

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHICAGO MERCANTILE EXCHANGE, INC.,
Petitioner,

v.

5th MARKET, INC.,
Patent Owner.

Case CBM2014-00114
Patent 7,024,387 B1

Before KALYAN K. DESHPANDE, MICHAEL R. ZECHER, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Petitioner, Chicago Mercantile Exchange, Inc. (“CME”), timely filed a Request for Rehearing under 37 C.F.R. § 42.71(d) on October 23, 2014. Paper 11, “Req. Reh’g.” CME’s Request for Rehearing seeks reconsideration of our Decision to Institute (Paper 9, “Dec.”) entered on October 9, 2014, particularly our determination to deny review of claims 1 and 2 of U.S. Patent No. 7,024,387 B1 (“the ’387 patent”) because the Petition (Paper 2, “Pet.”) fails to identify the specific portions of the Specification that describe the corresponding structure of each means-plus-function limitation recited in these claims. Dec. 16–19, 29.

In its Request for Rehearing, CME contends that our determination to deny review of claims 1 and 2 of the ’387 patent was improper for several reasons. In particular, CME argues that it inherently construed the “means for matching” and “means for matching or comparing” limitations recited in independent claim 1 when it identified prior art elements that correspond to these means-plus-function limitations in the claim charts included in the Petition. Req. Reh’g. 5–7. CME also advanced several other arguments in support of its position that we improperly denied review of claims 1 and 2 of the ’387 patent. *Id.* at 8–14.

As we explain below, we have considered the arguments presented by CME in its Request for Rehearing, as well as reconsidered our determination in the Decision to Institute to deny review of claims 1 and 2 of the ’387 patent, but we discern no sufficient reason to modify the Decision to Institute in any respect. As a consequence, we deny CME’s Request for Rehearing.

II. STANDARD OF REVIEW

When rehearing a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). A request for rehearing must identify specifically all matters the party believes we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. 37 C.F.R. § 42.71(d). With this in mind, we will address each argument presented by CME in turn.

III. ANALYSIS

A. Identifying Where Each Element is Found in the Prior Art Does Not Satisfy the Requirement of Identifying the Specific Portions of the Specification that Describe the Corresponding Structure For a Means-Plus-Function Limitation

CME contends that, pursuant to 35 U.S.C. § 322, it satisfies the statutory requirements of a petition, because it identifies the grounds for challenging the “means for matching” and “means for matching or comparing” limitations recited in independent claim 1 in the claim charts included in the Petition, and identifies where each means-plus-function limitation is found in the prior art. Req. Reh’g. 5–7.

CME's argument fails to recognize that the Petition, itself, must identify the specific portions of the Specification that describe the corresponding structure for each mean-plus-function limitation recited in claims 1 and 2 of the '387 patent. CME conflates 37 C.F.R. § 42.204(b)(3), which requires a petitioner to indicate how a challenged claim should be construed, including, where the challenged claim includes a means-plus-function limitation, identifying the corresponding structure for the claimed function, with 37 C.F.R. § 42.204(b)(4), which requires a petitioner to identify where each element of a challenged claim is found in the prior art. As we explained in the Decision to Institute, it is CME who bears the burden to provide claim constructions for each means-plus-function limitation so that it can demonstrate that the prior art renders claims 1 and 2 of the '387 patent more likely than not unpatentable. Dec. 19. Simply addressing where each means-plus-function limitation recited in independent claim 1 is found in the prior art is not, by itself, sufficient for CME to carry its burden of identifying the corresponding structure for each claimed function in the Specification of the '387 patent. 37 C.F.R. § 42.204(b)(3) and 37 C.F.R. § 42.204(b)(4) are separate and distinct regulatory requirements that must be satisfied by CME in the Petition.

CME's argument regarding whether the Petition satisfies the statutory requirements of 35 U.S.C. § 322 is misplaced. As we explained in the Decision to Institute, upon considering the arguments and supporting evidence presented in the Petition, we denied review of claims 1 and 2 of the '387 patent because CME did not identify the corresponding structure for the means-plus-function limitations recited in independent claim 1, as required by 37 C.F.R. § 42.204(b)(3). Dec. 17,

23, 25–26. Our determination in that regard was not based on whether CME’s Petition satisfied the statutory requirements of 35 U.S.C. § 322.

CME also argues that, by identifying where each means-plus-function limitation recited in independent claim 1 is found in the prior art, it necessarily identifies the corresponding structure for each claimed function. Req. Reh’g. 7. To support this argument, CME directs us to *Synopsys, Inc. v. Mentor Graphics Corp.*, Case IPR2012-00041, Paper 16, 5 (PTAB Feb. 22, 2013), in which CME alleges that the Board held that a petitioner may implicitly assert a claim construction by citing prior art elements in a claim chart. Req. Reh’g. 3, 5, 7.

