

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IBG LLC, INTERACTIVE BROKERS LLC,
TRADSTATION GROUP, INC., TRADESTATION SECURITIES, INC.,
TRADESTATION TECHNOLOGIES, INC., and IBFX, INC.,
Petitioner,

v.

TRADING TECHNOLOGIES INTERNATIONAL, INC.,
Patent Owner.

CBM2015-00179 (Patent No. 7,533,056 B2)
CBM2015-00181 (Patent No. 7,676,411 B2)
CBM2015-00182 (Patent No. 6,772,132 B1)

Before SALLY C. MEDLEY, MEREDITH C. PETRAVICK, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

On April 14, 2016, Patent Owner contacted Board personnel seeking a ruling regarding a discovery dispute. In particular, the parties disagree as to

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whether cross examination of Petitioner's witness, Mr. Atsushi Kawashima, falls under the routine discovery rule or under the additional discovery rule.

Background

In these proceedings, a decision was made to institute review based in part on a prior art reference known as TSE. CBM2015-00179, Paper 23.¹ TSE is a Tokyo Stock Exchange publication published in Japanese. Ex. 1004. In support of its showing that TSE qualifies as prior art, Petitioner relies on November 21, 2005 deposition testimony of Atsushi Kawashima taken during litigation between Patent Owner and a third party, eSpeed, Inc. Ex. 1007.

Patent Owner seeks to depose Mr. Kawashima. Petitioner believes that cross examination of Mr. Kawashima is not permitted per the routine discovery rule 37 C.F.R. § 42.51(b)(1). Further, according to Petitioner, Mr. Kawashima is unavailable. Patent Owner, on the other hand, seeks a ruling from the Board essentially indicating who is responsible for securing the availability of Mr. Kawashima. For the reasons that follow, we determine that Petitioner is responsible for producing Mr. Kawashima for cross examination.

Analysis

Cross examination of affidavit testimony is authorized under the routine discovery rule. 37 C.F.R. § 42.51(b)(1). We understand that Petitioner may be of the impression that cross examination of a witness whose testimony was obtained during a prior proceeding does not fall under the routine discovery rule, but rather falls under the rule for additional

¹ Citations are to CBM2015-00179.

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discovery, 37 C.F.R. § 42.51(b)(2). If the latter, the parties are of the impression that Patent Owner would need to file a motion for additional discovery, showing good cause why the cross examination of Mr. Kawashima is needed.

Here, Petitioner relies on the prior Kawashima testimonial evidence in support of its Petitions. It is a pivotal part of Petitioner's challenges based on TSE. Petitioner relies solely on the Kawashima testimony to show that TSE was publically available, and thus constitutes prior art. Based on the facts of these cases, we determine that it is Petitioner's responsibility to secure the availability of Mr. Kawashima. Patent Owner is authorized to cross examine Mr. Kawashima. To the Extent that Petitioner is unable to produce Mr. Kawashima for cross examination, we will consider his unavailability in weighing his original testimony in our Final Written Decisions.

Order

It is

ORDERED that Patent Owner is authorized to cross examine Mr. Atsushi Kawashima.

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