

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PERSEPHONE GmbH,
Petitioner Application 15/368,221,
Petitioner,

v.

SIMON TECHNOLOGIES LLC,
Respondent Application 14/726,075,
Respondent.

DER2017-00004

Before JAMESON LEE, MICHAEL R. ZECHER, and JUSTIN T. ARBES,
Administrative Patent Judges.

PER CURIAM.

ORDER

Denying Petitioner's Suggestions to Add Patent and
Application to Derivation Proceeding
37 C.F.R. § 42.408(b)

I. BACKGROUND

On December 2, 2016, Petitioner Persephone GmbH filed a Petition (Paper 1) requesting that we institute a derivation proceeding under 35 U.S.C. § 135 with respect to then-pending claims 1–16 of U.S. Patent Application No. 14/726,075 (“the ’075 application”) owned at the time by

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Goldman, Sachs & Co. Following a Notice from the Board (Paper 3) identifying certain procedural defects in the Petition, Petitioner filed a Corrected Petition (Paper 4, “Pet.”) on December 14, 2016.¹ Petitioner identifies U.S. Patent Application No. 15/368,221 (“the ’221 application”) as its own involved application. *See* Pet. 7; 37 C.F.R. § 42.402. Respondent SIMON Technologies LLC subsequently identified itself as the owner of the ’075 application. Paper 10.

Respondent’s ’075 application was filed on May 29, 2015, and claims the benefit of U.S. Provisional Patent Application No. 62/005,869, filed on May 30, 2014. Ex. 1001, code (60). Petitioner’s ’221 application was filed on December 2, 2016.

Since the filing of the Petition, the parties have amended the claims of the ’075 and ’221 applications multiple times. Claims 1, 2, 4, 5, 7, 8, 10, 11, and 17 of Respondent’s ’075 application are pending. Claims 1, 4–11, and 42–51 of Petitioner’s ’221 application are pending, with claims 17–41 withdrawn. Claims 1, 2, 4, 5, 7, 8, 10, 11, and 17 of Respondent’s ’075 application now appear to be identical to claims 42–50 of Petitioner’s ’221 application. We have not yet exercised exclusive jurisdiction over the applications under 37 C.F.R. § 42.3(a) for the purpose of determining whether to institute a derivation proceeding.

¹ Petitioner also appears to have filed, as an exhibit in the proceeding, an “Amended Petition” (Ex. 1110). Because the “Amended Petition” was filed prior to the Notice and Petitioner never sought authorization to file it, we consider the Corrected Petition, filed in response to the Board’s Notice, to be the operative petition in this proceeding. *See* 37 C.F.R. § 42.20.

II. SUGGESTION TO ADD THE '863 APPLICATION

On July 23, 2024, Petitioner filed a “Suggestion to Add a Patent to a Derivation Proceeding Under 37 CFR § 42.408 (Paper 27, “-863 Sugg.”).² Petitioner suggests the addition of U.S. Patent Application No. 18/092,863 (“the '863 application”) to this proceeding. -863 Sugg. 2. The '863 application was filed on January 3, 2023.³

Pursuant to 37 C.F.R. § 42.408(b), “[t]he petitioner may suggest the addition of a patent or application to the derivation proceeding. The suggestion should make the showings required under § 42.405 and explain why the suggestion could not have been made in the original petition.” See *Changes to Implement Derivation Proceedings; Final Rule*, 77 Fed. Reg. 56,068, 56,077 (Sept. 11, 2012). Rule 42.405 sets forth various required showings with respect to the petitioner’s claim(s), the respondent’s claim(s), and the invention allegedly disclosed to the respondent. See *Global Health Solutions LLC v. Selner*, DER2017-00031, Paper 91 at 7–8 (PTAB Mar. 30, 2023) (discussing the requirements of Rule 42.405); *Andersen Corp. v. GED Integrated Solutions, Inc.*, DER2017-00007, Paper 57 at 17 (PTAB Mar. 20, 2019) (same); *Catapult Innovations Pty Ltd v. adidas AG*, DER2014-00002,

² Petitioner also filed a “Petition Under 37 CFR §§ 1.182 and 1.183 to Accept Petitioner’s Suggestion to Add a Patent to a Derivation Proceeding Under 37 CFR § 42.408” (Paper 28). We understand this document to be a motion to consider the suggestion to add the '863 application. Given our consideration of that suggestion herein, we dismiss the motion as moot.

³ The '863 application is owned by Goldman Sachs & Co. LLC, not Respondent. Because we deny the suggestion for other reasons, as explained herein, we need not determine whether the '863 application may be added to the instant proceeding even though it is owned by an entity different from Respondent.