We are not persuaded by CME’s reliance on the Board’s decision in *Synopsys*. *Synopsys* is distinguishable from this proceeding in at least one respect. The limitation the Board construed in *Synopsys* was not a means-plus-function limitation. In other words, because the limitation in dispute in *Synopsys* was not a means-plus-function limitation, Petitioner in that case did not have to identify the specific portions of the specification that describe the structure corresponding to each claimed function, as required by 37 C.F.R. 42.104 (b)(3)—the counterpart to 37 C.F.R. § 42.204(b)(3) in an *inter partes* review. Instead, in the Decision in *Synopsys* relied upon by CME, the Board was able to rely upon the ordinary and customary meaning of the limitation in dispute, as would be understood by one of ordinary skill in the art, in the context of the entire disclosure. IPR2012-00041, Paper 16, 6–7.

B. Dependent Claim 4, By Virtue of its Dependency from Independent Claim 3, Does Not Include a Means-Plus-Function Limitation

CME contends that we instituted a review of dependent claim 4, which, by virtue of its dependency from independent claim 3, includes all the limitations of independent claim 3. Req. Reh’g. 8. CME argues that independent claim 3 recites a means-plus-function limitation—namely, a “controller computer means.” *Id.* (quoting Ex. 1001, 28:21–22). CME further argues that, although independent claim 3 is not challenged in this proceeding, we acknowledged that CME sufficiently addresses this purported means-plus-function limitation in its Petition. *Id.* (citing Dec. 3 n. 5). CME then asserts that, because we engaged in a prior art comparison to analyze the “controller computer means” included in dependent claim 4, we likewise should engage in a prior art comparison to analyze the means-plus-function limitations recited in independent claim 1. *Id.*

We are not persuaded that our determination to deny review of claims 1 and 2 is inconsistent with our determination to review dependent claim 4. CME’s argument is predicated on the notion that the “controller computer means” included in dependent claim 4, by virtue of its dependency from independent claim 3, is a means-plus-function limitation. We disagree. The use of the term “means” is central to the analysis of whether a claim limitation should be interpreted in accordance with 35 U.S.C. § 112 ¶ 6. *Flo Healthcare Solutions, LLC v. Kappos*, 697 F.3d 1367, 1373 (Fed. Cir. 2012); *Personalized Media Commc’ns, LLC v. Int’l Trade Comm’n*, 161 F.3d 696, 703-04 (Fed. Cir. 1998). In this case, the presence of the word “means” creates the strong—but rebuttable—presumption that the patentees intended that the “controller computer means” should be governed by

§ 112 ¶ 6. *See Flo Healthcare*, 697 F.3d at 1373. To determine whether the presumption is overcome, we must decide whether the claim phrase “controller computer” is one that connotes structure. *See Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382, F.3d 1354, 1360 (Fed. Cir. 2004).

The Specification of the ’387 patent discloses “a computer for receiving the outgoing orders and incoming order information from traders’ workstation, and for controlling the display device.” Ex. 1001, 4:1–4. Based on this disclosure, one with ordinary skill in the art would have recognized that a “computer” is a sufficiently definite structure. Therefore, contrary to CME’s assertion, the “controller computer means” included in dependent claim 4 should not be interpreted in accordance with §112 ¶ 6 because it is modified by sufficient structure. As a result, our determination to deny review of claims 1 and 2 because CME does not construe the means-plus-function limitations recited in these claims is not inconsistent with our determination to review dependent claim 4 because this claim does not include a means-plus-function limitation.

C. The Limitations Included in Dependent Claims 4, 6, and 10, By Virtue of Their Dependency from Independent Claims 3 and 9, Are Not Identical to the “Means for Matching or Comparing” Recited in Independent Claim 1

CME contends that we instituted a review of claims 4, 6, and 10, which, by virtue of their dependency from independent claims 3 and 9, include almost identical claim limitations to the “means for matching or comparing” recited in independent claim 1. Req. Reh’g. 9. CME then argues that, because we inherently construed the limitations included in claims 4, 6, and 10 when determining that these claims were more likely than not unpatentable over the combination of

CFTC¹ and Lupien,² we also should have analyzed the purported identical limitation recited in independent claim 1. *Id.* at 9–10.

Independent claims 1, 3, and 9 recite, in relevant part, “means for matching or comparing,” “a device for matching or comparing,” and “a segment for matching or comparing,” respectively. Ex. 1001, 27:38, 28:26, 30:11. By virtue of their dependency from independent claims 3 and 9, dependent claims 4, 6, and 10 include all the limitations recited in independent claims 3 and 9. “[A] device for matching or comparing” included in dependent claims 4 and 6, and “a segment for matching or comparing” included in dependent claim 10, however, are not presumed to be governed by 35 U.S.C. § 112, ¶ 6 because they don’t recite the terms “means for.” Nor does CME assert that either the “device” or “segment” included in dependent claims 4, 6, and 10 constitute a nonce word, or verbal construct, that is not recognized as the name of a structure, but rather a substitute for “means for.” Therefore, contrary to CME’s assertions, the aforementioned limitations that are included in dependent claims 4, 6, and 10, by virtue of their dependency from independent claims 3 and 9, are not similar to the “means for matching or comparing” limitation recited in independent claim 1 because they should not be construed in accordance with § 112, ¶ 6.

