

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORESIGHT DIAGNOSTICS INC.,
Petitioner,

v.

PERSONALIS, INC.,
Patent Owner.

IPR2023-00224 (Patent 11,384,394 B2)
IPR2023-00317 (Patent 11,408,033 B2)¹

Before ULRIKE W. JENKS, ROBERT A. POLLOCK, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

ORDER

Granting Patent Owner's Motion to Seal and
Entering Modified Protective Order
37 C.F.R. §§ 42.14, 42.54

¹ The combined caption is for administrative convenience only and does not indicate that IPR2023-00224 and IPR2023-00317 have been joined. The parties are not authorized to use this caption without express permission of the Board.

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I. INTRODUCTION

Patent Owner filed a Motion to Seal (Paper 30², “Motion”) in each of the above identified proceedings, in which Patent Owner moves to seal portions of Exhibits 1220, 1221, and 1222. The record in each proceeding currently includes redacted “Public” versions of these exhibits, as well as unredacted “Parties and Board Only” versions. Each Motion includes a proposed Protective Order (Paper 30, Ex. A, “Protective Order”), which is a modified version of the Board’s Default Protective Order (*id.* at 1 (citing Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“Trial Practice Guide”)³)). The Protective Order includes two tiers of protection for sealed documents—the “Outside Attorneys’ Eyes Only” tier, and the less restrictive “Protective Order Material” tier. *Id.* at Ex. A. Patent Owner represents that Petitioner “does not take a position on the Motion.” *Id.* at 1. Petitioner has not filed an opposition to the Motion and the deadline for such a filing has passed.

For the reasons discussed below, we *grant* Patent Owner’s Motion to Seal and *enter* Patent Owner’s Protective Order.

II. MOTION TO SEAL

The record of an *inter partes* review shall be made available to the public, except as otherwise ordered, and any documents filed with a motion to seal shall be treated as sealed until the motion is decided. 35 U.S.C.

² For expediency, we cite to the Motion in IPR2023-00224. A similar Motion was filed in IPR2023-00317.

³ Available at <http://www.uspto.gov/TrialPracticeGuideConsolidated>.

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§ 316(a)(1); 37 C.F.R. § 42.14. Only “confidential information” may be protected against public disclosure. 35 U.S.C. § 316(a)(7); 37 C.F.R. § 42.54. The Board observes a strong public policy in favor of making information filed in its proceedings open to the public. *See Argentum Pharms. LLC v. Alcon Research, Ltd.*, IPR2017-01053, Paper 27 at 3–4 (PTAB Jan. 19, 2018) (informative).

The standard for granting a motion to seal is “good cause.” 37 C.F.R. § 42.54(a). The moving party bears the burden of showing that the relief requested should be granted. 37 C.F.R. § 42.20(c). For a sufficient showing for a motion to seal, the Board has required that

(1) the information sought to be sealed is truly confidential, (2) a concrete harm would result upon public disclosure, (3) there exists a genuine need to rely in the trial on the specific information sought to be sealed, and (4), on balance, an interest in maintaining confidentiality outweighs the strong public interest in having an open record.

Argentum, Paper 27 at 3–4; *see also Corning Optical Commc’ns RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 46 at 2 (PTAB April 6, 2015) (requiring a showing that information has not been “excessively redacted”).

Patent Owner explains that the testimony of Dan Norton (Ex. 1220), current Director of Product Management at Personalis, contains “particularly sensitive” information relating to “the production of components for Personalis’ NeXT Personal Assay®,” “Personalis’ customers,” “Personalis’ products and position in the marketplace,” and “the process Personalis uses to draft documents, select speakers, and communicate with the media.” Paper 30, 8–9. Accordingly, Patent Owner moves to seal identified portions

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of Mr. Norton’s testimony and protect them under the “Outside Attorneys’ Eyes Only” tier.⁴ *Id.* at 10.

