

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CONFIGIT A/S,
Petitioner,

v.

VERSATA DEVELOPMENT GROUP, INC.,
Patent Owner.

IPR2021-01055
Patent 6,836,766 B1

Before SALLY C. MEDLEY, KEVIN F. TURNER, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background*

Configit A/S (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claims 1–5 and 9–19 of U.S. Patent No. 6,836,766 B1 (Ex. 1001, “the ’766 Patent”). Versata Development Group, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Further to our authorization, both parties submitted additional filings, directed to the issues of public availability of certain references, as discussed below. (Petitioner’s Reply to Patent Owner’s Preliminary Response (Paper 9, “Pet. Reply”); Patent Owner’s Sur-Reply to Petitioner’s Reply (Paper 10, “PO Sur-Reply”).

An *inter partes* review may be instituted only if “the information presented in the petition . . . and any [preliminary] response . . . 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.” 35 U.S.C. § 314(a) (2018). For the reasons given below, Petitioner has established a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims of the ’766 Patent. Accordingly, we institute an *inter partes* review of claims 1–5 and 9–19 of the ’766 Patent on the grounds of unpatentability raised in the Petition.

B. *Related Proceedings*

Both parties identify the following judicial or administrative matter that would affect, or be affected by, a decision in this proceeding: *Versata Software, Inc. et al v. Configit A/S*, Case No. 2:20-cv09019 (C.D. Cal.). Pet. 74; Paper 4, 1.

C. The '766 Patent

The '766 Patent is titled “Rule Based Configuration Engine for a Database,” and is asserted to “provide[] the ability to test rules in a rule-based system for configuring a product.” Ex. 1001, code (54), Abs. With respect to the prior art, the '766 Patent describes “configuring systems” or “configuration engines,” which allow a user to configure a product by interactively selecting components from various groups based on availability and compatibility of features and options. *Id.* at 1:13–17. It also details that the configured product “might consist of several hundred individual parts” that might be available on multiple products, and that:

A product is modeled by describing which parts and part groups are available in that product and which choices must be made from within the part groups, and then by writing additional rules that describe part-to-part relationships which are not modeled by the product structure.

Id. at 1:27–33. Thereafter, a compiler converts the product structure and rules into “rule types,” where “there might be several hundred, several thousand, or even more of these rules.” *Id.* at 1:34–42. Based on selections by the client, the parts that are selected or included are “selected,” or “not selectable,” if they have been excluded or deleted. *Id.* at 1:41–53.

The '766 Patent also details that “configuration errors may occur when a rule or series of rules is not properly defined and produces an undesired effect,” and can also occur when a series of improperly defined rules causes a part to be in more than one state at the same time. Ex. 1001, 1:54–61. It also details that for large models, such errors may be difficult to find and it is desirable to have “an automated testing tool to locate and analyze configuration errors.” *Id.* at 1:62–67.

The '766 Patent discloses its approach to debugging configuration errors of a configurator, wherein the “user provides test cases that select at least one part to include in the product configuration,” and thereafter, the “configuration tester processes the rule to determine whether” the configuration choice in the test case “conflicts with the plurality of parts” in the configurator. Ex. 1001, 2:7–11. The '766 Patent also summarizes multiple features and embodiments (*id.* at 2:12–3:29), but ultimately asserts that “these embodiments and variations are illustrative and the invention is not to be considered limited in scope to these embodiments and variations.” *Id.* at 12:22–25.

D. Challenged Claims

Claim 1 is the sole independent claim challenged in this proceeding, with each of challenged claims 2–5 and 9–19 dependent thereon, directly or indirectly, and is reproduced below:

1. [1.pre] A method of using a computer system to test a product configuration for configuration errors, wherein the product configuration is stored as electronic data in a computer system for generating product configurations, the computer system including at least one rule defining a relationship between at least two parts, the product configuration including a plurality of parts, the method comprising:

[1.1] entering a test case into the computer system to detect configuration errors in the product configuration, wherein the test case includes data to change the product configuration;

[1.2] processing the test case with the computer system in accordance with the at least one rule to detect whether the change in the product configuration, as a result of processing the test case in accordance with the at least one rule, produced a configuration error in the product configuration; and

[1.3] generating explanation data with the computer system to provide an explanation of any detected configuration error in the product configuration.

Ex. 1001, 12:30–50 (with annotations provided by Petitioner, Pet. 14–23).

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 1, 12–71), supported by the declaration of Dr. Kristin L. Wood (Ex. 1002):

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1, 9, 10, 14, 19	103(a) ¹	Oracle1, ² Oracle2, ³
15, 16	103(a)	Oracle1, Oracle2, SalesPlus ⁴
11–13, 17	103(a)	Oracle1, Oracle2, SalesPlus, Yu ⁵
2, 18	103(a)	Oracle1, Oracle2, Memon ⁶
3–5	103(a)	Oracle1, Oracle2, Memon, SalesPlus

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent claims priority to an application filed before March 16, 2013, we refer to the pre-AIA version of § 103.

