

Paper No. \_\_\_\_\_

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VOLUSION, INC.  
Petitioner

v.

VERSATA DEVELOPMENT  
GROUP, INC.  
Patent Owner

AND

VERSATA SOFTWARE, INC.  
Real Party-In-Interest

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Case CBM2013-00017  
Patent 6,834,282

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**PATENT OWNER'S MOTION FOR OBSERVATION REGARDING CROSS-  
EXAMINATION OF PHILIP GREENSPUN**

Pursuant to the Board's Order – Conduct of the Proceedings issued April 25, 2014 (Paper 36), Patent Owner submits the following Motion for Observation Regarding Cross-Examination of Philip Greenspun, Petitioner's reply witness. The Declaration of Philip Greenspun, Ph.D. In Support of Volusion's Reply to Patent Owner Response (Under 37 C.F.R. § 1.68) was previously filed as Exhibit 1017. The transcript of Dr. Greenspun's deposition was previously filed as Exhibit 2009. Citations to Exhibit 2009 are provided in page:line format.

**Observation 1:** In Exhibit 2009, at 116:7-20, Dr. Greenspun testified that claim 11 would not preempt all practical implementations of the Board's abstract idea. This testimony is relevant because it confirms Dr. Nettles' conclusions in at least paragraph 35 of Exhibit 2003. This testimony is also relevant because it contradicts the Board's statements in the Institution Decision at least at page 15. This testimony is also relevant because it supports the Patent Owner's argument that claim 11 is statutory subject matter. See *e.g.*, Patent Owner's Response, p. 17.

**Observation 2:** In Exhibit 2009, at 95:15-96:1, Dr. Greenspun testified that none of the embodiments explicitly taught by the '282 Patent Specification would not use a computer. This testimony is relevant because it supports Patent Owner's conclusion that the method claims are incapable of being performed in the human mind or using pen and paper. See, *e.g.*, Patent Owner Response at 29. This testimony is also relevant because it contradicts Petitioner's position that claims 11-20 could be done by an individual with a pen and paper.

Petition at 24. This testimony is also relevant because, prior to the cited portion, he testifies that "browsing," as used in the '282 Patent, is broad enough to include browsing without a computer, for example, in Exhibit 2009 at 95:4-9. Thus, his testimony is internally inconsistent.

**Observation 3:** In Exhibit 2009, at 14:7-18, Dr. Greenspun testified that his opinions that allege that certain claim elements of the '282 Patent would have been well-known, conventional, or routine would have been the same in 2001. This testimony is relevant to Petitioner's position that the submission of Dr. Greenspun's declaration complies with 37 C.F.R. § 42.23(b), and is also relevant to Petitioner's position and Dr. Greenspun's position that Exhibit 1017 is a proper rebuttal to Dr. Nettles' declaration. This testimony is also relevant to Patent Owner's position that the submission of Dr. Greenspun's declaration does not comply with 37 C.F.R. § 42.223.

**Observation 4:** In Exhibit 2009, at 56:22-57:1, Dr. Greenspun testified that his opinion of the qualifications of a person of ordinary skill in the art (Exh. 1017, ¶ 29) would not have been different had he drafted his declaration when the '282 Patent issued in 2004. This testimony is relevant to Petitioner's position that the submission of Dr. Greenspun's declaration complies with 37 C.F.R. § 42.23(b), and is also relevant to Petitioner's position and Dr. Greenspun's position that Exhibit 1017 is a proper rebuttal to Dr. Nettles' declaration. This testimony is also relevant to Patent Owner's position that the submission of Dr. Greenspun's declaration does not comply with 37 C.F.R. § 42.223.

**Observation 5:** In Exhibit 2009, at 103:16-105:19, Dr. Greenspun testified that his statement that “an implementation of the hierarchy described in the ‘282 patent on a computer would be a well-known, routine, and conventional use of a general purpose computer” (Exh. 1017, ¶ 66) would have been the same at the filing of the Petition. This testimony is relevant to Petitioner’s position that the submission of Dr. Greenspun’s declaration complies with 37 C.F.R. § 42.23(b), and is also relevant to Petitioner’s position and Dr. Greenspun’s position that Exhibit 1017 is a proper rebuttal to Dr. Nettles’ declaration. This testimony is also relevant to Patent Owner’s position that the submission of Dr. Greenspun’s declaration does not comply with 37 C.F.R. § 42.223.

**Observation 6:** In Exhibit 2009, at 114:25-115:8, Dr. Greenspun testified that his proposed abstract idea, articulated in paragraph 71 of his declaration (Exh. 1017, ¶ 71), would have been the same had he provided his opinion at the time of the Petition. This testimony is relevant to Petitioner’s position that the submission of Dr. Greenspun’s declaration complies with 37 C.F.R. § 42.23(b), and is also relevant to Petitioner’s position and Dr. Greenspun’s position that Exhibit 1017 is a proper rebuttal to Dr. Nettles’ declaration. This testimony is also relevant to Patent Owner’s position that the submission of Dr. Greenspun’s declaration does not comply with 37 C.F.R. § 42.223.

**Observation 7:** In Exhibit 2009, at 120:12-122:4, Dr. Greenspun testified that his opinion that claims 11 through 20 could be performed using a pen and paper (see Exh. 1017, ¶¶ 73-93) would have been the same had he provided his opinion at the time of the

Petition. This testimony is relevant to Petitioner's position that the submission of Dr. Greenspun's declaration complies with 37 C.F.R. § 42.23(b), and is also relevant to Petitioner's position and Dr. Greenspun's position that Exhibit 1017 is a proper rebuttal to Dr. Nettles' declaration. This testimony is also relevant to Patent Owner's position that the submission of Dr. Greenspun's declaration does not comply with 37 C.F.R. § 42.223.

**Observation 8:** In Exhibit 2009, at 126:11-127:1, Dr. Greenspun testified that his opinion regarding claim elements that would be well-known, routine, and conventional (see Exh. 1017, ¶¶ 73-93) would have been the same had he provided his opinion at the time of the Petition. This testimony is relevant to Petitioner's position that the submission of Dr. Greenspun's declaration complies with 37 C.F.R. § 42.23(b), and is also relevant to Petitioner's position and Dr. Greenspun's position that Exhibit 1017 is a proper rebuttal to Dr. Nettles' declaration. This testimony is also relevant to Patent Owner's position that the submission of Dr. Greenspun's declaration does not comply with 37 C.F.R. § 42.223.

**Observation 9:** In Exhibit 2009, at 128:4-129:8, Dr. Greenspun testified that his opinion regarding claim limitations that would be well-known, routine, and conventional (see Exh. 1017, ¶¶ 94-103) would have been the same had he provided his opinion at the time of the Petition. This testimony is relevant to Petitioner's position that the submission of Dr. Greenspun's declaration complies with 37 C.F.R. § 42.23(b), and is also relevant to Petitioner's position and Dr. Greenspun's position that Exhibit 1017 is a proper rebuttal to

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