

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CALLIDUS SOFTWARE INC.
Petitioner,

v.

VERSATA SOFTWARE, INC. and
VERSATA DEVELOPMENT GROUP, INC.
Patent Owner.

Cases CBM2013-00052 (Patent 7,904,326 B2)
CBM2013-00053 (Patent 7,958,024 B2)
CBM2013-00054 (Patent 7,908,304 B2)¹

Before HOWARD B. BLANKENSHIP and KEVIN F. TURNER,
Administrative Patent Judges.

TURNER, *Administrative Patent Judge.*

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

¹ This order addresses an issue that is identical in all three cases. Therefore, we exercise discretion to issue one order to be filed in each of the three cases. The parties, however, are not authorized to use this style heading in subsequent papers since doing so may cause confusion.

Cases CBM2013-00052, 00053, 00054
Patents 7,904,326; 7,958,024; 7,908,304

On August 14, 2014, a conference call was held involving counsel for the respective parties and Judges Blankenship and Turner. Petitioner requested the conference call to seek authorization to file a motion for waiver, pursuant to 37 C.F.R. § 42.5(b), of the page limits set for Petitioner's Replies to Patent Owner Responses set by 37 C.F.R. § 42.24(c)(1).

Petitioner argued that additional pages for each of its Replies to Patent Owner Responses were needed to address all of the issues presented in the Patent Owner's Responses. Petitioner argued that each Response addresses standing issues, under 35 U.S.C. § 325(a), changes involving issues of 35 U.S.C. § 101 under *Alice Corp. v. CLS Bank Int'l, et al.*, Docket No. 13-298 (2014) ("*Alice Corp.*"), and numerous claim constructions raised by Patent Owner that were not addressed in the Petitions nor the Decisions to Institute. Because of these issues, Petitioner requested a waiver of the Rules to permit it to file Replies to the Patent Owner Responses encompassing approximately 30 pages each.

Patent Owner countered that there was nothing in the Responses that necessitated that need for additional pages. Patent Owner indicated that each Response was under the page limits set by 37 C.F.R. § 42.24(b)(2), and that the number of issues discussed in each was not great. Patent Owner also argued that the standard needed to waive the rules had not been demonstrated by Petitioner. Patent Owner also indicated that if Petitioner was ultimately granted additional pages for its Replies, Patent Owner should be entitled to a Sur-Reply in response. No consensus was reached by the parties during the conference call.

Cases CBM2013-00052, 00053, 00054
Patents 7,904,326; 7,958,024; 7,908,304

We are persuaded that Petitioner's request does not present extraordinary circumstances that justify additional pages for their Replies. Petitioner need not address issues in their Replies that we have already decided in this proceeding. Additionally, Patent Owner stipulates that "Patent Owner herein repeats aspects of its earlier argument that Petitioner is barred under 35 U.S.C. 325(a), solely to ensure a complete record of this proceeding, and to preserve all issues for appeal." Paper 34, 33, Paper 29, 45, Paper 32, 52, in CBM2013-00052, -00053, and -00054, respectively. If Petitioner perceives that the issues raised in the Patent Owner Responses are sufficiently different in kind or scope from those raised earlier, Petitioner can address such distinctions in its Replies.

With respect to Petitioner's request for pages to address *Alice Corp.*, we have previously indicated that we would consider additional briefing beyond the proscribed filings to address the effect of *Alice Corp.* (Papers 33, 28, and 31, in CBM2013-00052, -00053, and -00054, respectively), but we received no such request from either party. With respect to extra pages to address the non-standing issues, i.e., claim constructions and the sole ground in each proceeding asserting that claims fail to recite patentable subject matter under 35 U.S.C. § 101, Petitioner's counsel indicated that addressing those issues alone would be under the 15 pages allotted for each Petitioner's Reply. As such, we not persuaded that Petitioner's desire to address the *Alice Corp.* and the non-standing issues warrant the extra pages sought by Petitioner, nor that a waiver of the rules would be appropriate based on the specific facts of these proceedings.

In consideration of the foregoing, it is hereby:

Cases CBM2013-00052, 00053, 00054
Patents 7,904,326; 7,958,024; 7,908,304

ORDERED that no authorization is granted for the filing of a motion for waiver, pursuant to 37 C.F.R. § 42.5(b), with respect to the page limits set for Petitioner's Replies to the Patent Owner Responses.

Cases CBM2013-00052, 00053, 00054
Patents 7,904,326; 7,958,024; 7,908,304

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