

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

Pursuant to the Board's April 25, 2014 Order on the Conduct of the Proceeding, Paper 36, Petitioner submits the following Response to Patent Owner's Motion for Observation Regarding Cross-Examination of Philip Greenspun (Paper 40).

Response to Observation 1: In Observation 1, Patent Owner cited certain testimony of Dr. Greenspun regarding whether claim 11 would preempt all practical applications of the "Board's abstract idea" and thus contradicts the Institution Decision. Dr. Greenspun's testimony, however, does not contradict the Board's statements in the Institution Decision. Dr. Greenspun testified that any difference between his expression of the abstract idea and the Board's expression does not "affect[] the analysis that the claim is, at its essence, a claim on an abstract idea," Ex. 2009, 110:8-111:8. Dr. Greenspun testified that his expression of the abstract idea is a more specific expression of the broader abstract idea expressed by the Board. Ex. 2009, 110:8-112:15. Dr. Greenspun did not confirm Dr. Nettles' conclusions in Paragraph 35 of Ex. 2003 that (i) the "recited hierarchy is operative" and (ii) claims 11-20 include many specific details regarding the operational features provided by the hierarchy that allow for practical alternatives not embraced by claims 11-20." Dr. Greenspun repeatedly testified that the claimed hierarchy is not "operative" or "operational." Ex. 2009, 79:5-81:22, 92:17-93:18, 96:5-97:13. Dr. Greenspun's testimony does not support Patent

Owner's argument that claim 11 is statutory subject matter because as discussed above, Dr. Greenspun testified that any difference between his expression of the abstract idea and the Board's expression does not "affect[] the analysis that the claim is, at its essence, a claim on an abstract idea." Ex. 2009, 110:8-111:8.

Response to Observation 2: In Observation 2, Patent Owner cited certain testimony of Dr. Greenspun regarding whether the patent specification explicitly teaches embodiments that would not use a computer. However, the cited testimony of Dr. Greenspun indicates that the specification of the '282 Patent does not explicitly teach that the *preferred embodiments would* be practiced without a computer. Ex. 2009, 95:15-96:1. Dr. Greenspun's further testimony that the *claims* of the patent *could* be practiced without a computer, by a person using pen and paper are entirely consistent with the cited testimony and thus do not contradict Petitioner's position that the claims could be performed using a pen and paper. *See, e.g.,* Ex. 2009, 120:19-121:3; 157:9-160:7. For instance, Dr. Greenspun testified that creation of Figure 3, an embodiment in the specification, can be performed by a human using pen and paper. Ex. 2009, 157:9-160:7.

Response to Observations 3-11: In Observations 3-11, Patent Owner argues Dr. Greenspun's testimony that his opinions would have been the same between 2001 and the present is relevant to whether Dr. Greenspun's declaration is proper rebuttal evidence and in compliance with 37 C.F.R. §§ 42.23(b) and 42.223.

Petitioner objects to Observations 3-11 as improper and not compliant with the Board's rules on observations on cross-examination. Section L of the Office Patent Trial Practice Guide, regarding Observations on Cross-Examination, states that "An observation (or response) is not an opportunity to raise new issues, re-argue issues, or pursue objections." 77 Fed. Reg. 48755, 48768 (Aug. 14, 2012). Patent Owner is once again attempting to improperly pursue its objections to the submission of Dr. Greenspun's declaration. As such, these observations should be disregarded as improper and irrelevant. Further, Dr. Greenspun's declaration was prepared as rebuttal to Dr. Nettles' testimony, as demonstrated by his testimony that he was engaged only to respond to the opinions of Dr. Nettles. *See, e.g.*, Ex. 2009, 8:23-9:19.

Response to Observation 12: In Observation 12, Patent Owner cited certain testimony of Dr. Greenspun regarding whether claim 11 would preempt all practical applications of the "Board's abstract idea" and thus contradicts the Institution Decision. Dr. Greenspun's testimony, however, does not contradict the Board's statements in the Institution Decision. Dr. Greenspun testified that any difference between his expression of the abstract idea and the Board's expression does not "affect[] the analysis that the claim is, at its essence, a claim on an abstract idea." Ex. 2009, 110:8-111:8. Dr. Greenspun testified that his expression of the abstract idea is a more specific expression of the broader abstract idea

expressed by the Board. Ex. 2009, 110:8-112:15. Dr. Greenspun did not confirm Dr. Nettles' conclusions in Paragraph 35 of Ex. 2003 that (i) the "recited hierarchy is operative" and (ii) claims 11-20 include many specific details regarding the operational features provided by the hierarchy that allow for practical alternatives not embraced by claims 11-20." Dr. Greenspun repeatedly testified that the claimed hierarchy is not "operative" or "operational." Ex. 2009, 79:5-81:22; 92:17-93:18; 96:5-97:13. Dr. Greenspun's testimony does not support Patent Owner's argument that claim 11 is statutory subject matter because, as discussed above, Dr. Greenspun testified that any difference between his expression of the abstract idea and the Board's expression does not "affect[] the analysis that the claim is, at its essence, a claim on an abstract idea." Ex. 2009, 110:8-111:8.

Response to Observation 13: In Observation 13, Patent Owner cited certain testimony of Dr. Greenspun that his opinions would have been the same if he had used Dr. Nettles' proposed level of ordinary skill in the art. Dr. Greenspun testified that Dr. Nettles' proposed level of ordinary skill in the art is inadequate. Ex. 2009, 17:1-18:25. Dr. Greenspun's testimony that his opinions would have been the same if he had used Dr. Nettles' proposed level of ordinary skill in the art is not relevant to Dr. Greenspun's opinion that Dr. Nettles' proposed level of ordinary skill in the art is inadequate.

Response to Observation 14: In Observation 14, Patent Owner cited certain

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