

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FORD MOTOR COMPANY  
Petitioner

v.

VERSATA DEVELOPMENT GROUP, INC.  
Patent Owner

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Case CBM2016-00101  
Patent No. 7,739,080

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**VERSATA'S SUR-REPLY TO FORD'S PRELIMINARY REPLY**

***Mail Stop "PATENT BOARD"***  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Despite originally only arguing in its petition that the '080 patent claims are “incidental or complementary” to a financial product or service, Ford provides additional briefing in an attempt to recast the claimed recitation of “a product” as finance-related activity. But Ford’s arguments still fail, by placing undue significance on an example specification embodiment rather than the claims themselves, and seeking broad applicability of CBM review based only on cases that existed prior to *Unwired Planet* while ignoring post-*Unwired Planet* decisions.

Ford argues that the recitation of “a product” in several claims of the '080 patent relates to financial services (*see* Ford Prelim. Reply, p. 2), and thus are directed to finance-related activities. But Ford’s premise, that the *claims* recite financial services, is unsupported by the metes and bounds of the claims themselves, or by any testimonial evidence. The specification gives exemplary applications of the '080 disclosure “to a wide range of industries,” with financial services being only one example among several, including construction, professional services, and manufacturing across various industries. ('080 patent, 18:3-9.) As said in *Unwired Planet*, “it cannot be the case that a patent covering a method and corresponding apparatuses becomes a CBM patent because its practice could involve a potential sale of a good or service.” *Unwired Planet*, No. 2015-1812, slip op. at 12.

Here, as in *Unwired Planet*, the claims are industry-agnostic at heart, and

this weak connection to finance-related activities is insufficient in a post-*Unwired Planet* CBM proceeding. The weakness of Ford's argument is evident in Ford's failure to address the standard in view of any decisions applying *Unwired Planet*, including the facts of *Unwired Planet* itself. These decisions are, so far, unequivocally unfavorable to Ford and fatal to its position. The '080 patent claims at best *could* involve financial services -- in specific embodiments of the claimed inventions. But this unduly myopic restriction is neither a requirement of the claims nor in any way central to the functioning of the claims.

Further, Ford's comparison of the *Volusion* and '080 patent specifications, rather than their claims, must be of no moment here. The *Volusion* claims bear no resemblance to the '080 patent claims. And, the Board is not bound by pre-*Unwired Planet*, non-precedential panel decisions. In any event, the *Volusion* claims would arguably have been found not CBM-eligible had the reasoning of *Unwired Planet* been applied. Ford's citation in this regard to such a non-authoritative case is purely conclusory. Of far more import is the Board's treatment of CBM eligibility since the November 21, 2016 decision in *Unwired Planet*<sup>1</sup>, denying institution in *T-Mobile v. Intellectual Ventures II*, CBM2016-00083; *Kayak v. IBM*, CBM2016-00077 and -00078; and *Facebook v. Skky*, CBM2016-

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<sup>1</sup> Ford's analysis of *Volusion* in view of the *Unwired Planet* decision opens the door to further consideration of the full state of the case law.

00091.<sup>2</sup>

In particular, in *Kayak* the petitioner argued that claims directed to “[a] method for presenting interactive applications” and “generating at least a first partition for presenting applications” are “limited to financial contexts because the recited ‘applications’ can be financial in nature.” *Kayak* -00077, Paper 15 at p. 12. But in denying institution, the Board found that the record supported several non-financial applications. *Id.* The parallel to the ’080 patent’s embodiments is direct.

Additionally, Ford’s statement that “Patent Owner’s Petition [sic] ... did ‘not address the explicit statement in the [’080] patent concerning ‘financial services’ that was pointed out in the Petition” is a misrepresentation (*see, e.g.*, POPR, pp. 8 and 12-13). This language was fully addressed with regard to *Unwired Planet*.

Ford’s analysis therefore fails to show how the industry-agnostic claims of the ’080 patent fall within the statute, and therefore institution must be denied.

Date: January 25, 2017

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<sup>2</sup> CBM review was instituted in three post-*Unwired Planet* cases. These are the two *Plaid Techs. v. Yodlee* decisions at CBM2016-00088 and -00089 (explicit claim to “financial transaction” / “amount of the transaction”) and *Emerson v. Sipco*, CBM2016-00095 (explicit claim to “ATM” / “vending machine”).

**CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))**

The undersigned hereby certifies that a true and correct copy of the enclosed **VERSATA'S SUR-REPLY TO FORD'S PRELIMINARY REPLY** was served electronically via e-mail on January 25, 2017 in its entirety on the following counsel of record for Petitioner:

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