

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 PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.207(a)**

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TABLE OF CONTENTS

TABLE OF CONTENTS..... i
EXHIBIT LIST ii
I. INTRODUCTION.....1
II. THE '825 PATENT TECHNOLOGY2
III. CLAIM CONSTRUCTION4
 A. “attribute”.....5
 B. “attribute prioritized”5
IV. THE '825 PATENT IS NOT ELIGIBLE FOR CBM REVIEW.5
 A. Ford relies on an incorrect standard for determining whether the claims are directed to a financial product or service.6
 B. Ford fails to demonstrate—and cannot demonstrate—that the claims are directed to a financial product or service under application of the correct standard.....9
 C. Ford’s reliance on “express” disclosures of financial products or services is based on disclaimed claims.13
 D. The claims of the '825 patent recite a technological invention.....14
V. FORD HAS NOT SHOWN THAT THE CLAIMS OF THE '825 PATENT ARE MORE LIKELY THAN NOT UNPATENTABLE.21
 A. The claims of the '825 patent are directed to statutory subject matter under 35 U.S.C. § 101.21
 B. Claims 16 and 20 have been disclaimed, rendering Ford’s ground of invalidity for indefiniteness moot.....35
VI. CONCLUSION.....36
CERTIFICATION OF WORD COUNT (37 C.F.R. § 42.24(b)(1))1
CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))2

EXHIBIT LIST

2001	Complaint, <i>Versata Development Group, Inc. et al. v. Ford Motor Co.</i> , Civ. No. 4:15-cv-00316 (E.D. Tex.), D.I. 1
2002	Declaration of Dr. David W. Franke
2003	<i>Curriculum Vitae</i> of Dr. David W. Franke
2004	Versata: About Us, available at http://cpq.versata.com/about-us , 2016.
2005	“Ford Starts Firm to Manage Its Web Sites,” <i>ComputerWorld</i> , February 28, 2000.
2006	McCartney, Laton, “Trilogy Making A Name For Itself,” <i>ZDNet</i> , July 28, 2000.
2007	Field, Tom, “Suit Yourself,” <i>InsideCIO</i> , Vol. 10, No. 13, April 15, 1997.
2008	“Ford and Trilogy Launch Web Company,” <i>InformationWeek</i> , February 23, 2000.
2009	Statutory Disclaimer for U.S. Patent No. 8,805,825, October 28, 2016.
2010	PTAB Board Email dated October 26, 2016
2011	“Report and Recommendation of the Special Master Regarding Claim Construction” <i>Ford Motor Company v. Versata Software, Inc.</i> , 15-10628 (E.D. MI) (2016)

I. INTRODUCTION

The Petition as filed on September 12, 2016 is woefully deficient, and Petitioner Ford Motor Company failed to satisfy its burden of persuasion at every turn. Regarding CBM eligibility, Ford's characterization of the claims as "financial" are a stretch at best, and are based solely on a "test" that the Federal Circuit has described as insufficient and misaligned with the CBM eligibility statute. Ford also completely failed to address an entire prong of the "technological invention" test, providing no discussion of the claimed invention's technical problem or technical solution.

Regarding subject matter eligibility, in its "analysis" of an alleged abstract idea, Ford created a strawman abstract idea that does not actually map to the language of the claims. And Ford's allegation that the claims recite routine and conventional functionality is based solely on attorney argument that includes no supporting evidence of what actually was routine and conventional. Any one of these deficiencies presents sufficient reason to deny the Petition outright; the combination of deficiencies renders the Petition fatally inadequate.

Further, Ford's ground of unpatentability of claims 16 and 20 under 35 U.S.C. § 112, second paragraph, is mooted by statutory disclaimer.

For the reasons summarized above and explained in more detail below, Ford has failed to establish that U.S. Patent No. 8,805,825¹ is eligible for CBM review and has also failed to establish that it is more likely than not that at least one of the claims of the '825 patent is unpatentable. The Board should therefore deny institution of this CBM review proceeding against any of the claims of the '825 patent.

II. THE '825 PATENT TECHNOLOGY

The '825 patent generally relates to computer assisted configuration technology. (Ex. 2002, Franke Decl., para. 23; Ex. 1001, '825 patent, 4:39-43.) Computer assisted configuration technology relies on a set of configuration rules, which can be queried using configuration questions to provide a set of valid answers. (Franke Decl., para. 25; Ex. 1001, 1:61-2:30) For example, when building a vehicle using a configuration model for that vehicle, it is possible to ask whether the parts 'red' and 'V6 engine' are compatible with each other, and receive an answer from the model. (Franke Decl., para. 26; Ex. 1001, 1:61-2:30.)

Configuration processing becomes particularly complex when configuration queries can include attribute-based configuration processing. Versata developed

¹ U.S. Patent No. 8,805,825 is marked as Ford's exhibit 1001. Versata will refer to this patent as "the '825 patent."

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