

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL SECURITIES EXCHANGE, LLC
Petitioner

v.

CHICAGO BOARD OPTIONS EXCHANGE, INCORPORATED
Patent Owner

Case CBM2013-00049 (Patent 7,356,498 B2)
Case CBM2013-00050 (Patent 7,980,457 B2)
Case CBM2013-00051 (Patent 8,266,044 B2)¹

Before JUSTIN T. ARBES, RAMA G. ELLURU, and JAMES B. ARPIN,
Administrative Patent Judges.

ARBES, *Administrative Patent Judge.*

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

¹ This Order addresses an issue pertaining to all three cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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An initial conference call in the above proceedings was held on March 25, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Arbes, Elluru, and Arpin. The purpose of the call was to discuss any proposed changes to the Scheduling Order in each proceeding and any motions the parties intend to file. Prior to the call, Patent Owner filed a list of proposed motions in each proceeding. *See* CBM2013-00049, Paper 19; CBM2013-00050, Paper 18; CBM2013-00051, Paper 17. The following issues were discussed.

Schedule

Patent Owner requested that DUE DATE 1 (April 15, 2014) in the Scheduling Orders be extended. Patent Owner argued that it requires additional time to depose Petitioner's declarant, Maureen O'Hara, Ph.D., and respond to the petitions and accompanying declarations. Petitioner agreed to a one-day extension, but opposed any further extension of time. We advised the parties, and remind them now, that they may stipulate to different dates for DUE DATES 1 through 3 in the Scheduling Orders, provided the dates are no later than DUE DATE 4, and encouraged the parties to reach an agreement on scheduling (e.g., extending DUE DATE 1 in exchange for reducing the time period for DUE DATE 3 filings). If the parties cannot agree, Patent Owner may request another conference call to discuss scheduling.

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Joint Motion to Stay

Subsequent to filing its petitions in the instant covered business method review proceedings, Petitioner filed petitions for *inter partes* review of the same three challenged patents:

Patent	Petitions Filed on September 6, 2013	Petitions Filed on November 12, 2013
7,356,498 B2	CBM2013-00049	IPR2014-00097
7,980,457 B2	CBM2013-00050	IPR2014-00098
8,266,044 B2	CBM2013-00051	IPR2014-00099

During the call, the parties requested authorization to file a joint motion to stay the instant proceedings until a determination is made whether to institute a trial in each of the *inter partes* review proceedings, pursuant to 35 U.S.C. § 325(d). The parties argued that the six proceedings then could be placed on the same schedule, which would be more efficient and convenient for the parties. For example, the parties' declarants could be deposed once, rather than twice for two sets of proceedings, and one oral hearing could be conducted for all six proceedings.

We took the matter under advisement, and ordered the parties to provide, by email to *Trials@uspto.gov* on March 26, 2014, a proposed schedule for all six proceedings, assuming that a trial is instituted in each *inter partes* review proceeding and the instant proceedings are stayed. The parties subsequently proposed the following schedule:

DUE DATE 1	July 21, 2014
DUE DATE 2	October 13, 2014
DUE DATE 3	November 3, 2014
DUE DATE 4	November 24, 2014

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DUE DATE 5	December 8, 2014
DUE DATE 6	December 15, 2014
DUE DATE 7	January 15, 2015

After considering the parties' request and proposed schedule, we are not persuaded that a joint motion to stay the instant proceedings is warranted under the circumstances. Each of the covered business method review proceedings involves a single issue—patent eligibility under 35 U.S.C. § 101—whereas the *inter partes* review proceedings involve different issues and different subject matter—namely, patentability over certain asserted prior art references under 35 U.S.C. §§ 102 and 103. Thus, at this time, we do not see a compelling need to have both sets of proceedings on the same schedule to maximize efficiency, particularly where the sets of proceedings were filed more than two months apart. Moreover, the Board has not yet determined whether to institute trials in the *inter partes* review proceedings. If the covered business method review proceedings were stayed, as the parties request, and we do not institute trials in the *inter partes* review proceedings, a significant period of time would have been wasted. Finally, we are required to issue a final written decision in each of the covered business method review proceedings within one year of institution (i.e., by March 4, 2015). *See* 35 U.S.C. § 326(a)(11). The parties' proposed schedule, with the oral hearing set for January 15, 2015, does not account sufficiently for this mandate.

Motions to Seal

Patent Owner indicated that it may file a motion to seal at some point in the proceedings. The parties are directed to the requirements of 37 C.F.R.

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§ 42.54 and the instructions for filing documents in the Patent Review Processing System (PRPS) on the Board's website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>. If a party believes that there is a need to file certain information under seal at some point in these proceedings, the party may file a motion to seal containing a proposed protective order. The proposed protective order may be a copy of the Board's default protective order. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,771 (Aug. 14, 2012). If not, the party's motion should identify specifically how the proposed protective order differs from the Board's default protective order, explain why such changes are warranted, and include with the motion a separate redlined version of the proposed protective order showing the differences. We encourage the parties to confer with each other and agree on the terms of a proposed protective order prior to filing any motion to seal. *See* 37 C.F.R. § 42.54(a).

Motions to Amend

Patent Owner stated that it may file a motion to amend in each of the instant proceedings. If Patent Owner decides to file a motion to amend, Patent Owner must request a conference call and confer with the Board before doing so. *See* 37 C.F.R. § 42.121(a). Also, the parties are referred to *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 (June 11, 2013), and *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00419, Paper 32 (Mar. 7, 2014), for guidance regarding the requirements for motions to amend.

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In consideration of the foregoing, it is hereby:

ORDERED that the parties are not authorized to file a joint motion to stay the instant proceedings.

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