

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Petitioners

TOPIA TECHNOLOGY, INC.,

Patent Owner

Case IPR2023-00427

Patent 9,143,561

PATENT OWNER'S MOTION TO MODIFY THE PROTECTIVE ORDER

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I. Introduction

Patent Owner requests that the Protective Order (Paper 9) be modified to allow Exhibits 1029 and 2018 (Declaration and Transcript of Heidi Keefe) to be used in the parallel district court litigation with real party in interest (RPI)/privy of Petitioners, Egnyte, Inc. (*Egnyte Inc., Topia Technology, Inc. v. Egnyte, Inc.*, C.A. No. 21-1821-CJB (D. Del)). The Delaware Court should have the fulsome record before it to decide for itself whether Egnyte is indeed an RPI/privy of Petitioners. Courts routinely permit the use of documents from parallel district court proceedings in IPRs. The Board should likewise allow the district court to use documents from this IPR.

While preparing the Petition (Paper 3), lead counsel for Petitioners, Heidi Keefe, simultaneously represented Egnyte in Delaware in the infringement suit brought by Patent Owner on the exact same patent at issue in this IPR (and the 5 related patents). EX2018, 41:6-10; EX1030. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Despite the inseparable relationship between Petitioners and Egnyte, and their overlapping

interests in this IPR and the related Delaware litigation¹, they asserted that Egnyte is not an RPI/privy of Petitioners. *See* Ex.2001, 42:3-4. This argument is not surprising given that if Egnyte is found to be an RPI/privy, Egnyte would be estopped from making prior art arguments that were raised or could have been raised by Petitioners under 35 U.S.C. § 315(e), and Petitioners' IPRs should be immediately terminated under 35 U.S.C. § 315(b).

Heidi Keefe submitted a Declaration (Ex. 1029) purporting to describe Petitioners' relationship with Egnyte. Patent Owner deposed her (Ex. 2018), and although the Board has preliminarily, "at this stage", declined to find Egnyte as an RPI/privy, the Delaware Court should be free to make its own determination, with the benefit of a full record. ID (Paper 17), 16. The Delaware case is subject to a protective order (EX2027), with even greater levels of protection from public disclosure than the Protective Order in the instant IPR, and Petitioners do not contend otherwise. Moreover, Egnyte's outside counsel is already privy to the confidential information on Heidi Keefe's representation of Egnyte. Ex.2018 47:12-20 (Heidi Keefe admitting to conversations with Egnyte's outside counsel regarding

¹ The Delaware Court characterized the relationship between Petitioners and Egnyte as being "about as close as you can get in terms of coordinating and understanding, et cetera." EX2001, 11:10-15.

the scope of her representation of Egnyte). Providing the Delaware Court with a more complete record regarding the RPI/privity issue, and the sufficiency of the protections afforded by the Delaware Court constitute “good cause” for modifying the Protective Order under 37 C.F.R. § 42.54. *See* 2019 Consolidated Trial Practice Guide (“TPG”), 19-20.

II. Facts

Petitioners chose to present Heidi Keefe’s testimony on the issue of whether Egnyte is an RPI/privity in this proceeding. That same evidence is also directly relevant to the same issue in the Delaware case. Patent Owner has acted with diligence in attempting to obtain this evidence for use in the Delaware case. Below are the relevant facts.

In December 2021, Patent Owner separately sued Petitioners and Egnyte for infringement of the patents at issue. Around the same time, Heidi Keefe began preparing the Petition. EX2018 122, 18-21. Shortly thereafter, Petitioners and Egnyte entered into the JDA. EX1030, 14. In fall of 2022, while still preparing the Petition, Heidi Keefe began representing Egnyte in Delaware to further assist the joint patent invalidation effort. EX2018, 41:2-10. After the IPR was filed, and while still representing Egnyte, in June 2023, Heidi Keefe submitted a Declaration (EX1029) in support of Petitioners’ argument that Egnyte is not an RPI/privity. Patent Owner subsequently deposed Heidi Keefe (EX2018).

Patent Owner has been attempting to obtain information on Heidi Keefe's representation of Egnyte for use in the Delaware case since August 2023. EX2028. Petitioners have attempted to thwart Patent Owner's efforts every step of the way. After Petitioners denied (without reason) Patent Owner's request to use the information in the Delaware case (*id.*), Patent Owner was forced to subpoena Petitioners, Heidi Keefe, and Heidi Keefe's law firm, Cooley. Thus far, these efforts have been unsuccessful. Box, Heidi Keefe, and Cooley objected to the subpoenas on various grounds, including asserting that Patent Owner "improperly [sought] to circumvent the discovery procedures set forth by the Patent Trial and Appeal Board." EX2029, 18, 33, and 61. Dropbox has yet to respond to its subpoena. In another attempt to obtain the relevant information, Patent Owner subpoenaed Heidi Keefe for deposition. Heidi Keefe's motion to quash this deposition is still pending. Patent Owner's litigation counsel and Petitioners', Heidi Keefe's and Cooley's shared counsel, Lowell Meade (backup counsel in this IPR) negotiated on a compromise whereby the deposition would be foregone in exchange for the transcript, along with various undertakings including relating to future discovery, but that the parties were unable to come to terms after a good faith discussion. EX2030, 1.

