

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.

Cases CBM2013-00049 and IPR2014-00097 (Patent 7,356,498 B2)
Cases CBM2013-00050 and IPR2014-00098 (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 issues pertaining to all five cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. Other than the motion and opposition expressly authorized herein, the parties are not authorized to use this style heading for any subsequent papers.

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IPR2014-00098

An initial conference call in Cases IPR2014-00097 and IPR2014-00098 (“the IPR proceedings”) was held on June 19, 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* IPR2014-00097, Paper 15; IPR2014-00098, Paper 15. During the call, the parties also discussed related Cases CBM2013-00049, CBM2013-00050, and CBM2013-00051 (“the CBM proceedings”). The following issues were discussed.

Schedule in the IPR Proceedings

Patent Owner requested that each of DUE DATE 5 (December 29, 2014) and DUE DATE 6 (January 5, 2015) in the Scheduling Orders in the IPR proceedings be extended by one week to account for holiday schedules. Petitioner stated that it had no objection. The due dates are extended in a Revised Scheduling Order entered concurrently with this Order. The parties also are advised that they may stipulate to different dates for DUE DATES 1 through 5 in the Revised Scheduling Order (provided the dates are no later than DUE DATE 6) and, if they do so, the parties shall file promptly a notice of the stipulation.

Schedule in the CBM Proceedings

In each of the CBM proceedings, Petitioner’s reply to Patent Owner’s response and Petitioner’s opposition to Patent Owner’s motion to amend are due on June 20, 2014 (DUE DATE 2). *See* CBM2013-00049, Paper 32;

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CBM2013-00050, Paper 31; CBM2013-00051, Paper 30. Petitioner requested a short extension of the schedule to account for the United States Supreme Court’s decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, __ U.S. __, No. 13-298, slip op. (U.S. June 19, 2014), issued earlier in the day on June 19, 2014. We advised the parties that, given the timing of the decision, DUE DATE 2 in the CBM proceedings will be extended for a limited period of time. We instructed the parties to confer with each other and provide, in a single email to *Trials@uspto.gov* by June 23, 2014, a proposed modified schedule for the CBM proceedings. The proposed modified schedule may not change DUE DATE 7 (August 22, 2014).

We encourage the parties to work together to reach a mutually agreeable modification to the schedule. If, however, the parties are unable to agree on a proposed modified schedule, the parties may request another conference call.

Discovery in the IPR Proceedings

Patent Owner requested that Petitioner be ordered to produce certain documents as routine discovery under 37 C.F.R. § 42.51(b)(1)(iii), or that Patent Owner be authorized to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2). Patent Owner stated that during prosecution of one of Petitioner’s patent applications, U.S. Patent Application No. 09/895,379, Petitioner made statements about a prior art reference at issue in the IPR proceedings, U.S. Patent No. 6,405,180 B2 (“Tilfors”). According to Patent Owner, Petitioner filed Office Action responses and a declaration from one of its employees that included statements regarding Tilfors. Patent Owner stated that it had copies of the declaration and certain other materials, but not

a copy of the complete file history, including the original application, because the application was abandoned and is not available publicly. Petitioner's statements are relevant to the issue of how a person of ordinary skill in the art would have understood Tilfors, and the complete file history is necessary to put those statements in context, according to Patent Owner. Patent Owner argued that the file history should be produced (1) as routine discovery because Petitioner's prosecution statements are "inconsistent" with positions advanced by Petitioner in the IPR proceedings, or (2) alternatively, as additional discovery necessary in the interest of justice.

Petitioner opposed Patent Owner's request, arguing that Patent Owner had not established the relevance of Petitioner's application to issues in the IPR proceedings. Petitioner also stated that the materials already were produced to Patent Owner in the related litigation between the parties as part of a larger document production. Petitioner argued that it would be unduly burdensome to piece together the complete file history from those materials. Petitioner acknowledged, however, that the original application could be located more easily than the complete file history. We took the matter under advisement.

Upon further consideration, we are not persuaded that the requested materials are discoverable as routine discovery under 37 C.F.R. § 42.51(b)(1)(iii) because it is unknown whether the additional material from the file history is "inconsistent" with any position advanced by Petitioner in the IPR proceedings. Patent Owner shall investigate other methods of obtaining the information it seeks, including a review of the documents produced in the related litigation, to the extent permitted. If, after doing so, Patent Owner is unable to obtain the necessary information, Patent Owner is

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authorized to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2), and Petitioner is permitted to file an opposition. Patent Owner in its motion should identify specifically the information that it seeks (e.g., a copy of the original application) and explain why it believes discovery is “necessary in the interest of justice.” *See* 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2). The parties are directed to *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (Mar. 5, 2013), for guidance regarding motions for additional discovery. In particular, the mere possibility of finding something useful and a mere allegation that something useful will be found are insufficient. Further, requests for discovery will not be granted if they are unduly broad and burdensome.

Motions to Amend in the IPR Proceedings

Patent Owner indicated that it has not determined yet whether it will file a motion to amend in each of the IPR proceedings. If Patent Owner decides to file a motion to amend, Patent Owner must request a conference call and confer with us 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.

In consideration of the foregoing, it is hereby:

ORDERED that in Cases IPR2014-00097 and IPR2014-00098, Patent Owner is authorized to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) by June 30, 2014, limited to five pages; Petitioner is

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authorized to file an opposition by July 7, 2014, also limited to five pages;
and no reply is authorized;

FURTHER ORDERED that the motion and opposition shall be filed
in Cases IPR2014-00097 and IPR2014-00098 using a heading for both
proceedings; and

FURTHER ORDERED that in Cases CBM2013-00049,
CBM2013-00050, and CBM2013-00051, the parties shall confer regarding a
modified schedule and submit such modified schedule by June 23, 2014, or
notify the Board by June 23, 2014 that the parties were unable to reach an
agreement.

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PETITIONER:

Michael M. Murray
Bryan DeMatteo
Michael J. Scheer
WINSTON & STRAWN LLP
mmurray@winston.com
bdematteo@winston.com
mscheer@winston.com

PATENT OWNER:

Joseph A. Hynds
Steven Lieberman
Jason Shapiro
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
jhynds@rfem.com