

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POLYGROUP LIMITED (MCO),
Petitioner,

v.

WILLIS ELECTRIC COMPANY, LIMITED,
Patent Owner.

Case: IPR2016-01610 (Patent 8,454,186 B2)

Case: IPR2016-01612 (Patent 8,454,187 B2)

Case: IPR2016-01613 (Patent 9,044,056 B2)

Cases: IPR2016-01615, -01616, and -01617 (Patent 8,936,379 B1)¹

Before WILLIAM V. SAINDON, JEREMY M. PLENZLER, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

DECISION

Granting-in-Part Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

Granting Petitioner's Request to Expunge Certain Exhibits and Dismissing
Petitioner's Motion to Seal
37 C.F.R. § 42.54

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

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We have instituted *inter partes* review in each of these cases. Prior to institution, in certain of these proceedings, i.e., IPR2016-01610, -01612, and -01613, we merged challenges of other proceedings. *See* IPR2016-001610, Decision Granting Joint Motion Regarding Multiple Proceedings (“Dec. Jt. Mtn. Multiple Proceedings,” Paper 13). 6–7.² Additionally, we authorized the parties to file papers and exhibits in non-Surviving Cases, for example, IPR2016-00800, into the records of the Surviving Cases, for example, IPR2016-01610. *Id.* at 7. In certain of those non-Surviving cases (i.e., IPR2016-00800, -00801, and -00802), we previously granted-in-part Patent Owner’s Motion to Additional Discovery. *See, e.g.*, IPR2016-00800, Decision Granting-In-Part Patent Owner’s Motion for Additional Discovery and Granting Joint Motion to Seal Exhibit 2017 (“Dec. ’800 Mtn. Adt’l Disc.,” Paper 28), 14. The parties were authorized to file that additional discovery in each of IPR2016-01610, -01612, and -01613. Dec. Jt. Mtn. Multiple Proceedings 6–7.

In the non-Surviving cases, Patent Owner also requested documents from pending litigation, identified by Bates number. *See, e.g.*, IPR2016-00800, Motion for Additional Discovery (“’800 Mtn. Adt’l Disc.,” Paper 23), 7. More specifically, Patent Owner requested documents produced in a pending lawsuit, i.e., *Willis Elec. Co. v. Polygroup Ltd.*, No. 0:15-cv-03443-DWF-SER (D. Minn. (filed Aug. 28, 2015)). *Id.* at 5. In the non-Surviving cases, we denied Patent Owner’s request for the Bates numbered documents because Patent Owner did not offer meaningful description of the

² Citations herein will be to IPR2016-01610, unless otherwise noted.

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information contained in these documents or sufficient explanation. Dec. '800 Mtn. Adt'l Disc. 13.

After receiving our authorization in the instant proceedings, on April 14, 2017, Patent Owner filed a redacted Motion for Additional Discovery ("1610 Disc. Mtn.", Paper 43)³ and on April 21, 2017, Petitioner filed an Opposition ("1610 Disc. Opp'n", Paper 46). Additionally, on April 14, 2017, the parties filed a Joint Motion to Seal (Paper 45), which we denied without prejudice on April 25, 2017 (Paper 47). Subsequently, on May 2, 2017 Petitioner filed a revised Motion to Seal ("1610 Mtn. to Seal," Paper 48) and a Second Proposed Amended Protective Order (Paper 49). The parties additionally filed a Joint Stipulation for Entry of the Second Proposed Amended Protective Order ("Protective Order Stip.", Paper 50). On May 3, 2017, Patent Owner filed a revised motion to seal disagreeing with Petitioner's confidentiality designations ("1610 Mtn. to Seal Opp'n," Paper 51).

Requests for Production (Ex. 2065)

In the instant proceedings, Patent Owner submits three requests for production as follows: (1) "documents relating to transition of industry and Polygroup from old pre-lit designs to adoption of One Plug designs/commercial success/nexus with the claimed design"; (2) "documents relating to price premium charged for Quick Set or EZ Connect features"; and (3) "documents relating to copying Willis designs or patents." *See, e.g.,*

³ Patent Owner also filed an unredacted Motion for Additional Discovery (Paper 44), which we do not need to rely on for the purposes of this Decision.

