UNITED STATES PATENT AND TRADEMARK OFFICE
_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD
_____

ABB INC.
Petitioner,

v.

ROY-G-BIV CORPORATION
Patent Owner

_____

Case IPR2013-00282
Patent 6,516,236 B1

_____

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

MOORE, Administrative Patent Judge.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I.   INTRODUCTION

A.   Background

ABB Inc. (Petitioner) requests *inter partes* review of claims 5-7 of US Patent 6,516,236 B1 (the '236 patent) pursuant to 35 U.S.C. §§ 311 et seq. Paper 1 (Pet.). Patent Owner has waived its right to file a Preliminary Response. Paper 13. We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a) which provides as follows:

> THRESHOLD – The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Petitioner separately has moved that this proceeding be joined with IPR2013-00062. Paper 4. In a separate decision entered today, we grant ABB's motion and join this proceeding with IPR2013-00062. To facilitate joinder, Petitioner moved to limit the petition (Paper 10) to the following grounds of obviousness (*see* Asserted Challenges and References, infra):

1.   Claims 5 and 6 based on the combination of Gertz, Stewart, Morrow, DDAG, and Brockschmidt;

2.   Claim 7 based on the combination of Gertz, Stewart, Morrow, DDAG, and HP86.

The Board granted the motion. Paper 11. As a result, the Petition now is limited to grounds of unpatentability that are based primarily on prior art that the Board relied upon in instituting *inter partes* review in *ABB, Inc. v. ROY-G-BIV Corporation*, Case IPR2013-00062.

For the reasons discussed below, we institute *inter partes* review of claims 5-7 on each of the proposed grounds — obviousness over the combination of Gertz, Stewart, Morrow, DDAG, and Brockschmidt, and obviousness over the combination of Gertz, Stewart, Morrow, DDAG, and HP86.

B. Asserted Challenges and References

ABB contends that the challenged claims are unpatentable under 35 U.S.C. § 103 based on the following prior art references:

1.   Gertz, Matthew W., A Visual Programming Environment for Real-Time Control Systems. Ph.D. dissertation, Carnegie Mellon University, Nov. 22, 1994 (Ex. 1008) ("Gertz");

2.   Stewart, David B., Real-Time Software Design and Analysis of Reconfigurable Multi-Sensor Based Systems. Ph.D. dissertation, Carnegie Mellon University, April 1, 1994 (Ex. 1012) ("Stewart");

3.   Morrow, J. Dan; Nelson, Bradley J.; and Khosla, Pradeep, "Vision and Force Driven Sensorimotor Primitives for Robotic Assembly Skills," Proceedings of the 1995 IEEE/RSJ Int. Conf. on Intelligent Robots and Systems, 234-240, January 1, 1995 (Ex. 1013) ("Morrow");

4.   Microsoft Corp., MS Windows 3.1 Device Driver Adaption Guide, Chs. 1-2, 4, 10-12 (Microsoft Press 1991) (Ex. 1010) ("DDAG");

5.   Brockschmidt, Kraig, Inside OLE 2 (Microsoft Press Programming Series 1994) (Ex. 1011) ("Brockschmidt");

6.   Hewlett Packard Co., Interface and Programming Manual, HP 7550 Graphics Plotter (3rd ed. 1986) (Ex. 1019) ("HP86").

C.   Related Proceedings

The '236 patent is involved in concurrent district court litigation. On November 15, 2011, ROY-G-BIV filed an infringement complaint against ABB.

ROY-G-BIV v. ABB et al., No. 11-cv-00622 (E.D. Tex.). That proceeding has not been stayed. *Id.* The '236 patent also was involved in prior litigation, dismissed with prejudice on November 20, 2009. *ROY-G-BIV Corp. v. Fanuc Ltd. et al*, No. 2:07-cv-00418 (E.D. Tex.).

D.   The Invention

The technology of the '236 patent is described in the decision (Paper 23) in IPR2013-00062 instituting *inter partes* review (the "IPR2013-00062 Decision") at pages 3-5. For the purposes of this decision, we adopt that prior description. Claims 5-7, at issue in this petition, are reproduced below.

> 5. A system as recited in claim 4, further comprising:
> an extended function pointer table that maps the non-supported extended driver functions to the combination of core driver functions employed to emulate the non-supported extended functions; and
>   the motion control component generates the control commands further based on the contents of the extended function pointer table.

> 6. A system as recited in claim 5, in which the extended function pointer table contains pointers for both supported and non-supported extended driver functions, where
>   the pointers for the supported extended driver functions point to driver code for implementing the supported extended driver functions and
>   the pointers for the non-supported extended driver functions point to the combination of core driver functions that emulate the non-supported extended functions.

> 7. A system as recited in claim 1, further comprising:
> means for determining a driver unit system employed by the software drivers; and
>   means for converting an application unit system employed by the application program into the driver unit system.

E.   Claim Construction

As a step in our analysis for determining whether to institute a trial, we determine the meaning of the claims. Consistent with the statute and the legislative history of the Leahy-Smith America Invents Act (AIA), the Board will interpret claims using the broadest reasonable construction in light of the specification. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012); 37 CFR § 42.100(b). ABB submits proposed interpretations for several claim terms. Pet. 17-32.

We adopt, for the purpose of this decision, the claim constructions presented in the IPR2013-00062 Decision at 6-11.

II.   ANALYSIS

A.   Overview

For the reasons described below, we institute an *inter partes* review of claims 5 and 6 of the '236 patent on the ground of obviousness over the combination of Gertz, Stewart, Morrow, DDAG, and Brockschmidt, and of claim 7 on the ground of obviousness over the combination of Gertz, Stewart, Morrow, DDAG, and HP86.

B.   Gertz, Stewart, and Morrow

The Gertz reference (Ex. 1008) is described in the IPR2013-00062 Decision at page 12. The Stewart (Ex. 1012) and Morrow (Ex. 1013) references are described in the the IPR2013-00062 Decision at page 15. For the purposes of this decision we adopt those prior descriptions.

1.   Obviousness over Gertz, Stewart, Morrow, DDAG, and Brockschmidt

Petitioner asserts that claims 5 and 6 would have been obvious over the combination of Gertz, Stewart, Morrow, DDAG, and Brockschmidt. Pet. 29-34. DDAG (Ex. 1010) is a manual describing Windows 3.1 device drivers and their

5

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.