

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDWARDS LIFESCIENCES CORPORATION,
Petitioner,

v.

BOSTON SCIENTIFIC SCIMED, INC.,
Patent Owner.

Case IPR2017-00060
Patent 8,992,608 B2

Before NEIL T. POWELL, JAMES A. TARTAL, and
ROBERT L. KINDER, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

DECISION

Denying Joint Motion for Entry of Stipulated Protective Order
37 C.F.R. §§ 42.14 and 42.54

As authorized by the Case Management and Scheduling Order (Paper 8, 2), Edwards Lifesciences Corporation, Edwards Lifesciences LLC, and Edwards Lifesciences AG (“Petitioner”) and Boston Scientific Scimed, Inc., (“Patent Owner”), (collectively, “the Parties”), jointly move for entry of a proposed Stipulated Protective Order. Paper 20 (“Mot.”); Ex. 2012.¹ The Parties contend that the proposed Stipulated Protective Order includes changes from the Board’s Default Protective Order “to harmonize the protective order” with a protective order filed in district court (the “Delaware Protective Order”),² “to permit information from such litigation to be used in this proceeding,” and “to further ensure the preservation of confidentiality of information that may be submitted to the Board.” *Id.* For the reasons provided below, the joint motion is denied without prejudice. Additionally, Patent Owner improperly filed a number of documents with restricted public accessibility unaccompanied by a motion to seal, which we also address below.

The Parties must show good cause why the modified protective order should be entered, as well as demonstrate that the relief requested is

¹ The proposed Stipulated Protective Order is referred to in the Motion as “Exhibit 1,” but appears in the record as Exhibit 2012.

² The Delaware Protective Order is attached to the proposed Stipulated Protective Order as “Appendix A” and is a copy of a document titled “[Proposed] Stipulated Protective Order” purportedly filed on January 16, 2017, in related litigation in the United States District Court for the District of Delaware in Case No. 1:16-cv-00275-SLR-SRF. Ex. 2012, 13–37. The Delaware Protective Order is signed by the Parties, but the signature space for entry of the proposed order by the district court is blank. Ex. 2012, 25. The Parties, however, represent that the district court protective order is “in place in Case No. 16-275-SLR-SRF (D. Del.)” Mot. 1.

warranted. *See* 37 C.F.R. §§ 42.20(c) and 42.54(a). A motion for entry of a proposed protective order that deviates from the Board’s default protective order should identify specifically how the proposed order substantively differs from the Board’s default protective order and also explain why each proposed change is warranted. *See* 37 C.F.R. § 42.54; Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48769–71 (Aug. 14, 2012). As explained below, we conclude that the proposed Stipulated Protective Order fails to adequately identify in substance how it differs from the Board’s default protective order, and that the Motion fails to explain why such modifications are warranted.

A fundamental flaw with the proposed Stipulated Protective Order stems from the attempt of the Parties to essentially incorporate by reference portions of the Delaware Protective Order. For example, regarding access to “Confidential Information,” the proposed Stipulated Protective Order states with respect to “Parties” that access is limited “only as permitted by the terms of the Delaware Protective Order.” Ex. 2012, 2. The proposed Stipulated Protective Order does not expressly state what specific terms are from the Delaware Protective Order are being referred to or what is permitted. Moreover, the Motion fails to provide any explanation of how the terms differ from the default protective order, or why they are warranted in this proceeding beyond general propositions. Under such an approach, it is also unclear whether any future order by the district court would impact the scope and meaning of terms, such as “Parties,” in the proposed Stipulated Protective Order were it adopted in this proceeding. Other portions of the proposed Stipulated Protective Order purport to allocate the

burden on proving a person may have access to information based on whether “that person would not be permitted under the terms of the Delaware Protective Order.” *Id.* at 3. We are not persuaded that it would be reasonable to premise a determination of what is permitted under the proposed Stipulated Protective Order on the content of separate requirements from the Delaware Protective Order, as the practical effect would be to impose on the Board the obligation of interpreting and enforcing terms of a district court protective order that may also be subject to future change. Accordingly, we find that the Parties have not shown that the proposed Stipulated Protective Order is warranted in this proceeding.

