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Paper: 69
Entered: December 13, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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OMEGA LINER COMPANY, INC.,
Petitioner,

v.

BUERGOFOL GmbH,
Patent Owner.

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IPR2023-01372
Patent 9,657,882 B2

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Before GRACE KARAFFA OBERMANN, KIMBERLY McGRAW, and JAMES J. MAYBERRY, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER
*Denying Patent Owner's Motion to Seal Exhibits 1060–1063 (Paper 28);*
*Denying Patent Owner's Motion to Seal Exhibits 1070–1072 (Paper 55);*
*Denying Patent Owner's Motion to Seal Exhibit 2029 (Paper 48);*
*Denying Patent Owner's Request to Enter Protective Order (Paper 42)*
35 U.S.C. § 316; 37 C.F.R. §§ 42.14, 42.20(c), 42.54(a)

## I. INTRODUCTION AND BACKGROUND

This Order resolves Patent Owner's motions to seal Exhibits 1060–1063, 1070–1072, and 2029. Papers 28, 48, 55. We collectively refer to those papers as "the Motions." In addition, this Order resolves Patent Owner's revised request to enter a protective order.[1] Paper 42 ("Request" or "Reqt."). Petitioner opposes the Motions and the Request. Papers 45, 49, 56.

Our rules protect "confidential information" from disclosure. 37 C.F.R. § 42.54. Patent Owner, as the movant, bears the burden of demonstrating good cause for the requested relief. 37 C.F.R. § 42.20(c).

For reasons that follow, we *deny* the Motions because Patent Owner has not shown sufficiently that any exhibit contains "truly confidential" information or, in the alternative, Patent Owner effectively waived any confidentiality associated with the information. *Argentum Pharmaceutical LLC v. Alcon Research, Ltd.*, IPR2017-01053, Paper 27, 2–3 (PTAB Jan. 19, 2018) (informative). Accordingly, we move Exhibits 1060–1063 and 1070–1072 to, and maintain Exhibit 2029 in, the public record.[2]

Because no document of record is shown to reflect confidential information, none requires sealing. On this record, therefore, Patent Owner

[1] The parties jointly propose a protective order in connection with the Request. Paper 43.

[2] Petitioner filed Exhibits 1060–1063 and 1070–1072 in the public record on October 7, 2024, where the exhibits remained until October 24, 2024. Paper 30, 5. On October 24, 2024, in response to Patent Owner's telephonic request, the Board placed those exhibits "under seal provisionally as a 'ministerial function' pending submission and resolution of Patent Owner's motion[s] to seal." *Id.* at 6; Ex. 3006. Patent Owner filed Exhibit 2029 in the public record on November 8, 2024, where that exhibit remains to date.

does not demonstrate adequately a basis for entry of a protective order. Thus, we *deny* the Request and do not enter a protective order.

## II. DISCUSSION

Strong public policy favors making information filed in an *inter partes* review open to the public, especially because the proceeding determines the patentability of claims in an issued patent and, therefore, affects the rights of the public. Under 35 U.S.C. § 316(a)(1) and 37 C.F.R. § 42.14, the default rule is that all papers filed in an *inter partes* review are open and available for access by the public, and a successful motion to seal must include a showing that the "information sought to be sealed is truly confidential" owned by the party seeking protection of the information. *Argentum Pharmaceutical LLC*, Paper 27, 2–3, 5.

We apply those principles in assessing the Motions, cognizant that our "rules aim to strike a balance between the public's interest in maintaining a complete and understandable file history and the parties' interest in protecting truly sensitive information." Patent Trial and Appeal Board Consolidated Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 2019)), 19 ("Trial Practice Guide").[3]

### *A. Motion to Seal Exhibits 1060–1063 (Paper 28)*

Exhibit 1060 is an English translation of an email that Patent Owner received from a non-party customer, relaying a problem that customer (Saertex) encountered with films purchased from Patent Owner. Ex. 1060; Paper 28, 4.

[3] Available at https:// www.uspto.gov/TrialPractice Guide Consolidated.

