

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL SECURITIES EXCHANGE, LLC,
Petitioner,

v.

CHICAGO BOARD OPTIONS EXCHANGE, INC.,
Patent Owner.

Case CBM2013-00051
Patent 8,266,044 B2

Before JUSTIN T. ARBES, RAMA G. ELLURU, and
JAMES B. ARPIN, *Administrative Patent Judges*.

ELLURU, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 328(a) and 37 C.F.R. § 42.73

I. BACKGROUND

Petitioner, International Securities Exchange, LLC, filed a second corrected Petition (Paper 7, “Pet.”) requesting review under the transitional program for covered business method patents of claims 1–3 of U.S. Patent No. 8,266,044 B2 (Ex. 1001, “the ’044 patent”). Patent Owner, Chicago Board Options Exchange, Inc., filed a Preliminary Response (Paper 14, “Prelim. Resp.”). On March 4, 2014, pursuant to 35 U.S.C. § 324, we instituted this trial as to claims 1–3 on one ground of unpatentability, 35 U.S.C. § 101 (Paper 15, “Dec. to Inst.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 24, “PO Resp.”), a First Supplemental Response (Paper 36, “PO First Supp. Resp.”), a Second Supplemental Response (Paper 48, “PO Second Supp. Resp.”), a Motion to Amend (Paper 23, “Mot.”), and a Reply in support of its Motion (Paper 39, “PO Reply”). Petitioner filed a Reply (Paper 33, “Pet. Reply”) to Patent Owner’s Response, a First Supplemental Reply (Paper 38, “Pet. First Supp. Reply”), a Second Supplemental Reply (Paper 49, “Pet. Second Supp. Reply”), and an Opposition to Patent Owner’s Motion to Amend (Paper 35, “Opp.”).

An oral hearing was held on August 22, 2014, and a transcript of the hearing is included in the record (Paper 46, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–3 of the ’044 patent are unpatentable.

A. *The '044 Patent*

The '044 patent, titled “Automated Trading Exchange System Having Integrated Quote Risk Monitoring and Integrated Quote Modification Services,” issued on September 11, 2012, based on U.S. Patent Application No. 13/178,289 (“the '289 application”), filed on July 7, 2011.¹

The '044 patent relates to automated trading systems for option contracts (“options”). Ex. 1001, 1:18–22, Abstract. Specifically, the claimed invention is directed to systems for managing the risk of a maker of an options market in an automated trading system. *Id.* at 1:18–22.

Options are traded publicly on exchanges. *Id.* at 1:27–28. Each option covers certain rights to buy or sell an underlying security at a fixed price for a specified period of time. *Id.* at 1:28–31. The potential loss to the buyer of an option is no greater than the initial premium paid for the option, regardless of the performance of the underlying security. *Id.* at 1:37–39. On the contrary, in exchange for the premium, the seller of the option (“the market-maker”) assumes the risk of being assigned the obligation to buy or sell the underlying security, according to the option terms, if the contract is exercised. *Id.* at 1:40–45. Thus, writing options may entail large risks to the market maker. *Id.* at 1:44–45.

Many option trading systems utilize an “open outcry” method. *Id.* at

¹ The '289 application is a continuation of U.S. Patent Application No. 12/035,996 (“the '996 application”), which issued as U.S. Patent No. 7,980,457 B2 (“the '457 patent”). The '996 application is a continuation of U.S. Patent Application No. 09/475,534, which issued as U.S. Patent No. 7,356,498 B2 (“the '498 patent”). The '457 patent is the subject of CBM2013-00050 and IPR2014-00098. The '498 patent is the subject of CBM2013-00049 and IPR2014-00097. Final Written Decisions also are entered in these cases concurrently with this Decision.

1:53–54. In such systems, market-makers are required to make a two-sided market by providing an order and offer quote. *Id.* at 1:54–56. In a non-automated open outcry system, a market-maker communicates verbally with traders indicating their willingness to buy and sell various quantities of securities. *Id.* at 1:56–59. Because a market-maker in such systems has personal control over the types and number of options traded, the market-maker can manage risk associated with his or her options portfolio. *Id.* at 1:59–61. A market-maker manages risk by modifying quotes for options to favor trades that tend to hedge against unwanted risk. *Id.* at 1:61–65.

The '044 patent Specification states that an automated trading environment already was known in the art. *Id.* at 1:66, 2:1–8. An automated computer-based trading system typically records quotes and automatically matches them with orders that enter the system. *Id.* at 1:66–2:4. One disadvantage of known automated trading systems is that the systems execute trades so rapidly that a market-maker may be unable to withdraw or modify his quotes in a timely manner. *Id.* at 2:4–15.

Software tools that assess trading option portfolio risk and recommend quote modifications also were known. *Id.* at 2:16–21. An automated trading system, however, processes transactions in the order received. *Id.* at 2:26–28. Thus, even if a market-maker uses such software tools to modify quotes, those tools may be unable to act in time, given the speed at which the automated trading exchange system executes orders. *Id.* at 2:21–26. For example, an automated trading exchange may have a message queue containing additional orders that must be processed before the automated exchange receives and processes the market-maker's quote modification request. *Id.* at 2:28–33. These known automated trading

exchange systems, therefore, limit a market-maker's ability to manage risk. *Id.* at 2:34–42. The '044 patent Specification recognizes the need for a method that automatically modifies quotes under certain trading conditions in an automated trading exchange system. *Id.* at 2:43–45.

The invention of the '044 patent is directed to systems for an automated trading exchange that modify quotes, where the system provides integrated quote risk monitoring and quote modification services. *Id.* at 2:49–51. Thus, one aspect of the invention is an apparatus that implements the method using a computer, having memory, a processor, and a communication port. *Id.* at 2:51–54.

The computer receives orders and quotes, wherein a quote has associated trading parameters, such as a risk threshold. *Id.* at 2:54–57. The computer then may generate a trade by matching the received orders and quotes to previously received orders and quotes. *Id.* at 2:64–66. If a trade is not generated, the computer stores each of the received orders and quotes. *Id.* at 2:66–67. The computer determines whether a market-maker's quote has been filled as a result of the generated trade, and, if so, determines a risk level and aggregate risk level associated with the trade. *Id.* at 2:67–3:4. The computer then compares the aggregate risk level with the market-maker's risk threshold for a quote; if the threshold is exceeded, the computer automatically modifies at least one of the market-maker's remaining quotes. *Id.* at 3:4–7.

B. Illustrative Claim

Of the challenged claims, claim 1 is the only independent claim. Claim 1 of the '044 patent, reproduced below, is illustrative of the challenged claims:

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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.

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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.

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