

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CONFIGIT A/S,  
Petitioner,

v.

VERSATA DEVELOPMENT GROUP, INC.,  
Patent Owner.

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IPR2021-01055  
Patent 6,836,766 B1

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Before SALLY C. MEDLEY, KEVIN F. TURNER, and  
DEBRA K. STEPHENS, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

On March 4, 2022, a conference call was held involving counsel for the respective parties and Judges Turner, Medley, and Stephens. The purpose of the conference call was to discuss (1) the nature of a protective order to be agreed to by the parties, (2) a motion to seal, and (3) Petitioner’s opposed request to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123(b).

On December 22, 2021, we instituted *inter partes* review of claims 1–5 and 9–19 of U.S. Patent No. 6,836,766 B1 (Ex. 1001; “the ’766 Patent”). Paper 11. Patent Owner’s Preliminary Response addressed the issue of whether Oracle1<sup>1</sup> and Oracle2<sup>2</sup> were prior art to the ’766 Patent. Paper 6, 16–24. The parties further addressed the issue through additional briefing. Papers 9, 10. We determined, in the Institution Decision, that Petitioner had sufficiently shown that those references were publicly available prior to the ’766 Patent’s priority date of January 31, 2001 for purposes of institution, and we set a date of publication or public accessibility for each reference, indicating that “[b]oth parties will be able to submit evidence and/or arguments to alter those dates set or seek to antedate or exclude evidence during the course of the trial.” Paper 11, 13, 15–17.

Petitioner requested the conference call seeking guidance on filing a protective order and a motion to seal. Based on the proceedings in a district court, Petitioner obtained a declaration from non-party Oracle (“the new declaration”) regarding the public availability of Oracle1 and Oracle2. Petitioner asserts that Oracle has designated the new declaration as

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<sup>1</sup> Oracle® Configurator Developer, User’s Guide, Release 11i for Windows 95/98 and Windows NT 4.0, April 2000 (Ex. 1003, “Oracle1”).

<sup>2</sup> Oracle® Configurator, Oracle Configuration Interface Object (CIO) Developer’s Guide, Release 11i, March 2000 (Ex. 1004, “Oracle2”).

“confidential,” and seeks to serve Patent Owner with a copy. On the conference call, Patent Owner’s counsel indicated that Patent Owner would be amenable to receipt of the new declaration, and both parties have agreed to use the Board’s Default Protective Order and be bound thereby.

We indicated on the conference call that the panel had no objection to the parties using the Board’s Default Protective Order in connection with service of the new declaration. This Order memorializes the intent of the parties. Until any document is filed in this proceeding under that Protective Order, there is no need for a motion to seal to be filed. Additionally, so long as both parties are bound by the Default Protective Order, there is no need for the Default Protective Order to be made of record in this proceeding. If either party seeks to make the new declaration of record, its submission should be accompanied by a motion to seal, indicating the Default Protective Order.

Petitioner also sought guidance regarding the appropriate mechanism for entering this new declaration into the record should Patent Owner re-raise the issue of prior art public availability in its Patent Owner Response. Petitioner requests the late submission of supplemental information, i.e., the new declaration, indicating that the information could not have been obtained earlier and that the consideration of that information would be in the interests-of-justice, pursuant to 37 C.F.R. § 42.123(b). Petitioner maintains that in case Patent Owner includes substantive arguments in its Patent Owner Response regarding the public availability of Oracle1 or Oracle2, Petitioner would like to file the new declaration now.

Patent Owner opposes the request, arguing that the supplemental evidence should have been filed with the Petition and would act as an untimely supplementation of the Petition. Patent Owner also indicated that

Petitioner had not identified any Rule under which such a submission would be proper. On the conference call, Patent Owner's counsel indicated that the issues to be raised in the Patent Owner Response, including the issue of the public availability of Oracle1 and Oracle2, had not yet been determined. We note that there has not been any evidentiary objection to Oracle1 or Oracle2 by Patent Owner under 37 C.F.R. § 42.64(b)(1), which would have needed to be made within ten (10) business days of the institution of trial.

Based on the facts of this case, we determine that Petitioner will have opportunity to respond to Patent Owner's Response in its Petitioner Reply and may file evidence in support of such arguments. Petitioner may also file the supplemental evidence to the extent necessary if Patent Owner files a motion to exclude. Based on the facts before us, Petitioner may introduce the new declaration in the ordinary course of the proceedings without filing a separate motion to submit supplemental information and all that that entails (a Patent Owner opposition to the motion and a Petitioner reply to the motion). *See* 37 C.F.R. § 42.1(b). *See also Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 (Dec. 20, 2019) (precedential) (detailing that additional evidence may be admitted so long as that evidence is responsive to the prior briefing).

We disagree with Patent Owner that the filing of such evidence in connection with Petitioner's Reply to Patent Owner's Response or to any Opposition to a Patent Owner Motion to Exclude would be prejudicial to Patent Owner, or act as an untimely supplementation of the Petition. Patent Owner will have the new declaration prior to the due date for its Patent Owner Response, and may cross-examine the declarant(s) prior to filing its Patent Owner Response. If additional time is needed for a deposition prior to the filing of the Patent Owner Response, Patent Owner may request an

extension of time to accomplish such a deposition. Patent Owner may also file the new declaration in this proceeding, assuming it does so under a motion to seal, if Patent Owner wishes to refer to the new declaration in its Patent Owner Response.

Patent Owner, therefore, will have many opportunities to address the veracity of the testimony of the new declaration and will be provided due process. *See Hamilton Beach Brands, Inc. v. F'real Foods, LLC*, 908 F.3d 1328, 1339 (Fed. Cir. 2018) (distinguishing *SAS* because the party asserting the APA violation “had notice of the contested claim construction issues and an opportunity to be heard”).

It is

ORDERED that Petitioner’s request to file a motion to submit supplemental information is *dismissed* as moot.

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