¹ Memorandum from the Commodity Futures Trading Commission on the New York Mercantile Exchange’s (“NYMEX”) Proposal to Implement the NYMEX ACCESS Trading System (Dec. 7, 1992) (on file with the Commodity Futures Trading Commission) (Ex. 1003).

² Lupien, U.S. Patent No. 5,101,353, issued Mar. 31, 1992 (Ex. 1004).

D. Our Determination Not to Attempt to Construe the Means-Plus-Function Limitations Recited in Independent Claim 1 is Not Inconsistent With the Board's Determination to Review Claims 1 and 2 of the '419 Patent in CBM2013-00027, Federal Circuit Precedent, or Office Guidance

CME contends that, in the Petition for this proceeding, it explained how independent claim 1 of the '419 patent, which is the patent involved in CBM2013-00027, includes essentially the same limitations as the limitations recited in independent claim 1 of the '387 patent. Req. Reh'g. 10 (citing Pet. 18–19). Based on this comparison, CME argues that we should have considered its construction of the means-plus-function limitations recited in independent claim 1 of the '419 patent in the Petition for CBM2013-00027 when evaluating the same means-plus-function limitations recited in independent claim 1 of the '387 patent. *Id.* at 11–12 (citing CBM2013-00027, Paper 3, 9–10).

As an initial matter, CME fails to recognize that, as required by 37 C.F.R. § 42.204(b)(3), its Petition for challenging the '387 patent must identify the specific portions of the Specification that describe the corresponding structure for each means-plus-function limitations recited in claims 1 and 2. CME cannot rely upon another petition challenging a different patent to meet that requirement, especially where the involved patent does not share the same disclosure.

In addition, we are not persuaded by CME's argument that we did not consider its construction of the means-plus-function limitations recited in independent claim 1 of the '419 patent in the Petition for CBM2013-00027 when evaluating the same means-plus-function limitations recited in independent claim 1 of the '387 patent. Contrary to CME's assertion, we recognized in the Decision to Institute that the same “means for matching” and “means for matching or

comparing” limitations recited in independent claim 1 of the ’387 patent also are recited in independent claim 1 of the ’419 patent, and that CME proposed claim constructions for these means-plus-function limitations in CMB2013-00027.

Dec. 17. We noted, however, that the ’387 patent is a continuation-in-part of the ’419 patent. *Id.* We then indicated that CME does not explain in the Petition whether its proposed claim construction of the means-plus-function limitations recited in independent claim 1 of the ’419 patent also applies to the same means-plus-function limitations recited in independent claim 1 of the ’387 patent. Nor does CME explain in the Petition whether the claim constructions of these means-plus-function limitations are different and, as a result of such differences, identify the new portions of the Specification of the ’387 patent that describe the structure corresponding to each claimed function. *Id.* at 18. We maintain this same position in this Decision on Request for Rehearing.

CME also argues that, by not attempting to construe the means-plus-function limitations recited in independent claims 1 of the ’387 patent, we ignored Federal Circuit precedent on interpreting the same claim terms in a continuation-in-part application, as well as Office guidance that the Board should take into account interpretations applied in other related proceedings when deciding whether to institute a review. Req. Reh’g. 13–14. We disagree that we misapprehended or overlooked this matter. As we explained at length above, upon considering the arguments and supporting evidence presented in the Petition, we denied review of claims 1 and 2 of the ’387 patent because CME did not identify the corresponding structure for the means-plus-function limitations recited in independent claim 1, as required by 37 C.F.R. § 42.204(b)(3). Dec. 17, 23, 25–26. CME formulated its

argument regarding our purported ignorance to Federal Circuit precedent and Office policy only after reviewing our Decision to Institute, particularly our determination to deny review of claims 1 and 2 of the '387 patent. A request for rehearing is not an opportunity to present new arguments or evidence that could have been presented and developed in a petition. In other words, we could not have overlooked or misapprehended arguments or evidence not presented and developed by CME in the first instance in the Petition.

IV. CONCLUSION

For the foregoing reasons, CME has not demonstrated that we abused our discretion when we denied review of claims 1 and 2 of the '387 patent because the Petition fails to identify the specific portions of the Specification that describe the corresponding structure of each means-plus-function limitation recited in these claims. Accordingly, CME's Request for Rehearing is DENIED.

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For PETITIONER:

Erika H. Arner
Timothy P. McAnulty
Justin Loffredo
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
erika.arner@finnegan.com
timothy.mcanulty@finnegan.com
justin.loffredo@finnegan.com

Matthew J. Kelly
Chicago Mercantile Exchange, Inc.
Matthew.Kelly@cmegroup.com

For PATENT OWNER:

D. Richard Anderson
George S. Dolina
Birch, Stewart, Kolasch & Birch, LLP
dra@bskb.com
gsd@bskb.com

J. Gregory Whitehair
The Whitehair Law Firm, LLC
jgw@whitehairlaw.com