

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

ASPHALT PRODUCTS UNLIMITED, INC.,  
Petitioner,

v.

BLACKLIDGE EMULSIONS, INC.,  
Patent Owner.

---

Cases IPR2017-01241 and -01242  
Patents 7,503,724 B2 and 7,918,624 B2

---

Before MITCHELL G. WEATHERLY, JAMES A. TARTAL, and  
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

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

I. BACKGROUND

All three panel members conducted a conference call at Patent Owner's urging to address whether the panel would authorize (1) a motion to disqualify Petitioner's technical expert, Alan James Ph.D., and (2) submission of a protective order differing from the default form used in *inter partes* review proceedings to include, among other changes, an ability

IPR2017-01241 and -01242  
Patent 7,503,724 B2 and 7,918,624 B2

for parties to designate information as “attorneys eyes only.” All counsel of record for each party participated in the call, and the call was transcribed by a court reporter.

The alleged need for an alternative protective order is driven by Patent Owner’s belief that we should authorize it to move to disqualify Dr. James because his testimony is based, at least in part, upon his allegedly improper use of confidential information<sup>1</sup> that he obtained from Patent Owner. Without such an alternative protective order, Patent Owner contends that it cannot share or submit the evidence underlying its belief that Dr. James should be disqualified. Before the call, Patent Owner had prepared and shared with Petitioner a draft form of a proposed protective order. Petitioner expressed concerns about the draft protective order based, in part, on restrictions in the draft order relating to sharing information with “other experts.” Based on its concerns about the confidentiality of information allegedly relied upon by Dr. James, Patent Owner had not fully provided to Petitioner its evidence allegedly supporting its contention that Dr. James had improperly relied upon confidential information in forming his opinions. Patent Owner contends that the protection afforded in the default protective order and under the Rules, *e.g.*, 37 C.F.R. § 42.55, is inadequate.

We instructed the parties to confer to determine whether they could agree upon terms that would permit exchange of information that could facilitate a resolution of the underlying issues relating to the allegedly improper use of confidential information by Dr. James. The parties are

---

<sup>1</sup> We use “confidential information” as defined in our Rules to refer to “trade secret or other confidential research, development, or commercial information.” 37 C.F.R. § 42.2.

IPR2017-01241 and -01242  
Patent 7,503,724 B2 and 7,918,624 B2

further instructed to contact the Board via e-mail within three (3) business days from the entry of this Order to indicate whether they have resolved their dispute regarding the appropriate form of a protective order for these proceedings.

The panel also informed the parties that it will take Patent Owner's request for authorization to move to disqualify Dr. James under advisement and issue a ruling in due course. To facilitate its consideration of Patent Owner's request, the panel instructed the parties to submit a copy of the transcript of the call as an exhibit in these proceedings at their earliest convenience. If the transcript is not filed within three (3) business days from the entry of this Order, the parties shall indicate in the e-mail communication mentioned above when they believe that the transcript will be filed.

## II. ORDER

For the reasons given, it is:

ORDERED that the parties shall confer to attempt to devise an alternative protective order that will facilitate an exchange of information needed by both parties to attempt to resolve their dispute relating to Dr. James' alleged improper use of confidential information;

FURTHER ORDERED that the parties shall promptly file as an exhibit in these proceedings a copy of the transcript of the conference call; and

FURTHER ORDERED that, within three (3) business days of the entry of this Order, the parties shall report via e-mail to [Trials@USPTO.gov](mailto:Trials@USPTO.gov) the status of their efforts (1) to agree upon an alternative protective order and (2) to file a transcript of the conference call if it has not already been filed;

IPR2017-01241 and -01242  
Patent 7,503,724 B2 and 7,918,624 B2

FURTHER ORDERED that Patent Owner's request for authorization to move to disqualify Dr. James is taken under advisement and will be addressed in due course in a separate paper.

IPR2017-01241 and -01242  
Patent 7,503,724 B2 and 7,918,624 B2

PETITIONER:

Robert Waddell  
Michael K. Leachman  
JONES WALKER LLP  
rwaddell@joneswalker.com  
mleachman@joneswalker.com

PATENT OWNER:

John F. Triggs  
Ryan D. Levy  
Seth R. Odgen  
William E. Seyki  
PATTERSON INTELLECTUAL PROPERTY LAW, P.C.  
jft@iplawgroup.com  
rdl@iplawgroup.com  
sro@iplawgroup.com  
wes@iplawgroup.com