

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MIAMI INTERNATIONAL HOLDINGS, INC.; MIAMI
INTERNATIONAL SECURITIES EXCHANGE, LLC; MIAx PEARL,
LLC; AND MIAMI INTERNATIONAL TECHNOLOGIES, LLC,
Petitioner,

v.

NASDAQ ISE, LLC,
Patent Owner.

Cases CBM2018-00020 (Patent 8,386,371 B2);
CBM2018-00021 (Patent 6,618,707 B1); CBM2018-00029 (Patent
7,747,506 B2); CBM2018-00030 (Patent 7,921,051 B2); CBM2018-00031
(Patent 7,246,093 B1); and CBM2018-00032 (Patent 7,933,827 B2)

Before TONI R. SCHEINER, MEREDITH C. PETRAVICK, MICHAEL
W. KIM, FRANCES L. IPPOLITO, KEVIN C. TROCK, and KRISTI L. R.
SAWERT, *Administrative Patent Judges*.¹

SAWERT, *Administrative Patent Judge*.

DECISION

Granting-In-Part Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

¹ This is not an expanded panel. The panel for CBM2018-00020, CBM2018-00029, CBM2018-00030, and CBM2018-00032 includes Judges Scheiner, Petravick, and Sawert. The panel for the other proceedings include Judges Kim, Ippolito, and Trock.

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I. INTRODUCTION

On October 11, 2018, Patent Owner filed a Motion for Additional Discovery. Paper 15 (“Motion” or “Mot.”).² On October 18, 2018, Petitioner filed a Response. Paper 20 (“Response” or “Resp.”). Patent Owner filed a Reply on November 14, 2018. Paper 23 (“Reply”). And, on November 21, 2018, Petitioner filed a Sur-Reply. Paper 25 (“Sur-Reply”). The Board granted-in-part Patent Owner’s Motion in an Order dated January 17, 2019. Paper 41 (“Order” or “Ord.”). Patent Owner filed a Request for Rehearing. Paper 45 (“Rehearing Request” or “Reh’g Req.”). For the following reasons, we grant-in-part and deny-in-part Patent Owner’s Rehearing Request.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that a decision should be modified. 37 C.F.R. § 42.71(d). The party must identify all matters it believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.* When rehearing a decision, we review the

² The parties filed identical papers in CBM2018-00020, CBM2018-00021, and CBM2018-00031. Patent Owner requested to file motions for additional discovery in CBM2018-00029, CBM2018-00030, and CBM2018-00032 on the same basis. *See* Ex. 2016. We held that request in abeyance. *See* Paper 21. The requested additional discovery would be substantially the same in all of these proceedings, and, thus, we include CBM2018-00029, CBM2018-00030, and CBM2018-00032 in this order as well. *See* Ex. 2016. For efficiency, we only refer to the papers filed in CBM2018-00021.

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decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.”

PPG Indus. Inc. v. Celanese Polymer Specialties Co., 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted).

III. DISCUSSION

Patent Owner requests that the Board reconsider its Order granting-in-part Patent Owner’s Motion for additional discovery. Reh’g Req. 1. Patent Owner argues that in granting less than all of its discovery requests, the Board misapprehended or overlooked the following matters:

(1) it is undisputed that Fish participated in at least one joint teleconference with Reed Smith in connection with retaining Dr. Hendershott, demonstrating that Fish & Richardson (“Fish”) has, in fact, been involved in the Reed Smith proceedings; (2) independent of the obvious risk of exchanging confidential information, Fish’s prior representation of Nasdaq involved the same patents at issue in the Reed Smith CBMRs, violating the “the same or a substantially related matter” prong of Rule 11.109(a); (3) Dr. Hendershott did not affirmatively testify that the identical portions of his declaration were prepared prior to engaging in more than pre-retention discussions with Fish: he repeatedly testified that he does not remember, which necessitates further discovery; and (4) the assumption that Dr. Hendershott prepared the identical portions of his declaration prior to engaging in more than pre-retention discussions with Fish is inconsistent with his testimony that Fish was “primarily” responsible for his understanding of the law of 35 U.S.C. § 101. Much of Dr. Hendershott’s declaration depends upon that understanding.

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Id. Patent Owner argues that each of these matters warrant full discovery as set forth in Patent Owner’s discovery requests. *Id.* at 1–2; *see also* Ex. 2015.

