#### B. Claim 8 of the ‘543 Patent Is Not “Insolubly Ambiguous”

Defendants infer that the absence of an explicit antecedent basis for “application program” in claim 8 is fatal to validity. This is not the law. *In re Skvorecz*, 580 F.3d 1262, 1268-1269 (Fed. Cir. 2009) (claim not invalid for lack of antecedent basis because “a person skilled in the field of the invention would understand the claim when viewed in the context of the specification”); *Energizer Holdings v. ITC*, 435 F.3d 1366, 1370-1371 (Fed. Cir. 2006).

Here, the face of the claim (reproduced below) resolves any ambiguity. Because claims 5, 6 and 7 do not require an application program, a person of ordinary skill reading this claim

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