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Paper 60
Entered: June 24, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IBG LLC, INTERACTIVE BROKERS LLC,
TRADESTATION GROUP, INC., TRADESTATION SECURITIES, INC.,
TRADESTATION TECHNOLOGIES, INC., and IBFX, INC.,
Petitioner,

v.

TRADING TECHNOLOGIES INTERNATIONAL, INC.,
Patent Owner.

CBM2015-00161 (Patent No. 6,766,304 B2)[1]
CBM2015-00172 (Patent No. 7,783,556 B1)
CBM2015-00179 (Patent No. 7,533,056 B2)[2]
CBM2015-00181 (Patent No. 7,676,411 B2)
CBM2015-00182 (Patent No. 6,772,132 B1)

Before SALLY C. MEDLEY, MEREDITH C. PETRAVICK and JEREMY M. PLENZLER, *Administrative Patent Judges.*

PETRAVICK, *Administrative Patent Judge*.

ORDER
Denying Motion for Additional Discovery
37 C.F.R. § 42.5

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[1] Case CBM2016-00035 has been joined with this proceeding.
[2] Case CBM2016-00040 has been joined with this proceeding.

INTRODUCTION

A conference call was held on June 13, 2016 between counsel for the parties and Judges Petravick and Plenzler. A transcript of the call appears in the record. Ex. 2140[3] ("Tr."). During the call, Patent Owner requested the discovery of 1) certain documents produced by the Petitioners in the related district court litigation ("Litigation Documents"), 2) transcripts of depositions held on June 8, 9, and 13, 2016 ("Deposition Transcripts"), and 3) other information from certain databases ("Databases"). Ex. 3004. Petitioners opposed the discovery request.

During the call, we authorized Patent Owner to file a motion for additional discovery in each of these proceedings no later than June 15, 2016 and for Petitioners to file an opposition no later than June 17, 2016. Tr. 32:5–33:8. We limited the motion for additional discovery to 12 pages, not including "a separate listing of the documents that you're seeking discovery of." *Id*. at 32:19–21.

Late on June 15, 2016 through the early hours of June 16, 2015 (*see* Ex. 3004), Patent Owner filed in each of these proceedings 1) a sealed motion for additional discovery submitted for "Board Only" (Paper 54), 2) a redacted motion for additional discovery (Paper 52, "Mot."), 3) some documents for which Patent Owner seeks discovery (Exs. 2143–2151, 2154, 2156–2158), 4) a listing of the Litigation Documents and Deposition

[3] For the purposes of this Order, CBM2015-00161 is representative and all citations are to papers in CBM2015-00161 unless otherwise noted.

Transcripts (Ex. 2152), 5) a listing of the Databases (Ex. 2153), 6) a table explaining the relevance of the Litigation Documents, Deposition Transcripts, and Databases (Ex. 2155), and 7) a motion to seal (Paper 53). The filings are identical in each proceeding. Mot. 1, n. 1.

On June 16, 2016, Petitioners, via email, requested a conference call to seek authorization for a motion to strike the motion for additional discovery.[4] *See* Ex. 3005, 2–3. We responded, via email, that we would consider the matter and that Petitioners' authorization to file an opposition to the motion for additional discovery was withdrawn. *Id*. No conference call was held.

For the reasons that follow, we determine that Patent Owner's motion for additional discovery is procedurally and substantively deficient and deny the motion without the need for an opposition from Petitioners.

DISCUSSION

A. Routine Discovery

As an initial matter, we address Patent Owner's assertion that the requested discovery is routine discovery. During the June 13, 2016 conference call, Patent Owner contended that its requested discovery is routine discovery under 37 C.F.R. § 41.51(b)(1)(i) and 41.51(b)(1)(iii). Tr. 5:10–22. We explained that the requested discovery did not fall under

[4] Petitioners' request for authorization to file a motion to strike the motion for additional discovery is moot because we deny the motion for additional discovery.

routine discovery, but falls under additional discovery under 37 C.F.R. § 41.51(b)(2)(i). *Id*. at 13:1–14:14. In its motion for additional discovery, Patent Owner again asserts that the requested discovery is routine discovery because "it is facially contrary to Petitioners' positions" or inconsistent with the Petitioners' position that the challenged claims of the patents at issue are obvious and not technological. *See* Mot. 1, n. 3, Mot. 3.

Under 37 C.F.R. § 41.51(b)(1)(iii), "[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" [privileged information excepted]. As explained in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 3–4 (PTAB Mar. 5, 2013) (Paper 26) (precedential),

> routine discovery under 37 C.F.R. § 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.

Here, Patent Owner's discovery request is overly broad and not narrowly tailored to relevant information known to the Petitioners to be inconsistent with a position advanced by the Petitioners in the proceeding. Patent Owner's requested discovery, thus, falls into additional discovery under 37 C.F.R. § 42.51(b)(2).

B. Motion for Additional Discovery

i. Procedural Deficiencies

Before turning to the merits, we address several procedural deficiencies of the motion for additional discovery. First, the Board authorized Patent Owner to file a 12 page motion for additional discovery and "a separate listing of the documents that you're seeking discovery of." Tr. 32:19–21. In addition to a 12 page motion for additional discovery and separate listings of the documents for which Patent Owner is seeking discovery (Ex. 2152, 2153), Patent Owner filed a single-spaced, 9 page table summarizing the relevance of the requested discovery (Ex. 2155). The table has 115 entries summarizing the relevance of the requested discovery. The motion for additional discovery mentions 15 documents or databases of the requested discovery. The motion for additional discovery cites to, relies upon, and essentially incorporates by reference the table to argue that most of the requested discovery is relevant, and does not, itself, address the relevance of all of the requested discovery. *See* Mot. 1, n. 2 ("The relevance of each document is listed in Exhibit 2155."), Mot. 3 ("TT has only summarized each document[']s relevance in Ex. 2155"). The table essentially increases the 12 page motion for additional discovery to at least 21 pages, exceeding the page limit set by us. The motion for additional discovery, thus, fails to comply with our order. Additionally, the motion for additional discovery fails to comply with 37 C.F.R. § 42.6(a)(3), which prohibits incorporation of arguments from one document into another. We, thus, will not consider the arguments in Ex. 2155.

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