

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOX, INC. and DROPBOX, INC.,
Petitioner,

v.

TOPIA TECHNOLOGY, INC.,
Patent Owner.

IPR2023-00427 (Patent 9,503,498 B2)
IPR2023-00433 (Patent 9,143,561 B2)

Before THOMAS L. GIANNETTI, NEIL T. POWELL,
CHARLES J. BOUDREAU, and JOHN R. KENNY,
*Administrative Patent Judges.*¹

GIANNETTI, *Administrative Patent Judge.*

ORDER
Denying Motion to Amend Protective Order
37 C.F.R. § 42.54

¹ This Order addresses issues that are identical in each of the above-captioned proceedings. This is not an order from an expanded panel of the Board, the proceedings have not been consolidated, and the Parties are not authorized to use this style heading in any subsequent papers.

I. INTRODUCTION

The Board received an email dated March 6, 2024, from Patent Owner’s counsel, requesting a conference call to request authorization to file a motion to modify, for good cause, the Protective Order (Paper 9) in each of these proceedings. Exhibit 3001.² The requested modification would permit use of two exhibits (Exhibits 1029 and 2018) in the parallel pending district court proceeding between Patent Owner and Egnyte, Inc. (*Topia Technology, Inc. v. Egnyte, Inc.*, C.A. No. 21-1821-CJB (D. Del.)). The two exhibits in question are, respectively, a declaration by Petitioner’s counsel, Heidi L. Keefe (Ex. 1029), and the transcript of Ms. Keefe’s deposition (Ex. 2018) in these proceedings. Both exhibits have been designated as Highly Confidential–Attorneys’ Eyes Only under the Protective Order in each of these proceedings. Petitioner opposed the request to modify the Protective Orders.

The Board held a conference with counsel for the parties to discuss the proposed motion on March 12, 2024. After hearing from the parties on the matter, the Board issued an order authorizing filing of the motion. Paper 42. Subsequently, Patent Owner filed its Motion to Modify the Protective Order (Paper 44, “Motion”) and Petitioner filed its Opposition (Paper 51, “Opp.”).³

² Citations to papers and exhibits refer to IPR2023-00427. Substantially identical papers and exhibits were filed in IPR2023-00433.

³ We denied a request by Patent Owner for further briefing on a specific issue (Petitioner’s alleged “mischaracterizations” of Patent Owner’s statements and arguments made during a hearing on Egnyte Inc.’s motion to

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For the reasons that follow, the Motion is *denied*.

II. BACKGROUND

Patent Owner contends that Egnyte, the defendant in *Topia Technology, Inc. v. Egnyte, Inc.*, 1:21-cv-01821-CJB (D. Del.) (the “Delaware Litigation”), should have been named in the Petition as a real party-in-interest. Prelim. Resp. 1–2. Patent Owner asserts that because Egnyte is “time-barred,” naming Egnyte as a real party-in-interest “necessitates denial of institution under 35 U.S.C. §315(b).” *Id.*

Patent Owner relies mainly on the alleged facts that Petitioner and Egnyte “share litigation counsel,” specifically, Ms. Heidi L. Keefe, a partner at the law firm Cooley LLP and lead counsel in this proceeding, and further, that Petitioner and Egnyte “are pursuing a single and unified invalidity defense strategy in all forums.” Prelim. Resp. 5. Patent Owner asserts also that Egnyte and Petitioner “are parties to a joint defense agreement” and “have submitted *identical* invalidity contentions, of which the grounds in the Petition overlap.” *Id.*

With its response, Petitioner submitted a declaration from Ms. Keefe. Ex. 1029 (“Keefe Decl.”). Ms. Keefe testified that her involvement in the Delaware Litigation was limited to arguing a motion to dismiss based on 35 U.S.C. § 101 (lack of statutory subject matter). *Id.* ¶¶ 5, 16. She testified that “[m]y oral argument on the Section 101 motion was the full extent of my representation of Egnyte. Neither I nor any other counsel for Petitioners involved in these IPRs have represented Egnyte on any other issue.” *Id.*

stay) because we do not rely on those statements in making our Decision. *See infra*, Section IV.

