

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SAP AMERICA INC. AND SAP AG,  
Petitioners,

v.

VERSATA DEVELOPMENT GROUP INC.,  
Patent Owner.

---

Case CBM2012-00001  
Patent 6,553,350

---

Before the honorable MICHAEL P. TIERNEY, SALLY C. MEDLEY and RAMA  
G. ELLURU.

**PETITIONER'S OPPOSITION TO PATENT OWNER'S  
REQUEST FOR REHEARING**

## TABLE OF CONTENTS

I.	Statement of Relief Requested.....	1
II.	Preliminary Statement.....	1
III.	Requested Additional Briefing .....	2
A.	The '350 claims remain unpatentable under 35 U.S.C. § 101 after <i>Ultramercial</i> .....	2
1.	<i>Ultramercial</i> reaffirmed the section 101 framework applied by the Board .....	2
2.	The Board was correct that the '350 claims cover an abstract idea—determining a price using organizational and product group hierarchies—and the <i>Ultramercial</i> decision did nothing to change this conclusion .....	3
3.	The Board’s conclusion that the claims are not drawn to a patentable application of the underlying abstract idea remains correct after <i>Ultramercial</i> .....	5
4.	Several other factors distinguish the Board’s final decision from the district court decision reversed in <i>Ultramercial</i> .....	8
B.	The Federal Circuit’s decision in <i>Versata Software Inc. v. SAP America Inc.</i> , 106 USPQ2d 1649 (Fed. Cir. 2013) has no effect on the PGR proceeding.....	11
1.	The Federal Circuit appeal remains active.....	12
2.	Even if the Federal Circuit mandate were to issue based on the May 1 opinion, there would be no final judgment in the litigation .....	13
3.	Versata waived any claim and issue preclusion defense .....	14
IV.	Conclusion .....	15

## TABLE OF AUTHORITIES

	<b>Page(s)</b>
<b>FEDERAL CASES</b>	
<i>Bilski v. Kappos</i> , 130 S. Ct. 3218 (2010).....	2, 3, 5
<i>CyberSource Corp. v. Retail Decisions, Inc.</i> , 654 F.3d 1366 (Fed. Cir. 2011).....	4, 9
<i>Dealertrack, Inc. v. Huber</i> , 674 F.3d 1315 (Fed. Cir. 2012).....	9
<i>Diamond v. Diehr</i> , 450 U.S. 175 (1981).....	2, 3
<i>Fresenius USA, Inc. et al. v. Baxter International</i> , No. 2012-1334, -1335, slip op. (Fed. Cir. July 2, 2013).....	12
<i>Gottschalk v. Benson</i> , 409 U.S. 63 (1972).....	2, 3, 5
<i>In re Alappat</i> , 33 F.3d 1526 (Fed. Cir. 1994).....	9
<i>Mayo v. Prometheus</i> , 132 S. Ct. 1289 (2012).....	2, 7, 8
<i>Miller Brewing Co. v. Jos. Schlitz Brewing Co.</i> , 605 F.2d 990 (7th Cir. 1979).....	13
<i>Parker v. Flook</i> , 437 U.S. 584 (1978).....	3, 7
<i>Research Corp. Techs. v. Microsoft Corp.</i> , 627 F.3d 859 (Fed. Cir. 2010).....	9
<i>Ultramercial, Inc. v. Hulu, LLC</i> , 107 USPQ2d 1193 (Fed. Cir. 2013).....	passim
<i>Vardon Golf Co., Inc. v. Karsten Mfg. Corp.</i> , 294 F.3d 1330 (Fed. Cir. 2002).....	13

*Versata Software Inc. v. SAP America Inc.*,  
106 USPQ2d 1649 (Fed. Cir. 2013) ..... 1, 11

**FEDERAL STATUTES**

35 U.S.C. § 101 ..... passim

35 U.S.C. § 326(e)..... 11

**RULES**

Fed. R. App. P. 41 ..... 13

## **LIST OF EXHIBITS**

- Exhibit 1037: Federal Circuit Letter Dated July 15, 2013 Requesting Response from Versata to SAP En Banc Petition
- Exhibit 1038: *Versata Software, Inc. et al. v. SAP America, Inc. et al.*, Federal Circuit Appeals 2012-1029, -1049, Slip Op. dated May 1, 2013
- Exhibit 1039: *FreseniusUSA, Inc. et al. v. Baxter International, Inc. et al.*, Federal Circuit Appeals 2012-1334, -1335, Slip Op. dated July 2, 2013

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.