Paper 19 at 5, 16–18 (PTAB July 18, 2014) (same). Rule 42.405(a)(2)(i) requires the petitioner to show that it has “at least one claim” that is “[t]he same or substantially the same as the respondent’s claimed invention.” Rule 42.405(a)(2)(ii) similarly requires the petitioner to show that the “at least one claim” is “[t]he same or substantially the same as the invention disclosed to the respondent.” Finally, Rule 42.405(b)(3)(i) requires the petitioner to show, “[f]or each of the respondent’s claims to the derived invention, . . . why the claimed invention is the same or substantially the same as the invention disclosed to the respondent.” “Same or substantially the same” for each of the required showings means “patentably indistinct.” 37 C.F.R. § 42.401; *see Global Health*, Paper 91 at 7–8; *Andersen*, Paper 57 at 16; *Catapult*, Paper 19 at 5.

In its suggestion, Petitioner asserts that

[c]laims 51 till 70 of pending United States Patent Application No. 15/368,221 claim subject matter substantially identical to claims 1–20, respectively, of United States Patent Application No. 18/092,863.

In addition, pending claims 1–2 and 4–11 of United States Patent Application No. 15/368,221 claim substantially the same invention as the ’863 Application, and that invention was disclosed to the Respondent as detailed in the Amended Petition and attachments in the above-identified derivation proceeding.

-863 Sugg. 3. Thus, with respect to the requirement of 37 C.F.R. § 42.405(a)(2)(i) that the petitioner show that it has “at least one claim” that is “[t]he same or substantially the same as the respondent’s claimed invention,” Petitioner appears to contend that claims 51–70 of the ’221 application were substantially the same as claims 1–20 of the ’863 application.

We have reviewed the prosecution history of Petitioner's '221 application. At the time the suggestion was filed on July 23, 2024, claims 1, 2, 4–11, and 42–50 were pending and claims 17–41 had been withdrawn. Thus, claims 51–70 did not exist and, as a result, no claims 51–70 can be compared to the claims of the '863 application.

Subsequent to Petitioner filing the suggestion, though, Petitioner added claim 51 in an Office Action response filed on August 27, 2024. Claim 51, however, differs from claims 1–20 of the '863 application in numerous ways. Claim 1 of the '863 application, for example, recites a “method of defining parameters of a derivative in an information-dense user interface,” comprising, among other things, the steps of “providing for display the information-dense user interface” including a “historical data portion” and “parameter-definition portion,” where “the historical data portion depicts historical price data for the derivative and the parameter-definition portion includes visual representations of the parameters positioned to indicate default values for the parameters of the derivative,” “receiv[ing] user input,” “determining updated values of one or more additional parameters of the derivative,” and “updating the information-dense user interface.” Ex. 3001, 36. Claim 51 of the '221 application, by contrast, recites “[o]ne or more non-transitory computer-readable media storing instructions” causing the generation of “one or more proposals, associated one or more cryptographic hashes and dynamic electronic contracts in order to be able and provide means to share, execute, clear and settle financial derivatives, investment products, transaction requests, transactions or securities,” the instructions comprising,

among other things, “generating tradable investment products,” “providing online courses associated with the tradable investment products,” and “establishing information exchange events between the user of the electronic platform and other users of the electronic platform.” Ex. 3002, 38–39.

Regardless, Petitioner provides no explanation as to how the claims are substantially the same.⁴ See -863 Sugg. 2 (stating only that “[t]he present suggestion meets the requirements of 37 CFR § 42.405”), 3.

To the extent Petitioner intended to compare claims 1, 2, and 4–11 of the ’221 application to claims 1–20 of the ’863 application, that contention would fail as well. At the time the suggestion was filed, claim 1 of the ’221 application recited “[a]n electronic platform comprising one or more data processing systems” where the platform comprises, among other things, “at least one distributed computing system and distributed network for establishing events identified by cryptographic hash in order to cryptographically identify and encrypt customized computed pricing data and associated electronic platform session or proposed investment product items,” a “product generation system,” a “product education system,” and a “product exchange system.” Ex. 3003, 2–7. The claim differs from claims 1–20 of the ’863 application in numerous ways and, regardless, Petitioner

⁴ Petitioner provides a set of claim charts, with claim 1 of the ’863 application and quotes from paragraphs of the written description of the ’221 application, purportedly showing how the claim is “supported by the specification” of the ’221 application, but does not compare any claims of the ’863 application to claims of the ’221 application. See -863 Sugg. 15–25.

provides no explanation as to how they are substantially the same. *See* -863 Sugg. 2–3.

Petitioner has not made the showing required by 37 C.F.R. § 42.405(a)(2)(i) that it have “at least one claim” that is “[t]he same or substantially the same as the respondent’s claimed invention.” Accordingly, we deny Petitioner’s suggestion to add the ’863 application to this proceeding, and need not determine whether Petitioner has met the other requirements of 37 C.F.R. §§ 42.405 and 42.408(b).

