

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

Patent 6,516,236 B1

**MOTION FOR JOINDER TO RELATED
INSTITUTED INTER PARTES REVIEW (37 C.F.R. § 42.122(b))**

Petitioner ABB Inc. files this Motion for Joinder of the Petition For Inter Partes Review Of Claims 1-10 Of U.S. Patent No. 6,516,236 B1 (“Second Petition”), with the instituted inter partes review, *ABB Inc. v. ROY-G-BIV Corporation*, Case No. IPR2013-00062 (“IPR2013-00062”), pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b).

No fee is required for consideration of this Motion. Petitioner has paid the fee for the IPR2013-00062 and will be paying the fee for the Second Petition for inter partes review. Should this be incorrect, the Patent Office is authorized to charge Deposit Account 02-4550 the necessary fee.

I. APPLICABLE RULES

37 C.F.R. § 42.122(b) states:

Request for joinder. Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any inter partes review for which joinder is requested. The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

II. RELIEF REQUESTED

In this Motion, Petitioner ABB Inc. requests that the Second Petition be joined with IPR2013-00062.

III. STATEMENT OF MATERIAL FACTS

1. On November 21, 2011, ABB was served with a complaint for infringement of U.S. Patent No. 6,516,236. That suit is currently pending in the U.S. District Court for the Eastern District of Texas, styled *ROY-G-BIV Corporation v. ABB, Inc. et al.*, 6:11-cv-00622-LED – ED Tex. (Tyler).

2. On November 21, 2012, ABB filed a Petition for Inter Partes Review requesting review of claims 1-10 of the '236 patent, now styled, *ABB, Inc. v. Roy-G-Biv Corporation*, Case No. IPR2013-00062.

3. On April 18, 2013, the Board instituted trial on claims 1-4 and 8-10 in *ABB, Inc. v. Roy-G-Biv Corporation*, Case No. IPR2013-00062.

4. On May 2, 2013, ABB filed a Motion for Reconsideration of Decision on Institution of Inter Partes Review in IPR2013-00062. That motion is pending.

5. Concurrently with this Motion, ABB is filing its Second Petition, challenging claims 1-10 of the '236 patent.

IV. ARGUMENT

The Board has authority under 35 U.S.C. § 315(c) to join a properly-filed second inter partes review petition to an instituted inter partes review proceeding. This request for joinder is timely and the time periods set forth in 37 C.F.R. § 42.101(b) do not apply to the Second Petition because it is accompanied by this request for joinder. 37 C.F.R. § 42.122(b).

The Second Petition involves the same parties, the same patent, the same claims, and much of the same prior art. In the Second Petition, ABB argues new grounds for the unpatentability of the challenged claims, based in part on the Board's claim interpretation in its decision in IPR2013-00062. Therefore, the Second Petition is related to IPR2013-00062, and joining the Second Petition with IPR2013-00062 would not prejudice ROY-G-BIV Corporation. ABB Inc. requests joinder of the Second Petition with IPR2013-00062.

Dated: May 17, 2013

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 this Motion for Joinder was served on the official correspondence address for the '236 Patent shown in PAIR and the attorneys of record for Patent Owner in Trial No. IPR2013-00062:

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