

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHICAGO MERCANTILE EXCHANGE, INC.,
Petitioner,

v.

5th MARKET, INC.,
Patent Owner.

Case CBM2015-00061
Patent 7,024,387 B1

Before MICHAEL R. ZECHER, KALYAN K. DESHPANDE, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION

Granting Petitioner's Motion to Apply for a Subpoena to Compel the
Testimony of Mr. Jonathan C. Wheeler
35 U.S.C. § 24 and 37 C.F.R. § 42.52(a)

I. INTRODUCTION

Petitioner, Chicago Mercantile Exchange, Inc. (“CME”), filed a Motion to Apply for a Subpoena under 35 U.S.C. § 24 to Compel the Testimony of Mr. Jonathan C. Wheeler pursuant to 37 C.F.R. § 42.52(a). Paper 21 (“Mot.”). Patent Owner, 5th Market, Inc. (“5th Market”), does not oppose this Motion. Paper 20, 2. 5th Market, nonetheless, filed a responsive paper addressing the scope and logistics of Mr. Wheeler’s testimony. Paper 23 (“Resp. to Mot.”). Based on the particular circumstances presented in this case, we *grant* CME’s Motion to Apply for a Subpoena to Compel the Testimony of Mr. Wheeler.

II. ANALYSIS

1. Subpoena to Compel the Testimony of Mr. Wheeler

At the outset, we note that two of the three grounds we instituted in this proceeding are based, in whole or in part, on CFTC.¹ Paper 9, 42. In its Patent Owner Response, 5th Market contends that CME has failed to carry its burden of establishing that CFTC is a printed publication within the meaning of 35 U.S.C. § 102(b) and, therefore, CFTC does not qualify as prior art to U.S. Patent No. 7,024,387 B1 (“the ’387 patent”). Paper 18, 17–18. CME represents that, as part of its Reply, it intends to rely on a Declaration of Mr. Wheeler (Ex. 1025), which it served as supplemental evidence under 37 C.F.R. § 42.64(b)(2) in response to evidentiary objections timely filed by 5th Market under 37 C.F.R. § 42.64(b)(1). Mot. 1 (citing Ex. 1024, 9:8–9). CME

¹ Memorandum from the Commodity Futures Trading Commission on the New York Mercantile Exchange’s (“NYMEX”) Proposal to Implement the NYMEX ACCESS Trading System (Dec. 7, 1992) (on file with the Commodity Futures Trading Commission) (Ex. 1003, “CFTC”).

acknowledges that the Declaration of Mr. Wheeler was not prepared for purposes of this proceeding. *Id.* at 3. According to CME, this previously prepared Declaration of Mr. Wheeler supports the instituted grounds, based in whole or in part, on CFTC. *Id.* at 1. CME further represents that Mr. Wheeler is a paralegal specialist at the Commodities Future Trading Commission—a third party to this proceeding. *Id.* CME also represents that Mr. Wheeler is not available voluntarily to offer further testimony. *Id.* at 1, 4.

Whether CFTC was made publicly accessible prior to the earliest effective filing date of the '387 patent is an issue that may be dispositive in this proceeding. Consequently, we are not inclined to deprive the parties of the opportunity to develop Mr. Wheeler's testimony regarding this issue through further examination. *See Marvell Semiconductor, Inc. v. Intellectual Ventures LLC*, Case IPR2014-00553, slip op. 3 (PTAB Apr. 8, 2015) (Paper 28) (The Board granted a Motion to Compel the Testimony of certain declarants regarding the public accessibility of an asserted reference noting that the declarants' availability "should not deprive the parties of the opportunity to develop their testimony through further examination.").

At this juncture in the proceeding, we recognize that CME has yet to present and develop the Declaration of Mr. Wheeler (Ex. 1025) in a substantive paper. CME, however, represents that it intends to rely on the Declaration of Mr. Wheeler in its Reply to support the instituted grounds based, in whole or in part, on CFTC (Mot. 1), which includes, among other things, demonstrating whether CFTC was made publicly accessible prior to the earliest effective filing date of the '387 patent. Consistent with the regulatory provision that mandates we "secure the just, speedy, and inexpensive resolution of every proceeding" (37 C.F.R. § 42.1(b)), we authorize the issuance of a subpoena to

compel to the testimony of Mr. Wheeler, at this time, so that CME can make Mr. Wheeler available for cross-examination regarding the testimony and subject matter in his Declaration.