III. Argument

The Board may modify a Protective Order for good cause. 37 C.F.R. § 42.54; TPG, 19-20. Courts generally have considered a number of factors. Under *Pansy v. Borough of Stroudsburg*, 23 F.3d 772, 786–87, 790 (3d Cir. 1994), in considering whether to modify a Protective Order, the Third Circuit weighs the factors of “the interest in privacy of the party seeking protection”; “whether the information is being sought for a legitimate purpose or an improper purpose”; “whether sharing of the information among litigants would promote fairness and efficiency”; and reliance on the original protective order by the opposing party, though the last factor “should not be outcome determinative.” *Arnold v. Pa., Dep’t of Transp.*, 477 F.3d 105, 108 (3d Cir. 2007); *Pansy*, 23 F.3d at 790. Courts in the 5th, 7th, and 9th Circuits consider similar factors. *United States v. Morales*, 807 F.3d 717, 723 (5th Cir. 2015); *Heraeus Kulzer, GmbH v. Biomet, Inc.*, 881 F.3d 550, 565 (7th Cir. 2018) (“[C]ourts consider the following four factors: ‘(1) the nature of the protective order; (2) the foreseeability, at the time of issuance of the order, of the modification requested; (3) the parties' reliance on the order; and most significantly (4) whether good cause exists for the modification.’”); *Blum v. Merrill Lynch Pierce Fenner & Smith Inc.*, 712 F.3d 1349, 1355 (9th Cir. 2013) (“Ninth Circuit precedent strongly favors disclosure to meet the needs of parties in pending litigation.”). The relevant factors here all weigh in favor of modification.

A. Petitioners' Privacy Interests Will be Protected

Petitioners' privacy interests will be protected by the Protective Order in Delaware (EX2027), which, like the Protective Order in the IPR, also includes an attorneys' eyes only designation. EX2027, 2-3.

More importantly, Egnyte's outside counsel is already privy to the confidential information contained in EXs. 1029 and 2018. In EX1029, Petitioners have redacted only paragraph 6, which describes the JDA with Egnyte. Not only should Egnyte's counsel be well-aware of the provisions in the JDA to which it is a party, the JDA has already been produced by Egnyte in the parallel litigation. ***There is literally no information in EX1029 that is either not public or not already known to Egnyte.*** Likewise, with respect to EX2018, Petitioners have redacted portions of the transcript relating to the JDA (EX2018, 105:1-17; 144:3-146:24; 160:9-19; 162:20-163:9); other agreements with Egnyte (*Id.*, 105:18-106:1), conversations Heidi Keefe had with Egnyte's other outside counsel (*Id.*, 52:4-12; 139:15-140:18), and Heidi Keefe's compensation regarding her representation of Egnyte (*Id.*, 57:2259:1; 61:6-62:2; 62:19-63:22; 64:7-67:16; 68:1-13; 68:24-73:13), all of which should be known to Egnyte. The only other portions of the transcript that are redacted relate to Heidi Keefe's compensation by Petitioners related to this IPR (*Id.*, 76:15-77:3; and 163:23-164:21) and other agreements with Petitioners relating to the IPR (*Id.* 146:25-147:4).

During the conference call with the Board on March 12, 2024, Petitioners argued that their competitive relationship with Egnyte should bar modification of the Protective Order. But this argument lacks merit. First, the declarant, Heidi Keefe, was already counsel for both Petitioners *and* Egnyte at the time the information was generated and disseminated in this IPR. Thus, if Egnyte's *other* outside counsel was not *already* privy to information sought as outlined above, Heidi Keefe, as acting outside counsel to Egnyte surely was. Second, Petitioners' argument about sharing confidential information with competitors is severely undercut by the fact that Petitioners themselves are direct competitors with each other and already share such information.

