

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YITA LLC,
Petitioner,

v.

MACNEIL IP LLC,
Patent Owner.

IPR2020-01139 (Patent 8,382,186 B2)
IPR2020-01142 (Patent 8,833,834 B2)¹

Before MITCHELL G. WEATHERLY, JAMES A. WORTH,
MICHAEL L. WOODS, and ARTHUR M. PESLAK,
Administrative Patent Judges.

PESLAK, *Administrative Patent Judge.*

ORDER

*Denying Patent Owner's Motion to Seal and for Entry of a Protective Order
and Entering the Board's Default Protective Order
37 C.F.R. §§ 42.14, 42.54*

¹ This Order applies to both proceedings. The parties are not authorized to use this caption.

I. INTRODUCTION

On May 5, 2021, Patent Owner filed its Patent Owner Response under seal in both of the captioned cases. Paper 28.² Patent Owner also filed a redacted version of the Patent Owner Response. Paper 29. In accordance with our rules, Patent Owner filed a Motion to Seal the Patent Owner Response and Exhibit 2042 and for Entry of a Protective Order. Paper 27 (the “Motion” or “Mot.”). On June 6, 2021, Petitioner filed an Opposition to Patent Owner’s Motion for Entry of a Protective Order. Paper 32 (the “Opposition” or “Opp.”). On July 7, 2021, Patent Owner filed a Reply to Petitioner’s Opposition to Patent Owner’s Motion to Seal and for Entry of a Protective Order. Paper 46 (the “Reply”). For the reasons discussed below, we deny Patent Owner’s Motion for Entry of the Protective Order attached to the Motion, enter the Board’s Default Protective Order, and deny without prejudice Patent Owner’s Motion to Seal the Patent Owner Response and Exhibit 2042.

II. DISCUSSION

a. Protective Order

Patent Owner proposes a Protective Order (the “Proposed Protective Order”) that deviates from the Board’s Default Protective Order. Mot. 1–4. The Proposed Protective Order, *inter alia*, adds an “Attorneys’ Eyes Only” designation, limits access to Protective Order Material by excluding support personnel for in-house counsel from receiving confidential information, and prohibits parties, employees of parties including in-house counsel from accessing information designated “Attorneys’ Eyes Only.” *Id.* at 1–2.

² We refer to the Papers filed in IPR2020-01139. For the purposes of this motion, the papers filed in IPR2020-01142 are substantially the same.

IPR2020-01139 (Patent 8,382,186 B2)

IPR2020-01142 (Patent 8,833,834 B2)

Patent Owner contends that these restrictions are necessary because “[p]roviding the parties or employees of parties access to confidential materials *could* cause harm to the producing party, as could providing unrestricted access to in-house counsel.” *Id.* at 2 (emphasis added). The Proposed Protective Order does not contain a definition of or description of materials that would fall under the category of “Attorneys’ Eyes Only.” *See generally* Mot. App. B. Rather, Patent Owner directs us to a definition of the “Attorneys’ Eyes Only category” in a District Court Protective Order entered into by Patent Owner and a Real Party-in-Interest of Petitioner. Reply 3 (citing Mot. App. C). Patent Owner further contends that the “designation is not overly inclusive such that the parties are encouraged to categorize all or most documents as such” and “contemplates that the parties will only use this designation for documents that would qualify for the designation in the district court proceeding.” Mot. 4.

Petitioner counters that the “Board’s [D]efault [P]rotective [O]rder is sufficient” and the “modified protective order imposes unduly prejudicial restrictions that are inconsistent with the integrity of this proceeding.” Opp. 1. Petitioner contends that Patent Owner “should not be able to argue that certain evidence demonstrates patentability on one hand, while simultaneously arguing that the very same evidence cannot be seen by” Petitioner on the other. *Id.*; *see also id.* at 5 (arguing against prohibition on in-house counsel and other personnel viewing Attorney’s Eyes Only material). For the following reasons, we deny Patent Owner’s Motion to enter the Proposed Protective Order, and we order entry of the Board’s Default Protective Order.

Patent Owner contends that the designation of “Attorneys’ Eyes Only” is necessary to protect it from unspecified harm and it will only use

IPR2020-01139 (Patent 8,382,186 B2)

IPR2020-01142 (Patent 8,833,834 B2)

the designation of “Attorneys’ Eyes Only” for material that would qualify for this designation under the terms of the District Court protective order. Mot. 2–4. These contentions are belied by the sealed documents filed by Patent Owner.

In the Patent Owner Response, Patent Owner argues that the patented invention has achieved commercial success. Paper 29, 77–78. In support of this assertion, Patent Owner relies on total gross revenues from sale of all products purportedly made in accordance with the teachings of the challenged patents from 2004 to the present. *Id.* at 77. Thus, it provides and redacts two numbers from the Patent Owner Response. *Id.* First, it provides total gross revenue in 2020 for these products and, second, it provides and redacts aggregate gross revenue from those products since 2004. *Id.* Patent Owner also filed a Declaration of Ryan Granger under seal. Ex. 2042. In the public version of this declaration, Patent Owner redacted two columns from a table setting forth the total number of products sold per year and the gross revenue per year from 2004 to 2020. *Id.* at 31. None of the underlying internal documents from which this information was determined is filed.

Because the redacted material was prepared for this litigation and contains merely total aggregate numbers, we question whether the redacted material would even qualify to be sealed in this case regardless of the provisions of any protective order. In addition, and contrary to Patent Owner’s assertion, the redacted information does not fit within the definition of material restricted to “Outside Counsel Attorneys’ Eyes Only” in the District Court Order. The District Court’s definition is:

“Outside Counsel Attorneys[’] Eyes Only” material shall include documents and tangible things produced or otherwise exchanged that (1) would otherwise be designated as confidential and (2) are reasonably believed by the designating party to represent a trade

IPR2020-01139 (Patent 8,382,186 B2)

IPR2020-01142 (Patent 8,833,834 B2)

secret or other confidential information of such sensitive nature that its dissemination cannot adequately be covered by the protections set forth for confidential materials. For example, financial and tax documents, molding, design, or other creation information would be considered Outside Counsel Attorneys' Eyes Only.

Mot., App. C ¶ 2.2.

Patent Owner fails to persuade us that the redacted information is either a trade secret or of such a sensitive nature that it should be designated Attorneys Eyes Only. Because the Patent Owner Response and Exhibit 2042 are the only documents filed under seal, we do not see the necessity for the deviations from the Board's Default Protective Order in the Proposed Protective Order. Therefore, we determine that the Board's Default Protective Order will govern this case. *See Consolidated Trial Practice Guide*³, 107 (Nov. 2019) ("The parties are encouraged to agree on the entry of a stipulated protective order. Absent such agreement, the default protective order may be entered by the Board.").

b. Motion to Seal

Patent Owner moves to seal the Patent Owner Response and Exhibit 2042. Mot. 6–8. Petitioner does not oppose the motion to seal. *See generally* Opp.

In light of our decision to enter the Board's Default Protective Order in lieu of the Proposed Protective Order, we will maintain the sealed status of the Patent Owner Response and Exhibit 2042. However, Patent Owner shall have 14 days from the entry of this order to address whether there is good cause under the standard articulated in *Argentum Pharms. LLC v. Alcon Research, Ltd.*, IPR2017-01053, Paper 27 (PTAB January 19, 2018)

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.