III. SUGGESTION TO ADD THE ’769 PATENT

On June 28, 2020, Petitioner filed a “Suggestion to Add a Patent to a Derivation Proceeding Under 37 CFR § 42.408” (Paper 12, “-769 Sugg.”).⁵ Petitioner suggests the addition of U.S. Patent No. 10,558,769 B2 (Ex. 3004, “the ’769 patent”) to this proceeding. -769 Sugg. 1. The ’769 patent issued on February 11, 2020, from U.S. Patent Application No. 16/240,446, filed on January 4, 2019. Ex. 3004, codes (21), (22), (45). Like the ’863 application, the ’769 patent is owned by Goldman Sachs & Co. LLC. *Id.* at code (73).

In its suggestion, Petitioner asserts that

[c]laims 17, 18 and 19 of pending United States Patent Application No. 15 368221 claim subject matter substantially identical to claims 1, 13 and 20, respectively, of United States Patent Number 10,558,769.

⁵ Petitioner appears to have filed multiple copies of the document as Papers 11 and 12, correcting an exhibit number on the last page. To ensure a clear record, we rely on Paper 12 and expunge Paper 11 with the incorrect citation.

In addition, pending claims 1–2 and 4–11 of United States Patent Application No. 15 368221 claim substantially the same invention as the '769 Patent, and that invention was disclosed to the Respondent as detailed in the Amended Petition and attachments in the above-identified derivation proceeding.

-769 Sugg. 3.⁶

With respect to the requirement of 37 C.F.R. § 42.405(a)(2)(i) that the petitioner show that it has “at least one claim” that is “[t]he same or substantially the same as the respondent’s claimed invention,” at the time the suggestion was filed, claims 17–19 of the '221 application appear to have been identical to claims 1, 13, and 20 of the '769 patent. *Compare* Ex. 3004, col. 44, ll. 16–45, col. 45, l. 51–col. 46, l. 27, col. 46, l. 65–col. 48, l. 26, *with* Ex. 3005, 11–13 (Office Action response filed on June 27, 2020).

Petitioner, however, has not satisfied the requirements of 37 C.F.R. § 42.405(a)(2)(ii) that it show that it has “at least one claim” that is “[t]he same or substantially the same as the invention disclosed to the respondent,” or 37 C.F.R. § 42.405(b)(3)(i) to show, “[f]or each of the respondent’s claims to the derived invention, . . . why the claimed invention is the same or substantially the same as the invention disclosed to the respondent.”

As indicated above, Petitioner asserts that claims 1, 2, and 4–11 of the '221 application “claim substantially the same invention as the '769 Patent, and *that invention* was disclosed to the Respondent.”

-769 Sugg. 3 (emphasis added). Thus, we understand Petitioner to identify

⁶ Petitioner’s “Suggestion to Add a Patent to a Derivation Proceeding Under 37 CFR § 42.208” does not include page numbers. *See* -769 Sugg. We consider the Title page as page 1 and then proceed from there in numerical order.

then-existing claims 1, 2, and 4–11 of the '221 application as “the invention disclosed to the respondent” under Rule 42.405.

Those claims, however, differ from claims 1, 13, and 20 of the '769 patent (which were identical to then-existing claims 17–19 of the '221 application) in numerous ways. For example, claim 1 of the '769 patent recites a “method for dynamically generating data structures representing scenarios for an event linked to a plurality of macro factors and a plurality of outcomes,” comprising, among other things, the steps of “receiving responses to a set of poll questions,” “generating a graph data storage structure representing scenarios,” “filtering the responses for bias based on sentiment factors,” “applying a set of rules to the filtered responses to generate values for the macro factors,” “populating the macro factor nodes in the graph data storage structure,” and “providing for display a user interface.” Ex. 3004, col. 44, ll. 16–45. By contrast, at the time the suggestion was filed, claim 1 of the '221 application recited “[a]n electronic platform residing at one or more servers that communicate with client devices associated with one or more users,” comprising a “product generation system configured to generate tradable investment products,” a “product education system configured to provide online courses associated with the tradable investment products,” and a “product exchange system configured to . . . establish an information exchange environment between the user of the electronic platform and other users of the electronic platform.” Ex. 3005, 2–4. And again, regardless, Petitioner provides

no explanation as to how the claims are substantially the same.⁷

See -769 Sugg. 2 (stating only that “[t]he present suggestion meets the requirements of 37 CFR § 42.405”), 3.

Petitioner has not made the showings required by 37 C.F.R. § 42.405(a)(2)(ii) that it have “at least one claim” that is “[t]he same or substantially the same as the invention disclosed to the respondent,” or 37 C.F.R. § 42.405(b)(3)(i) to show, “[f]or each of the respondent’s claims to the derived invention, . . . why the claimed invention is the same or substantially the same as the invention disclosed to the respondent.” Accordingly, we deny Petitioner’s suggestion to add the ’769 patent to this proceeding, and need not determine whether Petitioner has met the other requirements of 37 C.F.R. §§ 42.405 and 42.408(b).