2. Scope and Logistics of the Deposition of Mr. Wheeler

Regarding the scope and logistics of the deposition of Mr. Wheeler, CME contends that Mr. Wheeler's further testimony should be limited to the statements and subject matter in his Declaration. Mot. 4. CME also requests that a maximum of two hours be allotted for both parties to complete the deposition. *Id.* CME further requests that the deposition of Mr. Wheeler occur no later than January 10, 2016. *Id.* at 4-5.

In its Response to CME's Motion, 5th Market requests that we not limit Mr. Wheeler's further testimony to statements and subject matter in his Declaration, but we also order that the subpoena include a request for all the documents and records Mr. Wheeler may have relied upon to prepare his Declaration. Resp. to Mot. 1 (citing Ex. 1025 ¶¶ 1, 2, 6). In addition, 5th Market contends that CME's request to limit the deposition of Mr. Wheeler to a maximum duration of two hours is unreasonably short. *Id.* at 2. Instead, 5th Market requests that the duration of the deposition should be set according to 37 C.F.R. § 42.53(c)(2)—namely, seven hours of cross-examination; four hours for redirect examination; and two hours for re-cross examination. *Id.*

5th Market's assertion that the subpoena should include a request for all the documents and records Mr. Wheeler may have relied upon to prepare his Declaration falls outside of the scope of the Response authorized in the Order we entered on November 3, 2015. In that Order, we authorized 5th Market "to file a responsive paper that is tailored narrowly to address the scope and logistics of Mr. Wheeler's testimony." Paper 20, 3. We did not authorize 5th

Market to file a Response that includes a request to produce documents and records. In our view, such a request amounts to a new Motion for Additional Discovery under 37 C.F.R. § 42.51(b)(2)(ii).

Even if we were to treat 5th Market's assertion as a new Motion for Additional Discovery under 37 C.F.R. § 42.51(b)(2)(ii), 5th Market has not carried its burden of demonstrating that such discovery is "necessary in the interest of justice." 35 U.S.C. § 316(a)(5)(B) (setting standards and procedures for discovery of relevant evidence, including that such discovery should be limited to "what is otherwise necessary in the interest of justice"); *see also* 37 C.F.R. § 42.51(b)(2)(i) ("The moving party must show that such additional discovery is in the interests of justice . . ."). *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. 6–7 (PTAB Mar. 5, 2013) (Paper 26) (informative), sets forth a list of factors important in assessing whether a Motion for Additional Discovery meets the standard of "necessary in the interest of justice." Those factors include: (1) the request is based on more than a mere possibility of finding something useful; (2) the request does not seek the litigation positions of the other party; (3) the information is not reasonably available through other means; (4) the request is easily understandable; and (5) the request is not overly burdensome to answer.

5th Market does not address adequately these *Garmin* factors. For instance, 5th Market does not explain how its request is tailored narrowly to a discrete and manageable set of specific, identified documents and records. We, therefore, decline to expand the subpoena to include a request for all the documents and records Mr. Wheeler may have relied upon to prepare his Declaration.

We also decline 5th Market's request to set the duration of the deposition of Mr. Wheeler in accordance with the time limits set forth in 37 C.F.R. § 42.53(c)(2). We are mindful of the burden placed on Mr. Wheeler—a third party to this proceeding—by our decision to grant CME's Motion to apply for a subpoena to compel his testimony. The Declaration of Mr. Wheeler, excluding attachments, only spans seven pages and includes twenty-one paragraphs. Ex. 1025. Given that we are limiting Mr. Wheeler's testimony to the statements and subject matter in his Declaration, two hours of total deposition time seems more than sufficient to elicit any further testimony from Mr. Wheeler regarding, e.g., whether CFTC was made publicly accessible prior to the earliest effective filing date of the '387 patent.

III. ORDER

Accordingly, it is:

ORDERED that CME is authorized to file a Motion to Apply for a Subpoena under 35 U.S.C. § 24 to Compel the Testimony of Mr. Jonathan C. Wheeler pursuant to 37 C.F.R. § 42.52(a) in a United States District Court where such testimony will be taken;

FURTHER ORDERED that scope of the subpoena shall be limited to the statements and subject matter in the Declaration of Mr. Wheeler;

FURTHER ORDERED that the deposition of Mr. Wheeler is limited to cross-examination and redirect examination, the duration is limited to a maximum time of two hours, and it should occur no later than January 10, 2016. The deposition of Mr. Wheeler shall be subject to the following time limits: (1) one and half hours of cross-examination; and (2) a half hour of redirect examination; and

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FURTHER ORDERED that, although CME is permitted to conduct redirect examination of Mr. Wheeler, such redirect examination must be limited to the subject matter of his cross-examination testimony.

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