

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FEDERAL RESERVE BANK OF ATLANTA, FEDERAL RESERVE BANK OF BOSTON, FEDERAL RESERVE BANK OF CHICAGO, FEDERAL RESERVE BANK OF CLEVELAND, FEDERAL RESERVE BANK OF DALLAS, FEDERAL RESERVE BANK OF KANSAS CITY, FEDERAL RESERVE BANK OF MINNEAPOLIS, FEDERAL RESERVE BANK OF NEW YORK, FEDERAL RESERVE BANK OF PHILADELPHIA, FEDERAL RESERVE BANK OF RICHMOND, FEDERAL RESERVE BANK OF SAN FRANCISCO, and FEDERAL RESERVE BANK OF ST. LOUIS,
Petitioner,

v.

BOZEMAN FINANCIAL LLC,
Patent Owner.

Case CBM2017-00035 (Patent 6,754,640 B2)
Case CBM2017-00036 (Patent 8,768,840 B2)¹

Before MICHAEL W. KIM, WILLIAM V. SAINDON, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

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

¹ This Decision addresses the same issue in the above-identified post-grant reviews. Therefore, we issue one Decision to be filed in all cases.

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On April 4, 2018, Judges Kim, Saindon, and Cherry held a conference call with counsel for the parties regarding Petitioner's objections to certain slides of Patent Owner's demonstratives for the oral hearing (Exhibit 2009, filed Apr. 3, 2018) and Petitioner's concerns regarding the use of confidential materials at the oral hearing.

With respect to objections to Patent Owner's demonstratives, Petitioner objected to slides 2–4, 6–15, 22–23, and 32–35. Petitioner objected to slides 2–4 and 6–15 as including figures from the challenged patents that were never previously cited in Patent Owner's briefs. Slide 22 was objected to for including material not included in Patent Owner's briefs—namely, a comparison of a figure of U.S. Patent No. 8,311,945 B2 and a figure from the challenged patents. Slide 23 was objected to as including mischaracterizations of the record. Finally, slides 32–35 were objected to as including arguments regarding the Section 101 ground in CBM2017-00035 that were never previously raised.

On the call, we sustained-in-part and overruled-in-part Petitioner's objections. We overruled Petitioner's objections with respect to slides 2–4 and 6–15, because even though those figures of the challenged patents were not previously cited, Patent Owner remains free to use them as background in explaining its invention. We strongly cautioned Patent Owner to use them as background only and not to advance new arguments not contained in its written briefs. With respect to slide 22, we noted that Patent Owner had presented arguments regarding the similarities between its claims and the claims of U.S. Patent No. 8,311,945 B2. We declined to preemptively limit the way Patent Owner could present these arguments at the oral hearing. Again, however, we cautioned Patent Owner not to present new arguments using slide 22, and to limit the slide's use to presenting its existing arguments. As for slide 23, we declined to

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exclude the slide solely for alleged inaccuracies. We noted that Petitioner would have an opportunity at the oral hearing to point out, on the record, the alleged inaccuracies in Patent Owner's presentation. Finally, we sustained Petitioner's objections against slides 32–35. We noted that the Patent Owner Response in CBM2017-00035 contained no arguments on the Section 101 ground and merely attempted to incorporate by reference from the briefs filed in CBM2017-00036 (involving a different patent). We informed Patent Owner that this incorporation by reference was improper, and that we would not consider arguments incorporated by reference. Furthermore, we noted that even if the incorporated by reference arguments were considered, they did not include the limitation-by-limitation analysis of the claims of the patent challenged in CBM2017-00035, as was shown in slides 32–35. Thus, we sustained Petitioner's objection to slides 32–35.

As for the issues regarding confidentiality, Patent Owner agreed to waive, for purposes of the hearing, any confidentiality in the materials presented in Petitioner's slides. Patent Owner agreed that Petitioner would be able to file its unredacted slides in the public record and use them in the hearing without sealing the hearing room.

ORDERED that, for the reasons set forth above, Petitioner's objections to slides 2–4, 6–15, 22–23, and 32–35 are overruled-in-part and sustained in part; and

FURTHER ORDERED that slides 32–35 of Exhibit 2009 (filed on April 3, 2018) are excluded.

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