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'1610 Disc. Mtn. 1 (citing Ex. 2065). Additionally, each of these requests asks for a number of documents from a co-pending lawsuit, identified by Bates number. *See, e.g., id.* at 6; Ex. 2065, 1.

As an initial matter, Patent Owner does not submit a discovery request that is identical to Interrogatory No. 1 (IPR2016-00800, Ex. 2018), which we granted in modified form in certain of the non-Surviving cases, as discussed above. *See, e.g.,* Dec. '800 Mtn. Adt'l Disc., 14. Furthermore, such discovery would be redundant in some of the instant proceedings as the parties already were authorized to file that additional discovery in each of IPR2016-01610, -01612, and -01613. Dec. Jt. Mtn. Multiple Proceedings 6–7. The parties, however, have not been authorized to file that additional discovery in IPR2016-01615, -01616, and -01617. We interpret Patent Owner's requests for production in IPR2016-01615, -01616, and -01617 (*see, e.g.,* IPR2016-01615, Patent Owner's Motion for Additional Discovery ("1615 Mtn. Adt'l Disc.," Paper 22)) to include that previously-authorized discovery in the non-Surviving case IPR2016-00800. In light of the similarity of the technologies and issues, we authorize the parties to file the discovery received in IPR2016-00800 (Dec. '800 Mtn. Adt'l Disc.) in each of IPR2016-01615, -01616, and -01617.

We now turn to the three requests for production set forth above in the instant proceedings. Each of Patent Owner's requests asks for "documents relating to" and then specifies that the request further includes particular documents produced in co-pending litigation identified by Bates Numbers, such that the Bates numbered documents are a sub-set of Patent Owner's Request. Ex. 2065. We determine that Patent Owner does not address

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sufficiently each of the *Garmin* factors⁴ for the discovery not previously authorized in IPR2016-00800. For example, with respect to the requested documents not identified specifically by Bates number (“the other discovery documents”), *Garmin* factor 1 is not addressed because Patent Owner’s contentions pertain to only the subset of documents already produced in the co-pending lawsuit. *See, e.g.*, ’1610 Disc. Mtn. 11–14. Additionally, *Garmin* factor 4 is not addressed because Patent Owner offers no persuasive guidance as to what “relating to” means. *Id.* Accordingly, we are not persuaded to grant Patent Owner’s requests for production of the other discovery documents, i.e., discovery that extends beyond the Bates numbered documents.

We now turn to Patent Owner’s request for documents already produced in the co-pending lawsuit that are identified by Bates numbers in Patent Owner’s requests for production. Ex. 2065. Although Patent Owner’s motion is characterized as a discovery motion, the issue before us pertains directly to a protective order issued by the District Court in the co-pending lawsuit. More specifically, although Patent Owner already is in physical possession of the documents, Patent Owner “only has custody of and information regarding the sought-after discovery in copending district-

⁴ *Garmin Intern. Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (precedential). The *Garmin* factors are: (1) more than a possibility and mere allegation that something useful will be discovered; (2) requests that do not seek other party’s litigation positions and the underlying basis for those positions; (3) ability to generate equivalent information by other means; (4) easily understandable instructions; and (5) requests that are not overly burdensome to answer. *Id.*

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court litigation.” ’1610 Disc. Mtn. 7. Indeed, Patent Owner submits these materials in connection with its motion to aid in our decision, but by agreement of the parties, Patent Owner may not rely on them for other purposes in the instant proceedings. Protective Order Stip.; Second Proposed Amended Protective Order 4. Patent Owner contends that its “understanding of Petitioner’s concern is not that the Default Protective Order would be insufficient to protect its business information,” but that “Petitioner views the documents sought as irrelevant.” *Id.* at 5. Petitioner, however, contends that the Board’s Default Protective Order does not offer sufficient protection because it “allows disclosure of such materials to ‘Persons who are owners of a patent involved in the proceeding and other persons who are named parties to the proceeding,’ which could include the inventor of the Patents-at-Issue, Johnny Chen, the President and CEO of Willis.” ’1610 Disc. Opp’n 15.

