

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTRI-PLEX TECHNOLOGIES, INC. and MMI HOLDINGS, LTD.
Petitioner

v.

SAINT-GOBAIN PERFORMANCE PLASTICS RENCOL LIMITED
Patent Owner

Case IPR2014-00309
Patent 8,228,640 B2

Before MICHAEL W. KIM, WILLIAM A. CAPP, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

ORDER

On Motion to Seal and for Entry of Protective Order
and Notice of Revised Scheduling Order
37 C.F.R. §§ 42.5, 42.25, 42.54

INTRODUCTION

A teleconference was held on August 25, 2014, before Judges Kim, Capp, and Ippolito and attended by counsel for both parties. Counsel for the respective parties certified, at the commencement of the call and pursuant to a previous Order (Paper 29), that no unauthorized persons were in attendance.

The Panel received argument from the parties on the Motion to Seal and for Entry of Protective Order (the “Motion to Seal”) filed by Patent Owner Saint-Gobain Performance Plastics Rencol Limited (“Saint-Gobain”) on August 11, 2014. Paper 23. The Motion to Seal was accompanied by a proposed Protective Order that deviated from the Board’s default protective order. Paper 25; Ex. 2022 (redline). Saint-Gobain certified in the Motion to Seal that it had met and conferred with Petitioner Intri-Plex Technologies, Inc. and MMI Holdings, Ltd. (“Intri-Plex”), but no agreement was made on the scope of the proposed Protective Order. Mot. to Seal 6. In response, Intri-Plex filed its opposition to Saint-Gobain’s Motion to Seal on August 19, 2014. Paper 27.

Additionally, in an August 19, 2014 email to Board administrative staff, counsel for Intri-Plex requested a teleconference to ask for our authorization to file the following motions:

- 1- Motion to strike Patent Owner’s unredacted response and unredacted Exhibits 2005-2011, 2017, and 2018 for lack of service on Petitioner pending agreement on service of the unredacted documents on Petitioner;
- 2- Motion for additional discovery, including (a) production of documents related to conception and purported commercial success and (b) to compel testimony of Jeffrey S. Abel, a prosecuting attorney of the patent at issue; and

- 3- Motion for extension of time to file Petitioner's reply to Patent Owner's response (Due Date 2 in the Scheduling Order).

During the teleconference, the Panel discussed items 1 and 3. Intri-Plex's request for authorization to file a Motion for Additional Discovery was granted previously. Paper 29, 3.

During the teleconference, counsel for Saint-Gobain orally requested that, in the event we denied entry of the proposed Protective Order (Paper 25), that we enter the default Protective Order.¹ Counsel for Saint-Gobain also represented that, in the event that the default Protective Order is entered, it desired to withdraw certain exhibits that had previously been submitted under the Motion to Seal in connection with the initially proposed Protective Order and to substitute, in lieu thereof, alternative exhibits, declarations, and a Patent Owner Response and/or exhibits, declarations, and a Patent Owner Response with fewer redactions.

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. *Garmin Int'l, Inc. v. Cuozzo Speed Tech. LLC*, Case IPR2012-00001, slip. op. (PTAB Apr. 5, 2013). 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

¹ A copy of the Board's standing or default Protective Order is published in the *Office Patent Trial Practice Guide*, 77 Fed. Reg. 4848,756, 48,771 (Aug. 14, 2012).

issue is sealed pending the outcome of the motion. *Id.* It is, however, only “confidential information” that is protected from disclosure. *Id.*; 35 U.S.C. § 316(a)(7).² 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. 37 C.F.R. § 42.54.

The standard for granting a motion to seal is for “good cause.” 37 C.F.R. § 42.54(a). Patent Owner bears the burden of proof in showing that the materials identified in the Motion to Seal should be protected from disclosure as requested. 37 C.F.R. § 42.20(c); *Garmin, supra*.

With the Motion to Seal and proposed Protective Order, Saint-Gobain filed the following unredacted papers, declarations, and exhibits (collectively “papers”) with a request that portions thereof be maintained under seal: Patent Owner’s Response (Paper 21), Exhibits 2005-2011, 2017 and 2018. Saint-Gobain also filed redacted counterparts to the above-referenced papers.

