

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, 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 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

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On March 27, 2014, the initial conference call² was held involving counsel for the respective parties and Judges Blankenship, Medley and Turner.

Patent Owner Motion to Amend

Patent Owner intends to file a motion to amend in all three cases. Counsel for Patent Owner indicated that he was familiar with the requirements for a motion to amend. The Board directed attention to CBM2013-00017 and CBM2013-00018 for further guidance regarding motions to amend. *See, e.g.*, CBM2013-00017, Papers 19 and 24. The parties also are directed to the following orders and decisions: *Nichia Corporation v. Emcore Corporation*, IPR2012-00005, Paper 27 (June 3, 2013) and Paper 68 (February 11, 2014); *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 (June 11, 2013) and Paper 66 (January 7, 2014); and *ZTE Corporation and ZTE (USA) Inc. v. Contentguard Holdings Inc.*, IPR2013-00136, Paper 33 (November 7, 2013). Should either party have questions regarding a motion to amend, the party may initiate a conference call with opposing counsel and the Board to discuss.

Supplemental Information for CBM2013-00053 and -00054

Petitioner seeks authorization to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.223(c). Specifically, Petitioner seeks to

² The initial conference call is held to discuss the Scheduling Order and any motions that the parties anticipate filing during the trial. Office Patent Trial

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submit challenges to dependent claims of U.S. Patent No. 7,958,024 in CBM2013-00053 and dependent claims of U.S. Patent No. 7,908,304 in CBM2013-00054; claims that are not involved in either case. A party seeking to submit supplemental information not relevant to a claim for which the trial has been instituted must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice. 37 C.F.R. § 42.223(c).

Based on the facts presented, the Board has determined that considering the supplemental information in either CBM2013-00053 or CBM2013-00054 would not be in the interests-of-justice. As explained, considering such issues in either case would amount to having a trial within a trial. Specifically, a motion challenging multiple dependent claims, not involved in the trial would require briefing by the Petitioner, an opposition by the Patent Owner, and a reply by Petitioner. Moreover, there would need to be time to allow for cross-examination of any witness providing testimony as to the issues raised. All of this would impact the current schedule, and would not lead to a just, speedy, and inexpensive proceeding pursuant to 37 C.F.R. § 42.1(b). As further explained, Petitioner is not without recourse. Petitioner may file additional petitions raising the additional issues against additional claims. For all of these reasons, Petitioner is not authorized to file a motion to submit supplemental information.

Practice Guide, 77 Fed. Reg. 48756, 48765 (Aug. 14, 2012).

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Schedule

Petitioner requests authorization to file a motion to expedite times in all three cases. Patent Owner opposes. The Board considered the merits of the arguments during the conference call.

Petitioner requests that the Board expedite Due Dates 1-7. Patent Owner requests that the Due Dates remain unchanged, as they already have been somewhat shortened, and Patent Owner needs the allotted time. The sole issue for each trial is whether claims of the respective patent are unpatentable under 35 U.S.C. § 101. As such, a schedule of due dates that focused on the sole issue was set by the Board. Based on the facts presented during the conference call, the Board was not persuaded to change the current schedule. Specifically, the Board has determined that in order to resolve the proceedings in a speedy, yet just manner, the current schedule for each proceeding strikes a balance between the competing interests of the parties. 37 C.F.R. § 42.1(b). The parties were reminded that they may stipulate different dates for Due Dates 1 through 3. The parties were encouraged to consider doing so. The Board would consider expediting Due Dates 4-7 if the parties agreed upon an expedited schedule for Due Dates 1-3. For all of the above reasons,

It is

ORDERED that Petitioner's request to file a motion to submit supplemental information in CBM2013-00053 and CBM2013-00054 is *denied*; and

FURTHER ORDERED that Petitioner's request that the Board expedite Due Dates 1-7 in each proceeding is *denied*.

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PETITIONER:

Deborah Fishman
fishmand@dicksteinshapiro.com

Jeffrey Miller
millerj@dicksteinshapiro.com

PATENT OWNER:

Kent Chambers
kchambers@tcchlaw.com

Alisa Lipski
alipski@azalaw.com

David O'Brien
david.obrien.ipr@haynesboone.com