

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CHICAGO MERCANTILE EXCHANGE, INC.  
Petitioner

v.

5th MARKET, INC.  
Patent Owner

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Case CBM2013-00027  
Patent 6,418,419

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Before JAMESON LEE, JONI Y. CHANG, and MICHAEL R. ZECHER,  
*Administrative Patent Judges.*

ZECHER, *Administrative Patent Judge.*

DECISION  
Petitioner's Request for Rehearing  
*37 C.F.R. § 42.71*

## I. INTRODUCTION

Chicago Mercantile Exchange, Inc. (“Petitioner”) requests rehearing (Paper 11, “Reh’g Req.”) on the Board’s decision to institute (Paper 9, “Dec.”) a covered business method patent review of claims 1-23 and 41-49 of U.S. Patent No. 6,418,419 (“the ’419 patent”). In the decision to institute, the Board determined that Petitioner did not demonstrate that: (1) claims 1-23 and 41-49 are, more likely than not, directed to non-statutory subject matter under 35 U.S.C. § 101; and (2) claims reciting the claim phrase “means for matching” are, more likely than not, indefinite under 35 U.S.C. § 112, ¶ 2. Dec. 24-25, 35-41.

In its request for rehearing, Petitioner contends that: (1) the Board should consider recent developments pertaining to the unsettled law of statutory subject matter under § 101 and, therefore, institute the ground of unpatentability based on § 101 initially proposed by Petitioner so that the Board may gain the benefit of forthcoming guidance provided by the United States Supreme Court in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l.*; and (2) the Board misapprehended the specification of the ’419 patent when determining that there was sufficient structure that corresponds to the claim phrase “means for matching.” Reh’g Req. 2-15. For the reasons set forth below, Petitioner’s request for rehearing is denied.

## II. ANALYSIS

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The request for rehearing must identify specifically all matters the party believes the Board misapprehended or

overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. 37 C.F.R. § 42.71(d).

In its rehearing request, Petitioner presents a number of arguments explaining why the Board should reconsider its decision not to institute the alleged ground of unpatentability based on § 101. Reh'g Req. 2-11. Those arguments include the following: (1) the Board should institute the alleged ground of unpatentability based on § 101 to gain the benefit of forthcoming Supreme Court guidance in the fractured area of evaluating computer-implemented inventions under § 101; (2) instituting the alleged ground of unpatentability based on § 101 would not unduly delay this proceeding; (3) rehearing is proper because Petitioner could not have presented the aforementioned arguments in the petition; and (4) the Board has flexibility to determine how to include the alleged ground of unpatentability based on § 101 in this proceeding. *Id.* However, Petitioner's arguments do not identify specifically what we overlooked or misapprehended, and the place where each matter was addressed previously in the petition. Dec. 35-41.

If we were to reconsider our decision and institute the alleged ground of unpatentability based on § 101 just to gain the benefit of prospective guidance from the Supreme Court, this proceeding would be an open-ended process. Petitioner is reminded that the Board is charged with securing the just, speedy, and inexpensive resolution of every proceeding. 37 C.F.R. § 42.1(b). Instituting a ground of unpatentability based on § 101 that initially was denied in the decision on institution, or allowing the Petitioner to reintroduce such a ground at a later point in time during a proceeding, simply because the Board may receive new guidance from either the Supreme Court or the United States Court of Appeals for

the Federal Circuit, would defeat the purpose of that mandate. When determining whether to institute a covered business method patent review, the Board renders its decision in light of precedential case law that exists at that point in time. The Board does not render its decision using prospective guidance from either the Supreme Court or the Federal Circuit, nor will the Board speculate or assume what guidance is forthcoming.

Next, Petitioner contends that the specification of the '419 patent does not disclose sufficient structure that corresponds to the claim phrase "means for matching," but instead merely explains how orders are routed. Reh'g Req. 11-15. Petitioner presents new arguments and evidence that were not relied upon in the petition. *Compare* Pet. 8-10, 15-18 (citing Ex. 1001, 7:22-24) *with* Reh'g Req. 11-5 (citing Ex. 1001, 6:31-34, 6:47-7:47, fig. 3). A request for rehearing is not an opportunity to present new arguments or evidence that could have been presented and developed in the petition. We could not have overlooked or misapprehended arguments or evidence not presented and developed by Petitioner in the first instance in the petition. Therefore, we maintain our initial position that, because the specification of the '419 patent discloses sufficient structure for performing the recited function of "matching," Petitioner has not demonstrated that claims reciting the claim phrase "means for matching" are, more likely than not, indefinite under § 112, ¶ 2. Dec. 13-15, 24-25.

### III. CONCLUSION

For the foregoing reasons, the Board did not abuse its discretion in determining that Petitioner did not demonstrate that: (1) claims 1-23 and 41-49 are, more likely than not, directed to non-statutory subject matter under § 101; and (2) claims reciting the claim phrase “means for matching” are, more likely than not, indefinite under § 112, ¶ 2. Accordingly, Petitioner’s request for rehearing is denied.

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PETITIONER:

Erika H. Arner  
Timothy P. McAnulty  
Justin Loffredo  
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP  
[erika.arner@finnegan.com](mailto:erika.arner@finnegan.com)  
[timothy.mcanulty@finnegan.com](mailto:timothy.mcanulty@finnegan.com)  
[justin.loffredo@finnegan.com](mailto:justin.loffredo@finnegan.com)

Matthew J. Kelly  
Chicago Mercantile Exchange, Inc.  
[Matthew.Kelly@cmegroup.com](mailto:Matthew.Kelly@cmegroup.com)

PATENT OWNER:

D. Richard Anderson  
George S. Dolina  
Birch, Stewart, Kolasch & Birch, LLP  
[dra@bskb.com](mailto:dra@bskb.com)  
[gsd@bskb.com](mailto:gsd@bskb.com)

J. Gregory Whitehair  
The Whitehair Law Firm, LLC  
[jgw@whitehairlaw.com](mailto:jgw@whitehairlaw.com)