

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFESCAN, INC.,
Petitioner,

v.

FACET TECHNOLOGIES, LLC,
Patent Owner.

IPR2023-00712
Patent 8,840,635 B2

Before ULRIKE W. JENKS, JASON W. MELVIN, and DAVID COTTA,
Administrative Patent Judges.

JENKS, *Administrative Patent Judge.*

ORDER

Denying without Prejudice Motion to Seal
37 C.F.R. §§ 42.5, 42.14, 42.54

Patent Owner filed an unopposed Motion to Seal various exhibits. Paper 20. Specifically, Patent Owner requests to seal Exhibits 2023, 2024, 2030, 2040, 2044, 2045, 2050–2052, and 2058. *Id.* at 1. The Motion to Seal relates to information regarded by Patent Owner as confidential business information or confidential technical information. *Id.* at 6. The Motions to Seal persuades us that the information the Patent Owner seeks to seal constitutes confidential business, financial, or technical information.

A motion to seal must contain a protective order. 37 C.F.R. § 42.54(a). Patent Owner, however, submitted a joint Proposed Protective Order that is *unsigned*. *See* Paper 20 (Appendix A). Patent Owner also included a copy of the protective order entered in the parallel district court litigation. *See* Paper 20 (Appendix B). Our trial practice guide provides that parties may propose that the Board adopt a protective order entered by the district court, but stipulates that unnecessary and inappropriate provisions for practice before the Board are removed before submitting the protective order for entry. CTPG 116. The Proposed Protective Order contains a prosecution bar, a provision identified in our trial practice guide as rarely appropriate in Board proceedings. *See* Paper 20 (Appendix A, 17 (§ 8)).

Patent Owner should file a revised motion to seal along with a signed proposed protective order as a uniquely numbered exhibit. The proposed protective order should be signed by both parties and should also delete the prosecution bar section from the order. If the parties cannot agree to deleting the prosecution bar section from the proposed protective order, then the revised motion to seal should include an explanation why the inclusion of a prosecution bar is appropriate in this case.

ORDER

It is:

ORDERED that Patent Owner's Motion to Seal is *denied without prejudice*;

FURTHER ORDERED that, within fourteen (14) days of this order, Patent Owner is authorized to file a revised motion to seal Exhibits 2023, 2024, 2030, 2040, 2044, 2045, 2050–2052, and 2058; and

FURTHER ORDERED that Patent Owner file a signed proposed protective order as a uniquely numbered exhibit.

IPR2023-00712
Patent 8,840,635 B2

FOR PETITIONER:

Michael J. Lyons
Alexander B. Stein
MORGAN, LEWIS & BOCKIUS LLP
michael.lyons@morganlewis.com
alexander.stein@morganlewis.com

FOR PATENT OWNER:

S. Giri Pathmanaban
Steven W. Peters
Susan Y. Tull
Benjamin J. Behrendt
LATHAM & WATKINS LLP
giri.pathmanaban@lw.com
steven.peters@lw.com
susan.tull@lw.com
benjamin.behrendt@lw.com