

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STEADYMED LTD.,
Petitioner,

v.

UNITED THERAPEUTICS CORPORATION,
Patent Owner.

Case IPR2016-00006
Patent 8,497,393 B2

Before LORA M. GREEN, JONI Y. CHANG, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

HARLOW, *Administrative Patent Judge*.

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

A Decision to Institute an *inter partes* review is issued concurrently with this order. The Patent Owner's Preliminary Response, and Exhibits 2003, 2004, 2005, and 2006 were filed under seal. In addition, Patent Owner filed a Motion to File under Seal concurrently with its Preliminary Response and Exhibits. Paper 7. In that Motion, Patent Owner avers that the parties have agreed to the Default Protective Order in the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48771 (Aug. 14, 2012). *Id.*

We decline to rule on Patent Owner's Motion to File under Seal at this time. However, because it discusses information contained in Exhibits 2003, 2004, 2005, and 2006, we have filed our Decision to Institute under seal. We issue this order to request that the parties clarify and justify what, if anything, in the Decision to Institute should remain under seal.

In undertaking to identify material in the Decision to Institute that should remain under seal, we remind the parties of the strong public policy for making all information filed in a quasi-judicial administrative proceeding open to the public. This policy favoring public disclosure is heightened in an *inter partes* review which 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), the default rule is that all papers filed in an *inter partes* review are open and available for access by the public, and a party may file a concurrent motion to seal and the information at issue is sealed pending the outcome of the motion. Similarly, 37 C.F.R. § 42.14 provides:

The record of a proceeding, including documents and things, shall be made available to the public, except as otherwise ordered. 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. The document or thing shall be provisionally sealed on receipt of the motion and remain so pending the outcome of the decision on the motion.

It is, however, only “confidential information” that is protected from disclosure. 35 U.S.C. § 316(a)(7)(“The Director shall prescribe regulations — . . . providing for protective orders governing the exchange and submission of confidential information”). In that regard, note the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012), which 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.

Confidential information may also 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 at 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012)).

It is

ORDERED that the parties are directed to submit by April 28, 2016, a joint written statement identifying those parts of the Decision to Institute that should remain under seal, accompanied by a redacted copy of the Decision to Institute;

FURTHER ORDERED that if the parties come to an agreement that portions of the Decision to Institute should remain under seal, they should file a motion to seal; and

FURTHER ORDERED that if a response as to which portions of the Decision to Institute should remain under seal is not received by April 22, 2016, the Decision to Institute will be made available to the public in its entirety.

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