² Oracle® Configurator Developer, User’s Guide, Release 11i for Windows 95/98 and Windows NT 4.0, April 2000 (Ex. 1003, “Oracle1”).

³ Oracle® Configurator, Oracle Configuration Interface Object (CIO) Developer’s Guide, Release 11i, March 2000 (Ex. 1004, “Oracle2”).

⁴ Beologic A/S Reference Guide for the Beologic® salesPLUS™ Product Configurator, C language API, Version 2.0, 1995 (Ex. 1005, “SalesPlus”).

⁵ Bei Yu et al., “A configuration tool to increase product competitiveness,” IEEE Intelligent Systems and their Applications, vol. 13, no. 4, pp. 34-41, July-Aug. 1998 (Ex. 1006, “Yu”).

⁶ Atif M. Memon et al., “Automated Test Oracles for GUIs,” Proceedings of the 8th Int’l Symp. on the Found. of Software Engineering (FSE-8), San Diego, CA, Nov. 6, 2000 (Ex. 1007, “Memon”).

Patent Owner's Preliminary Response is supplemented by a declaration of Paul A. Navrátil, Ph.D. (Ex. 2001).

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Petitioner, supported by Dr. Wood's testimony, proposes that a person of ordinary skill in the art at the time of the invention would have had "a Bachelor's degree in Computer Science, Computer or Electrical Engineering, Engineering Science, an engineering major with a significant computational component, or a similar discipline, or with at least two years of research or experience in configurable systems including testing." Pet. 8 (citing Ex. 1003 ¶¶ 53–55). Patent Owner argues that "[t]here may be some differences between this and the correct level of skill in the art but those differences will not affect this case at this stage," such that Patent Owner applies the proposed level of skill in the art without agreeing to it. Prelim. Resp. 10 (citing Ex. 2001 ¶¶ 35–37).

At this stage of the proceeding, we find Petitioner's proposal consistent with the level of ordinary skill in the art reflected by the prior art of record, *see Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978), and, therefore, we adopt Petitioner's unopposed position as to the level of ordinary skill in the art for purposes of this decision.

B. Claim Construction

In this *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b) (2020). The

claim construction standard includes construing claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art at the time of the invention. *See id.*; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc). In construing claims in accordance with their ordinary and customary meaning, we take into account the specification and prosecution history. *Phillips*, 415 F.3d at 1315–17.

Petitioner does not identify any claim elements that warrant express constructions, opting instead that “all terms should be accorded their ‘ordinary and customary meaning . . . as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.’” Pet. 11 (citing 37 C.F.R. § 42.100(b)). Patent Owner asserts that two claim elements should be construed expressly and provides constructions and arguments relating to their adoption. Prelim. Resp. 10–16.

We consider each of Patent Owner’s proposed, express constructions below.

1. “configuration error”

With respect to the limitation “configuration error,” Patent Owner asserts that configuration error means “either (1) the condition that occurs when ‘a rule or series of rules is not properly defined and produces an undesired effect’ or (2) ‘a series of improperly defined rules causes a part to be in more than one state at the same time.’” Prelim. Resp. 10 (citing Ex. 1001, 1:54–61; Ex. 2001 ¶ 40). At this stage of the proceeding, we find that Patent Owner’s proposed construction is supported by the ’766 Patent specification, and adopt Patent Owner’s proposed meaning of “configuration

error,” with the following remarks with respect to Patent Owner’s additional arguments regarding the claim construction.

Patent Owner, however, also argues that “the specification concerns errors internal to the configuration engine and not ‘errors’ that prevent product configurator users from making their desired but impermissible selections.” Prelim. Resp. 10. We do not agree with Patent Owner’s argument because the first part of the construction, namely rules not being properly defined and “produc[ing] an undesired effect,” does not specify anything about an error being “internal” to the configuration engine. The specification provides that such a configuration error “may occur when a rule or series of rules is not properly defined and produces an undesired effect, *such as the exclusion of a part that should be selectable*” (Ex. 1001, 1:54–61, emphasis added), but the latter clause provides only one example of the undesired effect. We are not persuaded, based on our review of the Specification of the ’766 Patent that “an undesired effect” should be limited to the exclusion of a part. Thus, although Patent Owner argues that “a configuration error is *not* a condition that occurs when a user attempts to make a choice that is prohibited by a rule” (Prelim. Resp. 11 (citing Ex. 2001 ¶ 43)), at this juncture, we are not persuaded that such a condition would not be an undesired effect, according to the adopted construction. Therefore, we do not further limit the construction of “configuration error.”

2. “test case”

With respect to the limitation “test case,” Patent Owner asserts that the Specification of the ’766 Patent explicitly defines this limitation as “one or more (1) sets of selections that should be made and (2) sets of parts and their expected states based on new rules as well as rules previously included

in parts relations and product definitions.” Prelim. Resp. 13 (citing Ex. 1001, 7:64–8:1; Ex. 2001 ¶ 47). Patent Owner acknowledges that the definition was “raised in the context of the embodiment of Figure 3,” but asserts that those of skill in the art would have understood its explanation to be “definitional.” *Id.* at 14. Patent Owner also argues that claim differentiation supports its definition, as well as the prosecution history being consistent therewith. *Id.* at 14–16.

