

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
CBM2015-00181 (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
Conduct of the Proceedings
37 C.F.R. § 42.5

¹ Case CBM2016-00035 has been joined with this proceeding.

CBM2015-00161 (Patent No. 6,766,304 B2)
CBM2015-00181 (Patent No. 7,676,411 B2)
CBM2015-00182 (Patent No. 6,772,132 B1)

On October 25, 2016, Patent Owner sent an email to trials@uspto.gov requesting 1) authorization to file a “Citation of Supplemental Authority” in CBM2015-00161, CBM2015-00181, and CBM2015-00182 and 2) authorization to file a “Supplemental Case Law Statement” in CBM2015-00181 and CBM2015-00182. For the reasons discussed below, Patent Owner’s requests are denied.

First, Patent Owner requests permission to file a “Citation of Supplemental Authority” to bring to the Board’s attention precedential Federal Circuit cases that have issued on 35 U.S.C. § 101 and 35 U.S.C. § 103 after substantive briefing concluded on September 9, 2016. Patent Owner’s email includes a list of the cases. The list includes *Synopsis, Inc. v. Mentor Graphics Corp.*, No. 2015-1599 (Fed. Cir. Oct. 17, 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, No. 2015-1985 (Fed. Cir. Oct. 11, 2016); *Intellectual Ventures I LLC v. Symantec Corp.*, No. 2015-1769 (Fed. Cir. Sept. 30, 2016); *Affinity Labs. of Tex. v. DirecTV Digital LLC*, No. 2015-1845 (Fed. Cir. Sept. 23, 2016); *Affinity Labs. of Tex. v. Amazon.com Inc.*, No. 2015-2080 (Fed. Cir. Sept. 23, 2016); and *McRo, Inc. v. Bandai Namco Games Am. Inc.*, No. 2015-1080 (Fed. Cir. Sept. 13, 2016) and indicates that these cases relate to analysis under 35 U.S.C. § 101. The list also includes *Apple Inc. v. Samsung Electronics Co. Ltd.*, No. 2015-1171 (Fed. Cir. Oct. 7, 2016) and indicates that this case relates to secondary considerations of obviousness and evidence relating to the motivation to combine teachings. Patent Owner’s email indicates that Petitioners do not object to an identification of the cases.

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Patent Owner's first request is denied. There is no need for Patent Owner to file a separate "Citation of Supplemental Authority" paper to bring the cases to our attention. By listing the cases in its email, Patent Owner has already brought the cases to the Board's attention, and per this order, those cases are made of record.

Second, Patent Owner requests permission to file a "Supplemental Case Law Statement" in response to Petitioners' Replies. In particular, Patent Owner seeks to provide a citation to and explain how *J.T. Eaton & Co., Inc. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563 (Fed. Cir. 1997) clarifies the proper legal standard that applies to the secondary considerations analysis. Patent Owner's email indicates that Petitioners are opposed to supplemental briefing.

Patent Owner's second request is denied. In essence, Patent Owner is seeking to file a sur-reply to the Petitioners' Replies. Patent Owner's request is not timely. "A party should seek relief promptly after the need for relief is identified. Delay in seeking relief may justify a denial of relief sought." 37 C.F.R. § 42.25(b). Petitioners' Replies were filed on September 9, 2016. Paper 105.² We cannot discern a sufficient reason as to why Patent Owner waited more than a month, until after oral argument, to request to file a sur-reply. Patent Owner's email indicates that it intended to provide the citation and explanation during the oral argument. However, this is also not a sufficient reason, as parties are prohibited from raising new argument

² For the purposes of this Order, CBM2015-00181 is representative and all citations are to papers in CBM2015-00181 unless otherwise noted.

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at oral hearing. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012)); *see* Paper 110, 3 (discussing the prohibition of new arguments at oral hearing).

In addition, *J.T. Eaton* was decided on February 11, 1997. The Patent Owner's Response was filed on June 27, 2016. Paper 71. Patent Owner could have included the citation to and explanation of *J.T. Eaton* in its Patent Owner's Response.

It is:

ORDERED that Patent Owner's request for authorization to file a "Citation of Supplemental Authority" in CBM2015-00161, CBM2015-00181, and CBM2015-00182 and to file a "Supplemental Case Law Statement" in CBM2015-00181 and CBM2015-00182 is denied.

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