UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA INC. AND SAP AG

Petitioner,

v.

VERSATA DEVELOPMENT GROUP INC.

Patent Owner.

Case CBM2012-00001 (MPT)

Patent 6,553,350

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

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PETITIONER SAP'S SUBMISSION OF EXHIBITS REGARDING DISTRICT COURT PROTECTIVE ORDER

In reply to the Board's November 1, 2012, Order [Paper No. 16], and Patent

Owner's November 2, 2012, Filing of Exhibits in response to that order [Paper

No. 17], Petitioners SAP America Inc. and SAP AG (collectively "SAP") hereby

submit copies of the following documents relating to the protective order entered

in the underlying district court litigation:

- Memorandum Opinion and Order (Dkt. No. 572), Versata Software, Inc. et al. v. SAP America, Inc. et al., No. 2:07-cv-153 (E.D. TX) (see pp. 1, 13, discussing violations of the Court's Protective Order) [SAP Exhibit 1022];
- Highlighted version of SAP Exhibit 1022, Memorandum Opinion and Order (Dkt. No. 572), Versata Software, Inc. et al. v. SAP America, Inc. et al., No. 2:07-cv-153 (E.D. TX) (see pp. 1, 13, discussing violations of the Court's Protective Order) [SAP Exhibit 1023];
- Redacted Transcript of May 14, 2009, Motions Hearing, Versata Software, Inc. et al. v. SAP America, Inc. et al., No. 2:07-cv-153 (E.D. TX) (see pp. 39-81, addressing violations of the Court's Protective Order) [SAP Exhibit 1024];
- Highlighted version of SAP Exhibit 1024, Redacted Transcript of May 14, 2009, Motions Hearing, Versata Software, Inc. et al. v. SAP America, Inc. et al., No. 2:07-cv-153 (E.D. TX) (see highlighted portions on pp. 39-81, addressing violations of the Court's Protective Order) [SAP Exhibit 1025];
- 5. Order Granting Plaintiff's Unopposed Motion to Redact May 14, 2009 Hearing Transcript, *Versata Software, Inc. et al. v. SAP America, Inc. et al.*, No. 2:07-cv-153 (E.D. TX) [SAP Exhibit 1026];
- 6. Civil Docket Report for Versata Software, Inc. et al. v. SAP America, Inc. et al., No. 2:07-cv-153 (E.D. TX) [SAP Exhibit 1027]; and
- ORDER Setting Hearing on Motion for Protective Order (Dkt. No. 157), Versata Software, Inc. et al. v. SAP America, Inc. et al., No. 2:07-cv-153 (E.D. TX) [SAP Exhibit 1028].

SAP also identifies the following sealed docket entries relating to protective

order issues in the district court case:¹

- 1. 02/19/2009 Sealed SAP's Motion to Strike Versata's Equitable Claims as Sanction for Versata's Violation of the March 6, 2008 Protective Order and February 26, 2008 Order (Dkt. No. 144);
- 03/03/2009 Sealed Response in Opposition to SAP'S Motion to Strike Versata's Equitable Claims, filed by Versata Software, Inc (Dkt. No. 159);
- 03/10/2009 Sealed Reply in Support of SAP's Motion to Strike Versata's Equitable Claims, filed by SAP America, Inc., SAP AG (Dkt. No. 166);
- 4. 03/17/2009 Sealed Sur-Reply to SAP's Reply to Response to SAP'S Motion to Strike Versata's Equitable Claims, filed by Versata Software, Inc., (Dkt. No. 173)
- 5. 07/16/2009 Sealed Supplemental Sur-Reply to Reply to Response to SAP'S Motion to Strike Versata's Equitable Claims, filed by Versata Software, Inc. (Dkt. No. 235); and
- 07/17/2009 Sur-Reply to Reply to Response to SAP'S Motion to Strike Versata's Equitable Claims, filed by SAP America, Inc., SAP AG. (Dkt. No. 244).

Regarding Section I.c of the Board's Order, Versata's offer not to amend its

claims does not allay SAP's concerns regarding participation by Versata's lead

trial counsel in this proceeding. It is well established that, with or without a formal

amendment, statements and arguments made during post-grant proceeding can

change the meaning of a claim term, and thus scope of that claim. See Marine

¹ Copies are not provided because of the sealed nature of the documents.

Polymer Technologies, Inc. v. Hemcon, Inc. 672 F.3d 1350, 1363-64 (Fed. Cir.

2012) (en banc); Am. Piledriving Equip., Inc. v. Geoquip, Inc., 637 F.3d 1324,

1336 (Fed.Cir.2011); CIAS, Inc. v. Alliance Gaming Corp., 504 F.3d 1356, 1362-

63 (Fed.Cir.2007). Thus, even if Versata does not amend its claims, Mr. Cole can

still influence the scope of Versata's claims through his participation in this

proceeding.

Respectfully submitted,

Dated: November 5, 2012

By: /Joseph E. Palys/ Erika H. Arner, Lead Counsel Joseph E. Palys Michael V. Young, Sr. FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P. 11955 Freedom Drive Reston, VA 20190

Attorneys for Petitioners SAP America, Inc. and SAP AG

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing PETITIONER SAP'S

SUBMISSION OF EXHIBITS REGARDING DISTRICT COURT PROTECTIVE

ORDER and PETITIONER SAP'S EXHIBIT LIST was served on

November 5, 2012, to Nancy J. Linck and Martin M. Zoltick, Lead and Back-up

Counsel for Versata, respectively, at the service e-mail address of

VERSATA-PGR@rfem.com provided in Versata's Mandatory Notices. The

parties have agreed to electronic service.

/Larry White/ Larry White

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.