Trials@uspto.gov
571.272.7822

Paper 11
Entered: September 27, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY,
Petitioner,

v.

VERSATA DEVELOPMENT GROUP, INC.,
Patent Owner.

Case IPR2016-01014
Patent 5,825,651

Before HOWARD B. BLANKENSHIP, JAMES B. ARPIN, and WILLIAM M. FINK, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION
Denying *Inter Partes* Review
37 C.F.R. § 42.108

I. BACKGROUND

Ford Motor Company ("Petitioner") requests an *inter partes* review of claims 60–72 of U.S. Patent No. 5,825,651 (Ex. 1001, "the '651 patent") under 35 U.S.C. §§ 311–319. Paper 2 ("Petition" or "Pet."). Versata Development Group, Inc. ("Patent Owner") has filed a Preliminary Response. Paper 10 ("Prelim. Resp.").

We have jurisdiction under 35 U.S.C. § 314. Section 314(a) provides that an *inter partes* review may not be instituted unless "the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

For the reasons that follow, we do not institute an *inter partes* review of any of claims 60–72 of the '651 patent.

A. Related Proceedings

The parties report that the '651 patent is involved in *Ford Motor Company v. Versata Software, Inc.*, No. 2:15-cv-10628-MFL-EAS (E.D. Mich. 2015).[1] Pet. vi; Paper 5, 1. Petitioner reports also that the '651 patent was asserted against Petitioner in another District Court action, but the case was dismissed without prejudice. Pet. vi–vii.

---

[1] We presume the validity of the claims of the '651 patent was not challenged in the initial complaint. *See* 35 U.S.C. §§ 315(a)(1) ("An inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent."), 315(a)(3) ("A counterclaim challenging the validity of a claim of a patent does not constitute a civil action challenging the validity of a claim of a patent for purposes of this subsection.").

B. The '651 Patent

The '651 patent has an effective filing date of September 3, 1996. Ex. 1001, at [22]. Petitioner does not challenge this claim to priority in its Petition (*see* Pet. iii, 3–7), and Patent Owner does not suggest a different priority date in its Preliminary Response (*see* Prelim. Resp. 2–3).

C. Asserted Art

Petitioner relies upon the following references in support of its grounds for challenging the identified claims of the '651 patent:

Exhibit No.	Reference
1004	Tomas Axling et al., *A Tool For Developing Interactive Configuration Applications*, THE JOURNAL OF LOGIC PROGRAMMING, Vol. 19, 658–79[2] (1994) ("Axling")
1005	S.M. Fohn et al., *Configuring Computer Systems Through Constraint-Based Modeling and Interactive Constraint Satisfaction*, COMPUTERS IN INDUSTRY, Vol. 27, Issue 1, 3–21 (Sept. 1995) ("Fohn")
1010	H.J. Skovgaard, *A New Approach to Product Configuration*, Third International Conference icle, '95, Concurrent Engineering &Technical Information Processing, January 30 – February 3, 1995
1015	H.G. Baker, *Efficient Implementation of Bit-Vector Operation in Common Lisp*, ACM SIGPLAN Lisp Pointers 3, No. 2-4 1990

Pet. iii–iv.

D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability under 35 U.S.C. § 103(a) against claims 60–72:

[2] Petitioner asserts that Axling appears on pages 658–79 of Volume 19 of The Journal of Logic Programming. Pet. ii. Nevertheless, these page

Ground	Claim(s)	References
35 U.S.C. § 103(a)	60–62, 64–68, and 70–71	Axling, Fohn, and the general knowledge of a person of ordinary skill in the art
35 U.S.C. § 103(a)	63 and 69	Axling, Fohn, Skovgaard 1995, and Baker
35 U.S.C. § 103(a)	72	Axling, Fohn, and Skovgaard 1995

Pet. 2.

II. ANALYSIS

A. Prior Art Status of Axling

Petitioner argues that "Axling was published in the Journal of Logic Programming publication in 1994 and qualifies as prior art under 35 U.S.C. § 102(a) and (b). (Ex. 1004 [Axling].)" Pet. 1. In its Preliminary Response, Patent Owner contests that Axling is a prior art "printed publication" in accordance with 35 U.S.C. §§ 102 and 311(b). Prelim. Resp. 2–3, 41–45. We look to the underlying facts to make a legal determination as to whether a document is a printed publication. *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014). "The determination of whether a document is a 'printed publication' under 35 U.S.C. § 102(b) involves a case-by-case inquiry into the facts and circumstances surrounding its disclosure to members of the public." *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004) (citations omitted). Public accessibility is a key question in determining whether a document is a printed publication and is determined on a case-by-case basis. *Suffolk Techs.*, 752 F.3d at 1364. To

---

numbers do not appear on Exhibit 1004. Instead, Exhibit 1004 bears page numbers 1–22.

qualify as a printed publication, a document "must have been sufficiently accessible to the public interested in the art." *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009) (citations omitted).

Petitioner alleges that Axling appears in the Journal of Logic Programming, Volume 19, at pages 658 through 679, dated 1994. Pet. iii. According to Petitioner, "Axling was published in the Journal of Logic Programming publication in 1994 and qualifies as prior art under 35 U.S.C. [§§] 102(a) and (b)." *Id.* at 1; *see also* Ex. 1002 (Declaration of Dr. Philip Greenspun), 24 n.2 ("Ex. 1004 [Axling] is a true and accurate copy of: T. Axling, S. Haridi, A Tool For Developing Interactive Configuration Applications, The Journal of Logic Programming, Volume 19, 658-679 (1994).") (alteration in original).

