

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SCHOTT GEMTRON CORPORATION
Petitioner

v.

SSW HOLDING COMPANY, INC.
Patent Owner

Case IPR2013-00358
Patent 8,286,561 B2

Before JUSTIN T. ARBES, GEORGIANNA W. BRADEN, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

A conference call in the above proceeding was held on April 18, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Arbes and Braden. Petitioner requested the conference call to seek authorization to file (1) a motion requesting that we find certain deposition testimony to be

non-confidential information, and (2) a motion for additional discovery of a document relied upon by one of Patent Owner's declarants in his testimony.

Confidentiality of Deposition Testimony

Petitioner raised an issue regarding the depositions of two of Patent Owner's declarants, Bradley M. Nall and John Driver. During the depositions, Patent Owner's counsel indicated that certain portions of the transcripts should be designated as confidential, and counsel for both parties discussed how those portions of the transcripts should be treated. During the call, Patent Owner argued that the parties had agreed that the portions in question should be redacted and made available only to Petitioner's counsel, not Petitioner's representatives. Petitioner disagreed that any agreement had been reached, and argued that we should find the portions in question to be non-confidential information. The deposition transcripts have not been filed yet as exhibits in this proceeding.

As explained during the call, Patent Owner's previous motion to seal was withdrawn, *see* Papers 45, 47, and no protective order has been entered in this proceeding. A party intending for a document to be sealed must file a motion to seal with a proposed protective order. *See* 37 C.F.R. §§ 42.14, 42.54(a). Then, if such a motion is granted, the protective order would be entered and would govern the treatment of confidential information in the proceeding. Patent Owner, as the proponent of Mr. Nall's and Mr. Driver's testimony, shall file the deposition transcripts, *see* 37 C.F.R. § 42.53(f)(7), and may file a motion to seal. If Patent Owner intends to file a motion to seal, Patent Owner should file, for each transcript, a confidential, unredacted version under seal, and a non-confidential, redacted version to be publicly

available. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,770 (Aug. 14, 2012). The motion to seal must explain the basis for *every* redaction made to the deposition transcripts. Petitioner then may file an opposition to the motion to seal, explaining why it believes the material should not be sealed. The parties are reminded of the requirements of 37 C.F.R. § 42.54 and the guidance regarding motions to seal previously provided in Paper 44 in this proceeding.

The parties are encouraged to agree on the terms of a proposed protective order that, if entered, would provide appropriate protections to ensure confidentiality. To the extent the parties believe additional protections are necessary beyond those provided for in the Board’s default protective order, the parties may include such protections in the proposed protective order. If the proposed protective order differs from the Board’s default protective order in any way, the motion should identify specifically how the two protective orders differ and explain why such changes are warranted. A separate redlined version of the proposed protective order showing the differences between the default protective order and the proposed protective order also should be filed with the motion.

Motion for Additional Discovery

Petitioner argued that Mr. Nall testified during his deposition that he relied on a particular document¹ to make various “projections” regarding future sales, which Patent Owner relies on to argue commercial success as a

¹ Because the content of the document, and Mr. Nall’s testimony regarding the document, may be subject to Patent Owner’s forthcoming motion to seal, we do not discuss the document in detail at this time.

secondary consideration of nonobviousness. Petitioner sought authorization to file a motion for additional discovery of the document. Patent Owner acknowledged that Mr. Nall relied on the document, but argued that the document contains highly confidential information, Petitioner had the opportunity to cross-examine Mr. Nall about the document, and Petitioner cannot establish that production of the document is necessary in the interest of justice. Patent Owner also explained that it had agreed to produce the document, contingent on (1) the document only being made available to Petitioner's counsel, not Petitioner's representatives, and (2) the document not being submitted for our consideration in issuing a final written decision. Petitioner refused to agree to the latter condition. We discussed with the parties other potential resolutions to avoid the necessity for further briefing, but no agreement could be reached.

Given Mr. Nall's purported reliance on the document in question in formulating his "projections," we determine that a motion for additional discovery of the document under 37 C.F.R. § 42.51(b)(2) is warranted under the circumstances. Petitioner in its motion should explain why it believes discovery of the document is "necessary in the interest of justice." *See* 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2). The parties are directed to Paper 43 in this proceeding and *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (Mar. 5, 2013), for guidance regarding motions for additional discovery. Further, to the extent Petitioner's motion or Patent Owner's opposition include information believed to be confidential, the parties may file redacted and unredacted versions, following the procedures explained above, along with a motion to seal.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner shall file the transcripts of the depositions of Mr. Nall and Mr. Driver by April 21, 2014. Patent Owner may file a confidential, unredacted version under seal, and a non-confidential, redacted version to be publicly available, of each transcript;

FURTHER ORDERED that Patent Owner is authorized to file, by April 25, 2014, a motion to seal with respect to the deposition transcripts;

FURTHER ORDERED that any opposition from Petitioner to the motion to seal is due on May 2, 2014;

FURTHER ORDERED that the confidential, unredacted versions of the deposition transcripts shall remain provisionally sealed pending the disposition of Patent Owner's motion to seal;

FURTHER ORDERED that, to the extent Petitioner refers to any redacted portions of the deposition transcripts in its Reply (due on April 22, 2014), Petitioner shall file a confidential, unredacted version of the Reply under seal, and a non-confidential, redacted version of the Reply to be publicly available;

FURTHER ORDERED that Petitioner is authorized to file a motion for additional discovery of the document referenced by Mr. Nall by April 25, 2014, limited to five pages; and

FURTHER ORDERED that Patent Owner is authorized to file an opposition to the motion for additional discovery by May 2, 2014, limited to five pages.

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