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Registration No.: 40514

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

U.S. Patent No. 6,516,236 B2

MOTION CONTROL SYSTEMS

PATENT OWNER ROY-G-BIV CORPORATION'S

DECLARATION OF DAVID W. BROWN UNDER 37 CFR § 42.53

- 1 -

ROY-G-BIV CORPORATION

I, David W. Brown, hereby declare the following:

1) This Declaration attests to facts relating to the conception of the invention claimed in U.S. Patent No. 6,516,236 (“the ‘236 Patent”) in the United States before November 21, 1994, and reasonable diligence in the United States from at least November 20, 1994 through the constructive reduction to practice on May 30, 1995, as evidenced by the filing of U.S. Patent Application No. 08/454,736, the benefit of whose filing date is claimed by the ‘236 Patent.

BACKGROUND AS INVENTOR & OVERVIEW

2) I am a founder, Chairman and Chief Technical Officer of ROY-G-BIV Corporation (“RGB”), which is a software development company that developed and implemented software systems and components thereof that practice the claims of the ‘236 Patent. I have personal knowledge of the facts contained in this Declaration, am of legal age, and am otherwise competent to testify.

3) I am one of the co-inventors of the invention described and claimed in

U.S. Patent Application Serial No. 10/021,669 which was filed on December 10, 2001, now U.S. Patent No. 6,516,236, which is a continuation of and claims the benefit of the filing date of U.S. Patent Application No. 09/191,981, filed November 13, 1998; which in turn is a continuation of and claims the benefit of the filing date of U.S. Application No. 08/656,421, filed May 30, 1996, now U.S. Patent No. 5,867,385; which in turn is a continuation-in-part of and claims the benefit of the filing date of U.S. Application No. 08/454,736, filed May 30, 1995 (hereinafter the “Priority Application”), now U.S. Patent No. 5,691,897.

4) In the United States, Jay Clark and I had conceived of the system recited in at least claims 1-4 and 8-10 of the ‘236 Patent prior to November 21, 1994. After conception, I diligently worked in the United States toward reducing to practice the claimed invention, as evidenced by the filing of the Priority Application on May 30, 1995. The claimed invention also was subsequently actually reduced to practice, as evidenced by our commercial XMC product. This declaration relies upon the constructive reduction to practice date on May 30, 1995.

5) When I refer to “reduced to practice” or “reduction to practice” in this Declaration, I refer to the constructive reduction to practice that occurred on May 30, 1995 – *i.e.*, the date of the filing of the Priority Application for the ‘236 .

LIST OF EXHIBITS CORROBORATING CONCEPTION & DILIGENCE

6) Attached to my declaration are Exhibits 2010-1 through 2010-6, respectively, which are true and correct copies of the following documents:

Exhibit 2010-1: Draft of the WOSA/XMC MCAPI and MCSPI Design Specification by David Brown, dated July 1, 1994 (“Design Specifications.”) This document has also been produced in the concurrent litigation and assigned Bates Numbers in the range RGB00055896-55949, which may be referred to herein to direct the Board to relevant materials. The Design Specifications were each completed as of at least (not later than) July 24, 1994.

Exhibit 2010-2: Draft of the WOSA/XMC MCAPI and MCSPI Analysis Specification by David Brown, dated July 15, 1994 (“Analysis Specifications”). This document has also been produced in the concurrent litigation and assigned Bates Numbers in the range RGB00055881-55895, which may be referenced herein to direct the Board to

relevant materials. The Analysis Specifications were each completed as of at least (not later than) July 24, 1994.

Exhibit 2010-3: Dave Brown's time logs from November 20, 1994 through May 30, 1995. The time logs summarize my work on (1) the XMC software, which is a commercial embodiment of the invention claimed in the '236 patent; and (2) the draft patent application that became U.S. App. Serial No. 08/454,736, filed on May 30, 1995.¹

Exhibit 2010-4: A portion of the specification for the XMC software, which was filed as an appendix to U.S. App. Serial No. 08/454,736 as an exemplary embodiment, which is dated February 22, 1995 and is referenced in the

¹ Exhibit (2010-3) has been redacted to remove extraneous and/or personal information that is not believed relevant to showing that the invention claimed in the '236 Patent was conceived at least by November 20, 1994, and that I exercised reasonable diligence to reduce the invention to practice as of May 30, 1995.

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