Ms. Keefe also addressed the joint defense agreement (“JDA”). Keefe Decl. ¶ 6. She testified that the JDA “expressly states that [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED].” *Id.* Further, she testified that the JDA states that [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED].” *Id.*

Patent Owner took Ms. Keefe’s deposition prior to institution of this *inter partes* review. Ex. 2018 (transcript). At her deposition, under cross-examination by Patent Owner’s counsel, Ms. Keefe confirmed the statements in her declaration. She testified that her representation of Egnyte was “narrow.” *Id.* at 37:9–12 (“I entered a pro hac [in the Delaware Litigation] in order to represent Egnyte in the 101 hearing in Delaware. That was my narrow engagement. That is all I did. That’s all I’ve ever done.”). She testified that [REDACTED]

[REDACTED]

[REDACTED]. *Id.* at 58:3–8, 58:16–19. She testified that she is not Egnyte’s counsel in the litigation, but that she believes they are represented by another

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firm, FisherBroyles. *Id.* at 48:7–8. She testified that her representation of Egnyte ended with arguing the 101 motion. *Id.* at 48:20–23. She testified, emphatically, that “I am not, have not, and will not represent Egnyte in the district court litigation in Delaware for anything other than the 101 oral argument that I represented them in.” *Id.* at 85:15–18.

Based on this record, and considering the merits of the Petition, the Board instituted *inter partes* review. Paper 17.

III. PATENT OWNER’S MOTION AND PETITIONER’S OPPOSITION

Patent Owner contends that “Petitioners chose to present Heidi Keefe’s testimony on the issue of whether Egnyte is an RPI/privy in this proceeding. That same evidence is also directly relevant to the same issue in the Delaware case.” Motion 3. Patent Owner contends that the protective order in the Delaware case has “even greater levels of protection” than the protective order here. *Id.* at 2. Patent Owner contends further that it “has acted with diligence in attempting to obtain this evidence for use in the Delaware case.” *Id.* at 3. Patent Owner argues that it “has been attempting to obtain information on Heidi Keefe’s representation of Egnyte for use in the Delaware case since August 2023.” *Id.* at 4. Patent Owner outlines its so far unsuccessful attempt to subpoena the documents in the Delaware proceeding: “Box, Heidi Keefe, and Cooley objected to the subpoenas on various grounds.” *Id.*

Petitioner responds that before Ms. Keefe testified in this proceeding, “Petitioners conferred with [Patent Owner] and filed an agreed and [sic] unopposed Protective Order that expressly prohibits sealed material in this proceeding from being used outside of this proceeding.” Opp. 2. Further,

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Petitioner asserts that “[w]hen Ms. Keefe was deposed on June 20, 2023, Petitioners relied on the Protective Order to protect the sealed portions of the deposition that [Patent Owner] now seeks to unseal.” *Id.* Petitioner argues that they “are not parties to the Delaware case and are not relevant witnesses on any claim or defense in that case.” *Id.* at 4. Furthermore, Petitioner argues that it has served “meritorious” objections to Patent Owner’s subpoenas. *Id.* at 5. Finally, Petitioner alleges that “[t]he Board should deny [Patent Owner’s] motion for the additional reason that [Patent Owner] improperly seeks to use the information for the improper purpose of attempting to invade attorney-client and joint defense privileges.” *Id.* at 7–8.

IV. DISCUSSION

To succeed on its motion to modify the protective order, Patent Owner must demonstrate “good cause.” *See* 37 C.F.R. § 42.20(c) (“The moving party has the burden of proof to establish that it is entitled to the requested relief.”); 37 C.F.R. § 42.54(a) (“The Board may, for good cause, issue an order to protect a party or person from disclosing confidential information . . .”). This is a “well established” principle in proceedings before the Board and before the Third Circuit, where the Delaware Litigation is pending. *See Pansy v. Borough of Stroudsburg*, 23 F.3d 772, 786 (3rd Cir. 1994).⁴

In deciding whether good cause exists to modify a protective order, Delaware courts apply a balancing process, weighing the so-called *Pansy* factors. *See Arnold v. Pa. Dep’t of Transp.*, 477 F.3d 105, 108 (3rd Cir. 2007) (citing *Pansy*, 23 F.3d at 786–88). The *Pansy* Court identified the

⁴ *Pansy* is relied on by Patent Owner. Motion 5. The parties have not cited controlling Federal Circuit authority on this issue, nor are we aware of any.

following factors of the good cause balancing test: (1) the interest in privacy of the party seeking protection; (2) whether the information is being sought for a legitimate purpose or an improper purpose; (3) the prevention of embarrassment, and whether that embarrassment would be particularly serious; (4) whether the information sought is important to public health and safety; (5) whether sharing of the information among litigants would promote fairness and efficiency; (6) whether the party benefitting from the order of confidentiality is a public entity or official; and (7) whether the case involves issues important to the public. *Id.* (citing *Pansy*, 23 F.3d at 787–88). “The appropriate approach in considering motions to modify confidentiality orders is to use the same balancing test that is used in determining whether to grant such orders in the first instance, with one difference: one of the factors the court should consider in determining whether to modify the order is the reliance by the original parties on the confidentiality order.” *Pansy*, 23 F.3d at 790.