A. *The Order*

In its Order, the Board analyzed whether Patent Owner had met the good-cause standard for its additional discovery requests in accordance with the *Bloomberg* factors. Ord. 5 (citing 37 C.F.R. § 42.224(a); *Bloomberg Inc. v. Markets-Alert Pty Ltd.*, CBM2013-00005, slip op. at 5 (May 29, 2013) (Paper 32) (precedential)). The Board authorized Interrogatory 1³ and Discovery Request 1,⁴ as “relevant information only in the position of Fish and Reed Smith (*Bloomberg* Factor 3).” *Id.* at 10. In particular, the Board was persuaded that a pre-retention telephone discussion between Fish, Reed Smith, and Dr. Hendershott about Dr. Hendershott’s qualifications and knowledge “carries some risk that confidential factual information could have found its way from Fish to the proceedings concerning the Nasdaq

³ Interrogatory 1 relates to “a list of any meetings . . . that occurred involving both Reed Smith and Fish and Richardson relating to the MIAX CBMs.” Ex. 2015, 3.

⁴ Discovery Request 1 reads: “All documents and things in MIAX’s possession, custody, and/or control that were communicated from Fish and Richardson to which Reed Smith is a recipient, or vice versa, and that are related to the MIAX CBMs.” Ex. 2015, 5.

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patents.” *Id.* at 9. The Board denied related Interrogatories 2,⁵ 3,⁶ and 4,⁷ also related to the risk of confidential factual information flowing from Fish to Reed Smith, because those interrogatories pertained to questions where “an answer has either been, or could have been, obtained during Dr. Hendershott’s deposition (*Bloomberg* Factor 3).” *Id.* at 10 (citing Ex. 2020, 54:14–55:15, 47:11–48:6; Ex. 1059 ¶ 6).

The Board also denied Patent Owner’s discovery requests related to the writing and editing of certain common paragraphs found in Dr. Hendershott’s Declarations. *Id.* at 10–11. The Board was unpersuaded that a substantial risk that confidential factual information could have found its way from Fish to the proceedings concerning the Nasdaq patents because the evidence of record showed that the common paragraphs “were prepared by Dr. Hendershott, in conjunction with Reed Smith, **prior to** Dr. Hendershott engaging in more than general pre-retention discussions with Fish.” *Id.* at 9 (citing Ex. 1062, 47:20–48:6, 54:14–56:14; Ex. 1063, 110:6–111:4, 133:3–9). For this reason, the Board denied Interrogatory 5⁸ and Document

⁵ Interrogatory 2 relates to “a list of any meetings . . . that occurred involving both Reed Smith and Dr. Hendershott relating to the MIAX CBMs.” Ex. 2015, 4.

⁶ Interrogatory 3 relates to “a list of any meetings . . . that occurred involving both Fish and Richardson and Dr. Hendershott relating to the MIAX CBMs.” Ex. 2015, 4.

⁷ Interrogatory 4 asks “who originally drafted paragraphs 18–36 of the declaration by Dr. Hendershott.” Ex. 2015, 4.

⁸ Interrogatory 5 asks for “a list of any individuals who edited paragraphs 18–36 of the declaration by Dr. Hendershott.” Ex. 2015, 4.

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Request 2,⁹ and related Document Request 3.¹⁰ *Id.* at 10–11.

Finally, the Board denied Interrogatory 6¹¹ as “involv[ing] both the underlying bases for litigation positions (*Bloomberg* Factor 2), as well as ‘impressions, conclusions, opinions, or legal theories.’” *Id.* at 10 (quoting FED. R. CIV. PROC. 26(b)(3)(B)). And the Board denied Document Request 4¹² as “overly burdensome (*Bloomberg* Factor 5).” *Id.* at 11.

B. The Relevant Ethics Rules

Patent Owner argues that the Board misapprehended and misapplied the relevant ethics rules. Reh’g Req. 2–3. We grant Patent Owner’s request

⁹ Document Request 2 reads: “All documents and things in MIAx’s possession, custody, and/or control that were communicated from Fish and Richardson to which Dr. Hendershott is a recipient, or vice versa, and that communicate desired contents and edits on the text that would become paragraphs 18–36 of Dr. Hendershott’s declaration (Ex. 1003).” Ex. 2015, 5.

