

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INOGEN, INC.,
Petitioner,

v.

SEPARATION DESIGN GROUP IP HOLDINGS, LLC,
Patent Owner.

Case IPR2017-00300 (Patent 8,894,751 B2)
Case IPR2017-00453 (Patent 9,199,055 B2)¹

Before KRISTINA M. KALAN, JON B. TORNQUIST, and
CHRISTOPHER M. KAISER, *Administrative Patent Judges.*

KAISER, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order resolves issues common to both IPR2017-00300 and IPR2017-00453, so we use our discretion to enter the same Order in both proceedings. The parties may not use this combined caption without prior authorization from the Board.

IPR2017-00300 (Patent 8,894,751 B2)

IPR2017-00453 (Patent 9,199,055 B2)

INTRODUCTION

In IPR2017-0300, Inogen, Inc. (“Petitioner”) filed a Petition (Paper 1, “300 Pet.”) requesting *inter partes* review of claims 22–32 of U.S. Patent No. 8,894,751 B2 (Ex. 1001, “the ’751 patent”). Separation Design Group IP Holdings, LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “300 Prelim. Resp.”). We instituted *inter partes* review. Paper 8.

In IPR2017-00453, Petitioner filed a Petition (Paper 2, “453 Pet.”) requesting *inter partes* review of claims 12–21 of U.S. Patent No. 9,199,055 B2 (Ex. 1001, “the ’055 patent”). Patent Owner filed a Preliminary Response (Paper 8, “453 Prelim. Resp.”). We instituted *inter partes* review. Paper 10.

After institution of these reviews, Patent Owner filed its Response in both proceedings. IPR2017-00300, Paper 14; IPR2017-00453, Paper 16. Simultaneously, Patent Owner filed Exhibits numbered 2013–2045 in each proceeding. Certain of these Exhibits were produced by Petitioner in a related infringement suit under the terms of a protective order entered by the District Court. After the Response and accompanying Exhibits were filed, the parties discussed whether the Exhibits subject to the District Court protective order were allowed to be used in the present proceedings. Following those discussions, Patent Owner contacted the Board by email to request expungement of certain Exhibits, replacement of other Exhibits, and authorization to file a motion to seal the Response and some of the Exhibits.

We held a conference call, which was attended by counsel for Petitioner, counsel for Patent Owner, and Judges Kalan, Tornquist, and Kaiser.

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IPR2017-00453 (Patent 9,199,055 B2)

EXHIBITS 2014, 2015, 2035, 2036, AND 2038

Patent Owner requests that we expunge Exhibits 2014, 2015, 2035, 2036, and 2038 from the record of IPR2017-00300.² Petitioner does not oppose the expungement of these Exhibits. Patent Owner bases its request on the terms of a protective order entered in the District Court, under the terms of which these documents were produced, that prohibits the use of these documents in any proceeding other than the infringement litigation in the District Court. Because the parties agree that these Exhibits should not be part of the record of this proceeding, we grant Patent Owner's request and expunge Exhibits 2014, 2015, 2035, 2036, and 2038.

MOTIONS TO SEAL

Patent Owner requests authorization to file motions to seal several additional Exhibits. "A party may file a motion to seal where the motion to seal contains a proposed protective order." 37 C.F.R. § 42.54(a). During the conference call, the parties represented that they had discussed the terms of a protective order and that they believe they can come to an agreement on those terms, but that they had not yet reached such an agreement. We direct the parties to agree on the terms of a protective order and to move for the entry of the agreed order. If the parties cannot agree on a proposed protective order after conferring in good faith, Patent Owner shall move for entry of a protective order in conjunction with the motions to seal discussed below, and Petitioner will have an opportunity to oppose the motion. We discuss each of the parties' requests below.

² We note that these Exhibits were not filed in IPR2017-00453.

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EXHIBIT 2032

Like the Exhibits discussed above, Exhibit 2032 was produced by Petitioner in a related infringement suit and is subject to the protective order entered by the District Court. Unlike those Exhibits, Patent Owner contends that Exhibit 2032 is important to the resolution of this proceeding.

Accordingly, argues Patent Owner, expunging Exhibit 2032 altogether is not acceptable. During the conference call, the parties could not agree on the proper course of action with respect to this Exhibit. Therefore, we order the parties to agree on a course of action, such as replacing Exhibit 2032 with an acceptable redacted version or moving to seal Exhibit 2032, and we authorize the parties to move for such relief as is necessary to implement that agreed plan. If the parties cannot agree on a plan with respect to Exhibit 2032, Patent Owner shall move for appropriate relief, and Petitioner may oppose the motion as detailed below. Whether the motion is agreed or disputed, it must explain why there is good cause to grant the requested relief.

RESPONSE AND EXHIBIT 2040

Patent Owner requests authorization to file a motion to seal its Response and Exhibit 2040 in IPR2017-00453 and to file a redacted public version of each document omitting references to Exhibits 2014, 2015, 2032, 2035, 2036, and 2038, which have been expunged. Patent Owner may move to seal these documents. Patent Owner's motion shall note whether Petitioner disputes the granting of the requested relief; if so, Petitioner will be given an opportunity to oppose the motion. Whether the motion is agreed or disputed, it must explain why there is good cause to grant the requested relief.

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EXHIBIT 2039

Patent Owner requests authorization to file a motion to seal Exhibit 2039 in IPR2017-00300 and IPR2017-00453. Patent Owner may move to seal these documents. Patent Owner's motion shall note whether Petitioner disputes the granting of the requested relief; if so, Petitioner will be given an opportunity to oppose the motion. Whether the motion is agreed or disputed, it must explain why there is good cause to grant the requested relief.

ORDER

It is hereby

ORDERED that Patent Owner is authorized to file a motion, to be filed separately in each of IPR2017-00300 and IPR2017-00453, requesting the following relief:

Entry of a protective order in both IPR2017-00300 and IPR2017-00453;

Sealing or replacement of Exhibit 2032 in both IPR2017-00300 and IPR2017-00453;

Sealing of Exhibit 2040 and Patent Owner's Response in IPR2017-00453 only; and

Sealing of Exhibit 2039 in both IPR2017-00300 and IPR2017-00453;

FURTHER ORDERED that Patent Owner's motion shall explain whether Petitioner opposes each item of requested relief;

FURTHER ORDERED that Patent Owner's motion shall explain, for each item of requested relief, why there is good cause to grant the relief;

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