UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABB, INC. Petitioner

v.

ROY-G-BIV CORPORATION Patent Owner

> Cases IPR2013-00063 Patent 6,513,058 B2

Before THOMAS L. GIANNETTI, JENNIFER S. BISK, and JEREMY M. PLENZLER, *Administrative Patent Judges*.

GIANNETTI, Administrative Patent Judge.

FINAL WRITTEN DECISION 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

This case is one of a series of *inter partes* reviews (IPRs) initiated by ABB, Inc. ("Petitioner"), challenging various patents owned by ROY-G-BIV Corp. ("Patent Owner"). In that connection, the Board has issued two final decisions in related proceedings: IPR2013-00062 (Paper 84, "the '062 Decision") and IPR2013-00074 (Paper 80). In addition, there is a related district court litigation between the parties in the Eastern District of Texas, captioned *ROY-G-BIV Corporation v. ABB, Ltd. et al.*, 6:11-cv-00622-LED (E.D. Tex.).

In this proceeding, Petitioner requested an *inter partes* review of claims 1-5 of U.S. Patent No. 6,513,058 B2 (Ex. 1001, "the '058 patent").¹ Patent Owner filed a Preliminary Response. Paper 22. The Board granted the Petition and instituted trial for claims 1-5. Paper 24. Although several grounds were proposed by Petitioner, the Board instituted trial on a single ground: obviousness over the combination of the Gertz, Stewart, and Morrow references discussed below.

During trial, Patent Owner filed a Response ("PO Resp.") addressing the obviousness challenge, accompanied by an expert declaration from David B. Stewart, Ph.D. (Ex. 2013), author of the Stewart thesis relied upon by Petitioner. Paper 27. Petitioner filed a Reply ("Pet. Reply") and, for the first time in this proceeding, presented expert testimony, namely,

¹ Initially Patent Owner filed an incorrect petition. Paper 4. A corrected petition ("Pet.") was submitted as Exhibit 1032 to Petitioner's motion to correct (Paper 8), which motion was granted by the Board. Paper 21. The references in this decision are to the corrected petition, Ex. 1032 ("Pet.").

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declarations from Richard Voyles, Ph.D. (Ex. 1130), and Nikolaos Papanikolopoulos, Ph.D. (Ex. 1132). Paper 38.

Petitioner's experts, Drs. Voyles and Papanikolopoulos, worked in the same laboratory at Carnegie Mellon University as Dr. Stewart, and were presented by Petitioner to rebut Dr. Stewart's expert testimony. Patent Owner also has filed a Motion to Exclude Evidence (Paper 45) and a Motion to Submit Supplemental Information (Paper 63). An oral hearing was held on February 27, 2014. A transcript of the hearing is included in the record as Paper 70 ("Transcript"). This Final Decision will refer to the Final Decision in IPR2013-00062 ("the '062 Decision") and will, in places, rely on the Board's analysis therein.

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). For the reasons discussed below, we determine that Petitioner has not met its burden to prove by a preponderance of the evidence that claims 1-5 of the '058 patent are unpatentable.

B. The '058 Patent

The technology of the '058 patent is the same as that described in our '062 Decision at pages 3-4. The patent at issue there, U.S. Patent 6,516,236 ("the '236 patent"), is related to the '058 patent.² For the purposes of this Decision, therefore, we rely upon that prior description in the '062 Decision.

 $^{^{2}}$ The '236 patent is a continuation of U.S. Patent Application No. 09/191,181 (now abandoned). The '058 patent is a continuation-in-part of the same application.

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C. Illustrative Claim

Claim 1 is reproduced below, with emphasis added:

1. A system for allowing an application program to communicate with any one of a group of supported hardware devices, the system comprising:

- a software system operating on at least one workstation, the software system comprising
 - at least one application program comprising a set of *component functions* defining a desired motion sequence, the desired motion sequence being comprised of primitive operations that are necessary to define the desired motion sequence and non-primitive operations that may be simulated using a combination of primitive operations,
 - a core set of core driver functions, where each core driver function is associated with one of the primitive operations,
 - an extended set of extended driver functions, where each extended driver functions is associated with one of the non-primitive operations,
 - component code associated with each of the component functions, where the component code associates at least some of the component functions with at least some of the driver functions,
 - a set of software drivers, where each software driver is associated with one of the hardware devices and comprises driver code for implementing the driver functions, and
 - a control command generating module for generating control commands based on the component functions of the application program, the component code associated with the component functions, and the driver code associated with the software drivers; and

a network communication protocol that allows the control commands to be communicated from the control command generating module on the at least one workstation to at least one of the supported hardware devices over a network.

D. The Prior Art References Relied On By Petitioner

The following table identifies the Gertz, Stewart, and Morrow

references referred to above:

Gertz	Matthew Wayne Gertz, A Visual Programming Environment for Real-Time Control Systems (Ph.D. dissertation, Carnegie Mellon University)	Nov. 22, 1994	Ex. 1002
Stewart	David Bernard Stewart, <i>Real-Time Software</i> Design and Analysis of Reconfigurable Multi- Sensor Based Systems (Ph.D. dissertation, Carnegie Mellon University)	Apr. 1, 1994	Ex. 1004
Morrow	J. Dan Morrow, Bradley J. Nelson, & Pradeep Khosla, Vision and Force Driven Sensorimotor Primitives for Robotic Assembly Skills, INST. FOR SOFTWARE RES., paper 574	Jan. 1, 1995	Ex. 1005

II. DISCUSSION

A. Antedating Gertz and Morrow

1. Background

As in IPR2013-00062 and IPR2013-00074, Patent Owner contends that the claimed invention of the '058 patent was conceived prior to November 22, 1994, before the earliest date of publication alleged for Gertz and Morrow, and constructively reduced to practice on May 30, 1995, the filing date of the "priority application" (serial no. 08/454,736) that led to the '058 patent. PO Resp. 6-12. Patent Owner further contends that the inventors were reasonably diligent from November 21, 1994, to the date of

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