

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAP AMERICA INC. AND SAP AG,  
Petitioners,

v.

VERSATA DEVELOPMENT GROUP INC.,  
Patent Owner.

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Case CBM2012-00001  
Patent 6,553,350

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

**PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION FOR ADMISSION  
PRO HAC VICE OF SCOTT L. COLE**

Petitioners SAP America Inc. and SAP AG (collectively "SAP") oppose the request of Patent Owner Versata ("Versata") to have its lead trial counsel, Scott L. Cole, appear in this proceeding [Paper No. 12] ("Versata's Motion"). Having Versata's trial counsel participate in this proceeding would severely prejudice SAP because Mr. Cole has accessed, and has ongoing access to, SAP confidential information in the underlying district court litigation involving the patent-at-issue. Thus, it would be improper to allow Mr. Cole to participate in the prosecution activities of this proceeding, which allows Versata to amend its claims, with the knowledge he has of SAP products accused of infringement. Even though Mr. Cole would undoubtedly conduct himself with the best of intentions, given his exposure to SAP's confidential

information, that bell cannot be “un-rung.” Accordingly, SAP requests that the Board deny Versata’s Motion.

**I. Pro Hac Vice Admission to Appear Before the Board is Discretionary and Subject to Any Conditions Set Forth by the Board**

37 C.F.R. § 42.10(c) allows for *pro hac vice* representation before the Board upon a showing of “good cause.” The grant of a motion to appear *pro hac vice* is a “discretionary action taking into account the specifics of the proceeding.” 77 Fed. Reg. 48618 (August 14, 2012). Indeed, admission is subject to “any other conditions as the Board may impose.” *Id.* The specifics of this proceeding warrant the Board’s consideration of “other conditions” to deny Versata’s motion.

**II. Mr. Cole’s Access to SAP’s Confidential Information in the Underlying Litigation Should Preclude Him from Participating in the Prosecution Activities of this Proceeding**

In the district court litigation involving the patent-at-issue (“the ’350 patent”), *Versata Software, Inc. v. SAP America, Inc.*, No. 2:07-cv-153 (E.D. Tex), trial counsel for Versata gained access to highly confidential and proprietary information about SAP and its products. Use of this information in that case is governed by a Protective Order. As lead trial counsel, Mr. Cole has had access, and still has access, to SAP’s protected materials. In fact, Versata relies on Mr. Cole’s knowledge of the underlying litigation, which involved alleged infringement of the patent, to support its showing of good cause in its motion. (Versata’s Motion at 3.)

Mr. Cole’s participation in both proceedings puts him in the precarious position of being able to affect the scope of the claims of the ’350 patent while knowing how SAP’s products operate beyond that publically known. The statute and Board rules provide Versata the ability to amend the claims of the ’350 patent during this CBM proceeding. 35 U.S.C. § 326(a)(9);

37 C.F.R. § 42.221. Indeed, the Patent Office recognizes that “it is expected that amendments to a patent will be sought.” 77 Fed. Reg. 48618 (August 14, 2012).

District courts have recognized concerns regarding trial counsel’s involvement in Patent Office proceedings that allow the patent owner to amend its claims. For example, in *Bear Creek Technologies Inc. v. Verizon Services Corp.*, 2012 WL 3190762 at \*2 (D.Del. 2012), the court recognized that “strategically amending or surrendering claim scope during prosecution” implicates competitive decision-making that can necessitate the denial of lead trial counsel’s participation in reexamination proceedings. SAP shares these concerns in this situation.

Allowing Mr. Cole to participate in the patent prosecution activities of this proceeding would severely prejudice SAP because Mr. Cole will have the ability to provide advice on any amendments to the claims of Versata’s patent. Moreover, allowing Mr. Cole to participate in this proceeding could effectively circumvent the restrictions of the underlying district court’s protective order, which precludes litigation counsel’s use of any SAP protected materials beyond the scope of that litigation.

**III. Conclusion**

Given Mr. Cole's role in the district court litigation and his potential involvement in the prosecution activities in this proceeding, SAP asks the Board to deny Versata's Motion.

Respectfully submitted,

Dated: October 30, 2012

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**CERTIFICATE OF SERVICE**

The undersigned certifies that the foregoing PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION FOR ADMISSION *PRO HAC VICE* OF SCOTT L. COLE was served on October 30, 2012, to Nancy J. Linck and Martin M. Zoltick, Lead and Back-up Counsel for Versata, respectively, at the service e-mail address of VERSATA-PGR@rfem.com provided in Versata's Mandatory Notices. The parties have agreed to electronic service.

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/Larry White/  
Larry White

**FINNEGAN, HENDERSON,  
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L.L.P.**