Accordingly, the issue before us is whether to require that Petitioner produce in the instant proceedings discovery already provided in the co-pending lawsuit because Patent Owner is restricted by a protective order in that co-pending lawsuit that prohibits use of documents in the instant proceedings. Here *Garmin* factor 3, i.e., ability to generate equivalent information by other means, is dispositive. In particular, approaching the district court for permission to use the documents was, and is, “other means.” Patent Owner acknowledges that it could have sought permission from the District Court to use the documents in the instant proceedings. ’1610 Disc. Mtn. 7. More specifically, Patent Owner identifies “two ways”

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it could have sought such relief, by formal motion or seeking to alter the designation of materials. *Id.*

Patent Owner asserts that redress before the District Court is not feasible on the bases of timeliness and expense. *Id.* at 7–8. With respect to timeliness, we instituted *inter partes* review in the non-Surviving proceedings in mid-October 2016 (*see, e.g.*, IPR2016-00800, Paper 9), and discussed specifically the issue of the District Court protective order as it related to discovery in this proceeding during a conference call held on November 22, 2016, so Patent Owner has been aware for at least five months of the need to seek relief from the District Court protective order. Additionally, as noted above, we denied a similar discovery request on January 13, 2017 in the non-Surviving proceedings, so Patent Owner had notice again at that time that the only forum for relief might be the District Court. Dec. '800 Mtn. Adt'l Disc.13. Furthermore, Patent Owner's assertions regarding timeliness are vague and conclusory, identifying with specificity only a thirteen-day waiting period. '1610 Disc. Mtn. 7–8.

Patent Owner's assertions regarding expense similarly are not substantiated sufficiently. For example Patent Owner relies on vague assertions of “longer briefing” and expenses for “counsel to fly to court from out of state.” *Id.* Patent Owner does not take into account costs in the instant proceedings, including the burden of redacting information asserted by Petitioner. '1610 Disc. Opp'n 14–15.

Based on the record before us, there is no indication that Patent Owner approached the district court for either permission to use the identified documents in this IPR or challenge Petitioner's confidentiality

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designations. Because of the particular circumstances in the instant proceedings, on this record, *Garmin* factor 3 is dispositive and we deny Patent Owner's requests for documents identified by Bates numbers (Ex. 2065) on that basis.

Motion to Seal

Petitioner asserts that Exhibits 2068 through 2089 contain its confidential business information. '1610 Mtn. to Seal 1. Petitioner describes the information that it seeks to maintain as confidential and explains why this information is confidential. *See, e.g., id.* at 3–5. Consistent with Petitioner's contentions (*id.*), Exhibits 2068 through 2089 include a power point presentation with market information and e-mails with pricing information, as well as strategic legal information. Although Patent Owner contests Petitioner's designations, Patent Owner relies on attorney argument, with the exception that certain documents are several years old, which alone is not sufficient to demonstrate that they are public. '1610 Mtn. to Seal Opp'n 2–3. Based on the record before us, we determine that Petitioner has made a sufficient showing such that we decline to deny Petitioner's request and make its documents designated as highly confidential public at this time.

