

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. 7,739,080

CBM Case No.: 2016-00101

DECLARATION OF DEBORAH L. McGUINNESS, Ph.D.

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IV. While the disclosure of a patent specification is determined from the perspective of a person having ordinary skill in the art, the disclosure for purposes of analyzing a means-plus-function claim cannot be supplemented through expert opinion. For example, undisclosed subject matter that an expert might consider “obvious” or “known to those of skill in the art” at the time of the invention is not a part of the written description unless that subject matter is disclosed in the specification. Qualifications of one of ordinary skill in the art.....	11
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List of Exhibits

Exhibit No.	Description	Identifier
1001	U.S. Patent No. 7,739,080	'080 patent
1002	Versata Complaint in the <i>Versata</i> lawsuit	
1003	Versata Counterclaim in the <i>Ford</i> lawsuit	
1004	<i>A Guide to the Legislative History of the America Invents Act; Part II of II</i> , 21 Fed. Cir. Bar J. No. 4 (2002), pp. 539-653	AIA Legislative History Guide
1005	U.S. Patent No. 7,200,582	'582 patent
1006	Declaration of Deborah L. McGuinness	McGuinness Decl.
1007	File history of the '080 patent	'080 file history
1008	McGuinness <i>Curriculum Vitae</i>	
1009	Stefik, <i>Introduction to Knowledge Systems</i> (1995)	Stefik
1010	McDermott, <i>RI: an Expert in the Computer Systems Domain</i> , Proceedings AAAI-80 (1980)	McDermott
1011	McGuinness et al., <i>An Industrial-Strength Description Logic-Based Configurator Platform</i> , IEEE Intelligent Systems (1998)	
1012	McGuinness et al., <i>Description Logic in Practice: A CLASSIC: Application</i> , Proceedings of the 14th International Joint Conference on Artificial Intelligence, Montreal, Canada, (August 1995)	
1013	Versata's identification of "means" structure for claim 22 of the '080 patent from the <i>Ford</i> lawsuit	
1014	Versata's Opening Claim Construction Brief in the <i>Ford</i> lawsuit	

I, Deborah L. McGuinness, Ph.D., declare as follows:

I. Introduction

1. I am making this declaration at the request of Ford Motor Company in a Covered Business Method Review proceeding concerning U.S. Patent No. 7,739,080 (“the ‘080 Patent”).

2. I am being compensated for my work in this matter at my standard consulting rate of \$500 per hour and, when working while traveling, \$600. My compensation does not depend on the outcome of this proceeding.

3. I have been asked to provide my opinions related to the patentability of claims 1-22 of the ‘080 patent.

4. In preparation of this declaration, I have studied Exhibits 1001, 1005, and 1007-1014 as listed in the Exhibit List shown above in my report.

5. In forming the opinions expressed below, I have considered:

(a) The patents and file histories identified in the List of Exhibits;

(b) The relevant legal standards as explained to me by Ford’s counsel, including the standard for patentability under 35 United States Code §§ 101 and 112, ¶ 2; and

(c) My knowledge and experience based upon my work and study as described below, considering the patentability of the ‘080 patent from the

viewpoint of a person having ordinary skill in the relevant art as of the priority date of the '080 patent, which I am told is April 19, 2004.

II. Qualifications and Professional Experience

6. I have provided my full background in the curriculum vitae that is attached as Ex. 1008, which more fully details my 30-plus years of experience in computer science and electrical engineering. I am also an inventor on five patents, four of which directly relate to product configuration: U.S. Patent Nos. 5,720,008, 5,974,405, 6,256,627, 6,385,600, and 6,457,002.

7. My academic training includes completing the requirements for a Bachelor of Science in Computer Science and a Bachelor of Arts in Mathematics from Duke University in 1980. I completed a Master of Science degree from the Electrical Engineering and Computer Science Department of the University of California at Berkeley in 1981. I also completed a Ph.D. in Computer Science from Rutgers University in 1996.

8. I began my professional career immediately after my Bachelor's degree and began work for AT&T Bell Laboratories in 1980. I was immediately accepted into the Bell Laboratories "One Year on Campus" program which supported me to be a full time Master's student at Berkeley. Upon completion of my M.S. in 1981, I returned to Bell Laboratories and began work at the Home of the Future at the Home Information Systems Laboratory. In 1984, I transferred to

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