

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLOOMBERG INC.; BLOOMBERG L.P.; BLOOMBERG FINANCE L.P.;
THE CHARLES SCHWAB CORPORATION;
CHARLES SCHWAB & CO., INC.;
E*TRADE FINANCIAL CORPORATION; E*TRADE SECURITIES LLC;
E*TRADE CLEARING LLC; OPTIONSXPRESS HOLDINGS INC.;
OPTIONSXPRESS, INC.; TD AMERITRADE HOLDING CORP.;
TD AMERITRADE, INC.; TD AMERITRADE IP COMPANY, INC.; and
THINKORSWIM GROUP INC.
Petitioner,

v.

MARKETS-ALERT PTY LTD.
Patent Owner.

Case CBM2013-00005 (JYC)
Patent 7,941,357

Before JAMESON LEE, SALLY C. MEDLEY, JONI Y. CHANG, *Administrative Patent Judges.*

CHANG, *Administrative Patent Judge.*

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

On July 3, 2013, Markets-Alert filed a patent owner response and a motion to amend claims. Papers 39 and 40. The parties jointly initiated a telephone conference call, seeking the Board's guidance on the procedure for correcting the motion to amend claims. A telephone conference call was held between respective counsel for the parties and Judges Lee, Medley, and Chang on July 23, 2013.

During the telephone conference call, Markets-Alert indicated that its motion to amend claims is over the 15-page limit, and that the error was inadvertent. Markets-Alert requested authorization to file a revised motion that would comply with the page limit.

Bloomberg countered that a revised motion would place a burden on Bloomberg to determine whether the revised motion contains substantive changes. To alleviate Bloomberg's concern, Markets-Alert agreed to provide, with its revised motion, a certification that the revised motion does not add any substantive material and a list of the format changes and deletions.

Bloomberg also requested additional pages for its opposition and asked the Board to expunge Markets-Alert's patent owner response, alleging that the patent owner response is inappropriate as it merely contains arguments as to why the proposed substitute claims are patentable over the prior art.

The Board directed attention to 37 C.F.R. § 42.220(a) which provides that a "patent owner may file a response to the petition addressing any ground for unpatentability not already denied." As explained during the call, Bloomberg, in its reply to the patent owner response, may explain why Markets-Alert's patent owner response fails to comply with the rule requirement. And in its opposition to the motion to amend claims, Bloomberg may argue why the proposed substitute claims are unpatentable. It is not necessary to determine the propriety of the patent

owner response at this time, before Bloomberg files its reply, because that reply need not respond to improper content in the patent owner response.

In consideration of the foregoing, it is hereby:

ORDERED that Markets-Alert is authorized to file a revised motion to amend claims within three business days from the date of the conference call; the revised motion must be limited to 15 pages and must not add substantive material;

FURTHER ORDERED that Markets-Alert must file, as an exhibit with its revised motion to amend claims, a certification that the revised motion does not add any substantive material and a list of the format changes and deletions;

FURTHER ORDERED that Bloomberg's request for additional pages for its opposition is *denied*; and

FURTHER ORDERED that Bloomberg's request that Markets-Alert's patent owner response be expunged is *denied*.

Case CBM2013-00005

Patent 7,941,357

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