The materials sought to be protected fall generally into three categories: (1) Documents prepared in connection with development of the

² Confidential information will be made public where the existence of the information is identified in a final written decision following a trial. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012)).

patented invention and related declaration testimony;³ (2) A document that is a competitive analysis vis-à-vis a competing product;⁴ (3) Information related to the volume of sales of alleged commercial embodiments of the patented invention.⁵

Request for Entry of Non-Standard Protective Order

Saint-Gobain's Motion to Seal includes a request for entry of a non-standard Protective Order. We first address this request. We note that the Office Patent Trial Practice Guide states the following concerning protective orders:

(a) Purpose. This document provides guidance on the procedures for filing of motions to seal and the entry of protective orders in proceedings before the Board. The protective order governs the protection of confidential information contained in documents, discovery, or testimony adduced, exchanged, or filed with the Board. *The parties are encouraged to agree on the entry of a stipulated protective order. Absent such agreement, the default standing protective order will be automatically entered.*

Office Patent Trial Practice Guide, App'x B (emphasis added).

After considering all the evidence and both parties' positions, we are not persuaded that Saint-Gobain has met its burden of showing persuasively that Saint-Gobain will suffer substantial harm if the Board does not enter Saint-Gobain's proposed, non-standard Protective Order. The request is not supported by testimony or other evidence that shows that Saint-Gobain will

³ These include Exs. 2005–2010, and 2018 (Slayne Declaration).

⁴ Ex. 2011.

⁵ Ex. 2017 (Woodhead Declaration).

be injured if the default protective order is entered.⁶ Specifically, the request is supported by only vague representations of counsel that the information sought to be protected is “non-public confidential” information, without tying these representations to Saint Gobain’s proposed changes to the default protective order. Paper 23, ¶¶ A-J; *See In re Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.*, 184 F.Supp.2d 1353, 1362 (N.D.Ga. 2002) (calling a document confidential does not make it so in the eyes of the court). During the conference call, Saint-Gobain expressed concern, for the first time, that its confidential information may be disclosed to employees or consultants of Intri-Plex who are in a position to exploit such information to Intri-Plex’s advantage at Saint-Gobain’s expense. Saint-Gobain has failed to persuade us, however, why its concerns are not addressed adequately by our default Protective Order, in particular, paragraph 2(E) thereof, which expressly sets forth procedures regarding providing access of confidential information to Other Employees of a Party.

For these reasons, Saint Gobain’s request for entry of a non-standard Protective Order is DENIED. We enter the default Protective Order, but without imposing Saint-Gobain’s proposed conditions. Nevertheless, we will allow Saint Gobain to substitute the above-referenced papers to the extent indicated below.

Motion to Seal

At this juncture, we have not yet seen Saint-Gobain’s proposed substitute papers. Nonetheless, as we enter the default Protective Order, for

⁶ For example, at the teleconference, Saint-Gobain indicated that it could adequately demonstrate the commercial success of its invention as a secondary consideration of non-obviousness by relying on unit sales data in lieu of confidential profit and sales revenue data.

the reasons set forth above, it appears that information currently the subject of the Motion to Seal will be substituted or expunged by Saint-Gobain. Accordingly, we will permit Saint-Gobain to substitute the above-referenced papers by September 3, 2014, and defer our consideration of the Motion to Seal until after the substitutes have been filed. The substitute papers may only be a subset of the previously filed unredacted papers. No new legal theories or arguments are permitted. Upon filing of these substitute papers, Intri-Plex will have immediate access to them under the terms of the default Protective Order, and the Motion to Seal will be decided at a later date.

Intri-Plex's Request for Extension of Time

Intri-Plex expresses concern that it has been prejudiced by the delay attributed to Saint-Gobain's efforts to protect its alleged confidential information from disclosure. Specifically, Intri-Plex asserts that it was not served with the unredacted papers until one week after the filing of the Patent Owner Response, under the condition that the unredacted papers were for outside counsel's eyes only, a condition that Intri-Plex's counsel's indicated as limiting their ability to respond effectively to the Patent Owner Response. Additionally, Intri-Plex asserts it will be further prejudiced with delay if Saint-Gobain is allowed to submit substitute papers. Under the circumstances, we grant Intri-Plex's request for an extension of time.

