

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.
Petitioner,

v.

Patent of **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.

CHANG, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On March 4, 2013, a telephone conference call was held between respective counsel for the parties and Patent Judges Lee, Medley, and Chang. Counsel for the petitioner (“Bloomberg”) initiated the call to: (1) seek authorization to file supplemental information before a trial is instituted; (2) note that the patent owner preliminary response improperly contains new testimonial evidence; (3) seek authorization to file a motion for *pro hac vice* admission of an attorney; and (4) notify the Board that the concurrent district court actions identified in the petition have been stayed in view of the instant proceeding.

At the conference call, Bloomberg explained that it would like to submit an affidavit from the organization “Internet Archive” regarding certain archived Web pages cited in the petition as supplemental information so that the Board and patent owner would have the information as earliest as possible. According to Bloomberg, the affidavit relates to authentication of the cited prior art. Bloomberg indicated that, alternatively, it could seek authorization later after a trial has been instituted, to file a motion to submit supplemental information under 37 C.F.R. § 42.223.

In response, counsel for the patent owner (“Markets-Alert”) expressed that it is not clear whether there is anything else accompanying the affidavit and Markets-Alert would like an opportunity to respond to the submission.

Upon consideration of the parties’ discussion, the Board noted that such information is currently not needed to decide whether to institute a trial. If a trial is instituted, Bloomberg may renew its request. Markets-Alert may reply to the submission in its patent owner response.

As to the second item, Bloomberg directed attention to 37 C.F.R. § 42.207 which provides that a patent owner preliminary response “shall not present new

testimony evidence beyond that already of record, except as authorized by the Board,” and noted that the Board has not provided such authorization in this proceeding. In Bloomberg’s view, Markets-Alert’s exhibit 3 filed with the preliminary response containing a declaration of the sole inventor of the subject patent is unauthorized testimonial evidence.

Markets-Alert, however, counters that the declaration is a publically available document that was filed in a co-pending district court action, and thereby not “new testimony evidence” within the meaning of 37 C.F.R. § 42.207. The Board agrees with Markets-Alert that testimonial evidence previously filed in a different proceeding may be submitted in a preliminary response.

As to the third item, the Board previously authorized both parties to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c) (Paper 12). No new authorization is needed for Bloomberg to file a motion for *pro hac vice* admission.

With respect to the fourth item, the Board appreciates the information provided by Bloomberg that is related to the stay of the concurrent district court actions. The Board notes that it is not necessary for the parties to file any paper related to this matter.

For the foregoing reasons, it is

ORDERED that Bloomberg’s request for authorization to file supplemental information before a trial is instituted is denied without prejudice.

Case CBM2013-00005
Patent 7,941,357

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