At this juncture, we do not agree with Patent Owner’s proposed construction. The section of the Specification of the ’766 Patent which Patent Owner refers to cite its explicit definition starts off with “FIG. 3 shows an embodiment of the present invention,” and refers to “test cases 306,” with respect to that embodiment. Ex. 1001, 7:56, 61. “Test cases” are also referenced with respect to the broader summary of invention. *See id.* at 2:1–3:29. As Petitioner points out, the Specification of the ’766 Patent provides that a user is allowed “to enter a test case, wherein the test case selects at least one part to include in the product configuration,” and that “a test case [] selects at least one part to include in the product configuration. Pet. 19 (citing Ex. 1001, 2:59–62, 17–19). Both citations make clear that the broad, but reasonable construction of “test case” is not as constrained as the construction proffered by Patent Owner. As such, according to the analysis below, we construe “test case” according to its ordinary and customary meaning.

3. *Other terms*

We determine that it is not necessary to provide an express interpretation of any other claim terms. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir.

2017); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

C. Legal Standards – Obviousness

The U.S. Supreme Court sets forth the framework for applying the statutory language of 35 U.S.C. § 103 in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966):

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

As explained by the Supreme Court in *KSR Int’l Co. v. Teleflex Inc.*,

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)).

“Whether an ordinarily skilled artisan would have been motivated to modify the teachings of a reference is a question of fact.” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1327 (Fed. Cir. 2016) (citations omitted). “[W]here a party argues a skilled artisan would have been motivated to combine references, it must show the artisan ‘would have had a reasonable expectation of success from doing so.’” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1360–61 (Fed. Cir. 2017) (quoting *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1068–69 (Fed. Cir. 2012)).

D. Obviousness over Oracle1 and Oracle2

Petitioner asserts that the combination of Oracle1 and Oracle2 would have rendered the subject matter of claims 1, 9, 10, 14, 19 obvious to one of ordinary skill in the art at the time of the invention. Pet. 12–32. Patent Owner argues that the asserted prior art references are not prior art to the ’766 Patent, and those references do not teach or suggest all elements of claim 1, and claims dependent thereon challenged in this ground. Prelim. Resp. 16–35. We begin with brief discussions of the cited references, whether Oracle1 and Oracle2 have been shown to be prior art to the ’766 Patent, and then consider Petitioner’s arguments with respect to the references’ teachings applied to the instant claims as well as Patent Owner’s arguments asserting deficiencies in this ground of unpatentability.

1. Oracle1

Oracle1 is a manual for Oracle’s Configurator product, which discloses the configuring of products made up of components, or parts. Ex. 1003, 17. Oracle1 also provides that “[a] configurator enables end users to access the parts that make up your product and the rules that govern how

those parts go together. With a configurator, end users can generate any custom product configuration that the rules allow.” *Id.* Oracle1 describes implementation of a product configurator as a process including “defining test cases, designing the application, constructing and testing the application.” *Id.* at 143.

Oracle1 also provides a “Test/Debug” section wherein a user can test a model and the configuration rules to determine if errors are generated, where selected rules can be disabled to determine if any particular rule is cause of a problem. *Id.* at 95–99.

2. *Oracle2*

Oracle2 is a developer’s guide to Oracle’s Configuration Interface Object (CIO), which it indicates “is needed by developers of applications having customized user interfaces that need access to Oracle Configurator Active Model.” Ex. 1004, 13. Oracle2 details that CIO “is an API (application programming interface) that provides your programs access to the Model used by Oracle SellingPoint application, which you construct with Oracle Configurator Developer.” *Id.* at 37. With respect to related documents, Oracle2 cites to several related publications directed to Oracle Configurator Developer. *Id.* at 14. Oracle2 also provides a description of how product configurations are stored in a computer system. *Id.* at 42–43.

3. *Statuses of Oracle1 and Oracle2 as Prior Art to the ’766 Patent*

Patent Owner asserts that Oracle1 and Oracle2 are not prior art under 35 U.S.C. § 102(a) or (b). Prelim. Resp. 16–24. Patent Owner argues that the evidence presented by Petitioner in the Petition of the publication of Oracle1 and Oracle2 is contradictory and insufficient. *Id.* at 19–24.

