

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Jeffery Bruce McGeorge	§	Attorney Docket No.: PGR-2012-111
United States Patent No.: 7,941,357	§	
Formerly Application No.: 10/451022	§	
Issue Date: January 25, 2011	§	
PCT Filing Date: October 26, 2001	§	Case No: CBM2013-00005
Former Examiner: Ella Colbert	§	Patent Owner: Market-Alerts Pty Ltd

For: Trading System

MAIL STOP PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
Post Office Box 1450
Alexandria, Virginia 22313-1450

**PATENT OWNER'S REQUEST FOR AUTHORIZATION
TO SUBMIT EXPERT DECLARATION WITH ITS PRELIMINARY RESPONSE**

Pursuant to 37 CFR §§42.107(c) and 42.207(c), Patent Owner Markets-Alert Pty Ltd.

hereby requests authorization from the Patent Trial and Appeal Board to submit an expert declaration with its Preliminary Response.

As set forth in the Federal Register, 77 FR 48764: "New testimonial evidence may be permitted where a party demonstrates that such evidence is in the interests of justice. For example, the Board may permit new testimonial evidence where it addresses issues relating to the petitioner's standing, or where the Board determines that consideration of the identified evidence is necessary in the interests of justice as the evidence demonstrates that the trial may not be instituted".

Petitioners' bear the burden on standing to "demonstrate that the patent for which review is sought is a covered business method patent." 37 CFR §42.304(a). "Covered business method patents by definition do not include patents for technological inventions." 77 FR 48763-48764.

In their Petition, in an effort to demonstrate that the subject patent is a covered business method patent, Petitioners' submitted an alleged expert declaration. Specifically, Petitioner's alleged expert testified to his opinion that the subject patent does not come under the "technological invention" exception.

Patent Owner intends to submit the declaration of an expert in the relevant field of the subject patent to rebut Petitioners' standing. Specifically, Patent Owner anticipates submitting testimony by its expert that demonstrates the invention of the subject patent falls within the "technological invention" exception of the standing requirement. Since the anticipated new testimonial evidence will address issues relating to Petitioners' standing, the Board may permit Patent Owner's request.

Additionally, Patent Owner anticipates submitting testimony by its experts to address one or more of the following permitted threshold issues that would demonstrate that a trial should not be instituted: (1) The petitioner is statutorily barred from pursuing a review; (2) The references asserted to establish that the claims are unpatentable are not in fact prior art; (3) The alleged prior art lacks a material limitation in all of the independent claims; (4) The prior art teaches or suggests away from a combination that the petitioner is advocating; and (5) The petitioner's claim interpretation for the challenged claims is unreasonable. 77 FR 48764.

As Petitioners submitted alleged expert testimony to support their standing and other threshold burdens, permitting Patent Owner to submit rebuttal expert testimony on these threshold issues would be in the interest of justice and fairness. Without the benefit of rebuttal testimony, the Board would be relying on Petitioners' unchallenged testimony to determine whether or not to grant the Petition. This may result in the Board instituting a trial where trial is not actually warranted. By permitting Patent Owner to submit its own expert declaration, the

Board will avoid the potentially prejudicial effect of one-sided testimony and be fully informed as to the threshold requirements.

Therefore, Patent Owner respectfully requests the Board for authorization to submit an expert declaration with its Preliminary Response.

Respectfully Submitted,
/s/Andrew Choung/
Andrew Choung, Lead Counsel
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November 27, 2012

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing PATENT OWNER MARKETS-ALERT'S REQUEST FOR AUTHORIZATION TO PRESENT NEW TESTIMONIAL EVIDENCE IN ITS PRELIMINARY RESPONSE was served on November 27, 2012 by causing it to be deposited in the United States Postal Service as Express Mail (Label No. EI575260762 US) postage pre-paid in an envelope addressed to counsel for petitioner at the following address:

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