B. The Information is Being Sought For a Legitimate Purpose

Patent Owner seeks modification of the Protective Order for one single and legitimate purpose: to ensure that the Delaware Court has a record of relevant facts relating to Egnyte's RPI/privy status. *Sleep No. Corp. v. Sizewise Rentals*, 2019 U.S. Dist. LEXIS 239014, *9 (C.D.Cal. Sept. 26, 2019) ("Because plaintiff makes at least a colorable argument as to why producing these documents to PTAB is relevant to the IPR proceedings and its pending discovery motions, good cause exists for modifying the protective order . . ."). Petitioners and Heidi Keefe herself concede the relevance of the sought information to the RPI/privy inquiry, given that the evidence was generated by Petitioners specifically to argue their position on that

issue. *Trans Techs. Co. v. Hendrickson United States*, 2017 U.S. Dist. LEXIS 235779, *6 (N.D.Ga 2017) (ordering modification of protective order to allow documents conceded as relevant by opposing party).

During the call with the Board on March 12, 2024, Petitioners stated that Patent Owner seeks to “nefariously” use Exhibits 1029 and 2018 to argue that Heidi Keefe waived attorney client privilege. This personal attack aside, the argument that Heidi Keefe waived joint defense privilege is still part of the broader issue of Egnyte’s RPI/privity status, and Patent Owner should be entitled to make this argument. Heidi Keefe submitted a declaration that placed her state of mind and knowledge of the prior art at issue – as well as how Egnyte came to that exact same state of mind. She has taken the position that she advised Egnyte on patentable subject matter (*i.e.* § 101) with respect to the Asserted Patents, and not on the prior art. EX2018, 19:12-19. Despite this self-serving testimony on the very nature of her representation of Egnyte (“I represented Egnyte for the sole purpose of arguing a 101 motion”), Heidi Keefe has thus far attempted to maintain privilege over communications with Egnyte related to her representation. *See* EX 2018, 52:18-56:24. Patent Owner ought to be able to pursue Heidi Keefe’s voluntary disclosure of privileged information related to the scope of her representation of Egnyte as waiver of privilege as to all communication on the same subject matter. *Starsight Telecast, Inc. v. Gemstar Develop. Corp.*, 158 F.R.D. 650, 654 (N.D. Cal. 1994);

General Electric Co. v. Hoechst Celanese Corp., 15 U.S.P.Q.2d 1673, 1679 (D. Del. 1990) (finding waiver where patentee asserted good faith of attorney in response to assertion it committed fraud on the PTO).

Making a good-faith waiver argument is not “nefarious” or improper. The Delaware Court is fully capable of deciding the issue of whether Heidi Keefe waived joint defense privilege, and Egnyte is likewise fully capable of defending its (and Petitioners’) shared rights in this regard. Further, should issues arise in the Delaware case that necessitate the use of Exhibits 1029 and 2018 for other legitimate purposes, Patent Owner should not be precluded from such uses.

C. The Sharing of Information Will Promote Fairness and Efficiency

Modification of the Protective Order would “promote fairness and efficiency”, by allowing the Delaware Court to consider the protected information to facilitate the truth-finding process in determining whether Egnyte is an RPI/privy of Petitioners.

Moreover, the governing Protective Order is in the IPR, not Delaware or California (where the related subpoenas issued from). *Life Scis. Corp. v. Ion Torrent Sys., Inc.*, C.A. No. 15-595-LPS-CJB, D.I. 47 (D. Del. 2016) (“[w]hat may be used in an IPR, and what confidentiality status it will have, are matters for the PTO to decide”). As this Board has recognized, it is the province of the tribunal where the

protective order is entered to make a decision regarding modification thereof.

Samsung Electronics Co., Ltd. v. Acorn Semi, LLC, IPR2020-01183, Paper 24, 3.

By modifying the Protective Order in this IPR, the Board could streamline the adjudication of multiple subpoenas related to the Egnyte litigation and save significant resources by all parties and the courts.

D. Petitioners Do Not Heavily Rely on the Unmodified IPR Protective Order

Petitioners have no legitimate reliance interest in maintaining the existing Protective Order given that the information sought to be used in Delaware is already known to Egnyte's outside counsel.

E. Modification Was Not Foreseeable

When Patent Owner agreed to Petitioners' proposed Protective Order in June 2023, it did not anticipate Heidi Keefe submitting a declaration on her personal knowledge of her representation of Egnyte, and thus did not foresee needing modification to permit use of such a declaration and accompanying deposition transcript in Delaware. EX2031; *Sleep No. Corp. v. Sizewise Rentals*, 2019 U.S. Dist. LEXIS 239014, *9 (D. Del. 2019) ("The court finds no indication any such waiver occurred merely by the parties stipulating to a protective order.")

IV. Conclusion

For the foregoing reasons, the Board should permit modification of the Protective Order to allow Exhibits 1029 and 2018 to be used in Delaware.

Date: March 25, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the attached Patent Owner's Motion to Modify the Protective Order is being served by electronic mail on the following counsel of record:

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