

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLUSION, INC.
Petitioner

v.

VERSATA SOFTWARE, INC. AND
VERSATA DEVELOPMENT GROUP, INC.
Patent Owner

Case CBM2013-00017
U.S. Patent No. 6,834,282 B1

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and
KEVIN F. TURNER, *Administrative Patent Judges*.

PETITIONER VOLUSION, INC.'S
OPPOSITION TO
PATENT OWNER'S MOTION TO AMEND

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Other Authorities

35 U.S.C. § 1012, 8

37 C.F.R. § 42.20 passim

37 C.F.R. § 42.2213, 4

37 CFR § 42.713

LIST OF EXHIBITS

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|---------------|---|
| Exhibit 1016: | Transcript of the March 10, 2014 Deposition of Scott Nettles |
| Exhibit 1017: | Declaration of Philip Greenspun in Support of Petitioner's Reply to Patent Owner Response |
| Exhibit 1018: | Declaration of Philip Greenspun in Support of Petitioner's Opposition to Motion to Amend |
| Exhibit 1019: | Plaintiffs' Proposed Claim Constructions, <i>Versata Software, Inc., et al. v. Volusion, Inc.</i> , Civil Action No. 1:12-cv-893-SS (W.D. Tex.), served June 17, 2013 |
| Exhibit 1020: | Greenspun Demonstrative A |
| Exhibit 1021: | Greenspun Demonstrative B |
| Exhibit 1022: | Greenspun Demonstrative C |
| Exhibit 1023: | Curriculum Vitae of Philip Greenspun |

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I. INTRODUCTION

Patent Owner's Motion to Amend is fatally deficient. Most notably, Patent Owner's Motion is deficient because it fails to comply with the statutory and regulatory requirements for motions to amend and the Board's explicit Order in Paper No. 19 in this proceeding. That Order made clear that to carry its burden of proof, Patent Owner was required to provide arguments and explanations of why the proposed amended claims are patentable over the prior art. Patent Owner not only provided no such argument or explanation, it told the Board it refused to do so. The Motion to Amend should be denied for this reason alone.

Further, Patent Owner fails to provide any meaningful analysis of how the cited portions of the original disclosure support the proposed claims or why the proposed amendments are responsive to the instituted grounds. Again, both are clearly required by the Rules. Moreover, in attempting to amend the claims of the '282 Patent, Patent Owner fails to provide even a single proposed construction for critical new claim terms, thus failing to provide the Board with adequate information to determine whether the Patent Owner has demonstrated patentability. Consequently, Patent Owner fails to carry its burden of demonstrating patentability as required by 37 C.F.R. § 42.20(c).

Finally, even if Patent Owner had met all of the requirements necessary to amend the claims of the '282 Patent (which it clearly has not), the claim

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