

No Early Peek of Cross-Examination Documents TD Ameritrade Holding Corp. v. Trading Techs. Int'l, Inc.

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Addressing patent owner's challenge to the accuracy of the translation of a foreign language reference that was relied upon in a petition for covered business method (CBM) review, the U.S. Patent and Trademark Office's (PTO's) Patent Trial and Appeal Board (PTAB or Board) granted the patent owner's request to cross-examine the translator but denied the petitioner's request for additional discovery relating to the allegation of inaccuracy, finding that cross-examination of the translator is permitted under the routine discovery rule but additional discovery of patent owner was not permitted. *TD Ameritrade Holding Corp. v. Trading Techs. Int'l, Inc.*, Case Nos. CBM2014-00131; -00137 (PTAB, Jan. 22, 2015) (Medley, APJ.).

TD Ameritrade submitted CBM petitions related to two patents owned by Trading Technologies International (TTI). The CBM petitions were based on a prior art reference called TSE, published by the Tokyo Stock Exchange in Japanese. The TSE reference was submitted along with a 337-page translation thereof and a certification that the translation was true and accurate.

In response TTI requested to depose the translators, as TTI had reason to believe that the translation might be inaccurate. TD Ameritrade argued that this was not permitted per the routine discovery rule set forth in 37 C.F.R. § 42.51(b)(1). The Board explained that TTI may cross-examine the translators under the routine discovery rule, as TTI may investigate the accuracy of the translation once the translation has been submitted.

TD Ameritrade sought additional discovery of documents in TTI's possession supporting TTI's theory that the translations are inaccurate. The Board denied TD Ameritrade's request for the additional documents as TTI had not yet filed its Patent Owner Response to the CBM petition and had not yet raised the issue of the accuracy of the translation. Furthermore, the Board noted that a party that seeks to cross-examine a witness need not provide documents on which the party intends to rely on for cross-examination purposes days or weeks before the cross-examination. Rather, such documents, if not previously served on the opponent, need only be served at the deposition. The Board noted that providing cross-examination documents early would undermine the cross-examination process.

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