

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.
Petitioner,

v.

VERSATA DEVELOPMENT GROUP, INC.
Patent Owner.

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

Before SALLY C. MEDLEY, MICHAEL P. TIERNEY, and RAMA G. ELLURU,
Administrative Patent Judges.

TIERNEY, *Lead Administrative Patent Judge.*

DECISION
Conduct of the Proceeding
37 C.F.R. § 42.5

A conference call was held on February 5, 2013, at approximately 2:00 p.m.

involving:

1. Erika Arner and Joseph Palys, counsel for SAP
2. Martin Zoltick and Danny Huntington, counsel for Versata,
3. Michael Tierney, Sally Medley and Rama Elluru, Administrative Patent Judges.

A court reporter was present on the call.¹ The purpose of the call was to discuss the Schedule (Paper 37) and the parties' lists of motions (Papers 38 and 39).

The parties and the Board discussed the times set forth in the Schedule to determine whether the Schedule should be expedited. Specifically, petitioner requested that the Board expedite the times set forth in the Schedule as petitioner takes the position that the 35 U.S.C § 101 issue is a threshold legal issue in the case that can be resolved more quickly than the current Schedule envisions and that no further briefing would be required on the part of the petitioner.

Patent owner opposed petitioner's request. According to the patent owner, an expedited schedule would be premature because there are outstanding claim construction issues that could affect resolution of the § 101 issues. Patent owner indicated that an expedited schedule may be prejudicial to the patent owner.

¹ This Order summarizes statements made during the conference call. A more complete record may be found in the transcript, which is to be filed by Versata as an exhibit.

In order to better understand the parties' positions on expediting the times set forth in the Schedule, the Board ordered Petitioner to file a five (5) page brief by close of business on Wednesday, February 6, 2013, on three issues:

(1) petitioner's position as to why an expedited schedule of times on the § 101 ground of unpatentability was appropriate; (2) petitioner's position as to how the Board should handle the asserted ground of unpatentability pursuant to 35 U.S.C. § 102; and (3) how petitioner's proposed expedited schedule provided time for:

- Patent Owner to cross-examine Petitioner's expert Dr. Siegel, who provided a declaration in support of the Petition,
- Patent Owner to cross-examine Dr. Boyd, who provided testimony in the district court litigation on patentability issues, if the Board authorizes such discovery,
- Patent Owner Response and Motion to Amend Claims,
- Petitioner's Reply to Patent Owner Response and Opposition to Amendment,
- Patent Owner Reply to Opposition to Amendment, and
- Oral Hearing.

The Board further ordered the patent owner to file a five (5) page opposition by close of business on Friday, February 8, 2013, including patent owner's proposed schedule if it opposes petitioner's proposal.

Case CBM2012-00001
Patent 6,553,350

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