Patent Owner argues that "the Axling article does not exist in the identified publication." Prelim. Resp. 43. Patent Owner submits, as Exhibit 2007, the *entire* Volume 19 of The Journal of Logic Programming, published in 1994. *Id.* at 44; Ex. 2007. Patent Owner contends that the Axling article is not contained in the 719 pages of Volumes 19 and 20, as revealed by the Volumes' table of contents. Prelim. Resp. 44; Ex. 2007 (Part 1 of 12), 5–6.[3] Consistent with Patent Owner's contention, we do not find the Axling article listed in the Table of Contents contained in Exhibit 2007, which purports to be a copy of The Journal of Logic Programming, Volumes 19 and 20, May and July 1994. Ex. 2007 (Part 1 of 12), 5–6. We observe, further, that although Petitioner alleges that the Axling article

[3] According to Exhibit 2007, Volumes 19 and 20 of The Journal of Logic Programming were published as a double volume. Ex. 2007, 7.

begins at page 658 of Volume 19 of the Journal (*e.g.*, Pet. ii), page 658 of the Journal as reproduced in Exhibit 2007 appears to be part of an article concerning inductive logic programming, authored by Stephen Muggleton and Luc De Raedt. *Id.* at 6.

Patent Owner notes, further, that the printed header of Petitioner's Exhibit 1004 is "problematic" not only because it purports to show that Axling is contained in Volumes 19/20 of The Journal of Logic Programming, but also because it purports to show that the article appears at pages 1 through 679, though the article is only 22 pages long. Prelim. Resp. 43; Ex. 1004, 1 ("J. LOGIC PROGRAMMING 1994:19, 20:*1–679*" (emphasis added)). We agree and note, in addition, that, although Axling as represented in Exhibit 1004 purports to be contained in a paginated journal (Petitioner alleges at pages 658 through 679 (Pet. iii)), the pages of the Exhibit 1004 article are numbered (at the top of each page) as pages 1 through 22. *See supra* note 2.

Petitioner's Axling article contains the notation "*THE JOURNAL OF LOGIC PROGRAMMING*" followed by "© Elsevier Science Inc., 1994." Ex. 1004, 1. Patent Owner submits that the copyright date printed on Axling cannot be relied upon to establish its purported publication date. Prelim. Resp. 44–45. We acknowledge that some panels of the Board have determined that a copyright notice is hearsay while other panels have relied on such a notice as probative evidence of publication. *See, e.g.*, *Int'l Bus. Mach's Corp. v. Intellectual Ventures II LLC*, IPR2014-00681, slip op. at 13–14 (PTAB Oct. 30, 2014) (Paper 11) (copyright date sufficient for threshold showing that document is a printed publication); *FLIR Systems, Inc. v. Leak Surveys, Inc.*, IPR2014-00411, slip op. at 18–19 (PTAB Sept. 5,

2014) (Paper 9) (copyright notice establishes prima facie prior art date); *ServiceNow, Inc. v. Hewlett-Packard Co.*, Case IPR2015-00707, slip op. at 9–10 (PTAB Nov. 2, 2015) (Paper 14) (copyright notice entitled to no greater weight than hearsay in determining public accessibility). For purposes of this Decision, however, we need not determine the weight to be accorded a copyright notice, standing alone. As we have discussed, Petitioner's evidence of publication, considered as a whole, is insufficient to persuade us of Axling's publication given that Patent Owner's countervailing evidence tends to show that Axling was not *published* in the manner alleged by Petitioner. Specifically, Patent Owner has provided persuasive evidence that, contrary to Petitioner's allegation and Axling's header on its initial page, Axling was not published in Volume 19 (or Volumes 19/20) of The Journal of Logic Programming.

In view of the foregoing, we conclude that, on this record, Petitioner has failed to meet its burden of showing a reasonable likelihood that Axling (Ex. 1004) is a printed publication, as contemplated by 35 U.S.C. §§ 102 and 311(b).[4]

B. Asserted Grounds of Unpatentability

Because Petitioner has not made a satisfactory threshold showing that Axling is a prior art printed publication, the Petition fails to demonstrate a reasonable likelihood of prevailing on the ground that the subject matter of

[4] Because we determine that Petitioner fails to show that Axling is a printed publication, as contemplated by 35 U.S.C. §§ 102 and 311(b), we do not reach Patent Owner's other contentions regarding deficiencies in the Petition.

claims 60–72 would have been obvious over Axling and Fohn, alone or in combination with other references.

III. CONCLUSION

The Petition fails to demonstrate a reasonable likelihood of prevailing on the asserted ground that the challenged claims are unpatentable under 35 U.S.C. § 103(a) over the combination of Axling and Fohn, alone or in combination with other references.

IV. ORDER

It is

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted.

PETITIONER:

John S. LeRoy
Thomas A. Lewry
Frank A. Angileri
John P. Rondini
Christopher C. Smith
Jonathan D. Nikkila
BROOKS KUSHMAN P.C.
FPGP0126IPR1@brookskushman.com

PATENT OWNER:

Robert Green Sterne
Salvador M. Bezos
Joseph E. Mutschelknaus
Jonathan Tuminaro
STERN, KESSLER, GOLDSTEIN & FOX PLLC
rsterne-PTAB@skgf.com
sbezos-PTAB@skgf.com
jmustche-PTAB@skgf.com
jtuminar-PTAB@skgf.com

Kent B. Chambers
TERRILE, CANNATTI, CHAMBERS & HOLLAND, LLP
kchambers@tcchlaw.com

Sharoon Saleem
JONES & SPROSS, PLLC
sharoon.saleem@jonesspross.com