

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Configit A/S,
Petitioner

v.

Versata Development Group, Inc.,
Patent Owner

Case IPR2021-01055
U.S. Patent No. 6,836,766

PATENT OWNER'S PRELIMINARY RESPONSE

Mail Stop "PATENT BOARD"

Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I.	Summary of the '766 patent.....	1
A.	The '766 patent describes a problem with conflicting rules in a complex configurator.....	1
B.	Two types of configuration errors.....	4
1.	State errors.....	4
2.	Exception errors.....	5
C.	The '766 patent teaches and claims a debugger for high-complexity configuration systems.....	6
D.	Configuration error testing.....	8
II.	Prosecution history: the examiner tested the '766 patent.....	9
III.	Person of ordinary skill in the art.....	9
IV.	Claim construction.....	10
A.	Configuration errors.....	10
1.	The specification defines a “configuration error” as the condition that occurs when “a rule or series of rules is not properly defined and produces an undesired effect” or “a series of improperly defined rules causes a part to be in more than one state at the same time”.....	10
2.	The Prosecution History is silent on configuration error.....	13
B.	Test case.....	13
1.	Definition from the specification.....	13
2.	Claim differentiation supports this definition.....	14
3.	The Prosecution History is consistent with the definition of test case.....	15
V.	Neither Oracle1 nor Oracle2 are prior art to the '766 Patent and Memon is not § 102(b) prior art.....	16
A.	Oracle1, Oracle2, and Memon are not prior art under 35 U.S.C. § 102(b).....	16
B.	Oracle1 and Oracle2 are not prior art under 35 U.S.C. § 102(a).....	17

1.	Configit knows how to show the date of a prior art reference but has not done so for Oracle1 and Oracle2	17
2.	The “evidence” that Oracle1 and Oracle2 were published in 2000 is contradictory and insufficient	19
a)	The Tina Brand Declaration does not support Configit’s arguments.....	19
(1)	The Tina Brand Declaration calls into question even the April 2000 and March 2000 purported dates of Oracle1 and Oracle2 and fails to establish another date	19
(2)	Much of Brand’s declaration is inadmissible hearsay.....	21
b)	The testimony of Andrew Wolfe does not support Configit’s argument for the same reasons the Brand Declaration does not	23
VI.	Claims 1–5 & 9–19 are not unpatentable	24
A.	Ground 1: Oracle1 in view of Oracle2 does not render claims 1, 9–10, 14, 19 obvious.....	24
1.	Oracle1 describes an implementation of a product configurator rather than a debugger for configurators	26
2.	Oracle2 is similar to Oracle1.....	28
3.	Independent claim 1	28
a)	Oracle1 and Oracle2 do not teach a configuration error	28
(1)	Oracle1 does not teach the “configuration error” of the preamble (element 1.pre(i))	28
(2)	Oracle1 and Oracle2 do not teach a computer system to detect configuration errors in the product configuration (element 1.1)	30
(3)	Oracle1 and Oracle2 do not teach processing anything to detect whether any changes produce a configuration error (element 1.2)	32

(4)	Oracle1 and Oracle2 do not teach an explanation of a configuration error (element 1.3).....	33
4.	Dependent claim 9 is not taught by Oracle1 and Oracle2	33
5.	Dependent claim 10 is not taught by Oracle1 and Oracle2	34
6.	Dependent claim 14	34
7.	Dependent claim 19	35
8.	Reasons to combine Oracle1 and Oracle2	35
B.	Ground 2: The Oracle1-Oracle2 Combination in Further View of SalesPlus does not render claims 15 and 16 obvious.....	35
C.	Ground 3: The Oracle1-Oracle2 combination in further view of SalesPlus, and Yu do not renders claims 11–13 and 17 obvious	35
D.	Ground 4: The Oracle1-Oracle2 combination in further view of Memon do not render claims 2 and 18 obvious	36
E.	Ground 5: The Oracle1-Oracle2-Memon combination in further view of SalesPlus do not render claims 3–5 obvious	36
VII.	Conclusion.....	36

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Declaration of Paul A. Navrátil in Support of Patent Owner's Preliminary Response
2002	<i>Curriculum vitae</i> of Paul A. Navrátil
2003	Lora Green & Brian McNamara (JJ.), <i>Best Practices for Proving a Document is a Printed Publication</i> , at 14 (Dec. 7, 2017), at https://www.uspto.gov/sites/default/files/documents/proving_a_document_is_a_printed_publication_12_7_2017.pdf

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.