

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD.,
SAMSUNG ELECTRONICS AMERICA, INC. and APPLE, INC.,
Petitioner,

v.

NEONODE SMARTPHONE LLC,
Patent Owner.

IPR2021-00145
Patent 8,812,993 B2

Before MICHELLE N. ANKENBRAND, KARAL. SZPONDOWSKI, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

OGDEN, *Administrative Patent Judge*.

ORDER
Denying Motion for Entry of Protective Order
37 C.F.R. § 42.54

With our authorization, Petitioners Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”) filed a Motion to Seal and for Entry of Protective Order, seeking an order to seal and restrict access to Exhibit 2025 and a redacted portion of Exhibit 2015. Paper 31. The Motion included a First Proposed Protective Order that differs from the Board’s Default Protective Order. *Id.* at 9–10, App’x A. Because the First Proposed Protective Order was not a joint submission as the Scheduling Order requires, we ordered the parties to meet and confer with the goal of agreeing to a joint proposed protective order. Paper 34, 2. We authorized Samsung to file any such agreed proposed protective order “as a joint submission with the assent of all parties” by November 19, 2021. *Id.*

On November 19, 2021, Samsung and Patent Owner Neonode Smartphone LLC (“Neonode”) jointly filed a Second Proposed Protective Order (Paper 36, App’x A) and a marked-up version showing differences between the proposal and the Default Protective Order (Ex. 1049). Petitioner Apple, Inc. (“Apple”) was not a party to this submission, and the submitting parties failed to offer an explanation why Apple was not included in the joint filing.

According to the joint submission, the proposed modifications to the Default Protective Order “aim to account for providing Neonode party representatives and persons with knowledge of the agreement access to [Exhibit 2025], and excluding access to in-house personnel at Apple” in the event that we grant Samsung’s pending Motion to Seal. Paper 36, 1. The Second Proposed Protective Order replaces the normal category of confidential information with a heightened category labeled “SAMSUNG-NEONODE-CONFIDENTIAL—APPLE ATTORNEYS’ EYES ONLY” that

limits access to such documents by Apple's in-house personnel. *See* Ex. 1049, 2–3.

According to the Board's Trial Practice Guide, the Board will presumptively accept the parties' agreed modifications to the Default Protective Order "if they are consistent with the integrity and efficient administration of the proceedings." PTAB Consolidated Trial Practice Guide 115 (November 2019), <https://go.usa.gov/xpvPF>. This includes adding additional tiers or categories of confidentiality "as long as they are reasonable and adequately define what types of materials are to be included in the additional categories." *Id.* at 115–116. "The Board will not accept overly inclusive definitions that encourage the parties to categorize all or most of their discovery materials as 'Attorneys' Eyes Only.'" *Id.* at 116.

Rather than adding a heightened confidentiality tier, Samsung and Neonode have simply made the existing Default Protective Order more stringent by making confidential information "Attorney's Eyes Only" as to Apple alone. But under this proposed order, if a party will need to submit evidence in the future course of this proceeding that is confidential to Apple, the Second Proposed Protective Order will be inadequate and will need to be modified. Putting aside, for now, Samsung's Motion to Seal Exhibit 2025 and the redacted portion of Exhibit 2015, we have no reason to expect that all potential evidence in the remainder of this proceeding would necessarily merit an "Attorney's Eyes Only" level of scrutiny with respect to Apple.

Also, it does not appear from the submitted papers that Apple has assented to Samsung's and Neonode's joint proposal. Under the circumstances, Samsung and Neonode should not act unilaterally without

Apple, because the Second Proposed Protective Order would impose restrictions on Apple beyond those of the Default Protective Order.

Therefore, we deny, without prejudice, Samsung's Motion for Entry of a Protective Order. Samsung may, by December 17, 2021, submit another proposed protective order either jointly with both Neonode and Apple or with a statement indicating that Neonode and Apple agree with the proposal. The proposal must retain a non-Attorney's Eyes Only category of confidential information comparable to that of the Default Protective Order. To the extent that the proposal also includes a higher Attorney's Eyes Only tier of protected information (such as to exclude access by Apple's in-house personnel), the proposal must reasonably and adequately define what types of materials are to be included in the Attorney's Eyes Only category. The proposal may not simply refer to Exhibit 2025 and the redacted portion of Exhibit 2015, because the protective order must be generally applicable to any confidential information that arises in the future as part of this proceeding.

Any new proposed protective order must also include any other supporting material that the Scheduling Order requires, such as a marked-up comparison between the proposed and default protective orders and a joint explanation why good cause exists to deviate from the default protective order. *See* Paper 25, 2–3. Alternatively, if the parties cannot agree on a proposed protective order meeting the above requirements, Samsung must, by December 17, 2021, request a conference call with the Board and the parties to discuss the reasons why the parties have been unable to reach agreement on a new, proposed protective order.

Accordingly, it is

ORDERED that Samsung's Motion for Entry of Protective Order (Paper 31) is denied, *without prejudice*, but this Order does not resolve Samsung's Motion to Seal Exhibits 2025 and the redacted portion of 2015, which the Board will decide at a later time after entry of a suitable protective order;

FURTHER ORDERED that, by December 17, 2021, the parties must meet and confer, in good faith, with the goal of agreeing to a joint proposed protective order, as explained above, that (1) retains a non-Attorney's Eyes Only category of confidential information comparable to that of the Default Protective Order and (2) reasonably and adequately defines what types of materials are to be included in any additional, higher tier of protected information;

FURTHER ORDERED that Samsung must submit a proposed protective order by December 17, 2021, that is either a joint proposed order or indicates that all parties including Apple assent, and must include any other material that the Scheduling Order requires, such as a marked-up comparison between the proposed and default protective orders and a joint explanation why good cause exists to deviate from the Default Protective Order, as explained above; and

FURTHER ORDERED that, if the parties fail to reach agreement on a proposed protective order, Samsung must, by December 17, 2021, request a conference call with the Board and the parties to discuss the reasons why the parties have been unable to reach agreement.

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