

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SCHOTT GEMTRON CORP.
Petitioner

v.

SSW HOLDING CO., INC.
Patent Owner

Case IPR2013-00358
Patent 8,286,561 B2

Before JUSTIN T. ARBES, PHILIP J. HOFFMANN, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

DECISION
Motions to Seal
37 C.F.R §§ 42.14 and 42.54

INTRODUCTION

Patent Owner filed a Motion to Seal (Paper 67) that seeks to seal the deposition transcripts of John P. Driver (Exhibit 2062) and Bradley M. Nall (Exhibit 2063). Petitioner filed an Opposition to Patent Owner’s Motion to Seal (Paper 73). Each party submitted proposed protective orders that are different from the Board’s default protective order. *See* Exhibits 2064, 2065 (redline version), 1023, 1024 (redline version). Patent Owner added provisions to the Board’s default protective order defining a “highly confidential” information designation, what constitutes proper treatment of “highly confidential” information, and who may receive “highly confidential” information. Paper 67 at 7; Exhibit 2064 ¶¶ 2, 5(A), 5(B). Petitioner agreed to Patent Owner’s proposed protective order with two tiers of confidential information, but added a provision for challenging confidentiality designations. Paper 73 at 11–12; Exhibit 1024 ¶ 8. Based on the parties’ representations, we find a two-tiered protective order with a mechanism for challenging confidentiality designations to be appropriate for the present case. We enter the protective order submitted as Exhibit 2064. As a consequence, the protective order at Exhibit 2064 governs the treatment and filing of confidential information in this proceeding. For reasons

discussed below, Patent Owner's Motion to Seal (Paper 67) is *conditionally* granted.

DISCUSSION

There is a strong public policy in favor of making information filed in an *inter partes* review open to the public, especially because the proceeding determines the patentability of claims in an issued patent and, therefore, affects the rights of the public. Under 35 U.S.C. § 316(a)(1) and 37 C.F.R. § 42.14, the default rule is that all papers filed in an *inter partes* review are open and available for access by the public; a party, however, may file a concurrent motion to seal and the information at issue is sealed pending the outcome of the motion. It is, however, only "confidential information" that is protected from disclosure. 35 U.S.C. § 316(a)(7). In that regard, the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012) provides:

The rules aim to strike a balance between the public's interest in maintaining a complete and understandable file history and the parties' interest in protecting truly sensitive information.

...

Confidential Information: The rules identify confidential information in a manner consistent with Federal Rule of Civil Procedure 26(c)(1)(G), which provides for protective orders for trade secret or other confidential research, development, or commercial information. § 42.54.

The standard for granting a motion to seal is “for good cause.” 37 C.F.R. § 42.54(a). In Patent Owner’s Motion to Seal (Paper 67), Patent Owner bears the burden of proof in showing entitlement to the requested relief. 37 C.F.R. § 42.20(c). The Board needs to know why the information sought to be sealed constitutes confidential information.

In Patent Owner’s Motion to Seal (Paper 67), Patent Owner moves to seal Exhibits 2062 and 2063, because each exhibit “contain[s] information that can be categorized as either (1) confidential customer names, (2) confidential Patent Owner trade secrets, or (3) other confidential commercial information.” Paper 67 at 9. Patent Owner has submitted redacted versions of each exhibit that are the subject of Patent Owner’s Motion to Seal (Paper 67), and the redacted versions of the exhibits are publically available.¹

As discussed previously, there is a strong public policy for making all information filed in an *inter partes* review open to the public. However, upon review of the documents and considering the narrowly redacted

¹ The redacted versions of Exhibits 2062 and 2063 also are numbered as Exhibits 2062 and 2063. The redacted versions will be renumbered as Exhibits 2066 and 2067. In the future, exhibits submitted by the parties shall be “uniquely numbered sequentially” in the appropriate range. *See* 37 C.F.R. § 42.63(c).

testimony and stated confidentiality of the testimony by Patent Owner, rather than denying the Motion to Seal, which would make the exhibits immediately publicly accessible, the Board *conditionally* grants Patent Owner's Motion to Seal Exhibits 2062 and 2063 (Paper 67) for the duration of this proceeding. If the Board's final written decision substantively relies on any information in a sealed exhibit, that exhibit will be unsealed by an Order of the Board; and if any sealed exhibit contains no information substantively relied on by the Board in the final written decision, then that exhibit may be expunged from the record by an Order of the Board.

Finally, we are not persuaded that Petitioner's addition to Patent Owner's proposed protective order (Exhibit 1024 ¶ 8) is appropriate under the circumstances, as it would apply automatically a "proposed new designation" to a document after a certain time period without Board notification or approval. If a party believes that a document produced by the opposing party is incorrectly designated, it shall notify and confer with the opposing party in a good faith attempt to resolve the issue, and, if the issue cannot be resolved, the party may request a conference call with the Board.

CONCLUSION

For the foregoing reasons, Patent Owner's Motion to Seal (Paper 67) is *conditionally* granted. It is

ORDERED that Patent Owner's proposed protective order (Exhibit 2064) is entered and governs the treatment and filing of confidential information in this proceeding;

FURTHER ORDERED that the parties shall file a single copy of the proposed protective order filed as Exhibit 2064, signed by counsel for both parties, as a uniquely numbered exhibit, by May 19, 2014;

FURTHER ORDERED that with respect to Exhibits 2062 and 2063, Patent Owner's Motion to Seal (Paper 67) is *conditionally* granted and these exhibits will be kept under seal unless and until the Board refers to material in any of these exhibits in a final written decision; and

FURTHER ORDERED that the redacted versions of Exhibits 2062 and 2063, filed on April 22, 2014, are renumbered as Exhibits 2066 and 2067, respectively.

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Patent 8,286,561 B2

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