

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BECTON, DICKINSON AND COMPANY,
Petitioner,

v.

B. BRAUN MELSUNGEN AG,
Patent Owner.

Case IPR2017-01586 (Patent 8,328,762)
Case IPR2017-01587 (Patent 9,149,626)
Case IPR2017-01588 (Patent 8,460,247)
Case IPR2017-01589 (Patent 8,597,249)
Case IPR2017-01590 (Patent 9,370,641)¹

Before SCOTT A. DANIELS, MICHAEL L. WOODS, and
ROBERT L. KINDER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding and Granting Motions to Compel Discovery,
Granting Motions to Seal, and Entering Protective Order
37 C.F.R. § 42.5; 37 C.F.R. § 42.51(b)

¹ We issue one Order and enter it in each proceeding.

IPR2017-01586 (Patent 8,328,762); IPR2017-01587 (Patent 9,149,626)
IPR2017-01588 (Patent 8,460,247); IPR2017-01589 (Patent 8,597,249)
IPR2017-01590 (Patent 9,370,641)

On February 7, 2018, we authorized Patent Owner to file a Motion to Compel under 37 C.F.R. § 42.52. Paper 11.² Currently pending before us are the following motions and papers:

- 1) Patent Owner's Motion to Compel Production³ and Petitioner's Response;⁴
- 2) Joint Motion to Seal and for entry of a Protective Order;⁵
- 3) Petitioner's Motion to Seal its Response to Patent Owner's Motion to Compel.⁶

For the reasons set forth below, we grant each respective motion and order the immediate production of the identified documents.

DISCUSSION

Patent Owner's Motion to Compel

Patent Owner identifies (Ex. 2025) 31 documents produced by Petitioner under a protective order in the parties' co-pending litigation, *B. Braun Melsungen AG, et al. v. Becton, Dickinson and Company, et al.*, D. Del. Case No. 16-411 ("the Litigation"). Paper 13, 1. These Litigation documents, already in Patent Owner's possession, are alleged to "demonstrate that there was a long-felt but unmet need

² The motions considered raise substantially the same issues and all citations are to IPR2017-01586 unless otherwise indicated.

³ IPR2017-01586, Paper 13; IPR2017-01587, Paper 13; IPR2017-01588, Paper 14; IPR2017-01589, Paper 14; IPR2017-01590, Paper 14.

⁴ IPR2017-01586, Paper 17 (18 redacted); IPR2017-01587, Paper 17 (18 redacted); IPR2017-01588, Paper 18 (19 redacted); IPR2017-01589, Paper 17 (18 redacted); IPR2017-01590, Paper 17 (18 redacted).

⁵ IPR2017-01586, Paper 14; IPR2017-01587, Paper 12; IPR2017-01588, Paper 13; IPR2017-01589, Paper 13; IPR2017-01590, Paper 13.

⁶ IPR2017-01586, Paper 16; IPR2017-01587, Paper 16; IPR2017-01588, Paper 17; IPR2017-01589, Paper 16; IPR2017-01590, Paper 16.

IPR2017-01586 (Patent 8,328,762); IPR2017-01587 (Patent 9,149,626)
IPR2017-01588 (Patent 8,460,247); IPR2017-01589 (Patent 8,597,249)
IPR2017-01590 (Patent 9,370,641)

for the claimed invention, Petitioner copied Patent Owner's invention, and the invention has been commercially successful." *Id.* Patent Owner contends each document should be produced as "routine discovery" because they are relevant and demonstrate conflicting positions between the Litigation and these proceedings. *Id.* at 1–2.

Patent Owner also contends that if the 31 documents do not fall under "routine discovery," the documents should be produced as "additional discovery" pursuant to *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, 2013 WL 11311697, at *3 (PTAB Mar. 5, 2013) (precedential). *See id.* at 3–5.

Petitioner disagrees that the 31 documents should be produced. Paper 17, 1–5. Petitioner first contends that because Patent Owner stipulated that the product accused in the Litigation does not infringe, any facts related to the accused product "have no relevance to secondary considerations." *Id.* at 1. Further, any attempt by Patent Owner "to show a nexus (which Braun has not done) would require a trial within a trial on non-infringement about a product that Braun has stipulated does not infringe." *Id.* Petitioner also argues the documents do not demonstrate any inconsistency, for example, "Braun has not identified any district court testimony from Mr. Griffis that is inconsistent with his testimony in the IPRs." *Id.* at 3. Petitioner also disagrees that the documents should be produced as "additional discovery" pursuant to *Garmin*. *Id.* at 2–5.

