

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner,

v.

VERSATA DEVELOPMENT GROUP, INC.,
Patent Owner.

Case CBM2013-00042
Patent 5,878,400

Before MICHAEL P. TIERNEY, RAMA G. ELLURU, and
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

DECISION
Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

I. INTRODUCTION

Patent Owner, Versata Development Group, Inc. (“Versata”), filed a motion for additional discovery (“Mot.”, Paper 18) and Petitioner, SAP America Inc. (“SAP”), filed an opposition (“Opp.”, Paper 21). For the reasons stated below, Versata’s motion is denied.

Versata seeks additional discovery to obtain an installable and working version of the software product that is described in the printed publication software manuals (“R/3 Documentation”) asserted by SAP to anticipate claims at issue in U.S. Patent No. 5,878,400 (“the ’400 patent”). Specifically, “Versata seeks additional discovery to obtain a working version of Petitioners [SAP’s] R/3 version 2.2C software product (*e.g.*, a demonstration version available for installation from SAP’s demo install disks).” Mot. 1.

A. Analysis

Discovery in a covered business method review is less than what is normally available in district court patent litigation, as Congress intended covered business method review to be a quick and cost effective alternative to litigation. *See* H. Rep. No. 112-98 at 45-48 (2011).

A party seeking discovery beyond what is permitted expressly by rule must show “good cause as to why the discovery is needed” and demonstrate that the evidence sought is “directly related to factual assertions advanced by either party in the proceeding.” 37 C.F.R. §§ 42.51(b)(2)(i), 42.224.

Versata, as the movant, bears the burden of demonstrating that it is entitled to the additional discovery sought. 37 C.F.R. § 42.20(c). Accordingly,

CBM 2013-00042
Patent 5,878,400

Versata must explain with specificity the discovery requested and why each item is necessary for good cause.

In a covered business method review, we consider various factors in determining whether additional discovery is necessary for good cause. We consider whether there is more than a possibility and mere allegation of finding something useful, the ability of the party to generate equivalent information by other means, and whether the discovery requests are easily understandable and not overly burdensome to answer. *Bloomberg Inc. et al. v. Markets-Alert PTY LTD.*, CBM2013-00005, Paper 32 at 5 (May 29, 2013); *see also Garmin International, Inc. et al. v. Cuozzo Speed Technologies LLC*, IPR2012-00001, Paper 26 at 6-7 (Mar. 5, 2013) (setting forth factors considered in deciding a motion for additional discovery in *inter partes* review).

Versata avers that Dr. Siegel's testimony about the operation and use of the R/3 version 2.2C software relies on the actual software product and does not provide any citation or support from the R/3 Documentation. Mot. 1 (citing Ex. 1007 ¶¶ 88, 90-96, 103, 105, 113, 122, 141, and 146). For example, Versata cites seven paragraphs of Dr. Siegel's testimony that contain no citations to R/3 Documentation, aside from two general references to R3 Documentation that lack specific citations. Mot. 2-4.

We disagree with Versata's argument that the actual software product (R/3 version 2.2C) is relevant to the grounds upon which the trial has been instituted. *See* Mot. 5. Versata's evidence that Dr. Siegel's testimony relied on the actual R/3 version 2.2C product is based on the absence of references

to the R/3 Documentation. *See* Mot. 2-4. However, SAP's petition challenges the '400 patent under 35 U.S.C. § 102 as anticipated by the R/3 Documentation, which accompanied SAP's R/3 2.2C, not the actual software product. *See* Petition 21-36 (Paper 5).

Although Dr. Siegel's testimony does not provide citations to the R/3 Documentation, we are not persuaded that the absence of citations indicates that his testimony is supported by the actual operation of the software. Versata's reliance on Manual of Patent Examining Procedure § 2131.01 and *In re Baxter Travenol Labs.*, 952 F.2d 388 (Fed. Cir. 1991) is misplaced. The MPEP discuss the appropriate use of more than one reference in a 35 U.S.C. § 102 rejection. *In re Baxter* holds that one such use of multiple references is to "explain, but not expand, the meaning of a reference" as understood by a person of ordinary skill in the art. 952 F.2d at 390. SAP's petition does not rely on multiple references, but instead relies on the R/3 Documentation as anticipating the claims at issue in the '400 patent. *See* Petition 21-36 (Paper 5).

Versata failed to provide persuasive evidence or argument that Dr. Siegel relied on the actual SAP R/3 version 2.2C software product to explain the terms used in the R/3 Documentation. Mot. 5 (stating that R/3 software product would explain the meaning of terms "conditional technique" and "access sequence" as used in R/3 Documentation). Versata's allegations that Dr. Siegel relied tacitly or implicitly on the R/3 version 2.2C software product is not supported by the record. As SAP avers, Dr. Siegel's testimony states that he never accessed or reviewed the software product in

preparing his testimony. Opp. 3. Indeed, Appendix B of Ex. 1007 provides the list of documents and things considered by Dr. Siegel that form the basis of his opinion. Ex. 1007 ¶ 15.

We are not convinced that access to test the R/3 version 2.2C software product is required for Versata to evaluate the testimony of Dr. Siegel and cross-examine him regarding the basis for his opinions. *See* Mot. 5. Without access to the software product, Versata will be able to fully determine the extent that Dr. Siegel's opinions are not adequately supported by the R/3 Documentation (Ex. 1018) or rely on extrinsic evidence based on the actual software product.

II. ORDER

Accordingly, it is

ORDERED that Versata's motion for additional discovery is *denied*.

CBM 2013-00042
Patent 5,878,400

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