Petitioner, however, submits the Second Proposed Amended Protective Order with a use restriction as follows: “the Parties agree that the moving Party may file such confidential information under seal . . . to aid the Board in deciding whether moving Party is entitled to the discovery it seeks, and the non-moving Party's agreement to such limited use of the confidential information does not waive the non-moving party's right to

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oppose any other use of such confidential information in the IPR proceedings.” Second Proposed Amended Protective Order 4. However, as discussed above, we already have authorized or authorize in this Decision Patent Owner’s use of certain of Petitioner’s confidential material for purposes other than seeking discovery. Indeed, filings of such information have already been completed in certain of the instant proceedings. *See, e.g.*, IPR2016-01610, Ex. 2034 entitled “Exhibit 2017 from 800IPR (Polygroup Spreadsheet).” We determine that the use restriction in the Second Proposed Amended Protective Order contradicts our prior authorization of use of additional discovery obtained in the non-Surviving cases in each of IPR2016-01610, -01612, and -01613. Dec. Jt. Mtn. Multiple Proceedings 6–7. Additionally, it contradicts our authorization in this Decision to allow the parties also to use such discovery in each of IPR2016-01615, -01616, and -01617.

We determine that Petitioner’s Motion to Seal addresses sufficiently only information filed for our consideration in connection with Patent Owner’s request, i.e., in Exhibits 2068 through 2089. *See generally* ’1610 Mtn. to Seal. Because we deny Patent Owner’s request for additional discovery, we do not need to maintain these documents for use in the instant proceedings. Additionally, Petitioner indicates that it will seek leave to have its material expunged in the event of a denial. ’1610 Mtn. to Seal 2. We, therefore, treat Petitioner’s Motion to Seal as a request to expunge from the record such exhibits i.e., Exhibits 2068 through 2089 in IPR2016-01610, and grant Petitioner’s request in this regard.

The current record, however, includes at least potential ambiguity in

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light of the parties' failure to explain sufficiently in their respective papers their positions with respect to the other confidential documents that are authorized for use in these proceedings. '1610 Mtn. to Seal; '1610 Mtn. to Seal Opp'n. Accordingly, Petitioner's Motion to Seal is dismissed without prejudice to the parties re-filing a joint motion to seal to protect the confidentiality of the materials submitted from the non-Surviving cases. The parties shall file their joint motion to seal to protect the confidentiality of the materials submitted from the non-Surviving cases on or before close business May 31, 2017. *See* 37 C.F.R. § 42.14 ("A party intend[ed] a document or thing to be sealed shall file a motion to seal concurrent with the filing of the document or thing to be sealed.") The parties are reminded that they shall comply with guidance set forth in the Scheduling Order in each of these proceedings, including filing any proposed protective order with each revised Joint Motion to Seal.

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In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion for Additional Discovery is *granted-in-part* such that Patent Owner is authorized to file the discovery received in IPR2016-00800 in each of IPR2016-01615, -01616, and -01617; Patent Owner's other requests in its Motion for Additional Discovery (Papers 43 and 44) are *denied*;

FURTHER ORDERED that Petitioner's Motion to Seal (Paper 48) is *granted-in-part* as to expunging confidential materials submitted for consideration of Patent Owner's Motion for Additional Discovery including Patent Owner's Unredacted Motion (Paper 44) and Exhibits 2068 through 2089,⁵ and such submissions shall hereby be expunged; Petitioner's other requests in its Motion to Seal are *dismissed* as moot; and

FURTHER ORDERED that the parties shall file by May 31, 2017 a Joint Motion to Seal exhibits filed in the instant proceedings that were designated as confidential in the non-Surviving cases.

⁵ Please see the Appendix for identification of the same submissions filed in IPR2016-01612, -01613, -01615, -01616, and -01617.

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APPENDIX

Case	Petitioner's Revised Motion to Seal	Patent Owner's Un-redacted Motion for Additional Discovery	Exhibit Numbers
IPR2016-01610	Paper 48	Paper 44	Exs. 2068-2089
IPR2016-01612	Paper 50	Paper 47	Exs. 2054-2075
IPR2016-01613	Paper 43	Paper 39	Exs. 2026-2047
IPR2016-01615	Paper 26	Paper 23	Exs. 2013-2034
IPR2016-01616	Paper 25	Paper 21	Exs. 2011-2032
IPR2016-01617	Paper 26	Paper 22	Exs. 2010-2031