

No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CALLIDUS SOFTWARE INC.
Petitioner

v.

VERSATA DEVELOPMENT
GROUP, INC.
Patent Owner

AND

VERSATA SOFTWARE, INC.
Real Party-In-Interest

Case CBM2013-00053
Patent 7,958,024

Title: METHOD AND APPARATUS FOR PROCESSING SALES
TRANSACTION DATA

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UNDER 37 C.F.R. § 42.207**

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I. Introduction

Patent Owner Versata Development Group, Inc. (“Versata” or “Patent Owner”) submits the following Preliminary Response to the Corrected Petition filed by Callidus Software Inc. (“Callidus” or “Petitioner”) on September 17, 2013, requesting post-grant review of Claims 1, 2, and 35-47 of U.S. Patent No. 7,958,024 (“the ’024 Patent”) under § 18 of the America Invents Act’s transitional program for covered business method patent review. Versata respectfully requests that the Patent Trial and Appeal Board (“Board” or “PTAB”) decline to institute post-grant review of the ’024 Patent because Callidus is statutorily barred from seeking post-grant review.

Pursuant to 35 U.S.C. § 325(a)(1), a post-grant review proceeding cannot be instituted where the petitioner, prior to the filing of a petition for post-grant review, filed a civil action challenging the validity of a claim of the patent. Over 10 months before filing its Petition for post-grant review, Callidus filed a civil action in the Northern District of California seeking a declaratory judgment of invalidity of the claims of the ’024 Patent. As a result, a post-grant review proceeding cannot be instituted.

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