One interest which should be recognized in the balancing process is the interest in privacy on the part of the party seeking protection. *Pansy*, 23 F.3d at 787. Based on the record before us, we find that Petitioner has a high interest in the confidentiality of Ms. Keefe’s testimony and that its disclosure would be detrimental. The testimony reveals details of Ms. Keefe’s practice that are legitimately highly confidential. Patent Owner does not challenge this assertion of confidentiality by Ms. Keefe.

In determining whether to modify an already-existing confidentiality order, the parties’ reliance on the order is a relevant factor. *Pansy*, 23 F.3d at 789. We find that it was reasonable for Ms. Keefe and her firm to rely on

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the existing agreed-upon protective order with its provision that her testimony would be limited to this proceeding. Opp. 2, 9–10.

Another factor which a court should consider in conducting the good cause balancing test is whether a party benefitting from the order of confidentiality is a public entity or official. *Pansy*, 23 F.3d at 788. Ms. Keefe is neither a public entity or official. This factor weighs against modification. Similarly, we find the information in question does not appear to relate to public health or security.

That leaves two factors to consider: (1) whether the information is being sought for a legitimate purpose or an improper purpose; and (2) whether sharing of the information among litigants would promote fairness and efficiency. The parties differ on the importance of these issues. Motion 7, 9, Opp. 3, 7. A factor to consider is whether the information is being sought for a legitimate purpose or for an improper purpose. *Pansy*, 23 F.3d at 787. As noted, Petitioner argues that Patent Owner seeks to use the information for an improper purpose: an attempt to invade attorney-client and joint-defense privileges. Opp. 3. Petitioner does not deny that this is an objective. Motion 8–9 (“Patent Owner should be entitled to make this argument.”) The issue of whether and to what extent attorney-client and joint-defense privileges are applicable to Ms. Keefe is not before us, but presumably will be before the Delaware district court. Nor are we in a position to say that modifying the protective order would “promote fairness and efficiency” of the Delaware case. This is a question better answered by the Delaware district court. In our analysis, these two factors are neutral,

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Finally, we must consider whether there are alternative ways of obtaining the information sought, such as enforcement of the existing district court subpoenas Patent Owner has served. Recently, in *Wildcat Licensing WI LLC v. Atlas Copco Tools & Assembly Systems LLC*, No. 2022-1304, 2024 WL 89395, at *4 (Fed. Cir. Jan. 9, 2024), the Federal Circuit affirmed the Board’s denial of a request by plaintiff Wildcat to compel defendants to produce documents that had been produced in district court litigation, but which were subject to a protective order precluding their use before the Board. The Board’s refusal was based, in part, on the opportunity of Wildcat to obtain permission from the district court to use the documents. *Id.* In affirming the Board’s decision, the Federal Circuit remarked that Wildcat was not precluded from seeking permission from the district court to submit documents available to it under a governing protective order in the district court litigation. *Id.* at *5.

In light of these remarks by the Federal Circuit, we find the availability of subpoenas in the Delaware Litigation to obtain the documents is a further reason to deny the Motion. The Delaware district court is in a better position to consider Petitioner’s objections and decide whether or not to enforce the subpoenas.⁵

V. CONCLUSION

Upon weighing the relevant factors, we are not convinced that Patent Owner has met its burden of showing good cause for modifying the

⁵ We do not consider Petitioner’s argument that “judicial estoppel” forecloses Patent Owner from obtaining the documents. Opp. 4. The Delaware district court is in a better position to decide this issue as it involves proceedings that took place there.

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protective order in this proceeding to permit Exhibits 1029 and 2018 to be used in the Delaware Litigation involving Egnyte.

VI. ORDER

It is, therefore,

ORDERED that Patent Owner's Motion to Modify the Protective Order is *denied*;

FURTHER ORDERED that, no later than ten business days after the issuance of this Decision, the parties may file a joint motion to seal portions of the Decision, explaining why portions of it should remain under seal, and including as an attachment a redacted version of the Decision that can be made publicly available;

FURTHER ORDERED that this Decision shall remain under seal until any joint motion to seal the Decision is resolved; and

FURTHER ORDERED that the Decision shall be made public if, after the expiration of the time for the parties to file a joint motion to seal, no such motion has been filed.

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