¹⁰ Document Request 3 reads: “All documents and things in MIAx’s possession, custody, and/or control that were communicated from Reed Smith to which Dr. Hendershott is a recipient, or vice versa, and that communicate desired contents and edits on the text that would become paragraphs 18–36 of Dr. Hendershott’s declaration (Ex. 1003).” Ex. 2015, 5.

¹¹ Interrogatory 6 relates to “how Dr. Hendershott was identified and hired to serve as an expert on this CBM, including who at Fish, MIAx, or Reed Smith first contacted Dr. Hendershott relating to the MIAx CBMs and how Fish and Reed Smith identified Dr. Hendershott as an expert.” Ex. 2015, 4.

¹² Document Request 4 reads: “All documents and things in MIAx’s possession, custody and/or control communicated to both Fish and Richardson and Reed Smith as recipients, and that are related to the MIAx CBMs.” Ex. 2015, 5.

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for rehearing as to the applicable ethics rules. We take this opportunity to clarify the ethics rules and their application to this case.

Subpart D of 37 C.F.R. Part 11—the USPTO Rules of Professional Conduct—applies to all post-grant procedures before the Office. *See* 37 C.F.R. § 11.1 (“This part governs solely the practice of patent, trademark, and other law before the United States Patent and Trademark Office”); *see also id.* § 11.101 *et. seq.* At issue in this case is 37 C.F.R. § 11.109—“Duties to former clients.” Section 11.109(a) provides that “[a] practitioner who has formerly represented a client in a matter shall not thereafter represent another person in the same or a substantially related matter in which that person’s interests are materially adverse to the interests of the former client unless the former client gives informed consent, confirmed in writing.” Section 11.109(c) provides that:

A practitioner who has formerly represented a client in a matter or whose present or former firm has formerly represented a client in a matter shall not thereafter:

(1) Use information relating to the representation to the disadvantage of the former client except as the USPTO Rules of Professional Conduct would permit or require with respect to a client, or when the information has become generally known; or

(2) Reveal information relating to the representation except as the USPTO Rules of Professional Conduct would permit or require with respect to a client.

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It is undisputed in this case that Fish formerly represented Nasdaq Inc., and prosecuted the patents at issue in the Reed Smith CBMs (i.e., CBM2018-00029, CBM2018-00030, and CBM2018-00032). Ord. 3. It is also undisputed in this case that Fish currently represents Petitioner in the Fish CBMs (i.e., CBM2018-00020, CBM2018-00021, and CBM2018-00031), but did not prosecute the patents at issue in those cases. *Id.* We understand that Patent Owner seeks to disqualify Fish in the Fish CBMs, and seeks to move for sanctions against both Fish and Reed Smith in the Reed Smith CBMs. Reh’g Req. 3.

As to the Fish CBMs, there appears to be no dispute that that the applicable rule is 37 C.F.R. § 11.109(a). *Id.* To be sure, Fish “formerly represented a client in a matter”—i.e., Nasdaq, in the prosecution of the Nasdaq patents—and thus, “shall not thereafter represent another person in the same or a substantially related matter in which that person’s interests are materially adverse to the interests of the former client.” 37 C.F.R. § 11.109(a). The question in the Fish CBMs, therefore, is whether Fish’s representation of Petitioner in the Fish CBMs qualifies as “the same or a substantially related matter in which” Petitioner’s “interests are materially adverse to the interests of” Nasdaq. *Id.*

Part 11 of the 37 C.F.R. does not define a “substantially related” matter. See 37 C.F.R. § 11.1. Thus, as we did in the Order, we look to comment 3 to the ABA Model Rule 1.9, which defines “substantially related” as “involv[ing] the same transaction or legal dispute or if there

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otherwise is a substantial risk that confidential factual information as would normally have been obtained in the prior representation would materially advance the client's position in the subsequent matter." MODEL RULES OF PROF'L CONDUCT r. 1.9 cmt. 3 (AM. BAR ASS'N 2011). Because the Fish CBMs do not involve the "same transaction or legal dispute," there appears to be no dispute that "substantial risk" is the relevant language here. See Reh'g Req. 3 ("Patent Owner seeks to disqualify Fish under the second prong . . .").

