

Filed on behalf of: Versata Development Group, Inc.

Paper \_\_\_\_\_

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAP AMERICA, INC. ET AL.  
Petitioner

v.

VERSATA DEVELOPMENT GROUP, INC.  
Patent Owner

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Case CBM2012-00001 (MPT)  
Patent 6,553,350

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**PATENT OWNER VERSATA'S LIST OF PROPOSED MOTIONS**

1 MAIL STOP PATENT BOARD  
2 Patent Trial and Appeal Board  
3 U.S. Patent & Trademark Office  
4 P.O. Box 1450  
5 Alexandria, VA 22313-1450  
6

7 Pursuant to Decision – Institution of Covered Business Method Review (37  
8 *C.F.R.* § 42.208) dated January 9, 2013 (“Decision”) and in accordance with 77  
9 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012), Patent Owner Versata Development  
10 Group, Inc. (“Versata”) hereby files and serves the following list of proposed  
11 motions:

12 1. **Motion Under 37 C.F.R. § 42.51(b)(2) for Additional Discovery**

13 Versata seeks authorization to file a motion under 37 C.F.R. § 42.51(b)(2)  
14 for additional discovery establishing good cause why the requested additional  
15 discovery is needed (37 C.F.R. § 42.224(a)) and that the discovery is limited to  
16 evidence directly related to factual assertions advanced by SAP in the proceeding  
17 (37 C.F.R. § 42.224(b)). Specifically, Versata seeks authorization to conduct the  
18 following discovery from SAP:

19 (1) Provide copies or make available for inspection and copying  
20 documents, electronically stored information and things (including the documents,  
21 ESI and things produced by SAP in the ‘350 infringement case) directly relating to  
22 (i) SAP’s factual assertions as to the alleged meaning of the following language of  
23 claims 17 and 26-29 of the ‘350 patent: (1) sorting the pricing information, (2) the

1 pricing information that is less restrictive, (3) pricing types and pricing  
2 adjustments, and (4) pricing information; (ii) SAP's factual assertions as to the  
3 alleged unpatentability of claims 17 and 26-29 of the '350 patent under 35 U.S.C. §  
4 101; and (iii) SAP's factual assertions as to the alleged unpatentability of claims  
5 17 and 26-29 of the '350 patent under 35 U.S.C. § 102, including: (a) SAP R/3  
6 2.2A Online Documentation CD; and (b) SAP R/3 2.2B Online Documentation  
7 CD.

8 (2) Identify and make available for deposition those individuals  
9 (including fact and expert witnesses involved in the '350 patent infringement case)  
10 with specific knowledge directly relating to (i) SAP's factual assertions as to the  
11 alleged meaning of the following language of claims 17 and 26-29 of the '350  
12 patent: (1) sorting the pricing information, (2) the pricing information that is less  
13 restrictive, (3) pricing types and pricing adjustments, and (4) pricing information;  
14 (ii) SAP's factual assertions as to the alleged unpatentability of claims 17 and 26-  
15 29 of the '350 patent under 35 U.S.C. § 101; and (iii) SAP's factual assertions as  
16 to the alleged unpatentability of claims 17 and 26-29 of the '350 patent under 35  
17 U.S.C. § 102, including: (a) SAP R/3 2.2A Online Documentation CD; and (b)  
18 SAP R/3 2.2B Online Documentation CD.

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1           2.     **Contingent Motion Under 37 C.F.R. § 42.221 to Amend**

2           Versata may move to amend one or more of the involved claims of the '350  
3 patent, and will request entry of the claim amendments contingent upon the PTAB  
4 issuing a final decision maintaining the claim construction set forth in the  
5 Decision. Any such claim amendments will be made to respond to one or more of  
6 the grounds of unpatentability involved in the trial, and will not enlarge the scope  
7 of the claims of the '350 patent (37 C.F.R. § 42.221(a)(2)(i)) or introduce new  
8 matter (37 C.F.R. § 42.221(a)(2)(ii)). Specifically, such claim amendments may be  
9 directed to the terms "pricing types," "pricing adjustments," "pricing information"  
10 and "denormalized numbers," the meaning of which was addressed by the PTAB  
11 in the Decision at 11-17.

12   Respectfully submitted,

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15     Date: February 1, 2013

15           By:     */s/ Martin M. Zoltick*  
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24  
25   ***Attorneys for Patent Owner Versata***  
26   ***Development Group, Inc.***

**CERTIFICATE OF SERVICE**

I hereby certify that on this 1st day of February, 2013, a true and correct copy of the foregoing PATENT OWNER VERSATA'S LIST OF PROPOSED MOTIONS, was served, in accordance with the parties' electronic service agreement, by electronic mail upon the following lead and backup counsel of record for Petitioners SAP America, Inc. and SAP AG:

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*/s/ Erik van Leeuwen* \_\_\_\_\_

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