Additionally, the explanation of the Parties of the differences between the proposed Stipulated Protective Order and the Board’s default protective order also is insufficient. The Parties provide a document (referred to in the Motion as “Exhibit 2,” but appearing in the record as Exhibit 2013) purporting to compare the proposed Stipulated Protective Order to the Board’s Default Protective Order by showing changes between the two in redline. In principle, such a document would substantively show how the agreements differ. In practice in this case, however, the comparison provided by the Parties is of little practical value and offers no substantive explanation when directed to modifications like the addition of the statement “but only as permitted by the terms of the Delaware Protective Order.” *See* Ex. 2013, 3. In another example, the proposed Stipulated Protective Order appears to imply a prosecution bar is incorporated by reference from the Delaware Protective Order. *Id.* at 2. The Parties fail to provide any explanation to show inclusion of such terms in a protective order in this

proceeding, which appear to conflict directly with the Board's guidelines, is warranted. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. at 48771, para. (h) (stating that “[c]ounsel for a party who receives confidential information in a proceeding will not be restricted by the Board from representing that party in any other proceeding or matter before the Office.”). For the foregoing reasons, the Joint Motion for Entry of Stipulated Protective Order is denied without prejudice. The Parties are authorized to file a motion for entry of a substitute stipulated protective order, provided the motion addresses the necessary showing of good cause. While we appreciate the interest of the Parties in harmonizing requirements across the district court case and this proceeding for their convenience, that does not alleviate the need for the Parties to make the necessary showing in this proceeding in support of each and every modification of the Board's default protective order.

Additionally, Patent Owner filed a number of documents with restricted public accessibility, including an unredacted version of the Patent Owner's Response (Paper 21) and Exhibits 2031, 2034, 2035, 2036, 2039, 2040, 2041, 2042, 2043, 2044, 2045, 2046, 2055, 2056, 2057, 2063, 2077, 2078, 2080, 2085, 2086, 2087, 2088, 2089, 2090, and 2091. None of the confidential exhibits are accompanied by non-confidential versions of redacted exhibits. Moreover, Patent Owner did not file concurrently a motion to seal any of the documents Patent Owner filed with restricted public access.

The requirement that a motion to seal must accompany the filing of a document with restricted public access is unambiguous. In accordance with

37 C.F.R. § 42.14, “[a] party intending a document or thing to be sealed shall file a motion to seal concurrent with the filing of the document or thing to be sealed” (emphasis added). Our regulations clearly state that the “[r]ecord of a proceeding, including documents and things, shall be made available to the public, except as otherwise ordered.” 37 C.F.R. § 42.14. To this end, as set forth in the Board’s default protective order:

Where confidentiality is alleged as to some but not all of the information submitted to the Board, the submitting party shall file confidential and non-confidential versions of its submission, together with a Motion to Seal the confidential version setting forth the reasons why the information redacted from the non-confidential version is confidential and should not be made available to the public. The nonconfidential version of the submission shall clearly indicate the locations of information that has been redacted. The confidential version of the submission shall be filed under seal.

Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,771. Similarly, as set forth in the Case Management and Scheduling Order:

The Board has a strong interest in promoting public accessibility to the proceedings. If a party seeks to redact information from documents filed in this proceeding in accordance with a protective order, the redactions must be limited to isolated passages consisting entirely of confidential information, and the thrust of the underlying argument or evidence must remain clearly discernible.

Paper 8, 3. Thus, the default rule is that all papers filed in an *inter partes* review are open and available for access by the public; only “confidential information” may be protected from disclosure upon a showing of good cause. *See* 35 U.S.C. §§ 316(a)(1) and 316(a)(7); 37 C.F.R. §§ 42.14 and 42.54(a). Generally, the party asserting confidentiality bears the burden of showing that the relief requested should be granted. 37 C.F.R. § 42.20(c).

