Trials@uspto.gov
571-272-7822

Paper 72
Entered: January 27, 2022

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,
Petitioners,

v.

NASDAQ, INC.,
Patent Owner.

CBM2018-00030
Patent No. 7,921,051 B2

Before MEREDITH C. PETRAVICK, JON B. TORNQUIST, and KRISTI L. R. SAWERT, *Administrative Patent Judges.*

PETRAVICK, *Administrative Patent Judge*.

DECISION
Granting Patent Owner's Request for Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

INTRODUCTION

On November 4, 2019, Nasdaq, Inc. ("Patent Owner") filed a Request for Rehearing (Paper 68, "Req. Reh'g") of the Final Written Decision (Paper 65), which determined that claims 1–49 of U.S. Patent No. 7,921,051 B2 were unpatentable. Patent Owner requests rehearing in light of the Federal Circuit's decision in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019). Req. Reh'g 1. Patent Owner does not request rehearing of our unpatentability determination. *See generally id.*

STANDARD

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 decision for an abuse of discretion. *See generally* 37 C.F.R. § 42.71 (b)–(d). 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).

DISCUSSION

In its Request for Rehearing, Patent Owner relied on the Federal Circuit's *Arthrex* decision and requested that the final written decision be vacated and a new hearing before a new panel of Administrative Patent Judges. Req. Reh'g 2. On June 21, 2021, after Patent Owner filed its Request for Rehearing, the U.S. Supreme Court vacated the Federal Circuit's *Arthrex* decision. *United States v.*

Arthrex, Inc., 141 S. Ct. 1970 (2021). The Supreme Court held "that 35 U.S.C. § 6(c) is unenforceable as applied to the Director insofar as it prevents the Director from reviewing the decisions of the PTAB on his own. The Director may engage in such review and reach his own decision." *Arthrex*, 141 S. Ct. at 1987. The Supreme Court "conclude[d] that the appropriate remedy is a remand to the Acting Director for him to decide whether to rehear the petition." *Id.*

The United States Patent and Trademark Office subsequently implemented an interim procedure[1] whereby review of a final written decision by the Director may be requested by a party to a post-grant review proceeding.

On August 2, 2021, Patent Owner sent an email to the Board seeking guidance on the appropriate procedure to file a request for review by the Director of the Final Written Decision. Ex. 3002. By an email sent January 5, 2022, the Board indicated that it would construe Patent Owner's Request for Rehearing as requesting the Board to apply the Supreme Court's *Arthrex* decision by allowing Patent Owner to file a Request for Rehearing by the Director of the Final Written Decision. *See id*. The Patent Owner agreed with the Board's construction, and Petitioner did not oppose. *See id.*

Given the particular circumstances of this proceeding, particularly that the Request for Rehearing was filed prior to the Supreme Court's *Arthrex* decision, we construe Patent Owner's Request for Rehearing as requesting authorization to file a Request for Rehearing by the Director of the Final Written Decision and grant this request. Patent Owner is authorized to file a Request for Rehearing by the Director of the Final Written Decision within 30 days of the date of this decision. *See* 37 C.F.R. §§ 42.5, 42.71(d).

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[1] Available at https://www.uspto.gov/patents/patent-trial-and-appeal-board/procedures/uspto-implementation-interim-director-review.

CONCLUSION

Patent Owner's Request for Rehearing is *granted* as discussed above, and Patent Owner is authorized to file a Request for Rehearing by the Director of the Final Written Decision.

In Summary:

Final Outcome of Final Written Decision after Rehearing:

Claims	35 U.S.C. §	Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–49	101	Eligibility	1–49	
Overall Outcome			1–49	

ORDER

Accordingly, it is:

ORDERED that Patent Owner's Request for Rehearing is *granted*; and

FURTHER ORDERED that Patent Owner may file a Request for Rehearing by the Director of the Final Written Decision as provided for in the Office's interim procedures, within 30 days of the date of this decision.

For PETITIONER:

Lisa Chiarini
Sidharth Kapoor
Christine Morgan
REED SMITH LLP
lchiarini@reedsmith.com
sgrewal@reedsmith.com
cmorgan@reedsmith.com

For PATENT OWNER:

Robert Sokohl
Richard D. Coller III
Michelle Holoubek
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
rsokohl-ptab@sternekessler.com
rcoller-ptab@sternekessler.com
holoubek-ptab@sternekessler.com