Petitioner obtained a copy of the original German language email not from Patent Owner, but from Saertex. Ex. 1061. On October 7, 2024, Petitioner filed Exhibits 1060–1063[4] in the public record in support of its Reply to Patent Owner's Response to the Petition. Paper 24.

Patent Owner seeks to seal Exhibits 1060–1063 on the basis that the Saertex email reveals confidential information owned by Patent Owner. By way of support, Patent Owner argues it "does not publish or otherwise make publicly available private communications it has with its customers," that Exhibits 1060–1063 refer to "specific films sold commercially by" Patent Owner and disclose "highly sensitive business information," and that Patent Owner has designated similar communications "as highly confidential – attorneys eyes only in the corresponding litigation matter." Paper 28, 5.

Those assertions are insufficient to show that the Saertex email, generated by a non-party customer, reflects truly confidential information owned by Patent Owner. Patent Owner does not account for the key fact that the Saertex email was generated by a non-party that is not shown, on this record, to owe any obligation of confidentiality to Patent Owner. *Id*. Importantly, Patent Owner does not contend, much less demonstrate, that Saertex is, or ever has been, bound by any "confidentiality obligations to" Patent Owner. Paper 45, 1; *see* Paper 28 (nowhere addressing that issue).

Against that backdrop, we agree with Petitioner that the general rule, under which customer complaints "are not confidential, because they are known by third parties — the customers reporting the complaints," is

[4] Exhibit 1062 is a German language affidavit of the individual who translated the Saertex email to English. Exhibit 1063 is an English translation of that affidavit.

applicable and dispositive. Paper 45, 2 (quoting *Reyna v. Arris Int'l PLC*, 2018 WL 1400513 at *3 (N.D. Cal. Mar. 20, 2018)).

Additional facts and circumstances support that result. Patent Owner asserts that the Saertex email contains "highly sensitive business information" (Paper 28, 5), but that assertion cannot be squared with Patent Owner's own action of filing in the public record a copy of Exhibit 1060, without "any redactions of the product numbers or any other information." Paper 45, 5 (citing Ex. 2029 ¶ 10). That instance of public disclosure is not an aberration; Patent Owner repeatedly has described, in the public record, details of the very information that it now contends is highly sensitive and confidential. Paper 45, 5–6 (citing Ex. 2003 ¶¶ 21–24; Ex. 2004 ¶¶ 12, 14, 18, 19; Ex. 2028 ¶¶ 8–14; Ex. 2029 ¶¶ 10–15) (Patent Owner's publicly-filed descriptions of Exhibit 1060 and similar customer complaints); *see* Paper 28, 10 (Patent Owner's publicly-filed descriptions of Exhibit 1060). Patent Owner's public disclosures of the information sought to be sealed indicates Exhibits 1060–1063 contain no truly confidential information or, in the alternative, that Patent Owner effectively waived any confidentiality.

In addition, Patent Owner does not explain its failure to timely act to protect the assertedly confidential information in Exhibits 1060–1063. *See generally* Paper 28. Petitioner filed those exhibits in the public record on October 7, 2024, but Patent Owner first contacted the Board on October 24, 2024, to ask that the exhibits be provisionally sealed. Paper 30, 5–6. Patent Owner's unexplained, weeks-long delay in seeking to protect its assertedly "highly sensitive business information" indicates that Exhibits 1060–1063 contain no truly confidential information or, alternatively, that Patent Owner effectively waived any confidentiality. Paper 28, 5.

For the above reasons, returning Exhibits 1060–1063 to the public record strikes the appropriate "balance between the public's interest in maintaining a complete and understandable file history and" any demonstrated need on Patent Owner's part to protect "truly sensitive information." Trial Practice Guide, 19. Accordingly, we deny Patent Owner's motion to seal Exhibits 1060–1063 and remove their designation as available to the Board and parties only.

*B. Motion to Seal Exhibits 1070–1072 (Paper 55)*

` Dr. Kurt Stark is a co-inventor of the challenged patent. Ex. 1001, code (72). On June 21, 2024, Patent Owner's German counsel sent Dr. Stark's German counsel an email, enclosing a declaration prepared by Patent Owner's United States counsel for filing in this proceeding, requesting that Dr. Stark sign and return the declaration by June 26, 2024. Paper 55, 3; Ex. 1070 (English translation of email); Ex. 1071 (original German language email); *see* Ex. 1072 (Dr. Stark's email to Petitioner's counsel, including a marked-up copy of the declaration).