Turning to the Reed Smith CBMs, Patent Owner asserts that "any involvement from Fish is an ethical violation under the first prong" of the "substantially related" definition. *Id.* at 3. Upon reconsideration of the ethics rules, however, we believe that Fish's alleged involvement in the Reed Smith CBMs does not implicate 37 C.F.R. § 11.109(a). In this regard, § 11.109(a) applies when a practitioner "thereafter *represent[s]*" a second client materially adverse to the practitioner's former client, and here, Fish does not represent Petitioner in the Reed Smith CBMs. At most, then, Fish's alleged involvement falls under § 11.109(c), which would prohibit Fish from "us[ing] information related" to its prosecution of the Nasdaq patents "to the disadvantage of" Nasdaq, see 37 C.F.R. § 11.109(c)(1), or "reveal[ing] information relating" to the same, see 37 C.F.R. § 11.109(c)(2). Thus, the pertinent question as to the Reed Smith CBMs is whether Fish used or revealed information to Reed Smith relating to its prosecution of the Nasdaq patents.

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As a final matter, we address Patent Owner’s argument that *any* activity by Fish conducted in concert with Reed Smith—such as Fish leading the discussion with Dr. Hendershott during the pre-retention telephone call—constitutes an ethical violation because Fish prosecuted the Nasdaq patents. Reh’g Req. 5–9. We are unaware of any such *per se* rule. Ord. 7. Instead, we must follow the controlling authority, which, as we clarified above, is 37 C.F.R. § 11.109(c). Patent Owner cites multiple cases for the proposition that “an attorney who represented a client during prosecution of a patent application will not be permitted to represent a party attacking the validity of the resulting patent.” Reh’g Req. 7 (citing *Strojirenstvi v. Toyota*, 1986 Comm’r Pat. LEXIS 14 (Comm’r Pat. Aug. 29, 1986)). Although we, of course, agree, Patent Owner’s argument overlooks the fact that Fish is not *representing* Petitioner in the Reed Smith CBMs.

C. Patent Owner’s Discovery Requests

We now turn to Patent Owner’s individual discovery requests. As an initial matter, we note that Patent Owner submits no arguments in the Rehearing Request challenging the Board’s conclusion that Document Request 4 would be overly burdensome under *Bloomberg* Factor 5. *See generally* Reh’g Req. Thus, we deny Patent Owner’s request for rehearing as to Document Request 4. *See* Ord. 11. We also note that Patent Owner submits no arguments challenging the Board’s conclusion that Interrogatory 6 is improper under *Bloomberg* Factor 2 and FED. R. CIV. PROC. 26(b)(3)(B). *See generally* Reh’g Req. Thus, we also deny Patent Owner’s request for

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rehearing as to Interrogatory 6. *See* Ord. 10. As to the remaining interrogatories and discovery requests, we grant Patent Owner’s request for rehearing for the reasons explained below.

1. Discovery requests related to preparation of, and edits to, paragraphs 18–36 of Dr. Hendershott’s Declarations

Interrogatories 4 and 5, and Discovery Requests 2 and 3, relate to the questions of who prepared and edited paragraphs 18–36 of Dr. Hendershott’s declarations.¹³ As explained above, the Board was “unpersuaded that additional discovery into document preparation and edits are warranted.”

Ord. 9. The Board found that Dr. Hendershott prepared paragraphs 18–36 of his declarations before he was engaged in more than general pre-retention discussions with Fish. Ord. 10 (citing Ex. 2020, 47:11–48:6, 55:24–56:14, 110:6–111:4, 133:3–9).

Patent Owner argues that, in so doing, the Board “misapprehends or overlooks that Dr. Hendershott’s answers to questions about the sequence of events and the involvement of Reed Smith and Fish in the drafting and editing his declaration were far from definitive.” *Reh’g* Req. 11. Patent Owner argues that Dr. Hendershott instead “equivocated and qualified his answers concerning when individual paragraphs were prepared, and who provided input and edits when.” *Id.* at 11–12 (citing Paper 38, 3–5). Patent

¹³ The common paragraphs’ numbering vary depending on the case. For example, in CBM2018–00020, the common paragraphs are ¶¶ 17–35. *See* Mot. 7. In CBM2018-00021, the common paragraphs are ¶¶ 18–35. *Id.* For efficiency, we refer to the paragraphs relevant in CBM2018-00021.

