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CBM2013-00017, Paper 36
CBM2013-00018, Paper 36
Entered: April 25, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLUSION, INC.
Petitioner

v.

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

Cases CBM2013-00017 (Patent 6,834,282 B1)
CBM2013-00018 (Patent 7,426,481 B1)¹

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and
KEVIN F. TURNER, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

¹ This order addresses similar issues in the two cases. Therefore, we exercise discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style of heading in subsequent papers.

CBM2013-00017 (Patent 6,834,282)

CBM2013-00018 (Patent 7,426,481)

On April 22, 2014, a conference call was held between counsel for the respective parties and Judges Medley, Blankenship, and Turner. A number of issues were discussed and we address each issue in turn.

Proper procedure for requesting a conference call

The parties were reminded of the proper procedure for requesting a conference call and the appropriate content of any email filed with the Board regarding a conference call. In particular, an email requesting a conference call should copy the other party to the proceeding, indicate generally the relief being requested or the subject matter of the conference call, state whether the opposing party opposes the request, and include times when all parties are available. Emails regarding a conference call should not include arguments. *See* Technical issue 3 on the Board's website (<http://www.uspto.gov/ip/boards/bpai/prps.jsp>). During the conference call, the particular deficiencies were discussed, along with the potential consequences for any future abuse of the process. Exhibit 2010 at 3-5.

Motion to Strike

Patent Owner requested authorization to file a motion to strike. Specifically, Patent Owner seeks to strike two declarations made by Philip Greenspun (Exhibits 1017 and 1018 in both CBM2013-00017 and -00018) and the Petitioner's reply (CBM2013-00017, Paper 30 and CBM2013-00018, Paper 26). According to Patent Owner, Exhibit 1017, and the Petitioner's reply relying on Exhibit 1017, exceed the scope of the reply under 37 C.F.R. § 42.23(b). In addition, Patent Owner argued that the filing of Exhibits 1017 and 1018 was in violation of 37 C.F.R. § 42.223, which

CBM2013-00017 (Patent 6,834,282)

CBM2013-00018 (Patent 7,426,481)

requires a party to seek prior authorization before filing supplemental information. Petitioner opposed the request.

Patent Owner's request to file a motion to strike Exhibit 1017, Exhibit 1018, and the Petitioner's reply is denied. As explained during the call, whether a reply contains arguments or evidence that is outside the scope of a proper reply under 37 C.F.R. § 42.23(b) is left to the determination of the Board. The Board will determine whether a reply and evidence are outside the scope of a proper reply and evidence when the Board reviews all of the parties' briefs and prepares the final written decision. If there are improper arguments and evidence presented with a reply, the Board may exclude the reply and related evidence, for example. For all of these reasons, the Board will take under consideration any alleged violations in due course with respect to Petitioner's reply and Exhibit 1017, upon considering the record at the end of the trial.

As explained by Patent Owner, Exhibit 1018 is relied on by the Petitioner in connection with its opposition to Patent Owner's motion to amend. However, a Petitioner may present evidence to rebut arguments and evidence presented by Patent Owner with respect to a motion to amend and, therefore, such evidence would not be considered "supplemental information" and Patent Owner did not articulate a persuasive reason why Exhibit 1018 is supplemental information under 37 C.F.R. § 42.223.

Motion for observation

As discussed, Patent Owner is permitted to cross-examine reply declarants, and if necessary, Patent Owner may file a motion for observation regarding cross-examination of a reply witness during DUE DATE 4. As

CBM2013-00017 (Patent 6,834,282)

CBM2013-00018 (Patent 7,426,481)

noted, in the Scheduling Order (CBM2013-00017, Paper 9; CBM2013-00018, Paper 9), a motion for observation on cross-examination is a mechanism to draw the Board's attention to relevant cross-examination testimony of a reply witness. The observation must be a concise statement of the relevance of precisely identified testimony to a precisely identified argument or portion of an exhibit (including another part of the same testimony). An observation is not an opportunity to raise new issues, to re-argue issues, or to pursue objections. Each observation should be in the following form:

In exhibit ____, on page ____, lines ____, the witness testified ____.
That testimony is relevant to the ____ [stated or argued] on
page ____, lines ____ of _____. The testimony is relevant because
_____.

Each observation should not exceed one short paragraph. The Board may decline consideration or entry of argumentative observations. A motion for observation is limited to 15 pages. Although Petitioner argued that Patent Owner's motion for observation should be limited to 5 pages, Petitioner did not provide a persuasive reason for deviating from the normal procedure. Accordingly, Patent Owner's motion for observation due at DUE DATE 4 is limited to 15 pages. Petitioner may file a response by DUE DATE 5, limited to 15 pages.

Patent Owner's Reply exceeds the page limit

Lastly, Petitioner correctly pointed out that Patent Owner's Reply filed in each proceeding (CBM2013-00017, Paper 35 and CBM2013-00018, Paper 35) exceeds the page limit for replies, because the reply includes

CBM2013-00017 (Patent 6,834,282)

CBM2013-00018 (Patent 7,426,481)

single-spaced footnotes in violation of 37 C.F.R. §§ 42.6 and 42.24. Patent Owner is authorized to file a substitute reply, in each proceeding, for the sole purpose of meeting the page limit. No other changes are authorized.

It is

ORDERED that Patent Owner's request to file a motion to strike is *denied*; and

FURTHER ORDERED that Patent Owner is authorized to file, in each proceeding, a motion for observation on cross-examination by DUE DATE 4 consistent with this order;

FURTHER ORDERED that Petitioner is authorized to file, in each proceeding, a response to any motion for observation by DUE DATE 5 consistent with this order; and

FURTHER ORDERED that Patent Owner is authorized to file, in each proceeding, a substitute reply consistent with this order.

CBM2013-00017 (Patent 6,834,282)

CBM2013-00018 (Patent 7,426,481)

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