

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABB, INC.
Petitioner

v.

ROY-G-BIV CORPORATION
Patent Owner

Case IPR2013-00062 (Patent 6,516,236)
Case IPR2013-00074 (Patent 8,073,557)¹

Before THOMAS L. GIANNETTI, BRYAN F. MOORE, and
JENNIFER S. BISK, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

¹ This Order addresses a joint initial conference for these cases. The parties are not authorized to use this caption for any subsequent papers without authorization from the Board.

On May 21, 2013, the following individuals participated in a joint initial conference call in these matters: (1) Richard D. McLeod, counsel for Petitioner; (2) Richard T. Black and Joel B. Ard, counsel for Patent Owner; (3) Administrative Patent Judges Thomas L. Giannetti, Bryan F. Moore, and Jennifer S. Bisk.

The following matters were discussed:

1. Status of Related District Court Action

The pending action in the Eastern District of Texas is at the *Markman* Hearing stage. Patent Owner's reply papers are due at the end of this week.

2. Schedule

The parties are satisfied with the current schedule. Petitioner noted that the schedule may have to be adjusted depending on the outcome of joinder motions described infra.

3. Protective Order

Currently the parties do not foresee the need for entry of a protective order. They will contact the Board if that changes.

4. Initial Disclosures

The parties have not agreed to exchange initial disclosures. Neither party is requesting them at this time.

5. Compelled Discovery and E-Discovery

The parties do not foresee the need for compelled discovery or special E-discovery provisions at this time.

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6. Motion to Amend Claims

Patent Owner does not foresee filing a motion to amend the claims at this time.

7. Other Motions

Petitioner has filed additional petitions for *inter partes* review (IPR2013-00282, IPR2013-00286) and moved to join them with this proceeding if granted. Patent Owner intends to oppose.

Petitioner requested authorization to file supplemental materials from the litigation, i.e., the briefs for the *Markman* hearing. The Board authorized the motion. Patent Owner agreed to advise the Board whether or not it opposes after receiving the motion.

8. Settlement

Neither party is aware of the status of settlement. A mediation is scheduled for June in the pending litigation.

In view of the foregoing, it is hereby

ORDERED that Petitioner is authorized to file a motion to supplement directed to claim construction briefing in the related litigation. This motion is due within one week of the entry date of this Order. Petitioner is directed to 37 C.F.R. § 42.123 for guidance on the content of this motion.

FURTHER ORDERED that Patent Owner shall advise the Board within five days of receipt of the foregoing motion whether or not the motion is opposed.

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