Regarding the testimony of Jonathan MacQuitty (Ex. 1221), former Chairman of the Board of Directors at Personalis, Patent Owner identifies portions containing “particularly sensitive” information relating to “topics of discussion during Personalis’ Board of Directors meetings and policies in place at such meetings,” “the level of investment in Personalis before it became a publicly traded company,” and “discussions of patent disputes.” Paper 30, 5–6. Patent Owner moves to seal these portions of Mr. MacQuitty’s testimony and protect them under the “Outside Attorneys’ Eyes Only” tier. *Id.* at 6. Patent Owner further identifies portions of Mr. MacQuitty’s testimony that contain “confidential information” relating to his “current stock holdings and stock options,” and moves to seal these portions under the “Protective Order Material” tier. *Id.* at 7.

Regarding the testimony of John West (Ex. 1222), former Chief Executive Officer of Personalis, Patent Owner identifies portions containing “particularly sensitive” information relating to “the profitability of Personalis before it became a publicly traded company,” “Personalis’ C-level leadership,” and “details of Personalis’ whole genome plus product.” Paper 30, 3–4. Patent Owner moves to seal these portions of Mr. West’s testimony and protect them under the “Outside Attorneys’ Eyes Only” tier.

⁴ Although Patent Owner refers to an “Attorneys’ Eyes Only” tier throughout the Motion (*see* Paper 30, 1–10), we refer to this more restrictive tier as “Outside Attorneys’ Eyes Only,” as it is labeled in the Protective Order (*see id.* at Ex. A).

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Id. at 4. Patent Owner further identifies portions of Mr. West’s testimony that contain “confidential information” relating to his “current stock holdings and stock options,” and moves to seal these portions and protect them under the “Protective Order Material” tier. *Id.* at 5.

Upon review of Exhibits 1220, 1221, and 1222, we are persuaded that good cause exists to seal these exhibits in part, according to Patent Owner’s designation of identified portions of testimony under either the “Protective Order Material” or “Outside Attorneys’ Eyes Only” tiers. *See* Paper 30, 3–10. In particular, Patent Owner has narrowly tailored the identified portions of each exhibit to seal so as to protect sensitive or otherwise confidential information while balancing the public interest in disclosure of the testimony in the exhibits. *See id.*

III. MODIFIED PROTECTIVE ORDER

The Board may, for good cause, issue a protective order “to protect a party or person from disclosing confidential information.” 37 C.F.R. § 42.54(a). A protective order is not entered by default but must be proposed by one or more parties and must be approved and entered by the Board. Trial Practice Guide 19–20, 107. The Trial Practice Guide sets forth specific guidelines on proposing a protective order and provides a Default Protective Order. *See id.* at 19–20, 107–122. The parties may propose modifications to the Default Protective Order and the Board will generally accept such proposed changes if they are consistent with the integrity and efficient administration of the proceedings. *Id.* at 115.

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Patent Owner’s Protective Order includes the “Protective Order Material” designation for confidential information in the Board’s Default Protective Order (*see* Trial Practice Guide 117–122), and adds the “Outside Attorneys’ Eyes Only” tier of protection, which covers information that

constitutes or contains trade secrets or particularly sensitive scientific research, licensing, business, financial, market or other proprietary information, the disclosure of which information to other parties, including their in-house counsel or other employees, would create a substantial risk of serious harm to the disclosing party that could not be avoided by less restrictive means.

Paper 30, Ex. A ¶ 4.; *see also id.* at Ex. B (redline copy of the Protective Order showing modifications to the Default Protective Order).

After reviewing the proposed modifications to the Default Protective Order in Patent Owner’s Protective Order, particularly, the addition of the “Outside Attorneys’ Eyes Only” tier, we determine that the changes are consistent with the integrity and efficient administration of the proceedings. Specifically, Patent Owner indicates the need for a higher level of protection for certain sensitive information due to the parties’ relationship as business competitors (Paper 30, 2), and Petitioner has not opposed an “Outside Attorneys’ Eyes Only” tier for this purpose. Accordingly, we enter Patent Owner’s Protective Order.

IV. ORDER

Accordingly, it is

ORDERED that Patent Owner’s Motions to Seal are *granted* with respect to Exhibits 1220, 1221, and 1222; and

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FURTHER ORDERED that the Protective Order (Paper 30, Ex. A) is *entered* in each of the above identified proceedings.

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