UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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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.
Petitioners,

v.

MARKETS-ALERT PTY LTD.
Patent Owner.

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

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

SECOND DECLARATION OF NEAL GOLDSTEIN

I, Neal Goldstein, state and declare as follows:

1. In addition to what I previously reviewed for my Declaration of Neal Goldstein ("First Goldstein Dec.") (Ex. 2023), I have reviewed Patent Owner Markets-Alert *Substitute* Motion to Amend ("Motion"), Petitioner's Opposition to the Motion ("Opposition"), the Second Declaration of Steven R. Kursh ("Kursh") ("Second Kursh Dec.") (Exhibit 1043), Patent Owner Markets-Alert Response ("Response"), Petitioner's Reply To Patent Owner Markets-Alert Response ("Reply"), and Exhibits 1002-1015, 1024-1033, 1035-1041 and 2001.

2. I have been advised by counsel and understand that I must limit my testimony to respond to the arguments and issues raised in Petitioners' Opposition, the Second Kursh Dec., and Exhibits 1002-1015, 1024-1033, 1035-1041 and 2001. To leave no doubt that my testimony is within this proper scope, I have specified the paragraph of the Second Kursh Dec. to which I am responding.

3. I have also been advised by counsel and understand that Petitioners and Kursh did not challenge or controvert large portions of my prior testimony, the testimony of Graham Maxwell Lindsay, and Markets-Alert's Motion and Response, and these may be deemed admitted by the Board.

I. SCOPE OF CLAIMS 5-8

4. Contrary to Kursh's comment at Paragraph 2, I understand that, in the Motion, Markets-Alert *requested* the Board to cancel originally issued Claims 1-4

and substitute Claims 5-8. I further understand that the Board must grant any changes to the claims of the '357 Patent.[1]

5.   I have compared the supporting citations presented by Markets-Alert in their Motion at 5-15 with the original disclosure (as filed) of the '357 Patent. They are, in my opinion, identical or substantially identical. Moreover, the original disclosure is identical or substantially identical to the disclosure in (AU)PR 1097. The only difference between the original disclosure and the '357 Patent was the addition of Figure 3 and minor textual amendments. In my previous declaration, I did not refer to any parts of the '357 Patent specification that were not in the original disclosure (I understand that citing to the '357 Patent specification was just a matter of convenience). Consequently, in my opinion, contrary to Kursh's assertion at Paragraph 3, Claims 5-8 do not encompass any new subject matter, i.e., subject matter not already part of the teachings in the original disclosure of the '357 Patent, as viewed by a person of skill in the art. As I have testified previously, it is my opinion that Claims 5-8 are fully supported by the original disclosure of the '357 patent. *See* Ex. 2023 at ¶¶69-96; and Motion at 4 to 15. Except for disagreeing with some of my general conclusions, I saw that

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[1] Markets-Alert narrowed by disclaimer the scope of original Claims 1-4 with respect to at least the features of network of computers, technical analysis and real-time. The newly added limitations in Claims 5-8 essentially reflect that narrowing of these features. Thus, each of the arguments that Markets-Alert presented in its response distinguishing Claims 5-8 on these limitations apply equally to Claims 1-4, and would have rendered Claims 1-4 equally distinguishable over the prior art.

neither Petitioners nor Kursh disputed or challenged the evidence or rationale I
presented in my previous declaration.

6.   I also understand that the Petitioners allege that Claims 5-8 are
broader than the original claimed scope. I note that, as a matter of logic, if Claims
5-8 are broader, then Petitioners should not need prior art references other than the
four granted review by the Board – *unless Claims 5-8 are narrower in scope or the
four references granted review were insufficient to begin with*.

7.   Contrary to Kursh's assertion at Paragraph 4, the elements and
limitations in Claims 5-8 either trace back to Claims 1-4, in which case they are
supported by the original claims, or are taught in the original disclosure of the '357
Patent. In my opinion, Claims 5-8 are not broader in scope for the reasons I give
herein.

8.   For example, in Claim 5, the original claim term "network of
computers" is further limited by being a *provider's* network of computers, *which is
server-based, scalable and redundant*. Motion at 3 and 5-7. I understand that
Markets-Alert also narrowed the scope by disclaiming those parts of the Board
construction that were never intended to be covered by the claim. *Id.* at 5-6 ("The
amended language excludes a third-party personal computer (PC) connected to the
Internet *by itself* or just the Internet *in general*, as comprised by multiple third-
party PCs. That is, while a third-party PC connected to the Internet or multiple,

inter-networked third-party PCs may be part of, connected to, or in communication with the claimed network of computers, they do not by themselves constitute the claimed network of computers."); Response at 14-15.

9.   This is true also for original claim terms relating to "technical analysis." Claim 5 replaces technical analysis formula with "more than one technical analysis formula for predicting price trends based on market action." I understand that Markets-Alert also narrowed the scope by disclaiming those parts of the Board construction that were never intended to be covered by the claim. Motion at 7-8 ("Technical analysis is a term of art and would be understood… to require using a technical analysis formula *on* data (such as price and/or volume) to *predict* price trends.... Here, prediction requires an analytical approach…."); and Response at 15-16 and 22-25.

10.   At Paragraph 5, Kursh depicts a mark-up version of Claim 5. The important aspect to note here is that Claim 5 clearly traces back to Claim 1. I find Petitioners' assertion that Claims 5-8 "bear no resemblance" to the original claims to be a vast overstatement. In fact, Kursh's mark-up shows that Claim 5 retains the core structure and parallels the same steps of Claim 1. For example, Claim 5 has two receiving steps for stock market data and watch data, respectively, parallel to Claim 1(a) and (b); an applying step parallel to Claim 1(c); and a notification step parallel to Claim 1(d). The new language in Claim 5 only modifies, clarifies or

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