Petitioner asserts “[t]he references below [i.e., Oracle 1 and Oracle 2] are prior art under at least 35 U.S.C. § 102(a) & (b) (pre-AIA) and were publicly accessible before the ’766 patent’s priority date of January 31, 2001.” Pet. 1; *see also id.* at 1–4 (discussing Oracle1 and Oracle2). Petitioner acknowledges that the ’766 Patent’s priority date is January 31, 2001 (*id.* at 2), and we discern no concrete assertions by Petitioner that Oracle1 and Oracle2 have publication dates or demonstrated public availability greater than one year prior to that priority date. Petitioner asserts that both were publicly accessible before the priority date, but does not establish a publication date of either reference as being January 31, 2000 or earlier. As such, we take Petitioner’s position to be that Oracle1 and Oracle2 are prior art to the instant patent under 35 U.S.C. § 102(a). To the extent that Petitioner continues to assert that Oracle1 and Oracle2 are prior art to the instant patent under 35 U.S.C. § 102(b), Petitioner has not provided sufficient evidence to demonstrate such a status by a reasonable likelihood for either publication.

Turning to Oracle1 and Oracle2’s status as prior art under § 102(a), we determine that Petitioner has sufficiently shown that those references were publicly available prior to the ’766 Patent’s priority date of January 31, 2001 for purposes of institution. *See* Pet. 2–4; Pet. Reply 1–5; Exs. 1003, 1004, 1008, 1009, 1016–1019. We respond to Patent Owner’s arguments and Petitioner’s counter arguments below.

Patent Owner argues that Petitioner has not shown an actual date of publication or public availability for Oracle1 and Oracle2 because there is no evidence of public availability before the critical date of January 31, 2001. Prelim. Resp. 17–18. Patent Owner further argues that the “evidence”

provided by Petitioner is contradictory and insufficient. *Id.* at 19–24. Petitioner disputes those arguments, arguing that the evidence of record shows that both Oracle1 and Oracle2 were publicly available prior to the critical date, that Petitioner need not prove a precise date of public accessibility, and that Patent Owner’s evidentiary objections are premature at this point in the proceeding. Pet. Reply 1–5. Patent Owner reiterates that “there is no evidence categorically showing that [Oracle1 and Oracle2] are prior art,” that Petitioner is trying to convert art under § 102(a) to art under § 102(b), and that Patent Owner does not object to the admissibility of Oracle1 and Oracle2, but rather disputes the sufficiency of proof submitted with the Petition. PO Sur-Reply 1.

We address the arguments of the parties in reverse-order. Patent Owner argues that the Declaration of Ms. Tina Brand (Ex. 1008) (testimony as to the availability of the Oracle references) and the exhibits it refers to as being “inadmissible hearsay” (Prelim. Resp. 21–23); this argument is at least couched in the form of evidentiary objections, asserting that “the Board should exclude” certain exhibits. *Id.* As Petitioner points out, 37 C.F.R. § 42.64 provides such an opportunity for patent owners to raise evidentiary objections after institution. Pet. Reply 5. We agree with Petitioner and determine that Patent Owner will have the opportunity to seek to have Ms. Brand’s Declaration and its relied-upon exhibits be excluded, and, if excluded, it may diminish the weight of evidence applied under the preponderance of the evidence standard. To the extent that Patent Owner is asking to exclude documents at this stage of the proceeding, we decline to take up such considerations.

With respect to Petitioner's argument that Petitioner need not prove a precise date of public accessibility, we disagree to the extent that Petitioner is arguing that it need only show public accessibility prior to the critical date of the '766 Patent. During the course of the ensuing trial, Patent Owner may submit evidence seeking to antedate one or both of Oracle1 and Oracle2, but without setting a date of publication for each, that would be impossible. We agree with Patent Owner that *In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986), cited by Petitioner (Pet. Reply 4), is applicable to art applied under § 102(b), where antedating such a reference is not possible. PO Sur-Reply 2–3. As discussed below, at this juncture, we determine that Petitioner has sufficiently shown that those references were publicly available prior to the '766 Patent's priority date of January 31, 2001 for purposes of institution. As such, we set a date of publication or public accessibility for each reference, in considering the evidence and arguments of accessibility below. Both parties will be able to submit evidence and/or arguments to alter those dates set or seek to antedate or exclude evidence during the course of the trial.

For a reference to qualify as a printed publication, “before the critical date the reference must have been sufficiently accessible to the public interested in the art.” *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568 (Fed. Cir. 1988). “When there is an established publisher there is a presumption of public accessibility as of the publication date.” *VidStream LLC v. Twitter, Inc.*, 981 F.3d 1060, 1065 (Fed. Cir. 2020); *see also Hulu, LLC v. Sound View Innovations, LLC*, Case IPR2018-01039, Paper 29 (PTAB Dec. 20, 2019) (precedential) (determining that, based on the totality of the evidence, a reference bearing a copyright date, a printing

date, and an ISBN date all earlier than the critical date of the challenged patent, and the reference was a “textbook from an established publisher” provided sufficient indicia at the institution state).

