



THINK FORWARD

Brinks Gilson Secures USPTO Victory - Designated Informative Opinion by PTAB

April 23, 2019

CHICAGO – Brinks Gilson & Lione recently achieved an important client victory before the USPTO Patent Trial and Appeal Board (PTAB) where the PTAB applied the USPTO's *2019 Revised Patent Subject Matter Eligibility Guidance*. The subject matter in question related to Cboe Options Exchange's (formerly Chicago Board Options Exchange, Inc. (CBOE)) hybrid trading system that is able to concurrently trade securities or derivatives through both electronic and open-outcry trading mechanisms. Following this successful appeal, the PTAB designated this decision as an "informative" opinion—one that applied the USPTO's *2019 Revised Patent Subject Matter Eligibility Guidance* (published January 7, 2019), and should be referenced in similar cases moving forward.

The USPTO originally rejected six claims under 35 U.S.C. §101 as being directed to patent-ineligible subject matter. Brinks, on behalf of Cboe, appealed this decision to the PTAB and argued, in accordance with *Alice Corp. v. CLS Bank Int'l*, that the claims were directed to patent-eligible subject matter. More specifically, Brinks and Cboe successfully argued that the claimed method of temporarily restraining execution of quotes or orders in an otherwise automated trading system to include in-crowd participants was not directed to abstract subject matter. In deciding this appeal, the PTAB provided an example of how it is applying the USPTO's *2019 Revised Patent Subject Matter Eligibility Guidance*, noting that claim 1 is "integrated into a practical application" such that, although it recites a judicial exception, the claim "is not directed to the recited judicial exception."

"We're very excited to have received a reversal of the Examiner's initial rejection under § 101 on behalf of our client," said Kent E. Genin, Shareholder at Brinks Gilson & Lione and Cboe's legal representative. "Patent appeals regarding §101 rejections can be notoriously difficult to gain traction on and we're thrilled the PTAB agrees with our reasoning and selected our appeal as a good example of how the revised guidelines can be appropriately and effectively applied."

In addition to Genin, the Brinks team included Shareholder Scott Brim.

About Brinks Gilson & Lione

Celebrating more than 100 years of intellectual property law, Brinks Gilson & Lione is one of the largest intellectual property law firms in the U.S., and helps clients around the world to protect and enforce their intellectual property rights. Our lawyers, patent agents, and scientific advisors assist clients in all aspects of patent, trademark, unfair competition, trade secret, and copyright law. Brinks attorneys provide informed counsel with respect to innovations in a range of complex and valuable technologies, including pharmaceuticals, chemicals, bioengineering, industrial manufacturing, electronics and software, and medical devices. More information can be found at www.brinksgilson.com.