

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAP AMERICA, INC.  
Petitioner,

v.

VERSATA DEVELOPMENT GROUP, INC.  
Patent Owner.

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Case CBM2012-00001 (MPT)  
Patent 6,553,350

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Before MICHAEL P. TIERNEY, *Lead Administrative Patent Judge*, and SALLY C. MEDLEY and RAMA G. ELLURU, *Administrative Patent Judges*.

TIERNEY, *Lead Administrative Patent Judge*.

**DECISION**  
**Conduct of the Proceedings**  
**37 C.F.R. § 42.5**

A conference call was held on November 14, 2012 at approximately

2:00 p.m. involving:

1. Erika Arner and Joseph Palys, counsel for SAP
2. Martin Zoltick and Nancy Link, counsel for Versata,
3. Michael Tierney, Sally Medley and Rama Elluru, Administrative Patent Judges.

A court reporter was present on the call.<sup>1</sup> The purpose of the call was to discuss the parties' joint submission filed November 9, 2012. The joint submission identified four issues for discussion. The issues and the Board's decisions thereon are as follows.

#### I. Protective Order

The parties have discussed entry of a protective order, but have not yet agreed upon the terms. Specifically, Versata represented during the conference call that it was willing to adopt the Board's default protective order. SAP, however, has requested modifications to the protective order and represented that the modifications were consistent with those adopted in the related district court litigation protective order.

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<sup>1</sup> This Order summarizes statements made during the conference call. A more complete record may be found in the transcript, which is to be filed by Versata as an exhibit.

At the conference call, the parties represented that they were confident that they would reach an agreement as to an appropriate protective order for this proceeding. The Board requested that the parties reach an agreement by no later than close of business on Friday, November 16, 2012. Should the parties be unable to reach an agreement, the parties are to contact the Board and arrange for a conference call on Monday, November 19, 2012.

## II. Versata's Request for Additional Discovery

Versata previously requested that additional discovery be provided as to documents that were previously produced during the related district court litigation. According to Versata, the documents relate to allegations of invalidity of the involved '350 patent based on SAP's "R/3" documentation. See Paper 16, 4. The parties were unable to reach agreement as to the production of these documents.

At the conference call, Versata requested additional discovery of three groups of documents. These requests are discussed below.

### *i. Five Specifically Identified Documents*

Versata requested that unredacted copies of the following five documents be produced: 1) Boyd expert report, 2) Boyd deposition transcript, 3) Nettles expert

report, 4) Nettles deposition transcript; and 5) SAP's motion for JMOL. SAP objected to Versata's request alleging that the documents are not relevant to the issues raised in the proceeding.

The Board requested that SAP identify any prejudice to providing the requested documents. SAP did not identify any prejudice other than an alleged lack of relevance. Versata disagreed, contending that the requested documents related to issues of validity raised in the related litigation. Based upon the facts presented, the Board ordered SAP to produce the five requested documents once a protective order is entered in this proceeding.

*ii. Appendices and Exhibits Cited in the Five Specifically Identified Documents*

Versata requested that all appendices and exhibits cited in the five specifically identified documents be produced. SAP opposed this request contending that many of the requested documents are not relevant to the issues raised in this proceeding.

The Board requested that Versata contact SAP as to which of the exhibits and appendices it required and generally identify the relevance of the sought after documents. Should the parties be unable to agree as to the production of a

particular document, the parties are to contact the Board and arrange for a conference call.

*iii. General Request for Documents Relating to “R/3” Documentation*

Versata generally requested that SAP produce any documents relating to the “R/3” documentation. SAP opposed on various grounds.

The Board denied Versata’s request without prejudice to raising the issue, should the Board institute a trial.

III. Versata Experts

Versata requested that the Board authorize the use of its experts from the related litigation. SAP opposed contending that the use of the Versata experts would violate the district court’s protective order.

The Board takes no position as to whether or not Versata’s use of the experts violates the district court’s protective order.

IV. Time for Filing Patent Owner Preliminary Response

Versata requested that the time for filing a patent owner preliminary response be extended from November 23, 2012 to December 17, 2012. The Board noted that November 23, 2012 is the day after Thanksgiving. The Board extended

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the time for filing to November 30, 2012 to avoid conflicting with the  
Thanksgiving holiday.

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