Turning to the evidence supplied, we have the Declaration of Ms. Tina Brand (Ex. 1008). Ms. Brand testifies that she is a co-author of Oracle1, that she is familiar with Oracle2, and that both Oracle1 and Oracle2 are part of Release 11i of the Oracle Product Documentation set. Ex. 1008 ¶¶ 6–8. She also testifies both references were publicly available in 2000, although she does not testify to a specific date of publication for either publication. *Id.* ¶¶ 9–20. The Declaration of Mr. Andrew Wolfe also testifies to the availability of Oracle1 and Oracle2 during 2000 (Ex. 1009 ¶¶ 10–13), and that PDF metadata for the files on Oracle’s website show that Oracle1 was created April 19, 2000 and Oracle2 was created March 19, 2000 (*id.* ¶¶ 5–8). These dates comport with the facially dated inscriptions on Oracle1 and Oracle2 of “April 2000” and “March 2000,” respectively, each bearing “Copyright © 1996, 2000.” Ex. 1003, 1–2; Ex. 1004, 1–2. Petitioner also supplies additional exhibits to demonstrate that Oracle1 and Oracle2 constitute prior art printed publications. Exs. 1016–1019.

Patent Owner argues that “no one knows when Oracle1 and Oracle2 were publicly available,” and that the “declarations render the date on the face of the document highly suspect.” Prelim. Resp. 19. Patent Owner also argues that Ms. Brand’s testimony, with its lack of specificity, undermines the facial dates on each, where she “could have testified to” those dates. Prelim. Resp. 20-21 (citing Ex. 1008 ¶¶ 6, 9–10, 13, 16, 18–20).

We determine that the evidence provided is sufficient at this stage of the proceeding to establish a reasonable likelihood that the references were

published as of the date on the face of the document. Although it might be preferable that a declarant provide precise information, we are not persuaded to draw negative inferences; we discern no testimony of Ms. Brand that undermines the overall disclosure of the evidence supplied with the Petition.

Patent Owner also argues that many of the exhibits referred to by the Brand Declaration are hearsay or are not authenticated. Prelim. Resp. 21–23. As discussed above, we are not considering evidentiary objections of any of the exhibits at this point in the proceeding.

Patent Owner also argues that the testimony of Mr. Wolfe does not support Petitioner’s arguments, and argues that the creation dates of Oracle1 and Oracle2 say “nothing about its publication date or its availability to the public.” Prelim. Resp. 23. At this juncture, we do not agree; rather, Mr. Wolfe testifies to his knowledge of the documents and their general availability (Ex. 1009 ¶¶ 10–13), which is additive to the testimony of Ms. Brand.

Looking at all of the evidence presented and taking the arguments of the parties into consideration, we determine that Petitioner has sufficiently shown that Oracle1 and Oracle2 were publicly available to serve as art under § 102(a) for purposes of institution. For purposes of the trial, based on the evidence presented, we determine that Petitioner has shown by a reasonable likelihood that the references were published at dates consistent with the evidence and testimony submitted, and we set a publication date for Oracle1 as April 30, 2000 and set a publication date for Oracle2 as March 31, 2000. As discussed above, both parties may seek to submit evidence and arguments to prove or alter those dates set or seek to antedate or exclude evidence during the course of the trial.

4. *Patent Owner's Arguments Regarding Differences Between Oracle1 and Oracle2 and Claim 1*

Patent Owner makes general arguments regarding Petitioner's use of Oracle1 and Oracle2, against the claims of the '766 Patent. Prelim. Resp. 1–4, 24–28. More specifically, Patent Owner argues that “[a]t the heart of the Petitioner's obviousness arguments is that prior art configuration engines allowed user testing and informed users if they ‘ma[d]e a selection that violate[d] a configuration rule.’” Prelim. Resp. 24 (citing Pet. 13). Patent Owner contrasts this by stating that the claims are directed to a “debugging and testing system.” *Id.* Patent Owner continues that Oracle1 and Oracle2 show the operation of a perfectly operating configurator with perfectly defined rules and don't involve any “configuration error” within the scope of the claims. *Id.* at 25. Patent Owner also argues that Oracle1 discusses disallowed choices not “configuration errors” within the meaning of the claim. *Id.* at 26. Patent Owner characterizes “configuration errors” of the claims as being “directed to state errors and exception errors that would be allowed, rather than prevented, by improperly defined rules.” *Id.* at 28. We do not agree with Patent Owner's arguments.

As discussed above, although we adopt Patent Owner's construction of “configuration error,” including “a rule or series of rules is not properly defined and produces an undesired effect,” we disagree with Patent Owner that a configuration error is not a condition that occurs when a user attempts to make a choice that is prohibited by a rule. We acknowledge the differences that Patent Owner is espousing, but we are not persuaded that those differences are differentiated by the claims of the '766 Patent. As discussed above, Oracle1 discloses that users can generate any custom product configuration, and can debug or test a model and the configuration

rules to determine if errors are generated, where selected rules can be disabled to determine if any particular rule is cause of a problem. We are persuaded that such behavior would result in “configuration error” that comports with the claim construction adopted.

Similarly, Patent Owner argues that:

In the disclosure of the ’766 patent, those of skill would understand “user” to be a configuration engineer using the invention to support product definition design and implementation rather than a configuration user who uses a given product definition outside the creation and maintenance process.

