

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TD AMERITRADE HOLDING CORP., TD AMERITRADE, INC., AND
TD AMERITRADE ONLINE HOLDINGS CORP.,
Petitioner,

v.

TRADING TECHNOLOGIES INTERNATIONAL, INC.,
Patent Owner.

CBM2014-00131 (Patent 7,533,056)
CBM2014-00133 (Patent 7,676,411)
CBM2014-00135 (Patent 6,772,132)
CBM2014-00136 (Patent 6,766,304)
CBM2014-00137 (Patent 7,685,055)

Before SALLY C. MEDLEY, MEREDITH C. PETRAVICK, and
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.20

CBM2014-00131 (Patent 7,533,056)
CBM2014-00133 (Patent 7,676,411)
CBM2014-00135 (Patent 6,772,132)
CBM2014-00136 (Patent 6,766,304)
CBM2014-00137 (Patent 7,685,055)

INTRODUCTION

On August 8, 2014, a telephone conference call was held between respective counsel for the parties and Judges Medley, Petravick, and Hoffmann. Patent Owner requested the call to seek authorization to file a motion for additional discovery related to Petitioner's real parties-in-interest.

DISCUSSION

Patent Owner's Request for Authorization to File a Motion for Additional Discovery

Patent Owner requests authorization to file a motion for additional discovery related to whether eSpeed and other unnamed parties are real-parties-in-interest. According to Patent Owner, the parties agreed to, and Petitioner has already answered, an initial set of three questions related to this issue, but the parties cannot agree as to two further follow up questions. Ex. 3002, 6-7.

Patent Owner argues that certain facts suggest that "perhaps" Petitioner, eSpeed, and other unnamed parties have a joint defense group. *Id.* at 11. Those alleged facts are: that the Petition (Paper 4) cites to a memo written by an attorney at Winston & Strawn, LLP for the "eSpeed file" (Ex. 1006, "eSpeed Memo"); that Petitioner stated, in a previous conference call (*see* Paper 10; Ex. 3001) that the memo may contain attorney work product; and that there are other parties involved currently in the same litigation as these patents and Petitioner. Ex. 3002, 10-11.

CBM2014-00131 (Patent 7,533,056)
CBM2014-00133 (Patent 7,676,411)
CBM2014-00135 (Patent 6,772,132)
CBM2014-00136 (Patent 6,766,304)
CBM2014-00137 (Patent 7,685,055)

According to Petitioner, Petitioner obtained the 2005 eSpeed Memo, in response to a request for prior art, which was made in the 2010 time frame after Petitioner was sued by Patent Owner and which was prior to the existence of covered business method patent review in the statute. *Id.* at 12-14. Petitioner stated that the eSpeed Memo “may be work product of Winston & Strawn and eSpeed in 2005” (*id.* at 13), but that it was not created for these proceedings. *Id.* Petitioner stated that it already had told Patent Owner, in response to their initial questions, that no other party provided work product for the Petitions in these proceedings or provided comments on drafts of the Petitions. *Id.* at 13.

In covered business method patent proceedings, motions for additional discovery may be granted upon a showing of good cause as to why the discovery is needed. 37 C.F.R. §§ 42.224. *See also Bloomberg Inc. et al. v. Markets-Alert Pty. Ltd.*, CBM2013-00005, 5 (2013) (setting forth factors that are helpful in determining whether discovery requests may be granted). Patent Owner, as the moving party, has the burden of proof. 37 C.F.R. §§ 42.20(c), 42.224.

Patent Owner has not explained sufficiently how it could demonstrate “good cause as to why the discovery is needed” to justify a motion for further additional discovery. *See* 37 C.F.R. §§ 42.51(b)(2)(i), 42.224. Patent Owner’s explanation, based mainly upon Petitioner’s possession of the eSpeed Memo and Petitioner’s “work product” statement, is mere speculation that it will discover information regarding an alleged joint defense group between Petitioner, eSpeed, and other unnamed entities. Petitioner has explained already how it obtained the eSpeed Memo and what

CBM2014-00131 (Patent 7,533,056)
CBM2014-00133 (Patent 7,676,411)
CBM2014-00135 (Patent 6,772,132)
CBM2014-00136 (Patent 6,766,304)
CBM2014-00137 (Patent 7,685,055)

it meant by the “work product” statement, and Patent Owner provides no reasons as to why Petitioner’s explanation is insufficient. The only other fact Patent Owner relies upon is that Petitioner and other parties are involved in the same district court litigation over the patents at issue in these proceedings. This fact, alone, is insufficient reason to authorize a motion for further additional discovery; particularly, in light of Petitioner’s representation that no entities other than TD Ameritrade, “was authorized, controlled, reviewed [,] or provided work product for the CBMs that TD Ameritrade filed” (Ex. 3002, 14). For these reasons, Patent Owner’s request for authorization to file a motion for additional discovery is denied.

Patent Owner’s Request for Guidance on a Routine Discovery Issue

Patent Owner seeks “guidance” as to how to enforce compliance with the routine discovery rules. Ex. 3002, 9. Patent Owner alleges that Petitioner did not serve a document, which is from an eSpeed litigation and publicly available, that includes inconsistent statements. *Id.*

Because Patent Owner asks us for “guidance” and seeks no other relief from us, we decline to provide an affirmative declaration as to whether Petitioner should have or should not have served the document that contains the alleged inconsistent statements pursuant to the routine discovery rule. For guidance, Patent Owner is directed to 37 C.F.R. § 42.51(b)(1)(iii), which states “[u]nless previously served, a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency.” “Routine discovery under 37 C.F.R. §

CBM2014-00131 (Patent 7,533,056)
CBM2014-00133 (Patent 7,676,411)
CBM2014-00135 (Patent 6,772,132)
CBM2014-00136 (Patent 6,766,304)
CBM2014-00137 (Patent 7,685,055)

41.51(b)(1)(iii) is narrowly directed to specific information *known to the responding party to be inconsistent* with a position advanced by that party in the proceeding, and not broadly directed to any subject area in general within which the requesting party hopes to discover such inconsistent information.” Decision –On Motion for Additional Discovery in Case IPR2012-00001 (*Garmin Int’l., Inc. v. Cuozzo Speed Techs. LLC*, (Paper 26, p. 4)) (emphasis added). As to the complained about document, which according to Patent Owner is publicly available, Patent Owner is free to address the alleged inconsistent statements in its Preliminary Response or Patent Owner Response.

ORDER

It is:

ORDERED that Patent Owner is not authorized to file a motion for additional discovery.

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.