

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 IPR2016-01013
Patent 7,882,057 B1

Before HOWARD B. BLANKENSHIP, JAMES B. ARPIN, and
WILLIAM M. FINK, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION
Denying *Inter Partes* Review
37 C.F.R. § 42.108

I. BACKGROUND

Ford Motor Company (“Petitioner”) requests an *inter partes* review of claims 17, 30, and 44–46 of U.S. Patent No. 7,882,057 B1 (Ex. 1101, “the ’057 patent”) under 35 U.S.C. §§ 311–319. Paper 2 (“Petition” or “Pet.”). Versata Development Group, Inc. (“Patent Owner”) has filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314. Section 314(a) provides that an *inter partes* review may not be instituted unless “the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons that follow, we do not institute an *inter partes* review of any of claims 17, 30, and 44–46 of the ’057 patent.

A. Related Proceedings

The parties report that the ’057 patent is involved in *Ford Motor Company v. Versata Software, Inc.*, No. 2:15-cv-10628-MFL-EAS (E.D. Mich.).¹ Pet. v; Paper 5, 1. Petitioner also reports that the ’057 patent was asserted against Petitioner in another District Court action, but the case was dismissed without prejudice. Pet. v–vi.

¹ Patent Owner filed a counterclaim and served that counterclaim on Petitioner on October 28, 2015. Pet. v. We presume the validity of the claims of the ’057 patent was not challenged in the initial complaint. See 35 U.S.C. §§ 315(a)(1) (“An *inter partes* review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.”), 315(a)(3) (“A counterclaim challenging the validity of a claim of a patent does not constitute a civil action challenging the validity of a claim of a patent for purposes of this subsection.”).

B. The '057 Patent

The '057 patent has an effective filing date of October 4, 2004. Ex. 1101, at [22]. Petitioner does not suggest a different priority date in its Petition.

C. Asserted References

Exhibit No.	Reference
1105	U.S. Patent No. 7,873,503 B2 to Loomans <i>et al.</i> , effective filing date Sept. 28, 2001, filed Nov. 18, 2002
1106	A. Stahl, R. Bergmann, S. Schmitt, <u>A Customization Approach for Structured Products in Electronic Shops</u> , Electronic Commerce: The End of the Beginning, <i>13th International Bled Electronic Commerce Conference</i> (June 19–21, 2000)

D. Asserted Ground of Unpatentability

Petitioner asserts the following ground of unpatentability under 35 U.S.C. § 103(a) against claims 17, 30, and 44–46 of the '057 patent (Pet. 2):

References	Basis	Claims
Loomans, Stahl, and the general knowledge of a person of ordinary skill in the art ²	35 U.S.C. § 103(a)	17, 30, and 44–46

II. ANALYSIS

A. Prior Art Status of Stahl

In its Preliminary Response, Patent Owner contends that Petitioner fails to show that Stahl is a prior art “printed publication” in accordance with

² Because petitioners must base their claim challenges on patents or printed publications, we understand Petitioner’s reference here to the general knowledge of a person of ordinary skill in the art to refer to how such a person would understand the teachings of Loomans and Stahl. *See* 35

35 U.S.C. §§ 102 and 311(b). Prelim. Resp. 14, 16–22. We look to the underlying facts to make a legal determination as to whether a reference is a printed publication. *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014). “The determination of whether a reference is a ‘printed publication’ under 35 U.S.C. § 102(b) involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.” *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004) (citations omitted). Public accessibility is a key question in determining whether a document is a printed publication. *Suffolk Techs.*, 752 F.3d at 1364. To qualify as a printed publication, a document “must have been sufficiently accessible to the public interested in the art.” *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009) (citations omitted).

Petitioner makes inconsistent allegations regarding the public accessibility of Stahl. Initially, Petitioner identifies Ex. 1106 as “A. Stahl, R. Bergmann, S. Schmitt, A Customization Approach for Structured Products in Electronic Shops, *Electronic Commerce: The End of the Beginning, 13th International Bled Electronic Commerce Conference* (June 19–21, 2000).” Pet. ii. Thus, Petitioner appears to rely on the public accessibility of Stahl during the conference to qualify the reference as a printed publication. Subsequently, Petitioner alleges that “Stahl was published in the *Proceedings of the 13th International Bled Electronic Commerce Conference* in 2000.” *Id.* at 1. Petitioner’s declarant, Dr. Greenspun, testifies that “Stahl is a printed publication titled “A Customization Approach for Structured Products in Electronic Shops,”

U.S.C. § 311(b); 37 C.F.R. § 42.104(b)(2).

which was published during the 13th International Bled Electronic Commerce Conference in Bled, Slovenia in June 2000.” Ex. 1102 ¶ 66 (emphasis added) (footnote omitted). Dr. Greenspun further asserts that “Ex. 1106 is a true and accurate copy of: Armin Stahl, Ralph Bergmann, Sascha Schmitt, ‘A Customization Approach for Structure Products in Electronic Shops,’ 13th International Bled Electronic Commerce Conference June 19-21, 2000. Available at (<https://domino.fov.uni-mb.si/ecomframes.nsf/pages/bled2000>.)” Ex. 1102 ¶ 66 n.9. The hyperlink provided by Dr. Greenspun, however, is undated and merely permits the purchase of copies of the “13th International Bled Electronic Commerce Conference 2000 – Conference Proceedings.” Ex. 3001. Based on these inconsistent representations, Dr. Greenspun testifies that it is his “understanding” that Stahl qualifies as prior art to the ’057 patent. Ex. 1102 ¶ 66.

Patent Owner contends that Petitioner has not established that Stahl is a printed publication. Prelim. Resp. 14. According to Patent Owner, the Petition fails to indicate clearly “how Ford is alleging Stahl was published.” *Id.* at 17. Further, if Petitioner is arguing that Stahl was made publicly accessible during the conference, Patent Owner contends that Petitioner has failed to provide the requisite evidence to show such public accessibility. *Id.* at 18. If, instead, Petitioner is arguing that Stahl was published in the *Proceedings of the 13th International Bled Electronic Commerce Conference* later in 2000, Patent Owner contends that Petitioner has failed to show that Ex. 1106 is from such a publication. *Id.* at 21–22.

In considering its Petition seeking *inter partes* review, the burden rests on Petitioner to demonstrate that Stahl, specifically, as embodied in

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