Prelim. Resp. 3-4 (citing Ex. 2001 ¶ 52⁷). Dr. Navrátil provides that “a configuration engineer may assume the role of a configuration user in order to specify input selections to validate a configuration model, but such model validation is not performed by end users otherwise uninvolved in the model development and maintenance process.” Ex. 2001 ¶ 50. We are not persuaded, however, that one of ordinary skill in the art in review of the ’766 Patent would arrive at the same conclusion. The word “engineer” appears nowhere in the Specification of the ’766 Patent, and the distinction between types of users is nowhere explicitly disclosed. The Specification discusses “valid” and “invalid” configurations (Ex. 1001, 5:23, 64), but the same terminology is applied in the discussion of the related art (*id.* at 1:38). Given the breadth of the instant claims, and the disclosure of the ’766 Patent, we are not persuaded that the claims are directed to use by a “configuration engineer,” and not a “configuration user.”

⁷ Although paragraph 52 of Dr. Navrátil’s declaration was cited, it appears that paragraph 50 is directed to the support that Patent Owner is seeking.

5. *Claim 1*

a. *Element [1.pre]: Preamble*

With respect to the preamble of claim 1, Petitioner asserts that Oracle1 describes using a computer system to test a product configuration for configuration errors to verify the functionality of the configurator. Pet. 14 (citing Ex. 1003, 25; Ex. 1002 ¶ 137). Petitioner also asserts that Oracle1 discloses a computer system for generating product configurations, and that one of ordinary skill in the art would have understood the configurations to be stored as electronic data. *Id.* at 15–16 (citing Ex. 1003, 98; Ex. 1002 ¶ 138). Additionally, Petitioner asserts that Oracle2 discloses a product configuration being stored as electronic data in a computer system. *Id.* at 16 (citing Ex. 1004, 42, 43; Ex. 1002 ¶ 139). Petitioner also asserts that Oracle1 gives illustrative examples of its computer system including at least one rule defining a relationship between at least two parts. *Id.* at 17–18 (citing Ex. 1003, 17, 35, 61, 97–98; Ex. 1002 ¶¶ 140–141).

Patent Owner argues that Oracle1 and Oracle2 do not teach this element of claim 1 because it does not teach the production of the recited “configuration error.” Prelim. Resp. 28–30. Patent Owner argues that the rules in Oracle1 are properly defined, because otherwise the system could not reliably validate or invalidate user selection to prevent an invalid configuration, such that the system in Oracle1 does not produce configuration errors, as Patent Owner has construed that term. *Id.* at 29. As discussed above, we do not agree with Patent Owner’s argument. The examples in Oracle1 show the operation of a condition that occurs when a rule or series of rules is not properly defined and produces an undesired effect. We are not persuaded that the adopted claim construction is

applicable to only determine errors that result from improper operation of the system; such a construction requires that we view claim 1 as performing operations for a “configuring engineer,” as Patent Owner has alleged. We are unpersuaded that a violation of a rule or series of rules, that produces an undesired result, could not be considered a “configuration error.”

We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that the combination of Oracle1 and Oracle2 meets the limitations of the preamble of claim 1 for the reasons explained by Petitioner.

b. Element [1.1]: “entering a test case”

With respect to the method step of entering a test case into the computer system to detect configuration errors in the product configuration, Petitioner asserts that Oracle1 teaches implementing a configurator by “defining test cases, designing the application, constructing and testing the application.” Pet. 19–20 (quoting Ex. 1003, 143). Petitioner also asserts that Oracle1 discloses making multiple selections, which are validated, so that one of ordinary skill in the art would have understood that the second part selection changes the product configuration. *Id.* at 20–21 (citing Ex. 1003, 43, 50, 97; Ex. 1002 ¶ 146). Petitioner also asserts that it was well-known that test cases could be stored and loaded for later use, and they would have been used to increase testing speed and consistency. *Id.* at 21 (citing Ex. 1002 ¶ 149).

Patent Owner argues that the combination of Oracle1 and Oracle2 do not teach this element, because the combination does not disclose a “test case” or “configuration errors.” Prelim. Resp. 30–32. As discussed above, we do not adopt Patent Owner’s construction of “test case,” and we are

persuaded that Oracle1 and Oracle2 provide for or render obvious the use of a test case. With respect to the latter, Patent Owner again argues that Oracle1 “is designed to prevent rather than detect errors,” and that a “configuration error is not about whether ‘the configuration’ is in a ‘state that violates the rules.’” *Id.* at 32. As discussed above with respect to the prior claim element, we are not persuaded by Patent Owner’s arguments.

We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that the combination of Oracle1 and Oracle2 meets this limitation of claim 1 for the reasons explained by Petitioner.

c. Element [1.2]: “processing the test case”

Claim 1 recites, in part, the processing of the test case with the computer system in accordance with the at least one rule to detect whether the change in the product configuration, as a result of processing the test case in accordance with the at least one rule, produced a configuration error in the product configuration. Petitioner asserts that Oracle1 discloses, through its Test/Debug section, selections are automatically validated against the rules as they are added, and if a selection is made that violates a configuration rule, a window displays a message describing the violation and the options available to deal with it. Pet. 22 (citing Ex. 1003, 97).