This includes showing that the information is truly confidential, and that such confidentiality outweighs the strong public interest in having an open record.³ A motion to seal will not be granted if based only on broad or generic contentions of confidentiality. Moreover, information subject to a protective order will become public if identified in a final written decision in this proceeding, and a motion to expunge information will not necessarily prevail over the public interest in maintaining a complete and understandable file history. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,761. As such, the Parties are encouraged to stipulate to facts or use other means to present evidence without the need for a motion to seal.

Counsel should be well-aware of the procedures for filing confidential documents, including the requirement for a motion to seal. Counsel are directed to review the Office Patent Trial Practice Guide, the Case Management and Scheduling Order, and the Board's regulations to assure adherence to such procedural requirements. Further, Patent Owner or Petitioner shall file a motion to seal addressing every document filed with

³ To the extent further guidance is necessary, we make the following observations. Few, if any, exhibits, even business records, should ever be confidential in their entirety, without good cause to show that *all* of the information contained therein is truly sensitive. *See* 37 C.F.R. § 42.54(a). Even business records (e.g., sales forecasts, license agreements) often contain some non-confidential information serving to identify the nature of confidential portions of the exhibit. Conversely, deposition transcripts, declarations, and papers containing a party's arguments will generally contain *substantial* non-confidential portions. In all cases, the Motion to Seal must *set forth the reasons why the information redacted from the non-confidential version is confidential and should not be made publicly available*. Patent Office Trial Practice Guide, 77 Fed. Reg. at 48,771 (emphasis added).

restricted public access by July 28, 2017, for which confidentiality is sought to be maintained. A document will be provisionally sealed on receipt of a motion to seal and remain so pending the outcome of the decision on the motion. 37 C.F.R. §§ 42.14. Any document filed with restricted public access not addressed in a motion to seal and not identified to be expunged by that date will be designated public.

It is

ORDERED that the Joint Motion for Entry of Stipulated Protective Order is *denied without prejudice*;

FURTHER ORDERED that the Parties are authorized to file a motion for entry of a substitute stipulated protective order on, or before, July 28, 2017, providing good cause for entry of such order, and shall not make the stipulated protective order dependent on any other agreement of the Parties, in accordance with the foregoing guidance;

FURTHER ORDERED that, in the absence of a substitute stipulated protective order granted by the Board, the Board's Default Protective Order shall govern the conduct of the proceedings unless otherwise modified;

FURTHER ORDERED that Patent Owner shall file, on or before July 28, 2017, a motion to seal addressing each and every paper or exhibit Patent Owner seeks to maintain as confidential as filed with the Board with the understanding that any document filed with restricted public access not addressed in a motion to seal by that date will be designated public;

FURTHER ORDERED that Petitioner shall file, on or before July 28, 2017, a motion to seal addressing each and every paper or exhibit Petitioner seeks to maintain as confidential as filed with the Board with the

understanding that any document filed with restricted public access not addressed in a motion to seal by that date will be designated public; and

FURTHER ORDERED that on, or before, July 28, 2017, with respect to each and every paper or exhibit filed with restricted public access, the Parties shall:

(1) file a non-confidential, redacted version of each exhibit or paper sought to be maintained as confidential;

(2) notify the Board to specifically identify each exhibit or paper, if any, no longer sought to be maintained as confidential; and

(3) notify the Board to specifically identify each exhibit or paper, if any, sought to be expunged and no longer relied upon in this proceeding; and

FURTHER ORDERED that the Parties are instructed to meet and confer in good faith as necessary to give effect to the foregoing instructions.

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For PETITIONER:

Gregory S. Cordrey
JEFFER MANGELS BUTLER & MITCHELL, LLP
gcordrey@jmbm.com

Brian Egan
MORRIS, NICHOLS, ARSHT & TUNNELL LLP
began@mnat.com

Catherine Nyarady
PAUL, WEISS, RIFKIND, WHARTON & GARRISON LLP
cnyarady@paulweiss.com

For PATENT OWNER:

Jennifer A. Sklenar
Wallace Wu
ARNOLD & PORTER LLP
jennifer.sklenar@aporter.com
wallace.wu@porter.com