UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY
Petitioner,

v.

VERSATA SOFTWARE, INC.
Patent Owner.

U.S. Patent No. 8,805,825

CBM Case No.: 2016-00100

FORD'S REPLY IN SUPPORT OF ITS PETITION FOR REHEARING

The Board should strike Versata's Response because it violates the Board's Order in two respects. *First*, Versata devotes just a page (Section II) to *Rembrandt*, disregarding the Board's Order limiting the Response to "addressing . . . *Rembrandt*." (Paper 14, p. 4.) *Second*, to gain more space, Versata used 28-point spacing rather than the required double-spacing for its Response (*compare* the line spacing in Paper 6 *with* that in Paper 15), flouting the Board's page limitation. (Ex. 2013 at 11:18-25; 37 C.F.R. § 42.6(a)(2)(iii).)

In *Rembrandt*, the Federal Circuit held that a statutory disclaimer only enlarges the public's rights; a Patent Owner cannot use disclaimer to diminish those rights. *Rembrandt Wireless Techs., LP v. Samsung Electrs. Co.*, 853 F.3d 1370, 1384 (Fed. Cir. 2017). *Rembrandt* is not merely about the effect of disclaimers on the marking statute, as Versata asserts. Rather, *Rembrandt* cites decisions from a range of litigation and administrative matters, all rejecting a patent owner's effort to limit others' rights by disclaiming claims. *Id*. The core principle in the cases is: ***Once rights are held by a member of the public, they cannot be rescinded by disclaimer.*** *Id*. Versata's disclaimer did not rescind Ford's rights to pursue the CBM.

By suing Ford for infringement, Versata gave Ford the right to seek CBM review. CBMs differ from the other post-grant reviews because a patent is insulated from CBM review until the Patent Owner has made a charge of infringement. AIA § 18(a)(1)(B). Once Ford had the right to seek CBM review, Versata could not—

retroactively—extinguish that right, especially where Versata made its disclaimer only ***after*** Ford filed its Petition.

Rembrandt is not inconsistent with 37 C.F.R. § 42.207(e), which states that "[n]o post-grant review will be instituted based on disclaimed claims." The PTO's explanation of that Rule clarifies that its purpose is simply to ensure that "no post-grant review will be instituted ***to review disclaimed claims***." 77 Fed. Reg. 48,680, 48,692 (Aug. 14, 2012) (emphasis added). Ford does not seek a "review [of] disclaimed claims" 5, 10, and 15—Ford seeks review of the remaining claims.

Because of its disclaimer, Versata can no longer pursue ***infringement*** with respect to the disclaimed subject matter (*i.e.*, configuration of "products from the group comprising: vehicles, computers, and financial products"); indeed, Judge Arpin was correct that the "disclaimer of claims 5, 10, and 15 also narrowed the scope of claims 1, 6, and 11." (Paper 12, Arpin, APJ concurring, p. 7.). However, as *Rembrandt* makes clear, Versata's disclaimer does not diminish Ford's (and the public's) rights–including the right to seek ***CBM review***. Therefore, for purposes of determining whether to institute a CBM, the Board must treat the remaining claims as encompassing such "financial products" –which the claims encompassed before the disclaimer—irrespective of the "products" that Versata dedicated to the public.

Dated: May 16, 2017

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Certificate of Service

The undersigned hereby certifies that the foregoing Ford's Reply in Support of its Petition for Rehearing**,** including all exhibits and supporting evidence, was served in its entirety on **May 16, 2017,** upon the following parties by electronic mail at PTAB@skgf.com, rsterne-PTAB@skgf.com; sbezos-PTAB@skgf.com; holoubek@skgf.com; jmutsche-PTAB@skgf.com; jtuminar-PTAB@skgf.com; kchambers@tcchlaw.com; sharoon.saleem@jonesspross,com:

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Respectfully submitted,

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