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*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Configit A/S ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting institution of *inter partes* review of claims 1–5 and 9–19 of U.S. Patent No. 6,836,766 B1 (Ex. 1001, "the '766 Patent"). Versata Development Group, Inc. ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp."). Further to our authorization, both parties submitted additional filings, directed to the issues of public availability of certain references, as discussed below. (Petitioner's Reply to Patent Owner's Preliminary Response (Paper 9, "Pet. Reply"); Patent Owner's Sur-Reply to Petitioner's Reply (Paper 10, "PO Sur-Reply").

An *inter partes* review may be instituted only if "the information presented in the petition . . . and any [preliminary] response . . . 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." 35 U.S.C. § 314(a) (2018). For the reasons given below, Petitioner has established a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims of the '766 Patent. Accordingly, we institute an *inter partes* review of claims 1–5 and 9–19 of the '766 Patent on the grounds of unpatentability raised in the Petition.

B. Related Proceedings

Both parties identify the following judicial or administrative matter that would affect, or be affected by, a decision in this proceeding: *Versata Software, Inc. et al v. Configit A/S*, Case No. 2:20-cv09019 (C.D. Cal.). Pet. 74; Paper 4, 1.

C. The '766 Patent

The '766 Patent is titled "Rule Based Configuration Engine for a Database," and is asserted to "provide[] the ability to test rules in a rule-based system for configuring a product." Ex. 1001, code (54), Abs. With respect to the prior art, the '766 Patent describes "configuring systems" or "configuration engines," which allow a user to configure a product by interactively selecting components from various groups based on availability and compatibility of features and options. *Id*. at 1:13–17. It also details that the configured product "might consist of several hundred individual parts" that might be available on multiple products, and that:

> A product is modeled by describing which parts and part groups are available in that product and which choices must be made from within the part groups, and then by writing additional rules that describe part-to-part relationships which are not modeled by the product structure.

Id. at 1:27–33. Thereafter, a compiler converts the product structure and rules into "rule types," where "there might be several hundred, several thousand, or even more of these rules." *Id*. at 1:34–42. Based on selections by the client, the parts that are selected or included are "selected," or "not selectable," if they have been excluded or deleted. *Id*. at 1:41–53.

The '766 Patent also details that "configuration errors may occur when a rule or series of rules is not properly defined and produces an undesired effect," and can also occur when a series of improperly defined rules causes a part to be in more than one state at the same time. Ex. 1001, 1:54–61. It also details that for large models, such errors may be difficult to find and it is desirable to have "an automated testing tool to locate and analyze configuration errors." *Id*. at 1:62–67.

The '766 Patent discloses its approach to debugging configuration errors of a configurator, wherein the "user provides test cases that select at least one part to include in the product configuration," and thereafter, the "configuration tester processes the rule to determine whether" the configuration choice in the test case "conflicts with the plurality of parts" in the configurator. Ex. 1001, 2:7–11. The '766 Patent also summarizes multiple features and embodiments (*id*. at 2:12–3:29), but ultimately asserts that "these embodiments and variations are illustrative and the invention is not to be considered limited in scope to these embodiments and variations." *Id*. at 12:22–25.

D. *Challenged Claims*

Claim 1 is the sole independent claim challenged in this proceeding, with each of challenged claims 2–5 and 9–19 dependent thereon, directly or indirectly, and is reproduced below:

> 1. [1.pre] A method of using a computer system to test a product configuration for configuration errors, wherein the product configuration is stored as electronic data in a computer system for generating product configurations, the computer system including at least one rule defining a relationship between at least two parts, the product configuration including a plurality of parts, the method comprising:
>
> [1.1] entering a test case into the computer system to detect configuration errors in the product configuration, wherein the test case includes data to change the product configuration;
>
> [1.2] processing the test case with the computer system in accordance with the at least one rule to detect whether the change in the product configuration, as a result of processing the test case in accordance with the at least one rule, produced a configuration error in the product configuration; and

[1.3] generating explanation data with the computer system to provide an explanation of any detected configuration error in the product configuration.

Ex. 1001, 12:30–50 (with annotations provided by Petitioner, Pet. 14–23).

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 1, 12–71), supported by the declaration of Dr. Kristin L. Wood (Ex. 1002):

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1, 9, 10, 14, 19	103(a)[1]	Oracle1,[2] Oracle2,[3]
15, 16	103(a)	Oracle1, Oracle2, SalesPlus[4]
11–13, 17	103(a)	Oracle1, Oracle2, SalesPlus, Yu[5]
2, 18	103(a)	Oracle1, Oracle2, Memon[6]
3–5	103(a)	Oracle1, Oracle2, Memon, SalesPlus

[1] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent claims priority to an application filed before March 16, 2013, we refer to the pre-AIA version of § 103.

[2] Oracle® Configurator Developer, User's Guide, Release 11i for Windows 95/98 and Windows NT 4.0, April 2000 (Ex. 1003, "Oracle1").

[3] Oracle® Configurator, Oracle Configuration Interface Object (CIO) Developer's Guide, Release 11i, March 2000 (Ex. 1004, "Oracle2").

[4] Beologic A/S Reference Guide for the Beologic® salesPLUS™ Product Configurator, C language API, Version 2.0, 1995 (Ex. 1005, "SalesPlus").

[5] Bei Yu et al., "A configuration tool to increase product competitiveness," IEEE Intelligent Systems and their Applications, vol. 13, no. 4, pp. 34-41, July-Aug. 1998 (Ex. 1006, "Yu").

[6] Atif M. Memon et al., "Automated Test Oracles for GUIs," Proceedings of the 8th Int'l Symp. on the Found. of Software Engineering (FSE-8), San Diego, CA, Nov. 6, 2000 (Ex. 1007, "Memon").

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