

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAMPBELL SOUP COMPANY,
CAMPBELL SALES COMPANY, and
TRINITY MANUFACTURING, LLC,
Petitioner,

v.

GAMON PLUS, INC.,
Patent Owner.

Cases IPR2017-00087 (Patent 8,827,111 B2);
IPR2017-00091 (Patent D621,645 S);
IPR2017-00094 (Patent D612,646 S)¹

Before GRACE KARAFFA OBERMANN, BART A. GERSTENBLITH,
and ROBERT L. KINDER, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION
Granting Petitioner's Motion for Protective Order
37 C.F.R. §§ 42.05, 42.54

¹ We exercise our discretion to issue one Decision and Order in each of these proceedings. The parties may not use this caption style.

IPR2017-00087 (Patent 8,827,111 B2)

IPR2017-00091 (Patent D621,645 S)

IPR2017-00094 (Patent D621,646 S)

I. DISCUSSION

A conference call was held on November 21, 2017, between respective counsel for the parties and Administrative Patent Judges Obermann, Gerstenblith, and Kinder. The discussion is detailed in our November 29, 2017, Order. Paper 46.² Pursuant to that Order, Petitioner filed a Motion for Entry of Protective Order (Paper 48; “Motion” or “Mot.”) in each of the three proceedings captioned above. Petitioner’s Motion includes the following exhibits: Exhibit A, Petitioner’s proposed protective order; Exhibit B, a redline version of the Board’s default protective order showing the differences between it and the protective order proposed by Petitioner; and Exhibit C, excerpts from Petitioner entity Trinity Manufacturing LLC’s website. Patent Owner filed an Opposition to Petitioner’s Motion in each proceeding. Paper 49.

In short, Petitioner produced certain undisputedly confidential documents to Patent Owner on an “attorneys’ eyes only” basis. Patent Owner seeks to show the documents to its CEO, Mr. Johnson, so that he can assist Patent Owner’s counsel in preparing a sur-reply on the issue of secondary considerations of non-obviousness. Mr. Johnson previously submitted a declaration in each proceeding purporting to provide testimony as both a fact and expert witness. *See, e.g.*, Paper 49, 1 (discussing Mr. Johnson’s dual role as a fact and expert witness).

Petitioner seeks to preclude Mr. Johnson from reviewing the documents for several reasons set forth in Petitioner’s Motion. Petitioner’s proposed protective order makes only two changes to the Board’s default

² Citations are to IPR2017-00087 unless otherwise indicated.

IPR2017-00087 (Patent 8,827,111 B2)
IPR2017-00091 (Patent D621,645 S)
IPR2017-00094 (Patent D621,646 S)

protective order. First, it eliminates access to confidential information for persons who are owners of a patent involved in the proceeding and other persons who are named parties to the proceeding. Mot., Ex. B at 2. Second, it adds a restriction to the clause pertaining to experts, carving out experts who are employed by a party. *Id.* Each of these changes is directed toward precluding Mr. Johnson from accessing the confidential material contained within the documents Petitioner produced.

We are persuaded that under the facts presented here, Petitioner has established good cause for entering the protective order proposed. 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 . . .”). First, Petitioner has set forth several reasons in its Motion for said protective order and we hereby adopt those reasons as our own.

Second, Patent Owner chose to use Mr. Johnson as both a fact and expert witness. That was a decision made at potentially Patent Owner’s own peril. It places Patent Owner in a difficult position because documents that otherwise might have been accessible by a *neutral* expert might not be accessible to an expert employed by an opposing party. Such circumstances are precisely those presented before us, where documents contain undisputedly confidential information that, as Petitioner has shown, should not be shared with an adversary. Patent Owner chose to rely upon a party witness and, thus, under these circumstances, must bear the consequences of that decision.

Third, we find that Patent Owner unreasonably delayed seeking production of the 2002 study, discussed in previous orders in these

IPR2017-00087 (Patent 8,827,111 B2)

IPR2017-00091 (Patent D621,645 S)

IPR2017-00094 (Patent D621,646 S)

proceedings.³ Mr. Johnson's Declaration (Paper 16)⁴ makes clear that he knew of the decade-old study well before Patent Owner reached out to Petitioner and, ultimately, to us to seek its production. The delay here is relevant because we are now just over a month away from oral argument in these proceedings and discovery has long since concluded.

Fourth, although we authorized Patent Owner to file a sur-reply limited to the issue of secondary considerations of non-obviousness, we did not authorize Patent Owner to include new evidence in the form of a declaration that would then potentially result in a second deposition and further extension of discovery. *See* Paper 37 (authorizing a sur-reply); *see also* Paper 46, 3 (explaining that we did not authorize Patent Owner to include new evidence in the form of declaration testimony or otherwise as part of the sur-reply, with the exception of the documents produced by Petitioner). Additionally, although Patent Owner contends that Mr. Johnson can shed light on the meaning of the documents, Mr. Johnson has not seen the documents and any potential assistance he might provide is tenuous at best. Accordingly, we find that any potential benefit to counsel he may offer by having access to review these confidential documents is outweighed by the potential harm to Petitioner in disclosing the confidential information contained therein.⁵ That potential harm is as high as it is because of Patent Owner's choice to use its CEO to offer alleged expert testimony.

³ Although the study was not located, the documents at issue were located during Petitioner's search for the study.

⁴ Patent Owner filed Mr. Johnson's Declaration as a "paper" instead of an "exhibit" even though it is identified as "Exhibit 2001."

⁵ Patent Owner did not pursue other means that may have shed light on the meaning of the information contained within the documents, including, for

IPR2017-00087 (Patent 8,827,111 B2)
IPR2017-00091 (Patent D621,645 S)
IPR2017-00094 (Patent D621,646 S)

Accordingly, for the reasons explained herein, we find that Petitioner has established good cause to enter the proposed protective order.

II. ORDER

It is:

ORDERED that Petitioner's Motion for Entry of Protective Order (Paper 48, IPR2017-00087; Paper 54, IPR2017-00091; Paper 54, IPR2017-00094) is *granted*;

FURTHER ORDERED that Petitioner shall file, as a "paper" in each of these three proceedings, the proposed Protective Order shown in Exhibit A to its Motion, except that the title of the document shall be changed to "PROTECTIVE ORDER" (from "STIPULATED PROTECTIVE ORDER") because Patent Owner does not stipulate to its entry; and

FURTHER ORDERED that Patent Owner's sur-reply limited to the issue of secondary considerations of non-obviousness shall be due within one week of the date of this Order, as previously set forth in our November 29, 2017, Order (Paper 46, IPR2017-00087; Paper 52, IPR2017-00091; Paper 52, IPR2017-00094).

example, by seeking authorization to depose the custodian of the documents or someone with knowledge of the material contained therein. At present, however, we are well past the point where such option may have been viable in these proceedings.

IPR2017-00087 (Patent 8,827,111 B2)

IPR2017-00091 (Patent D621,645 S)

IPR2017-00094 (Patent D621,646 S)

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