IV. RECORD OF THE PROCEEDING

Both applications involved in this proceeding have published and are available to the public. The ’221 application published as U.S. Patent Application Publication No. 2018/0158142 A1 on June 7, 2018. The ’075 application published as U.S. Patent Application Publication No. 2015/0348192 A1 on December 3, 2015. Also, the ’769 patent issued

⁷ Petitioner provides a set of claim charts, with claims 1, 5, 13–16, 18, and 20 of the ’769 patent and quotes from paragraphs of the written description of the ’221 application, purportedly showing how the claims are “supported by the specification” of the ’221 application, but does not compare any claims of the ’769 patent to claims 1, 2, and 4–11 of the ’221 application. *See* -769 Sugg. 16–45; Ex. 1020.

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on February 11, 2020, and the '863 application published as U.S. Patent Application Publication No. 2023/0214923 A1 on July 6, 2023.

Pursuant to 37 C.F.R. § 42.412(b)(1), “[t]he record of a Board proceeding is available to the public, unless a patent application not otherwise available to the public is involved.” A party, however, may file a motion to seal and proposed protective order, and the information at issue is sealed pending the outcome of the motion. 37 C.F.R. §§ 42.14, 42.54, 42.55. Only “confidential information” is protected from disclosure. 37 C.F.R. §§ 42.54, 42.55. In that regard, the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 19, *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>, provides:

The rules aim to strike a balance between the public’s interest in maintaining a complete and understandable file history and the parties’ interest in protecting truly sensitive information.

. . .

Confidential Information: The rules identify confidential information in a manner consistent with Federal Rule of Civil Procedure 26(c)(1)(G), which provides for protective orders for trade secret or other confidential research, development, or commercial information. 37 C.F.R. § 42.54.

The standard for granting a motion to seal is “for good cause.” 37 C.F.R. § 42.54(a). The filing party bears the burden of proof in showing entitlement to the relief requested in a motion to seal. 37 C.F.R. § 42.20(c).

The parties appear to have filed certain documents (Papers 9–16, 21–23, and 25–28, and Exhibits 1020–1022 and 2001) as “Parties and Board Only” in the Board’s electronic filing system, but did not file any corresponding motion to seal. Because all applications are available to the public, the record of this proceeding will be made publicly available in the

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Board's electronic filing system within ten days from the date of entry of this Order. Also, the documents filed as "Parties and Board Only" will be changed to "Public" after expiration of ten days from the date of entry of this Order unless a motion to seal is filed before that time directed to these documents to justify their sealing. *See* 37 C.F.R. § 42.412(b)(1). To the extent any future filings contain confidential information, the parties must file, concurrently, a motion to seal pursuant to 37 C.F.R. §§ 42.14 and 42.54.

The parties also are reminded that "[e]ach party's exhibits must be uniquely numbered sequentially in a range the Board specifies. For the petitioner, the range is 1001–1999, and for the [respondent], the range is 2001–2999." 37 C.F.R. § 42.63(c). Exhibits must be labeled and must include page numbers. 37 C.F.R. § 42.63(d). Petitioner filed two documents designated as Exhibit 1017. Petitioner shall file an updated exhibit list and the documents will be renumbered in the Board's electronic filing system as appropriate. *See* 37 C.F.R. § 42.63(e).

Finally, to ensure a clear record and proper consideration of whether it is appropriate for the Board to exercise exclusive jurisdiction over the '221 and '075 applications under 37 C.F.R. § 42.3(a) for the purpose of determining whether to institute a derivation proceeding, the parties are directed to file, within one week, (1) a listing of each respective party's claims as originally filed and as currently pending, and (2) a brief explanation of the status of the party's application. No substantive argument is permitted.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's suggestions to add U.S. Patent No. 10,558,769 B2 and U.S. Patent Application No. 18/092,863 to the instant proceeding under 37 C.F.R. § 42.408(b) are *denied*;

FURTHER ORDERED that Petitioner's motion to accept its suggestion to add U.S. Patent Application No. 18/092,863 is *dismissed* as moot;

FURTHER ORDERED that the record of this proceeding will be made publicly available within ten days from the date of entry of this Order, and all documents filed in this proceeding will be changed to "Public" in the Board's electronic filing system after expiration of ten days from the date of entry of this Order unless a motion to seal is filed before that time;

FURTHER ORDERED that Paper 11 is expunged from the record of the proceeding;

FURTHER ORDERED that each party shall file, within one week of this Order, a paper (1) listing the party's claims as originally filed and as currently pending, and (2) providing a brief explanation of the status of the party's application; and

FURTHER ORDERED that Petitioner shall file an updated exhibit list within one week of this Order.

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