

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TD AMERITRADE HOLDING CORP., TD AMERITRADE, INC., AND  
TD AMERITRADE ONLINE HOLDINGS CORP.,  
Petitioner,

v.

TRADING TECHNOLOGIES INTERNATIONAL, INC.,  
Patent Owner.

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CBM2014-00131 (Patent 7,533,056)  
CBM2014-00137 (Patent 7,685,055)

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Before SALLY C. MEDLEY, MEREDITH C. PETRAVICK, and  
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

On January 20, 2015, a conference call was held involving counsel for the respective parties and Judges Medley, Petravick, and Hoffmann. Patent Owner requested the call to seek guidance regarding a discovery dispute. In particular, and according to Patent Owner, Petitioner will not permit the cross examination of several witnesses.

*Background*

In these two proceedings, a decision was made to institute review based in part on a prior art reference known as TSE. CBM2014-00131, Paper 19.<sup>1</sup> TSE is a Tokyo Stock Exchange publication published in Japanese. Ex. 1003. Petitioner submitted a 337 page English translation of the document (Ex. 1004) along with an affidavit of Courtney O'Connell (Ex. 1005) certifying that the English translation was true and accurate. In accordance with 37 C.F.R. § 42.64(b)(1), Petitioner objected to the affidavit of Courtney O'Connell as failing to comply with 37 C.F.R. § 42.63. In response to the objection, Petitioner served several declarations from individuals who had translated various portions of TSE.<sup>2</sup>

Patent Owner is of the impression that the translation of TSE is inaccurate and seeks to depose the individuals who translated TSE. Petitioner believes that cross examination of the individuals is not permitted per the routine discovery rule 37 C.F.R. § 42.51(b)(1).

*Analysis*

Cross examination of affidavit testimony is authorized under the routine discovery rule. 37 C.F.R. § 42.51(b)(1). We have considered arguments from both Petitioner and Patent Owner. Based on the facts of these proceedings, we agree with Patent Owner that cross examination of the

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<sup>1</sup> Citations are to CBM2014-00131.

<sup>2</sup> Although the declarations were served, they were not filed. Notwithstanding 37 C.F.R. § 42.64, Petitioner is herein ordered to file the declarations of the individuals who translated TSE in each of the two proceedings. Petitioner shall not file the declarations in either of CBM2014-00133 or CBM2014-00135 because we did not institute review based on TSE in either of those proceedings.

individuals who translated various portions of TSE is permitted under 37 C.F.R. § 42.51(b)(1). During the call, we explained that Patent Owner is authorized to cross examine these individuals.

In light of our explanation, Petitioner sought authorization to file a motion for additional discovery for documents in Patent Owner's possession in support of Patent Owner's theory that the TSE English translation is inaccurate. We denied the request. Patent Owner has not filed its Patent Owner Response. Patent Owner does not know, at this juncture of the trial, whether it will raise the accuracy of the translation of TSE as an issue. Moreover, as pointed out by Patent Owner, a party that seeks to cross examine a witness need not provide documents that that party intends to rely on for cross examination purposes many days or weeks prior to cross examination. Rather any documents a deposing party will rely on for cross examination, if not previously served, must be served at the deposition. 37 C.F.R. § 42.53(f)(3). Providing the sought after documents to Petitioner days or weeks prior to the cross examination of Petitioner's witnesses would undermine the cross examination process. Accordingly, Petitioner's request for authorization to file a motion for additional discovery is denied.

#### *Related Matters*

Patent Owner represented that Petitioner's real party in interest filed a motion to stay the related district court case and indicated that it would file an updated notice regarding any decision of the motion to stay. 37 C.F.R. § 42.8. Patent Owner further represented that a motion for summary judgment was filed in another district court proceeding involving Patent Owner and a third party. According to Patent Owner, that proceeding also involves some of the same issues and patents that are involved in these or

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related CBM2014-00133 and CBM2014-00135 proceedings. Patent Owner indicated that it would file an updated notice regarding the decision of the summary judgment motion.

*Order*

It is

ORDERED that Petitioner shall file, in these two proceedings, declarations of the individuals who translated TSE by January 26, 2015;

FURTHER ORDERED that Patent Owner is authorized to cross examine the individuals who translated TSE; and

FURTHER ORDERED that Petitioner's request to file a motion for additional discovery is *denied*.

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