

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLUSION, INC.
Petitioner

v.

VERSATA DEVELOPMENT
GROUP, INC.
Patent Owner

AND

VERSATA SOFTWARE, INC.
Real Party-In-Interest

Case CBM2013-00017
Patent 6,834,282)

**VERSATA'S PATENT OWNER'S RESPONSE
PURSUANT TO 37 C.F.R. § 42.220**

TABLE OF CONTENTS

I. INTRODUCTION 1

II. SIMPLIFICATION OF ISSUES; MOTION TO AMEND 1

III. PETITIONER'S BURDEN 2

IV. U.S. PATENT 6,834,282..... 2

 A. Overview 2

 B. Claim Construction..... 8

 1. Hierarchy 8

 C. Status of Claims..... 11

 1. Patent Owner Has (Separately) Filed Motion to Amend to Address Issue Raised *Sua Sponte* by the Board; Accordingly Claims 1-10 Are Not Separately Argued Here 11

 2. Statutory Process Claims 11-20 are Argued Here; Amendments are (Separately and Contingently) Sought in Motion to Amend 12

V. PETITION DOES NOT ESTABLISH THAT CLAIMS ARE UNPATENTABLY ABSTRACT 12

 A. Petitioner Has Developed No Factual Record that Would Support a Conclusion that Claims Are Unpatentably Abstract..... 12

 B. The Claims Do Not "Preempt" any Abstract Idea 15

 1. Claim 11 Recites a Statutory Process, Not an Abstract Idea 17

 2. Claim 13, 14 and 15 Recite Statutory Processes, Not Abstract Ideas..... 25

 3. Claim 16 Recites a Statutory Process, Not an Abstract Idea 28

 C. Method Claims Are Incapable of being Performed in the Human Mind or Using Pen and Paper 29

VI. CONCLUSION 31

TABLE OF AUTHORITIES

Cases

In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359 (Fed. Cir. 2004).....3
In re Nuijten, 500 F.3d 1346 (Fed. Cir. 2007)11
Mayo Collaborative Servs. v. Prometheus Labs., Inc., 132 S.Ct. 1289 (2012)13, 15,
16
Research Corp. Techs. v. Microsoft Corp., 627 F.3d 868 (Fed. Cir. 2010) 13, 16
SiRF Tech., Inc. v. ITC, 601 F.3d 1319 (Fed. Cir. 2010) 13, 17
Ultramercial, Inc. v. Hulu, LLC, 722 F.3d 1335 (Fed. Cir. 2013) . 13, 14, 15, 16, 17

Statutes

35 U.S.C. § 326(e) 2, 14
35 U.S.C. §1011

Rules

37 CFR § 42.1(b)11
37 CFR § 42.1(d)2
37 CFR § 42.220(a).....17

I. INTRODUCTION

The claims of U.S. Patent 6,834,282 (“the ’282 Patent”) recite patent eligible subject matter. Claims 1-20 are in issue in the present Covered Business Method Patent Review. In its Petition, Petitioner alleged that claims 1-23 were directed to an unpatentable abstract idea. The Board denied institution as to claims 21-23; however, it did institute trial as to claims 1-20, solely on grounds under 35 U.S.C. § 101.¹ This Response, together with a Motion to Amend filed herewith, address all grounds on which the trial has been instituted.

II. SIMPLIFICATION OF ISSUES; MOTION TO AMEND

In addition to the present Response, Patent Owner files herewith a Motion to Amend. In that Motion to Amend, Patent Owner proposes four (4) substitute claims 24-28 for respective, individual ones of the first ten (10) claims of the ’282 Patent. In addition, and contingent upon a Board determination that original claim 11-13, 15 or 16 of the ’282 is invalid on § 101 grounds, proposes one-for-one

¹ In its Preliminary Response (Paper No. 6), Patent Owner argued that Section 101 is not a "condition of patentability" as required by 35 U.S.C. §§ 321(b) and 282(b) and Part II of Title 35 U.S.C., and therefore cannot serve as a basis for review under the Transitional Program for Covered Business Method Patent Review. Patent Owner maintains its earlier position and reserves the right to raise this issue in any later appeal or related proceeding.

substitute claims 29-33. Specifically, substitute claim 29 is contingent on adverse decision as to claim 11; claim 30 as to claim 12; claim 31 as to claim 13; claim 32 as to claim 15; and claim 33 as to claim 16. Patent Owner's Motion to Amend is (1) filed after conferring with the Board and no later than the filing of this Response, (2) responsive to the sole ground of unpatentability (§ 101) authorized in this proceeding, (3) does not seek to enlarge the scope of the claims of the patent or introduce new subject matter and (4) proposes a reasonable number of one-for-one substitutes.

III. PETITIONER'S BURDEN

35 U.S.C. § 326(e) states “[i]n a post-grant review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.” *See also* 37 CFR § 42.1(d).

IV. U.S. PATENT 6,834,282

A. Overview

The '282 Patent describes computational system mechanisms that allow a computer system, *e.g.*, a webserver and related information systems, to define in a flexible, expressive and (most importantly) operative way, an ***organization that is computationally imposed*** upon data items that are ***stored in a database*** so as to facilitate presentation to users, *e.g.*, to human users browsing content served by a website, of content sourced from relevant subsets of the ***items in the database*** in

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