

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY
Petitioner

v.

VERSATA DEVELOPMENT GROUP, INC.
Patent Owner

Case CBM2016-00100
Patent No. 8,805,825

VERSATA'S SUR-REPLY TO FORD'S PRELIMINARY REPLY

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Despite originally only arguing that the '825 patent claims are “incidental or complementary” to a financial product or service, Ford provides additional briefing in an attempt to recast the claimed use of “attributes” as finance-related activity. But Ford’s arguments still fail, by placing undue significance on an example embodiment of the claimed “attributes,” and seeking broad applicability of CBM review based only on cases that existed prior to *Unwired Planet* while ignoring post-*Unwired Planet* decisions.

Ford argues that the recitation of an “attribute” and “prioritizing the valid configuration answers by one or more of the plurality of attributes” in independent claims 1, 6, and 11 involves pricing/cost data in view of the specification (*see* Ford Prelim. Reply, p. 1) and in view of disclaimed dependent claims 5, 10, and 15 (*see id.*, pp. 2-3). Ford argues that because the claims referred to pricing/cost data, the claims are directed to finance-related activities.

But Ford’s premise is unsupported by the metes and bounds of the claims themselves, or by any testimonial evidence. As noted in the POPR, the claimed “attributes” can be of many types; price and cost are only examples (along with “weight,” “towing capacity,” etc.). (POPR, pp. 10-11.) As said in *Unwired Planet*, “it cannot be the case that a patent covering a method and corresponding apparatuses becomes a CBM patent because its practice could involve a potential sale of a good or service.” *Unwired Planet*, No. 2015-1812, slip op. at 12.

Here, as in *Unwired Planet*, the claims are industry-agnostic at heart, and this weak connection to finance-related activities is insufficient post-*Unwired Planet*. The weakness of Ford's argument is evident in Ford's failure to address the standard in view of any decisions applying *Unwired Planet*, including the facts of *Unwired Planet* itself. These decisions are, so far, unequivocally unfavorable to Ford and fatal to its position. The remaining claims of the '825 patent, even arguably considering their scope in view of the disclaimed claims¹, at best *could* involve price or cost data -- in specific embodiments of the claimed inventions. But this unduly myopic restriction is neither a requirement of the claims nor in any way central to the functioning of the claims.

Further, Ford's comparison of the *Volusion* and '825 patent specifications, rather than their claims, must be of no moment here. The *Volusion* claims bear no resemblance to the '825 patent claims. And, the Board is not bound by pre-*Unwired Planet*, non-precedential panel decisions. In any event, the claims there would arguably have been found not CBM-eligible had the reasoning of *Unwired Planet* been applied. Ford's citation in this regard to such a non-authoritative case

¹ Like in *Great West*, even if the disclaimed claims are considered as relevant to the independent claims' scope, the Board should similarly deny institution here. See *Great West Cas. Co. v. Intellectual Ventures II*, CBM2015-00171, Paper 10. And *Great West* questioned but did not address the propriety of such consideration.

is purely conclusory. Of far more import is the Board's treatment of CBM eligibility since the November 21, 2016 decision in *Unwired Planet*², denying institution in *T-Mobile v. Intellectual Ventures II*, CBM2016-00083; *Kayak v. IBM*, CBM2016-00077 and -00078; and *Facebook v. Skky*, CBM2016-00091.³

In particular, in *Kayak* the petitioner argued that claims directed to “[a] method for presenting interactive applications” and “generating at least a first partition for presenting applications” are “limited to financial contexts because the recited ‘applications’ can be financial in nature.” *Kayak* -00077, Paper 15 at p. 12. But in denying institution, the Board found that the record supported several non-financial applications. *Id.* The parallel to the '825 patent “attributes” is direct.

Ford's analysis therefore fails to show how the industry-agnostic, claimed “attributes” are finance-related, and therefore institution must be denied.

Date: January 25, 2017

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² Ford's analysis of *Volusion* in view of the *Unwired Planet* decision opens the door to further consideration of the full state of the case law.

³ CBM review was instituted in three post-*Unwired Planet* cases. These are the two *Plaid Techs. v. Yodlee* decisions at CBM2016-00088 and -00089 (explicit claim to “financial transaction” / “amount of the transaction”) and *Emerson v. Sipco*, CBM2016-00095 (explicit claim to “ATM” / “vending machine”).

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that a true and correct copy of the enclosed **VERSATA'S SUR-REPLY TO FORD'S PRELIMINARY REPLY** was served electronically via e-mail on January 25, 2017 in its entirety on the following counsel of record for Petitioner:

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