Based on the record before us, Patent Owner has specifically identified 31 documents (in its possession) that it contends show inconsistencies between the Petitioner's litigation position and the position taken before us in these proceedings. These documents purportedly demonstrate copying, long-felt need, and other objective indicia of nonobvious. Paper 13, 1. Although, routine discovery under 37 C.F.R. § 41.51(b)(1)(iii) is narrowly directed to specific

IPR2017-01586 (Patent 8,328,762); IPR2017-01587 (Patent 9,149,626)
IPR2017-01588 (Patent 8,460,247); IPR2017-01589 (Patent 8,597,249)
IPR2017-01590 (Patent 9,370,641)

information known to the responding party to be inconsistent with a position advanced by that party in the proceeding, Patent Owner has shown that the identified documents are inconsistent with a current position taken before the Board. Statements made by a party or by the party's expert that are inconsistent with a position taken during this trial should be produced and become part of the record. For example, the Federal Circuit recently vacated and remanded a Board's final written decision and ordered the Board to admit and consider an expert's trial testimony in a similar *inter partes* review. *See Ultratec, Inc. v. CaptionCall LLC*, 872 F.3d 1267, 1273 (Fed. Cir. 2017) (“[N]o reasonable fact finder would refuse to consider evidence of inconsistent sworn testimony. Moreover, any such inconsistencies would likely bear on the overall credibility of the expert.”). Looking at the summaries provided for these 31 documents (Ex. 2025) Patent Owner has sufficiently shown that these documents should be produced as routine discovery because these materials could contradict Petitioner's positions taken related to objective indicia of nonobviousness. Patent Owner's requested discovery is also narrowly tailored to identify evidence (31 documents) relevant to the issues in the present case.

In the Litigation, the parties stipulated to non-infringement, but did so in order to have an underlying claim construction appealed. Paper 13, 4; Ex. 3001. We understand, however, that this stipulation was based on the district court claim construction for which we have, in our initial Decision to Institute, reached a different determination. *See* Ex. 3001, 2–3. Thus, at this preliminary phase, the stipulated non-infringement decision in the related Litigation, currently on appeal, does not necessarily prevent Patent Owner from establishing a nexus between the accused device and the evidence of nonobviousness.

IPR2017-01586 (Patent 8,328,762); IPR2017-01587 (Patent 9,149,626)
IPR2017-01588 (Patent 8,460,247); IPR2017-01589 (Patent 8,597,249)
IPR2017-01590 (Patent 9,370,641)

To clarify, nothing in this Order shall be construed as requiring or authorizing either party to ignore or set aside any obligation imposed by a protective order in the Litigation. The entry of this Order and acceptance of the Joint Motion to Seal and for entry of a Protective Order should provide the parties with the protections necessary to comply with their obligations in the Litigation. Further, the parties are reminded that each paper or exhibit sought to be filed under seal should have a public version with as few redactions as possible and each should be supported by a motion to seal addressing why specific redactions are necessary. The parties should meet and confer to determine necessary redactions.

Joint Motion to Seal and for entry of a Protective Order

Pursuant to 37 C.F.R. §§ 42.14 and 42.55, the parties jointly move for leave to file under seal the redacted information contained within Exhibit 2025 filed in connection with Patent Owner’s Motion to Compel Under 37 C.F.R. §42.52. Paper 14, 1–5. The parties further request entry of a slightly modified version of the Proposed Default Protective Order as set forth in Appendix B of the Office Patent Trial Practice Guide (Ex. 2027). *Id.* The parties agree that “the redacted portions of Exhibit 2025 describe certain documents produced in the co-pending litigation that Petitioner has designated as ‘CONFIDENTIAL OUTSIDE COUNSEL ONLY,’ indicating that they contain or reflect confidential, proprietary, trade secret, and/or commercially sensitive information.” *Id.* at 2.

The parties propose a slight variation to the default protective order found in Appendix B of the Trial Practice Guide as shown in attached Exhibit 2027. *Id.* at 3. Exhibit 2028 shows in strike-through and underlining the changes in the proposed stipulated Protective Order, as compared to the default Protective Order. The parties allege that good cause exists to enter the proposed protective order because disclosure of the parties’ sensitive confidential information to competitive

IPR2017-01586 (Patent 8,328,762); IPR2017-01587 (Patent 9,149,626)
IPR2017-01588 (Patent 8,460,247); IPR2017-01589 (Patent 8,597,249)
IPR2017-01590 (Patent 9,370,641)

decision makers would present an unacceptable risk of inadvertent disclosure of those materials. The parties also agree that “the proposed Protective Order clarifies that independent legal translators, stenographic reporters, and videographers, as well as graphics or design services retained by outside counsel, may have access to confidential material to assist counsel in this proceeding.” *Id.* at 4.