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Owner also argues that “Dr. Hendershott made statements that show or at least suggest that Fish was involved in the initial drafting” of his declaration. *Id.* at 12 (citing Paper 38, 3–5). “Thus,” Patent Owner argues, “the evidence of record does not support the Board’s assumption that all of the identical paragraphs of Dr. Hendershott’s declaration were prepared for Reed Smith prior to Dr. Hendershott engaging in more than general pre-retention discussions with Fish.” *Id.*

Patent Owner also argues that “[t]he Board’s assumption that Dr. Hendershott prepared the identical portions of his declaration prior to engaging in more than general pre-retention discussions with Fish is inconsistent with Dr. Hendershott’s testimony” that “attorneys from Fish had been ‘primarily’ responsible for providing him with an understanding of § 101.” *Id.* at 13 (citing Paper 38, 2). According to Patent Owner, this “critical admission” undermines the Board’s conclusion that Fish spoke to Dr. Hendershott only as to his CV and general knowledge. *Id.*

Upon reconsideration, we agree with Patent Owner that the timing of Dr. Hendershott’s preparation and the editing of common paragraphs 18–36 is unclear on the current record. For example, Dr. Hendershott testified that he could not remember whether Fish suggested that he provide a history of Wall Street and the exchanges, which are embodied in paragraphs 18–36. *See* Ex. 1062, 53:14–19. Dr. Hendershott also testified that he received from Fish versions of his declaration containing edits, but did not remember whether any of those edits were substantive in nature. *See id.* at 51:19–25,

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52:8–22. Dr. Hendershott also did not review the edits to his declarations and thus was arguably not prepared to testify as to the circumstances surrounding the creation and editing of the common paragraphs. *See id.* at 58:2–8. Thus, we grant Interrogatories 4 and 5 and Discovery Request 2, as relevant information only in the possession of Fish and Reed Smith (*Bloomberg* Factor 3).

We deny Document Request 3, however, because we remain unpersuaded that it is relevant to showing that confidential information could have found its way from Fish to Reed Smith. Ord. 11. In particular, Document Request 3 relates to information flowing from Reed Smith to Dr. Hendershott, and is therefore not relevant to whether Fish used or revealed information to Reed Smith relating to its prosecution of the Nasdaq patents.

2. Discovery requests related to meetings between counsel and Dr. Hendershott

Interrogatories 2 and 3 request information related to any meetings that occurred between Reed Smith and Dr. Hendershott, and between Fish and Dr. Hendershott, respectively. The Board denied these interrogatories because “as an answer has either already been, or could have been, obtained during Dr. Hendershott’s deposition (*Bloomberg* Factor 3).” Ord. 10. The Board relied on Dr. Hendershott’s testimony that, other than the initial pre-hiring telephone call, no meeting occurred that was attended by him, Fish, and Reed Smith. *Id.* (citing Ex. 2020, 54:14–55:15).

We are unable to discern any argument in Patent Owner’s Rehearing Request directly relevant to Interrogatories 2 and 3. Moreover, it appears to

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us that any relevant information that could be obtained from Petitioners' response to these interrogatories would be duplicative from that obtained from Interrogatory 1. Thus, we deny Patent Owner's request for rehearing as to Interrogatories 2 and 3. *See* Ord. 10.

IV. ORDER

Accordingly, it is:

ORDERED that Patent Owner's Rehearing Request is *granted* as to the applicable ethics rules, Interrogatory 4, Interrogatory 5, and Document Request 2;

FURTHER ORDERED that Petitioner is given seven (7) business days from the date of this Order to respond to Interrogatory 4, Interrogatory 5, and to produce the indicated items responsive to Document Request 2;

FURTHER ORDERED that Patent Owner's Rehearing Request is *denied* as to Interrogatory 2, Interrogatory 3, Interrogatory 6, Document Request 3, and Document Request 4; and

FURTHER ORDERED that, in CBM2018-00020, CBM2018-00021, and CBM2018-00031, each party is authorized to file a five (5) page Supplemental Brief, within fifteen business (15) days of this Order, limited to explaining how any additional discovery produced relates to Patent Owner's Motion to Disqualify Petitioner's Counsel.

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