On June 26, 2024, Dr. Stark sent an email to Petitioner's counsel (***not*** Patent Owner's counsel), referencing "our video conference" and including a copy of the declaration with red annotations added by Dr. Stark. Ex. 1072.

Patent Owner seeks to seal Exhibits 1070–1072, which Petitioner filed in support of Petitioner's Reply to Patent Owner's Response to the Petition. Patent Owner asserts that it "does not publish or otherwise make publicly available private communications it has with its attorneys, associated international counsel, potential witnesses, and the like." Paper 55, 3–4. Patent Owner further asserts that the "draft declaration" that it forward to Dr. Stark "is attorney work product." *Id.* at 4.

Based on the particular facts and circumstances presented, we determine that Patent Owner's assertions, in that regard, are insufficient to establish that Exhibits 1070–1073 reflect truly confidential information owned by Patent Owner under the work product doctrine or any other theory. Patent Owner "does not establish any confidentiality obligations owed to" Patent Owner "or its German counsel by Dr. Stark or his counsel." Paper 56, 2. By providing the information to an entity under no obligation to preserve its confidentiality, Patent Owner effectively waived any confidentiality associated with the information.

Alternatively, Petitioner directs us to uncontested evidence,[5] in the form of a Table that maps Exhibit 1072 to papers filed in the public record of this proceeding, showing adequately that "all the information" provided by Patent Owner's counsel "in Dr. Stark's declaration is publicly available." *Id*. at 3 (Table). That circumstance supports our determination that Patent Owner has not shown that any of the information contained in the declaration constitutes confidential information of Patent Owner.

Significantly, moreover, Petitioner argues, and Patent Owner does not contest, that the markings Dr. Stark added to Exhibit 1072 "were independently created by him without any confidentiality obligation and were not shared with" Patent Owner. *Id*. Rather, the markings added by Dr. Stark were sent by Dr. Stark to Petitioner's counsel, not to Patent Owner's counsel. As such, the markings added by Dr. Stark do not constitute Patent Owner's protected attorney work product. Patent Owner does

[5] Petitioner placed this evidence into the record on November 14, 2024. Paper 38, 2. Patent Owner does not contest that evidence in the instant motion filed on November 27, 2024. *See generally* Paper 55.

demonstrate that these markings represent Patent Owner's confidential information under any theory. *See generally* Paper 55.

On this record, no showing is made that Exhibits 1070–1072 contain Patent Owner's "truly confidential information" because Patent Owner can assert "no ownership interest in the information sought to be sealed." *Argentum*, Paper 27, 2–3, 5. To be clear, Patent Owner does not show sufficiently that any information contained in these exhibits is protected attorney work product. In the alternative, Patent Owner effectively waived any asserted confidentiality over the information.

Additional facts and circumstances support the result here. In particular, as asserted by Petitioner, "Dr. Stark is adverse to" Patent Owner, as "there have been over a dozen lawsuits between" Patent Owner "and Dr. Stark over the past few years; many of them are still ongoing." Paper 56, 8 (quoting Paper 25, 17:14–16). Patent Owner has stated "Dr. Stark 'cannot be trusted' and 'is likely to divulge" Patent Owner's "privileged information." *Id*. (quotations omitted).

Notwithstanding those facts, Patent Owner sent the declaration to Dr. Stark "without obtaining any assurances of confidentiality or other protection for the purported 'work product.'" Paper 56, 8; *see generally* Paper 55 (Patent Owner, nowhere citing evidence that Dr. Stark owed Patent Owner a duty of confidentiality relating to the factual information[6] contained in Exhibits 1070–1072). "It is well-established that work product immunity is waived when a document is disclosed to a third party" in a manner "that 'substantially increase[s] the opportunities for potential adversaries to obtain

[6] Patent Owner prepared the declaration in anticipation of Dr. Stark's participation in this proceeding as a fact witness. Paper Ex. 1085, 15:15–20.

the information.'" 8 Wright & Miller, *Federal Practice & Procedure* § 2024 (3d ed.); Paper 56, 9 (and additional supporting citations therein).

