

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THERMO FISHER SCIENTIFIC, INC.,
Petitioner,

v.

THE REGENTS OF THE UNIVERSITY OF CALIFORNIA,
Patent Owner.

Case IPR2018-01367 (Patent 8,835,113 B2)
Case IPR2018-01368 (Patent 8,835,113 B2)
Case IPR2018-01369 (Patent 8,110,673 B2)
Case IPR2018-01370 (Patent 8,110,673 B2)

Before ERICA A. FRANKLIN, MICHELLE N. ANKENBRAND, and
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION¹

Denying Petitioner's Combined Motion for Entry of Protective Order and
Motion to Seal

37 C.F.R. §§ 42.14, 42.54

¹ This Order addresses issues that are common to each case.

IPR2018-01367 (Patent 8,835,113 B2)
IPR2018-01368 (Patent 8,835,113 B2)
IPR2018-01369 (Patent 8,110,673 B2)
IPR2018-01370 (Patent 8,110,673 B2)

In each of the above-captioned proceedings, Petitioner filed a Combined Motion for Entry of Modified Protective Order and Motion to Seal Confidential Information. Paper 3.² Patent Owner has not filed an opposition to the combined motions.

Petitioner asserts that its Proposed Protective Order (Paper 3, Addendum A) differs from the Board’s default protective order set forth in the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,771 (Aug. 14, 2012) (“Trial Practice Guide”) by “(i) including counsel of record in the related litigation; (ii) clarifying the scope of in-house counsel authorized to receive confidential information; and (iii) specifying a timeframe during which those in possession of confidential information must destroy it after a final decision in this proceeding.” Paper 3, 1; *see id.* Addendum B (Redlined version of Proposed Protective Order showing modifications to Board’s default protective order). Petitioner seeks to seal Exhibits 1048, 1051, 1052, 1053, 1054, 1055, and 1056, in their entirety.³

As set forth in 37 C.F.R. § 42.54, a motion to seal must include a proposed protective order and a “certification that the moving party has in good faith conferred or attempted to confer with other affected parties in an effort to resolve the dispute.” In its combined motions, Petitioner states,

² Citations to paper numbers and exhibits refer to those filed in IPR2018-01367. Similar papers and exhibits were filed in IPR2018-01368, IPR2018-01369, and IPR2018-01370.

³ Petitioner includes a prefix of “TFS” for its exhibits that we do not include here.

IPR2018-01367 (Patent 8,835,113 B2)
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“[b]ecause this motion is being submitted concurrently with Thermo Fisher’s petition, Thermo Fisher has not yet conferred with patent owner regarding this motion or inquired whether patent owner would oppose the requested relief.” Paper 3, 2. In other words, Petitioner acknowledges that its combined motions do not comply with § 42.54. Further, based upon our review of the current record, we do not find that Petitioner has subsequently satisfied that rule by submitting the required certification at some later date. Accordingly, we deny the combined motions without prejudice.

After meeting and conferring in good faith, Petitioner may renew its combined motion for entry of a proposed protective order and motion to seal, wherein the combined motion includes the proper certification. In each case, we exercise our discretion to maintain the exhibits under a provisional seal to permit Petitioner and Patent Owner an opportunity to meet and confer, and to allow Petitioner an opportunity to file a renewed combined motion in each proceeding, in accordance with the following Order. Petitioner is reminded that “[a]fter denial of a petition to institute a trial or after final judgment in a trial, a party may file a motion to expunge confidential information from the record.” 37 C.F.R. § 42.56.

ORDER

In accordance with the foregoing, it is hereby:

ORDERED that Petitioner’s Combined Motion to Seal and Motion for Protective Order in each captioned case is *denied* without prejudice;

FURTHER ORDERED that Petitioner may renew its combined motion on or before March 6, 2019;

IPR2018-01367 (Patent 8,835,113 B2)
IPR2018-01368 (Patent 8,835,113 B2)
IPR2018-01369 (Patent 8,110,673 B2)
IPR2018-01370 (Patent 8,110,673 B2)

FURTHER ORDERED that Petitioner may file a motion to expunge from the record any of Exhibits 1048, 1051, 1052, 1053, 1054, 1055, and 1056;

FURTHER ORDERED that Patent Owner may file an opposition to any renewed combined motion and/or motion to expunge filed by Petitioner within 5 business days after Petitioner files such motion(s); and

FURTHER ORDERED that Exhibits 1048, 1051, 1052, 1053, 1054, 1055, and 1056 shall remain provisionally sealed until a decision on any filed renewed combined motion for entry of protective order and motion to seal is entered, or, if no such motion is filed, 45 days after denial of the petition to institute.

IPR2018-01367 (Patent 8,835,113 B2)
IPR2018-01368 (Patent 8,835,113 B2)
IPR2018-01369 (Patent 8,110,673 B2)
IPR2018-01370 (Patent 8,110,673 B2)

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