

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.  
Petitioners,

v.

**MARKETS-ALERT PTY LTD.**  
Patent Owner.

---

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

---

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

**PATENT OWNER MARKETS-ALERT  
REPLY TO PETITIONERS' OPPOSITION TO MOTION TO AMEND**

## TABLE OF CONTENTS

	<b>Page</b>
I. NEW CLAIMS 5-8 ARE NOT BROADER IN SCOPE .....	1
II. NEW CLAIMS 5-8 ARE SUPPORTED BY THE SPECIFICATION.....	3
III. CLAIM CONSTRUCTION WAS PROVIDED .....	4
IV. NEW CLAIMS 5-8 WERE SHOWN TO BE PATENTABLE .....	5

## TABLE OF AUTHORITIES

Page

### **Federal Statutes**

37 Code of Federal Regulations 1.121(e) .....	3
37 Code of Federal Regulations 42.221 .....	1
37 Code of Federal Regulations 42.221(a)(3) .....	2
37 Code of Federal Regulations 42.23 .....	1
Manual of Patent Examining Procedure § 2111.01 .....	5
Manual of Patent Examining Procedure § 2163.07 .....	3
Manual of Patent Examining Procedure § 608.01(o) .....	3
Manual of Patent Examining Procedure § 1302.01 .....	3
Manual of Patent Examining Procedure § 1412.03 .....	1, 2

## LIST OF CITED EXHIBITS

Exhibit 1043	Second Declaration of Steven R. Kursh (“Second Kursh Dec.”)
Exhibit 2025(a)	Deposition Transcript of Steven R. Kursh (“Kursh Depo.”)
Exhibit 2078	Second Declaration of Neal Goldstein (“Goldstein Dec.”)

Patent Owner Markets-Alert (“Markets-Alert”) respectfully requests the Board to grant its *Substitute* Motion to Amend (“Motion”) because proposed Claims 5-8 comply with 37 C.F.R. 42.221 in all respects. Claims 5-8 are and have been shown to be patentably distinguishable over the prior art of record and known to Markets-Alert.<sup>1</sup> Petitioners have failed to justify any alleged basis for denying the Motion.<sup>2</sup>

### **I. NEW CLAIMS 5-8 ARE NOT BROADER IN SCOPE**

Petitioners’ argument that omitting a previous limitation *by itself* means that the new claim is broader is false logic. *See* Ex. 2078 at ¶6. It ignores the clarifying limitations that replace the omitted limitations, as well as completely new limitations, which make Claims 5-8 considerably narrower in scope. A claim should only be considered broadened “if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement.” Manual of Patent Examining Procedure (“MPEP”) §1412.03. That is simply not the case here and Petitioners make no showing otherwise.

Applying watch data “as the real-time stock market data is received” is not broader than “periodically apply,” in view of the Board’s claim construction of “include[ing] one or more time intervals.” Ex. 2078 at ¶¶13-16. “When the valid

---

<sup>1</sup> In their Opposition to Markets-Alert’s Motion (“Opposition”), Petitioners argue that Claims 1-4 are cancelled and no claims are pending review. This is incorrect since no claims are cancelled, amended or substituted until the Motion is granted.

<sup>2</sup> Petitioners did not include a separate statement of material facts pursuant to 37 C.F.R. 42.23.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.