

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner,

v.

RAYTHEON COMPANY,
Patent Owner.

Case IPR2015-01201
Patent 5,591,678

Before JO-ANNE M. KOKOSKI, JENNIFER MEYER CHAGNON, and
JEFFREY W. ABRAHAM *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

DECISION

Patent Owner's Motion for Entry of a Modified Protective Order
37 C.F.R. § 42.54

I. INTRODUCTION

Raytheon Company (“Patent Owner”) filed a Motion for Entry of a Modified Protective Order. Paper 14 (“Mot.”). Sony Corporation (“Petitioner”) filed an Opposition (Paper 15, “Opp.”) and Patent Owner filed a Reply (Paper 18, “Reply”). A copy of a Proposed Protective Order was filed together with Patent Owner’s Motion as Exhibit 2002 (redline comparison to the Default Protective Order) and Exhibit 2003 (clean copy). With its Reply, Patent Owner filed a revised Proposed Protective Order (Ex. 2007), including changes responsive to Petitioner’s objections set forth in the Opposition. We refer to the revised version of the Proposed Protective Order (Ex. 2007) throughout this Decision.

In its Motion, Patent Owner indicates that it “intends to submit, with its Patent Owner Response, documents that are subject to The International Traffic in Arms Regulations (‘ITAR’).” Mot. 1 (citing 22 C.F.R. Parts 120–130); *see id.* at 2–3 (citing Ex. 2001 ¶¶ 4, 6; Ex. 2005 ¶ 3). Patent Owner, thus, requests entry of a modified protective order (Ex. 2007), prior to filing its Patent Owner Response, in order to comply with its obligations under ITAR. Mot. 3–4.

The Proposed Protective Order differs from the Board’s Default Protective Order primarily in that it includes several provisions regarding access to ITAR designated materials (i.e., “ITAR Restricted Documents”). *See* Ex. 2007 ¶¶ 2, 4–7; Ex. 2002 (red-line comparison to the Default Protective Order). The Proposed Protective Order also removes

paragraph 2(A)¹ from the Board’s Default Protective Order, and adds a new paragraph 10 relating to “Retained Jurisdiction.” *See* Ex. 2007 ¶¶ 2, 10.

Petitioner opposes the Proposed Protective Order for several reasons. *See* Opp. 4–10. Specifically, Petitioner objects to certain changes proposed by Patent Owner as they relate to non-ITAR confidential information as burdensome to Petitioner (*id.* at 4–5); and to certain ITAR-related provisions, particularly reporting obligations related to potential ITAR infractions, the ability to submit ITAR Restricted Documents to the Board, and the non-mutuality of the ITAR-related provisions (i.e., specific references to Raytheon in these provision) (*id.* at 5–10). Petitioner argues also that Patent Owner has not shown it even needs to submit the ITAR information. *Id.* at 8–9. Finally, Petitioner notes how the Proposed Protective Order potentially would affect Board operations. Opp. 11–12.

In its Reply, Patent Owner revises the Proposed Protective Order to address some of Petitioner’s objections, and responds to Petitioner’s contentions.

II. ANALYSIS

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

¹ Paragraph 2(A) allows access to confidential information by “Parties” defined as “Persons who are owners of a patent involved in the proceeding and other persons who are named parties to the proceeding.” *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,771 (Aug. 14, 2012) (Appendix B).

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.*

77 Fed. Reg. at 48,769 (Appendix B) (emphasis added). As indicated in Patent Owner's Motion, the parties were unable to agree on the scope of the Proposed Protective Order. Mot. 12. Given the unique circumstances of this proceeding, particularly regarding the implication of ITAR, rather than addressing the Proposed Protective Order as a whole, we follow the guidance of the Trial Practice Guide with respect to contested non-ITAR-specific provisions, and address the contested ITAR-specific provisions separately. Patent Owner, as the moving party, has the burden to show that it is entitled to the relief it requests. *See* 37 C.F.R. § 42.20(c).

Submission of ITAR Restricted Documents

As indicated above, Patent Owner intends to submit ITAR Restricted Documents with its Patent Owner Response. According to Patent Owner, these documents are related to the conception and reduction to practice of the invention claimed in the '678 patent. Mot. 2 (citing Ex. 2001 ¶ 4; Ex. 2005 ¶ 3). Patent Owner intends to submit these documents to establish that Bertin² is not prior art under 35 U.S.C. § 102(e). *Id.* According to Patent Owner, the ITAR Restricted Documents it intends to submit were subject to ITAR prior to the filing of the Petition in this proceeding. *Id.* at 3 (citing Ex. 2005 ¶ 3). The ITAR Restricted Documents are governed by ITAR, and must be treated accordingly. *Id.* (citing Ex. 2001 ¶ 6). Patent Owner further asserts that “[w]ithout the entry of such a protective order

² In our Decision on Institution, we instituted the instant trial based, in part, on U.S. Patent No. 5,202,754 to Bertin. *See* Paper 6, 23–24.

[that will ensure compliance with ITAR in connection with the submission of ITAR Restricted Documents, its] ability to respond to Petitioner’s challenges, and therefore its due process rights, would be compromised.” *Id.*

Petitioner argues that Patent Owner “has not made a sufficient case that it needs ITAR information at all.” Opp. 8. In this regard, Petitioner argues that “Patent Owner has not addressed what steps it has taken to limit the need for ITAR-based restrictions.” *Id.* at 3. Petitioner further asserts that Patent Owner has known its case would involve ITAR Restricted Documents since at least July 2015, and that Patent Owner should have indicated whether it had sought or will seek a license from the U.S. State Department to lift the ITAR-restricted designation from the documents. *Id.* at 8–9 (citing Ex. 1023).

We are not persuaded that Patent Owner has a burden in its Motion for entry of a protective order to demonstrate that the material it wishes to submit is necessary for its substantive case. Further, Patent Owner asserts that it “intends to submit only a small fraction” of the 11,000 pages of documents designated as ITAR protected that were produced in the related district court proceeding. Reply 2. Petitioner also does not cite to any authority to support the asserted obligation of Patent Owner to limit the use of ITAR information, or to obtain a license for the use thereof, prior to submission of such information in this *inter partes* proceeding.

We are persuaded that Patent Owner has demonstrated a need to submit ITAR Restricted Documents in this proceeding. We also are persuaded that a modified Protective Order, addressing the treatment of ITAR Restricted Documents, is necessary in order to satisfy Patent Owner’s obligations under ITAR.

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