

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TARO PHARMACEUTICALS U.S.A., INC.,
Petitioner,

v.

APOTEX TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2017-01446
Patent 7,049,328 B2

Before LORA M. GREEN, JEFFREY N. FREDMAN, and
ZHENYU YANG, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION
Denying Motions to Seal Without Prejudice
37 C.F.R. § 42.54

I. INTRODUCTION

With authorization of the Board, Paper 18, Taro Pharmaceuticals U.S.A., Inc. (“Petitioner”) filed a redacted motion for additional discovery relating to Exhibits 1037–1045 and 1047–1049 (Paper 22) along with a Motion to Seal. Paper 21. Apotex Technologies, Inc. (“Patent Owner”)

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filed a redacted paper that opposes the Motion (Paper 30), and also filed a Motion to Seal. Paper 31. In the motion, Petitioner explains that these documents were generated during litigation in parallel litigation related to the '328 patent, *ApoPharma Inc. v. Taro Pharmaceutical Industries, Ltd.*, No. 2:16-cv-00528, currently pending in the District Court for the Eastern District of Texas – Marshall Division.

Patent Owner moves to seal Exhibits 1037–1045 and 1047–1049 on the basis that they “are documents that Patent Owner has designated as Highly Confidential pursuant to the Stipulated Protective Order entered in the concurrent district court case, *ApoPharma Inc. v. Taro Pharmaceutical Industries, Ltd.*, Case No. 2:16-cv-00528 (E.D. Tex.)” Paper 31, 2. *See also*, Petitioner’s motion to seal. Paper 21, 3. However, neither Patent Owner, the owner of the information sought to be sealed, nor Petitioner, have made any showing to establish that the material sought to be sealed is, in fact, confidential, or to justify that sealing outweighs the public’s interest in an open file history.

On that point, the standard for granting a motion to seal in this forum is “good cause,” reflecting the strong public policy for making all information in *inter partes* review proceedings open to the public. 37 C.F.R. § 42.54. The moving parties bear the burden of showing that the relief requested should be granted. 37 C.F.R. § 42.20(c). That includes a showing that the information is truly confidential, and that such confidentiality outweighs the strong public interest in having an open record. *See Garmin Int’l v. Cuozzo Speed Techs., LLC*, Case IPR2012–00001, slip op. at 3 (PTAB Mar. 14, 2013) (Paper 36). The stated reason by Patent Owner and Petitioner for sealing—that the documents contain information previously

sealed by a district court (Paper 31, 2–3, Paper 21, 2)—is insufficient, as that fact, by itself, is insufficient to establish good cause as to why the information should be sealed. Accordingly, the Motion is denied.

Either party may file a motion to seal Exhibits 1037–1045 and 1047–1049 within ten (10) business days of the entry date of this Order. The parties are directed to provide in their motion a justification sufficient to establish good cause for sealing the exhibit in its entirety. If no timely motion is filed, Exhibits 1037–1045 and 1047–1049 shall be made public. In the interim, those documents, and our concurrently entered Decision Granting Petitioner’s Motion for Additional Discovery, shall be protected according to the terms of the Board’s Default Protective Order.

Exhibit 1051 is a joint proposed Protective Order. It is based in substantial part on the default standing protective order in the Office Patent Trial Practice Guide. In light of the parties’ agreement on the scope of the proposed Protective Order and their competitive position (Papers 21, 31), we determine the proposed Protective Order is acceptable, that order shall apply to confidential information filed under seal in this proceeding.

II. CONCLUSION

For the reasons discussed above, we conclude neither Patent Owner’s nor Petitioner’s Motion to Seal met the requirement of a “good cause” showing that the need for confidentiality outweighs the strong public interest in having the record open to the public.

III. ORDER

Accordingly, it is:

ORDERED that Patent Owner’s and Petitioner’s Motions to Seal and for Entry of Protective Order are denied without prejudice;

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FURTHER ORDERED that each party is authorized to file a Second Motion to Seal subject to the conditions set forth in this Order for the purpose of requesting to seal Exhibits 1037–1045 and 1047–1049;

FURTHER ORDERED that the Second Motion to Seal is limited to seven (7) pages;

FURTHER ORDERED that the Second Motion to Seal shall be filed within ten (10) business days of entry of this Order;

FURTHER ORDERED that the Second Motion to Seal shall address the “good cause” standard as explained in this Order;

FURTHER ORDERED that the Modified Default Standing Protective Order filed as Exhibit 1051 shall apply to confidential information filed under seal in this proceeding.

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