Based on the information presented, therefore, we agree with Petitioner that Patent Owner's disclosure to Dr. Stark, whom Patent Owner itself characterizes as "both 'adverse' and 'untrustworthy,'" and "likely to divulge" Patent Owner's "privileged information," without obtaining any assurances of confidentiality, represents an unequivocal waiver of "any claim of work product immunity." Paper 56, 9.

In addition, Patent Owner does not explain its failure to timely act to protect the asserted work product or other confidential information allegedly reflected in Exhibits 1070–1072. *See generally* Paper 55. Petitioner filed the exhibits in the public record on October 7, 2024, but Patent Owner first contacted the Board on October 24, 2024, to ask that the exhibits be provisionally sealed. Paper 30, 5–6. That unexplained, weeks-long delay does not square with Patent Owner's assertion that Exhibits 1070–1072 contain Patent Owner's truly "confidential information." Paper 55, 4.

For the above reasons, we agree with Petitioner that Patent Owner does not "establish any legitimate confidentiality interest in" Exhibits 1070–1072, "much less one that outweighs 'the strong public interest in having an open record.'" Paper 56, 15. Accordingly, we deny Patent Owner's motion to seal Exhibits 1070–1072 and remove their designation as available to the Board and parties only.

*C. Motion to Seal Exhibit 2029 (Paper 48)*

On November 8, 2024, Patent Owner filed Exhibit 2029 with the Board as a document available to the public. On November 22, 2024, Patent Owner moved to seal Exhibit 2029. Given that Patent Owner itself filed

Exhibit 2029 in a manner that ensured public access to that document, we find meritless Patent Owner's contention that it did so "with the misunderstanding that the exhibit it would be confidential." Paper 48, 2; *see* Paper 49, 1 (Petitioner, pointing out that this argument "defies logic and lacks any credible support"). In addition, Patent Owner's weeks-long delay in seeking to place Exhibit 2029 under seal suggests that the exhibit contains no "truly confidential information" owned by Patent Owner. *Argentum*, Paper 27, 2–3. Alternatively, the weeks-long delay represents a waiver of any confidentiality that Patent Owner could assert over the information.

Our conclusions, on those points, are confirmed by examination of the information that Patent Owner identifies as confidential within Exhibit 2029. In particular, Patent Owner argues that a screenshot of Exhibit 1060, reproduced in paragraph 10 of Exhibit 2029, is confidential. Paper 48, 2. Our reasoning set forth above, in connection with Patent Owner's assertions of confidentiality over Exhibit 1060, applies with equal force to Patent Owner's assertions of confidentiality over the screenshot of Exhibit 1060 that appears in Exhibit 2029.

Accordingly, we deny Patent Owner's motion to seal Exhibit 2029, which shall remain in the public record.

*D. Request to Enter Protective Order (Paper 43)*

Patent Owner requests entry of a jointly proposed Protective Order (Paper 43). *See* Paper 42 (Request). Upon entry of the instant Order, all papers and exhibits in this proceeding properly shall be made available in the public record. Accordingly, entry of a protective order is neither necessary nor appropriate. We deny the Request and do not enter a protective order.

## III. CONCLUSION

We *deny* the Motions and *deny* the Request.

## IV. ORDER

It is

ORDERED that Patent Owner's Motion to Seal Exhibits 1061–1063 (Paper 28) is *denied*;

FURTHER ORDERED that Patent Owner's Motion to Seal Exhibits 1070–1072 (Paper 48) is *denied*;

FURTHER ORDERED that Patent Owner's Motion to Seal Exhibit 2029 (Paper 55) is *denied*;

FURTHER ORDERED that the Board shall move Exhibits 1060–1063 and 1070–1072 to the public record and shall maintain Exhibit 2029 in the public record; and

FURTHER ORDERED that Patent Owner's Revised Request to Enter Protective Order (Paper 42) is *denied*.

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