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35811	7590	01/24/2013	EXAMINER	
IP GROUP OF DLA PIPER LLP (US) ONE LIBERTY PLACE 1650 MARKET ST, SUITE 4900 PHILADELPHIA, PA 19103			EBERSMAN, BRUCE I	
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE PATENT TRIAL AND APPEAL BOARD
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7 *Ex parte* MICHAEL BONI, GREG HAMAMGIAN,
8 EDWIN MARCIAL, JEFFREY C. SPRECHER,
9 and ALLAN WANSKY

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12 Appeal 2011-003165
13 Application 11/024,146
14 Technology Center 3600
15 _____

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18 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
19 MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

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21 FETTING, *Administrative Patent Judge*.

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24 DECISION ON REQUEST FOR REHEARING

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STATEMENT OF THE CASE

This is a decision on rehearing in Appeal No. 2011-003165. We have jurisdiction under 35 U.S.C. § 6(b).

Requests for Rehearing are limited to matters misapprehended or overlooked by the Board in rendering the original decision. 37 C.F.R. § 41.52.

ISSUES ON REHEARING

Appellant raises two issues in the Request for Rehearing. The first issue relates to a rejection under 35 U.S.C. §101. The second issue relates to whether the panel misapprehended the combination of the references or the applicability of the last mile problem to the claims.

ANALYSIS

As to the first issue, the Examiner withdrew the rejection under 35 U.S.C. §101. Ans. 4. The panel took notice of this withdrawal in footnote 2 at Decision 5. Thus it was proper to omit discussion of that rejection.

As to the obviousness rejections, the panel found in its Decision that the rejection of claims 1-3, 5-12, and 14-21 under 35 U.S.C. § 103(a) as unpatentable over Lynn and WebICE was proper. (Decision 6).

The Appellants argue (1) that because Lynn pushes data onto a workstation and WebICE restricts access to view only, they are incompatible and teach away from one another, and that even if they could be combined, the result would be inoperative (Request 2), and (2) that the claims provide an unexpected benefit in solving the last mile problem (Request 3). Appellants refer to this last mile problem by contending that transferring proprietary data to a user's computer, even with a protection module, invokes this well-known and widely recognized problem. In essence, the

1 "last mile problem" is a recognition that no matter how many protections are
2 built into the proprietary data, there is a loss of control and thus a risk of
3 illegal copying and distribution once the data reaches an end user's machine /
4 computer.

5 We find that rather than the panel misapprehending the art, the
6 Appellants apparently do not appreciate the breadth of their claims. Claim 1
7 has 8 limitations (the wherein clause [5] below is not a limitation, but a
8 preface to limitations [6]-[9]):

- 9 [1] an exchange server
10 comprising a market database,
11 said market database storing proprietary market
12 data of an exchange entity;
- 13 [2] a data interface
14 coupled to the exchange server
15 for accessing the proprietary market data;
- 16 [3] an external data source
17 generated from an application program
18 having user generated data;
- 19 and
- 20 [4] a trader module
21 coupled to the data interface
22 for receiving and displaying the proprietary market
23 data
24 and
25 coupled to the external data source
26 for receiving and displaying the user generated
27 data,
- 28 [5] wherein the trader module:
29 [6] resides on a server
30 that is distinct and remote from any user trader
31 computer;
32 [7] provides the user with access
33 to view and use the proprietary market data
34 merged with the user generated data
35 within said trader module,

1 [8] prevents removal or transfer
2 of the proprietary market data
3 from said trader module
4 to any external software utility,
5 and
6 [9] prevents the user
7 from accessing or manipulating
8 said proprietary market data outside
9 of said trader module.
10

11 The first 4 are the structural components, *viz.* an exchange server for a
12 market database, an interface to that server, some data source external to the
13 exchange server, and a trader module that receives data from both the data
14 source and market database. Limitations [6]-[9] are all characteristics of the
15 trader module, subsumed under the preface [5]. These limitations keep the
16 trader module separate from a user trader's computer; allow view and use of
17 the proprietary data but prevent removal or transfer of that same data and
18 prevent the user from accessing or manipulating that proprietary data outside
19 the trader module.

20 The Appellants' arguments regarding incompatibility of the references
21 assumes the user and proprietary data are merged on a user's computer.
22 Request 2. But the art was applied under a model in which the data was
23 merged on the exchange's trading platform, consistent with limitation [6].
24 This same misapprehension on the part of Appellants explains why the last
25 mile problem is not relevant. Apparently, Appellants mean for the trader
26 module to be separate from the exchange trading platform, and allowing
27 orders to be sent to the trading platform. The claim is not so narrow.

28 Clearly, the open order data of the exchange satisfies the proprietary data
29 limitation and the user's security information sent to the order platform

1 satisfies the user generated data limitation. Once these data are merged
2 among remaining open orders, the user cannot access or manipulate that data
3 – it is protected by the exchange’s trading software. And once merged, the
4 data must stand together, as it is only the two separate sources of the data
5 that patentably distinguish the proprietary and user data. The label of being
6 proprietary or user in attribute is non-functional and given no patentable
7 weight.

8 We notice that in describing the last mile problem, the Appellants refer
9 to the problem of copying data. That is not in the claim and, in fact, the
10 claim provides for copying data – by providing view access, as copying may
11 be done with paper and pencil. As to using the data on the exchange trading
12 platform – the user can send in an order cancellation, or even again copy the
13 data. There is no narrowing of the manner of use.

14
15 **CONCLUSION**

16 Nothing in Appellant’s request has convinced us that we have
17 overlooked or misapprehended the combination of the references or the
18 applicability of the last mile problem to the claims as argued by Appellant.
19 Accordingly, we deny the request to reverse the rejection.

20
21 **DECISION**

22 To summarize, our decision is as follows:

- 23 • We have considered the **REQUEST FOR REHEARING**.
24 • We **DENY** the request that we reverse the Examiner as to the claim
25 rejections.

26 **REHEARING DENIED**

27 Klh