

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 JONI Y. CHANG,
Administrative Patent Judges.

TIERNEY, *Lead Administrative Patent Judge.*

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

Petitioner (“SAP”) has filed a motion requesting that the Board exercise its discretion and expedite consideration of the patentability of claims 17 and 26-29 of Versata’s U.S. Patent No. 6,553,350 (‘350) under 35 U.S.C. § 101. Mot., Paper 40 at 1. Versata opposes this request. Opp., Paper 42.

SAP contends that consideration of patentability under § 101 should be expedited as early resolution of this dispositive issue helps further the Board’s goal of establishing a more efficient and streamlined patent system by significantly reducing the proceeding’s pendency and avoiding unnecessary discovery and briefing costs. Mot. 1-2. According to SAP, the § 101 issue is a legal issue that would resolve the patentability of the instituted claims, claims 17 and 26-29. *Id.* at 2. SAP states however, that should the claims ultimately be held patentable under § 101, the proceeding would then continue on to a final determination on the remaining instituted ground of patentability under § 102. *Id.* at 5.

Versata opposes SAP’s request alleging that SAP failed to provide a sufficient explanation as to why expedited treatment of the § 101 issue was warranted. Opp. 1. Versata notes that SAP has failed to demonstrate any meaningful savings of resources as SAP proposes and states that bifurcating the § 101 and § 102 issues is unwarranted due to the potential for increased costs and delay.

The Board agrees with SAP that resolution of the § 101 issue could serve a key purpose of the America Invents Act and help lead to an early disposition of the proceeding. The Board however, also agrees with Versata that bifurcating the § 101 and § 102 issues has the potential to increase costs and delay should the claims be held patentable under § 101. SAP however, has agreed to withdraw the instituted grounds of unpatentability under § 102 should the Board order an expedited schedule. Reply, Paper 44. In light of SAP's agreement to withdraw the § 102 issue, we enter SAP requested expedited schedule as follows:

DUE DATE 1	March 8, 2013
DUE DATE 2	March 29, 2013
DUE DATE 3	April 5, 2013
DUE DATES 4-6	Not provided for (conference call if needed)
DUE DATE 7	April 17, 2013

A hearing (Due Date 7) is scheduled for **2:00 pm** Eastern Time on **April 17, 2013** on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia.

Please note that the oral argument will be open to the public. Information about public attendance is available at:

http://tampa-wip.uspto.gov/ip/boards/public_hearing_info.jsp

Five (5) spaces have been reserved for each party. If a party desires to have more than five people in attendance, the party should immediately notify the Board of the total number that they wish to have attend.

Each party will have up to **sixty minutes** total to present its arguments.

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The Board will provide a stenographer for the oral argument. Consequently, the parties shall not provide their own stenographer. Unless otherwise ordered, the transcript will become part of the record and is not open to correction after the oral argument.

It is:

Ordered that the 35 U.S.C. §102 instituted grounds are withdrawn from this trial.

Further Ordered that the times for taking action are reset as provided in this Order above, and a hearing is scheduled for **April 17, 2013 at 2 pm.**

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PETITIONER:

Erika.arnner@finnegan.com
CPdocketkiklis@oblon.com

PATENT OWNER:

nlinck@rfem.com
VERSATA-PGR@rfem.com