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Paper 20
Entered: July 14, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL SECURITIES EXCHANGE, LLC,
Petitioner,

v.

CHICAGO BOARD OPTIONS EXCHANGE, INCORPORATED,
Patent Owner.

Case IPR2014-00097 (Patent 7,356,498 B2)
Case IPR2014-00098 (Patent 7,980,457 B2)[1]

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

ARBES, *Administrative Patent Judge.*

DECISION
Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

[1] This Decision addresses an issue pertaining to both cases. Therefore, we exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

Patent Owner filed a motion for additional discovery in the instant proceedings. IPR2014-00097, Paper 18 ("Mot."); IPR2014-00098, Paper 18. Petitioner was authorized to file an opposition by July 7, 2014, but did not do so. *See* IPR2014-00097, Paper 16 at 5–6; IPR2014-00098, Paper 16 at 5–6. For the reasons stated below, Patent Owner's motion is *granted*.

In an *inter partes* review proceeding, a party seeking discovery beyond what is expressly permitted by rule must do so by motion, and must show that such additional discovery is "necessary in the interest of justice." 35 U.S.C. § 316(a)(5); *see* 37 C.F.R. § 42.51(b)(2)(i). We consider various factors in determining whether additional discovery in an *inter partes* review proceeding is necessary in the interest of justice. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26).

Patent Owner contends that during prosecution of one of Petitioner's patent applications, U.S. Patent Application No. 09/895,379 ("the '379 application"), Petitioner made statements about a prior art reference asserted in the instant proceedings, U.S. Patent No. 6,405,180 B2 ("Tilfors"), that are inconsistent with positions taken by Petitioner in its petitions. Mot. 2–4. Patent Owner states that it has portions of the '379 application file history that were produced in the related litigation between the parties, but does not have the complete file history, which is not available publicly because the application was abandoned. *Id*. (citing Exs. 2001–2009). According to Patent Owner, Petitioner's statements during prosecution of the '379 application "are relevant to how a person skilled in the art would have understood Tilfors, and the complete file history is necessary to put those statements in context." *Id*. at 2. Patent Owner requests that Petitioner be

ordered to "(1) authorize [Patent Owner] to obtain the file history from the USPTO; or (2) request that one of the numerous patent search firms obtain the file history from the USPTO on behalf of [Petitioner]." *Id*. at 5.

After reviewing Patent Owner's motion, we are persuaded that Patent Owner's request satisfies the factors set forth in *Garmin* and that the additional discovery is necessary in the interest of justice. Patent Owner's request is narrow, easily understandable, and not unduly burdensome, and demonstrates more than a mere possibility of uncovering something useful. *See id*. at 3–5. In addition, because the '379 application was not published, the file history of the application appears to represent information that Patent Owner cannot obtain reasonably without a discovery request, and the discovery sought by Patent Owner is not related to Petitioner's litigation positions or the underlying basis for such positions. *See id*. at 4–5. We also note that Petitioner did not file an opposition to the motion or otherwise indicate any confidentiality issues with respect to the abandoned application during the conference call on June 19, 2014.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's motion for additional discovery is *granted*; and

FURTHER ORDERED that Petitioner shall, by July 18, 2014, provide a copy of the complete file history of the '379 application to Patent Owner, or authorize Patent Owner to obtain a copy from the Office.

IPR2014-00097 (Patent 7,356,498 B2)
IPR2014-00098 (Patent 7,980,457 B2)

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