“There is a strong public policy for making all information filed in a quasi-judicial administrative proceeding open to the public.” *Garmin Int’l v. Cuozzo Speed Techs., LLC*, IPR2012–00001, slip op. at 1–2 (PTAB Mar. 14, 2013) (Paper 34). The standard for granting a motion to seal is “good cause.” 37 C.F.R. § 42.54. That standard includes showing that the information addressed in the motion to seal is truly confidential, and that such confidentiality outweighs the strong public interest in having the record open to the public. *See Garmin*, slip op. at 2–3. The moving party bears the burden of showing that the relief requested should be granted, and establishing that the information sought to be sealed is confidential information. 37 C.F.R. § 42.20(c).

In reviewing the documents and information that the parties seek to seal, we observe that Exhibit 2025 describes several documents that contain descriptions of sensitive commercial and financial information such as sales data and internal product development strategy. Further, many of the redactions describe exhibits that are deposition transcripts and documents that were produced under a protective order in the Litigation. For these reasons, the parties have shown good cause to seal Exhibit 2025 and for entry of the stipulated Protective Order (Exhibit 2027).

IPR2017-01586 (Patent 8,328,762); IPR2017-01587 (Patent 9,149,626)
IPR2017-01588 (Patent 8,460,247); IPR2017-01589 (Patent 8,597,249)
IPR2017-01590 (Patent 9,370,641)

Petitioner's Motion to Seal its Response to Patent Owner's Motion to Compel

Petitioner moves for leave to file under seal the redacted information contained within Petitioner's Response to Patent Owner's Motion to Compel. Paper 16, 1. Petitioner has filed its Response to Patent Owner's Motion to Compel under seal (Paper 17), as well as a publicly-available redacted version of its Response (Paper 18). Reviewing these redacted portions, we agree with Petitioner's contention that "[t]he redacted portions of Petitioner's Response to Patent Owner's Motion to Compel describe certain documents produced in the co-pending litigation that Petitioner has designated as 'CONFIDENTIAL OUTSIDE COUNSEL ONLY,' indicating that they contain or reflect confidential, proprietary, trade secret, and/or commercially sensitive information." Paper 16, 2–3. The redactions are limited and address confidential materials. Petitioner has established the redactions are necessary to protect its confidential business information and the confidential business information of third parties. Thus, Petitioner demonstrates good cause for restricting the public's viewing of that information.

ORDER

In consideration of the foregoing, it is:

ORDERED that Patent Owner's Motion to Compel Production is granted and each of the 31 documents identified in Exhibit 2025 should be immediately produced;⁷

ORDERED that the Joint Motion to Seal and for entry of a Protective Order⁸ is granted and Exhibit 2025 shall remain under seal; and,

⁷ See n.3 for the paper numbers for each corresponding proceeding.

⁸ See n.5 for the paper numbers for each corresponding proceeding.

IPR2017-01586 (Patent 8,328,762); IPR2017-01587 (Patent 9,149,626)
IPR2017-01588 (Patent 8,460,247); IPR2017-01589 (Patent 8,597,249)
IPR2017-01590 (Patent 9,370,641)

ORDERED that Petitioner's Motion to Seal its Response to Patent Owner's Motion to Compel is granted and the Motion (Paper 17 in IPR2017-01586)⁹ shall remain under seal.

PETITIONER:

Heather M. Petruzzi
Natalie Pous
David L. Cavanaugh
WILMER CUTLER PICKERING HALE AND DORR LLP
Heather.Petruzzi@wilmerhale.com
Natalie.Pous@wilmerhale.com
David.Cavanaugh@wilmerhale.com

PATENT OWNER:

Barry J. Schindler
Heath J. Briggs
Julie P. Bookbinder
Joshua L. Raskin
GREENBERG TRAURIG, LLP
SchindlerB@gtlaw.com
BriggsH@gtlaw.com
BookbinderJ@gtlaw.com
RaskinJ@gtlaw.com

⁹ See n.4 for the paper number of the motion, including the redacted version, for each corresponding proceeding.