Patent Owner reiterates its arguments regarding the combination of Oracle1 and Oracle2 and its teaching of “configuration errors.” Prelim. Resp. 32–33. We remain unpersuaded with respect to this element of claim 1.

We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that the combination of Oracle1 and

Oracle2 meets this limitation of claim 1 for the reasons explained by Petitioner.

d. Element [1.3]: “generating explanation data”

Claim 1 recites, in part, generating explanation data with the computer system to provide an explanation of any detected configuration error in the product configuration. Petitioner asserts that Oracle1 discloses that when the user makes a selection that violates a configuration rule, a message describing the violation and options are provided to the user. Pet. 23 (citing Ex. 1003, 49–51, 97).

Patent Owner reiterates its arguments regarding the combination of Oracle1 and Oracle2 and its teaching of “configuration errors.” Prelim. Resp. 33. We remain unpersuaded with respect to this element of claim 1.

We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that the combination of Oracle1 and Oracle2 meets this limitation of claim 1 for the reasons explained by Petitioner.

e. Conclusion

Neither party presents evidence of objective considerations of nonobviousness at this stage of the proceeding. *See* Pet.; Prelim. Resp. We have reviewed the arguments and evidence and find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that the combination of Oracle1 and Oracle2 teaches or suggests all of the limitations of independent claim 1 for the reasons explained by Petitioner.

6. Dependent Claims 9, 10, 14, and 19

Claims 9 and 10 further recite that the explanation data are based on the selection of a part or the execution of a rule, respectively. With respect

to claim 9, Petitioner asserts that Oracle1 teaches making part selections to configure a product, and that explanation data are generated based on that selection if it causes an error. Pet. 24 (citing Ex. 1003, 17, 25, 97–98). With respect to claim 10, Petitioner asserts that Oracle1 teaches if a selection violates a configuration rule, the configuration window displays a message describing the violation and options for addressing it. *Id.* at 25 (citing Ex. 1003, 49, 97).

Claim 14 provides that the test case selects a product and at least one part, and generates a part state of the selected part based on one or more rules. Petitioner asserts that Oracle1 discloses the selection of the car as a product, and that making or changing part selections connotes the selection of at least one part, such as selecting one wheel in the car example. Pet. 26–28 (citing Ex. 1003, 36). Petitioner also asserts that Oracle1 teaches that an item has a logic state, which is generated in response to a rule triggered by another selection the use has made. *Id.* at 28–29 (citing Ex. 1003, 43, 51).

Claim 19 provides that the test case selects at least one part to include in the product configuration and that at least one rule is processed to determine whether the at least one part selected in the test case conflicts with the plurality of parts previously includes in the product configuration. Petitioner asserts that product configurations in Oracle1 include a plurality of parts and that Oracle1 teaches the processing of at least one rule to determine the at least one part conflicts with the previously included parts. Pet. 30–31 (citing Ex. 1003, 35, 36, 50, 51, 60–64, 97).

With respect to these dependent claims, Patent Owner argues that Petitioner has not shown the aspects of those claims associated with a configuration error. Prelim. Resp. 33–35. We have addressed the

“configuration error” limitation in the context of independent claim 1, and we do not find Patent Owner’s arguments to be persuasive. Thus, we find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that Oracle1 and Oracle2 meet the limitations of claims 9, 10, 14, and 19 for the reasons explained by Petitioner.

E. Obviousness over Oracle1, Oracle2, and SalesPlus

Petitioner asserts that the combination of Oracle1, Oracle2, and SalesPlus would have rendered the subject matter of claims 15 and 16 obvious to one of ordinary skill in the art at the time of the invention. Pet. 33–37. Patent Owner does not raise any argument specifically addressing this ground in the Preliminary Response, other than asserting arguments with respect to the first ground applicable to this ground, i.e., the application of Oracle1 and Oracle2. Prelim. Resp. 35.

Petitioner discusses SalesPlus, detailing that it is a reference guide for a product configurator, and that it explains various configurator features in the context of a Saab automobile configuration problem. Pet. 33 (citing Ex. 1005). Petitioner also asserts that “SalesPlus teaches determining whether a product is actually selectable based on prior part selections, and reports the state of the product as not selectable when selection of the product conflicts with a rule.” *Id.* (citing Ex. 1005, 23–24). Petitioner also asserts that a person of ordinary skill in the art would have sought out SalesPlus’s teachings to augment the product configuration testing capabilities taught in the Oracle1-Oracle2 combination, to address the known problem that configurators could configure products that were not actually selectable, addressed by SalesPlus, and that skilled artisans would have viewed SalesPlus’s teachings as a natural extension to Oracle1’s functionalities and

would have required only routine modification. *Id.* at 35–37 (citing Ex. 1002 ¶¶ 101–106). Petitioner also details how the combination of Oracle1, Oracle2, and SalesPlus would have rendered the subject matter of claims 15 and 16 obvious. *Id.* at 33–45.