Under the current Scheduling Order, Intri-Plex's "Due Date 2" for submitting Petitioner's Reply to Patent Owner's Response to Petition is October 10, 2014. We note that, in the present case, Saint-Gobain has not filed a motion to amend the '640 Patent. Accordingly, there is no need for Due Date 3, which is October 31, 2014. The time period between August 11, 2014 and September 3, 2014 is roughly congruous with the time

period between Due Date 2 and Due Date 3. Accordingly, we extend the due date for Intri-Plex to file a Reply to Patent Owner's Response to Petition to October 31, 2014, provided Intri-Plex does not rely on testimony of any rebuttal witnesses. If Intri-Plex intends to rely on testimony of any rebuttal witnesses, the due date is extended to October 21, 2014 to provide sufficient time for Saint-Gobain to cross-examine any rebuttal witnesses.

*Intri-Plex's Request for Authorization to file
Motion to Strike for Lack of Service*

In light of the above, Intri-Plex's request for authorization to file a Motion to Strike for Lack of Service is DENIED.

ORDER

In view of the foregoing considerations, we enter the following ORDER:

1. Saint-Gobain's request for entry of a non-standard Protective Order set forth in Paper 23 is DENIED.
2. The Board's default Protective Order is hereby ENTERED.
3. Intri-Plex's request to file a Motion to Strike Patent Owner's unredacted response and unredacted Exhibits 2005-2011, 2017, and 2018 for Lack of Service is DENIED.
4. Intri-Plex's request for extension of time is GRANTED, and the Scheduling Order entered in this case (Paper 16) is hereby MODIFIED so that Intri-Plex's Due Date 2 for submitting Petitioner's Reply to Patent Owner's Response to Petition shall be October 31, 2014, provided Intri-Plex does not rely on testimony of a rebuttal witness. If Intri-Plex intends to rely on testimony of a rebuttal witness, the due date is extended to

October 21, 2014. All other Due Dates in the Scheduling Order shall remain in full force and effect.

5. Saint-Gobain shall have until September 3, 2014, to file substitute documents and declarations in lieu of the confidential and redacted versions of Patent Owner's Response (Papers 21 & 22); Exs. 2005-2011; and the Woodhead and Slayne Declarations (Exs. 2017 & 2018). All substitute documents shall be filed as new papers and exhibits. Saint-Gobain shall not materially change the substance of its Patent Owner's Response and supporting Exhibits and Declarations. The only changes to these materials that are authorized are to remove previous redactions, to replace appropriate citations, and to either delete confidential information from the Patent Owner's Response or substitute items of confidential information referred to in the Patent Owner's Response with other, less sensitive items of information.

6. Saint-Gobain shall have until September 5, 2014, to submit a written request to expunge Patent Owner's Confidential Response (Paper 21) and unredacted Exhibits 2005-2011, 2017, and 2018. Such materials shall remain provisionally sealed until disposition of such written request to expunge.

7. Within a reasonable time after service of Saint-Gobain's substitute Patent Owner's Response and supporting Exhibits and Declarations, counsel for Intri-Plex shall contact counsel for Saint-Gobain and provide reasonable assurance that confidential versions of Patent Owner's Response and supporting Exhibits and Declarations provided by Saint-Gobain to Intri-Plex for purposes of this motion proceeding have been permanently deleted or destroyed.

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8. This Order is without prejudice to our consideration of Intri-Plex's pending motion for additional discovery which is still in the briefing stage.

PETITIONER:

Albin Gess
ages@swlaw.com

Sina Aria
saria@swlaw.com

PATENT OWNER:

Edmund Walsh
Ewalsh-ptab@wolfgreenfield.com

Gerald Hrycyszyn
GHrycyszyn-PTAB@wolfgreenfield.com