

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

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