We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that the combination of Oracle1, Oracle2, and SalesPlus meets the limitations of claims 15 and 16 for the reasons explained by Petitioner.

F. Obviousness over Oracle1, Oracle2, SalesPlus, and Yu

Petitioner asserts that the combination of Oracle1, Oracle2, SalesPlus, and Yu would have rendered the subject matter of claims 11–13 and 17 obvious to one of ordinary skill in the art at the time of the invention. Pet. 37–52. Patent Owner does not raise any argument specifically addressing this ground in the Preliminary Response, other than asserting arguments with respect to the first ground applicable to this ground, i.e., the application of Oracle1 and Oracle2. Prelim. Resp. 35.

Petitioner discusses Yu, detailing that it is an article about the product configurator disclosed in SalesPlus, and discusses generating explanations for various types of errors, including for parts that are erroneously in two states at the same time, as well as a look ahead process, and the determination of sets of excluded parts based on a product selection. Pet. 37 (citing Ex. 1006, 3–5). Petitioner also asserts that a person of ordinary skill in the art would have sought out Yu and SalesPlus’s teachings to augment the product configuration testing capabilities taught in the Oracle1-Oracle2 combination, including the generation of expanded explanation data beyond that was taught in Oracle1, to be able to catch errors as a part of product

configuration testing, and produce more complete and efficient testing. *Id.* at 49–52 (citing Ex. 1002 ¶¶107–114; Ex. 1003, 62, 97; Ex. 1005, 28; Ex. 1006, 4, 1028, 1050). Petitioner additionally details how the combination of Oracle1, Oracle2, SalesPlus, and Yu would have rendered the subject matter of claims 11–13 and 17 obvious. *Id.* at 38–48.

We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that the combination of Oracle1, Oracle2, SalesPlus, and Yu meets the limitations of claims 11–13 and 17 for the reasons explained by Petitioner.

G. Obviousness over Oracle1, Oracle2, and Memon

Petitioner asserts that the combination of Oracle1, Oracle2, and Memon would have rendered the subject matter of claims 2 and 18 obvious to one of ordinary skill in the art at the time of the invention. Pet. 52–62. Patent Owner does not raise any argument specifically addressing this ground in the Preliminary Response, other than asserting arguments with respect to the first ground applicable to this ground, i.e., the application of Oracle1 and Oracle2. Prelim. Resp. 36. Additionally, Patent Owner argues that Memon is not prior art under 35 U.S.C. § 102(b), but does not appear to argue that Memon is not prior art under § 102(a). *Id.* at 16–17. Further to our discussion above, at this juncture, we determine that Memon was publicly accessible as of November 14, 2000, based on the information provided by Petitioner. Pet. 5 (citing Ex. 1010 ¶¶ 4–6 & 12–16; Ex. 1007, 1).

Petitioner discusses the subject matter of claims 2 and 18, as well as Memon. Pet. 52–55. Petitioner supplies a rationale to combine the teachings of Memon with those of Oracle1 and Oracle2, and discusses that

the combination renders the subject matter of claim 2 and 18 obvious. *Id.* at 56–62. We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that the combination of Oracle1, Oracle2, and Memon meets the limitations of claims 2 and 18 for the reasons explained by Petitioner.

H. Obviousness over Oracle1, Oracle2, Memon, and SalesPlus

Petitioner asserts that the combination of Oracle1, Oracle2, Memon, and SalesPlus would have rendered the subject matter of claims 3–5 obvious to one of ordinary skill in the art at the time of the invention. Pet. 62–71. Patent Owner does not raise any argument specifically addressing this ground in the Preliminary Response, other than asserting arguments with respect to the first ground applicable to this ground, i.e., the application of Oracle1 and Oracle2. Prelim. Resp. 36. We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that the combination of Oracle1, Oracle2, Memon, and SalesPlus meets the limitations of claims 3–5 for the reasons explained by Petitioner.

III. CONCLUSION

For the foregoing reasons, Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that at least one claim of the '766 Patent is unpatentable.

IV. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 1–5 and 9–19 of the '766 Patent on the following asserted grounds:

Claims 1, 9, 10, 14, and 19 under 35 U.S.C. § 103(a) as unpatentable over Oracle1 and Oracle2;

Claims 15 and 16 under 35 U.S.C. § 103(a) as unpatentable over Oracle1, Oracle2, and SalesPlus;

Claims 11–13 and 17 under 35 U.S.C. § 103(a) as unpatentable over Oracle1, Oracle2, SalesPlus, and Yu;

Claims 2 and 18 under 35 U.S.C. § 103(a) as unpatentable over Oracle1, Oracle2, and Memon; and

Claim 3–5 under 35 U.S.C. § 103(a) as unpatentable over Oracle1, Oracle2, Memon, and SalesPlus; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, the trial commencing on the entry date of this Decision.

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Patent 6,836,766 B1

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