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Paper No. 10
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TD AMERITRADE HOLDING CORP., TD AMERITRADE, INC., AND
TD AMERITRADE ONLINE HOLDINGS CORP.,
Petitioner,

v.

TRADING TECHNOLOGIES INTERNATIONAL, INC.,
Patent Owner.

CBM2014-00131 (Patent 7,533,056)
CBM2014-00133 (Patent 7,676,411)
CBM2014-00135 (Patent 6,772,132)
CBM2014-00136 (Patent 6,766,304)
CBM2014-00137 (Patent 7,685,055)

Before JAMESON LEE, MEREDITH C. PETRAVICK, and
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.20

CBM2014-00131 (Patent 7,533,056)
CBM2014-00133 (Patent 7,676,411)
CBM2014-00135 (Patent 6,772,132)
CBM2014-00136 (Patent 6,766,304)
CBM2014-00137 (Patent 7,685,055)

INTRODUCTION

On July 17, 2014, a telephone conference call was held between respective counsel for the parties and Judges Lee, Petravick, and Hoffmann. In addition to the parties's counsel, Mr. Sean Legue, of Arnold & Porter, LLP, was present on behalf of Finnegan, Henderson, Farabow, Garrett & Dunner, LLP ("Finnegan"). Counsel for TD Ameritrade Holding Corp. et al. ("TD Ameritrade") initiated the conference call to seek authorization to file a motion to disqualify counsel for Trading Technologies International, Inc. ("Trading Tech") from Finnegan. In addition, counsel for Trading Tech sought permission to present a live demonstration in support of the Trading Tech's Preliminary Response and to file a motion for additional discovery related to the real-parties-in-interest listed in the Petition and inquired as to the procedure for filing exhibits that contain videos or animations.

During the conference call, TD Ameritrade's counsel requested authorization to file a motion for additional discovery regarding the date that Trading Tech's counsel was first engaged to represent Trading Tech in this proceeding, and requested that Exhibit 1006[1] be expunged from the record.

[1] For expediency, CBM2014-00131 is representative and all subsequent citations are to CBM2014-00131 unless otherwise noted.

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CBM2014-00137 (Patent 7,685,055)

DISCUSSION

TD Ameritrade's Request for Authorization to File Motion to Disqualify Trading Tech's Counsel from Finnegan and Related Request for Authorization to File Motion for Additional Discovery

TD Ameritrade seeks authorization to file a motion to disqualify Trading Tech's counsel from the firm of Finnegan. TD Ameritrade also seeks authorization for additional discovery to determine the date that Trading Tech engaged Finnegan to represent Trading Tech in these proceedings. TD Ameritrade alleges that, at a time shortly after the filing of the Petitions in these proceedings, both TD Ameritrade and Trading Tech were clients of Finnegan. According to TD Ameritrade, Finnegan's concurrent representation of both parties caused Finnegan to have a conflict of interest according to the American Bar Association's ("ABA") Model Rule of Professional Conduct 1.7 and violates the terms of an engagement agreement between Finnegan and TD Ameritrade. TD Ameritrade seeks to file a motion to disqualify Trading Tech's counsel from Finnegan based on this alleged conflict of interest and alleged breach of the engagement agreement.

Finnegan disputes TD Ameritrade's allegation that Finnegan represented, concurrently, both parties and that Finnegan breached its engagement agreement with TD Ameritrade. Finnegan's counsel stated that Trading Tech engaged Finnegan to represent it in these proceedings on June 6, 2014, after Finnegan no longer represented TD Ameritrade.

Upon inquiry by the judges, counsel for TD Ameritrade stated that, as of date of the conference call, TD Ameritrade was no longer a client of

Finnegan and that Finnegan was no longer handling any matters for TD Ameritrade. Upon further inquiry by the judges, TD Ameritrade stated that the matters Finnegan handled for TD Ameritrade were not related, substantially, to the matters in these proceedings.

Disqualification is resolved on a case-by-case basis, where the moving party bears a heavy burden of proving facts showing that disqualification is necessary. *Anderson v. Eppstein*, 59 U.S.P.Q.2d 1280, 1286 (Bd. Pat. App. & Int. 2001) (informative). *See also Rules of Practice for Trials Before the Patent Trial and Appeal Board; Final Rule* 77 Fed. Reg. 48,630 (August 14, 2012) ("[t]he determination whether to disqualify counsel is based on the facts and circumstance of the case"; "[m]otions to disqualify opposing counsel are disfavored because they cause delay and are sometimes abused").

On the information presented to us by respective counsel during the conference call, we see no reason to authorize a motion to disqualify Trading Tech's counsel from Finnegan in this proceeding. Both parties agree that TD Ameritrade is no longer represented by Finnegan, and TD Ameritrade makes no allegation that Finnegan has, currently, any conflict of interest under, for example ABA Model Rule 1.9 or 37 C.F.R. § 11.109, by remaining as counsel for Trading Tech despite its past representation of TD Ameritrade. Note, in particular, that TD Ameritrade makes no allegations that Finnegan possesses confidential information gained from TD Ameritrade during its representation that is related to these proceedings.

We decline to authorize a motion to disqualify counsel where, as here, the conflict complained of exists merely for a time period in the past, if at

all. For these reason, TD Ameritrade's request for authorization to file a motion to disqualify Trading Tech's counsel from Finnegan is *denied*.

TD Ameritrade requests additional discovery to determine the date that Trading Tech first engaged Finnegan to represent Trading Tech in these proceedings. Even if information is discovered that differs from Finnegan's alleged date of first engagement, our analysis above would not be changed because the alleged conflict will still be in the past. TD Ameritrade's request to file a motion for additional discovery regarding disqualifying Trading Tech's counsel is also *denied*.

Trading Tech's Request to Present Live Demo in Support of Preliminary Response

Trading Tech requests permission to present a live demonstration of the invention in support of its Preliminary Response. Trading Tech explained that the demonstration would include live narration of a pre-existing video. Trading Tech explained that it felt a live demonstration would be helpful in demonstrating that the patented invention is not a business method, but is technical. TD Ameritrade objected to the presentation of a live demonstration.

On the information presented during the call, we do not authorize the proposed live demonstration. The proposed demonstration, with live narration, likens in kind to new testimony evidence and also is tantamount to additional briefing in "live" format. Section 42.07(c) of Title 37 of the Code of Federal Regulations states that "[t]he preliminary response shall not present new testimony evidence beyond that already of record, except as

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