

Filed on behalf of: Versata Software, Inc. and  
Versata Development Group, Inc.

Paper \_\_\_\_\_

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

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Case CBM2013-00017  
Patent 6,834,282

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Pursuant to 37 C.F.R. § 42.207(a), Patent Owner, Versata Software, Inc. and Versata Development Group, Inc. (collectively “Versata”), submit this Preliminary Response to the Petition for Post-Grant Review of U.S. Patent No. 6,834,282 (“’282 patent”) filed by Volusion, Inc. (“Volusion”).

**I. STATEMENT OF THE PRECISE RELIEF REQUESTED**

The Board should deny Volusion’s petition and not institute the requested covered business method review for three independent reasons.

*First*, Petitioner has failed to show, pursuant to 37 CFR §§ 42.301 and 42.304(a), that the ‘282 patent meets the definition of a covered business method patent. The ‘282 patent claims are directed to a technological invention, not a method or corresponding apparatus used in the practice, administration or management of a financial product or service, and Petitioner has failed to meet its burden of showing otherwise. Pet. 11-17. *See* Section II(A) below.

*Second*, the sole basis for Petitioner’s challenge is that the claims are not patent eligible under 35 U.S.C. § 101. Pet. 21-31. But § 101 is not a ground “specified” in Part II of Title 35 as a “condition of patentability,” as required by § 321(b), and, thus, it is not a permitted ground for instituting a covered business method review under 35 U.S.C. § 321(b). The only conditions of patentability *specified* in Part II are those found in §§ 102 and 103. *See* the express language of Part II, Title 35 U.S.C. *See* Section II(B) below.

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