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Paper 14
Entered: February 13, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE SHERWIN-WILLIAMS COMPANY.,
Petitioner,

v.

ARCH CHEMICALS, INC.,
Patent Owner.

Case IPR2019-01497 (Patent 9,723,842 B2)
Case IPR2019-01498 (Patent 9,723,842 B2)

Before GRACE KARAFFA OBERMANN, CHRISTOPHER G. PAULRAJ, and JOHN R. KENNY, *Administrative Patent Judges*.

KENNY, *Administrative Patent Judge*.

DECISION

Granting Requests to Seal Exhibits and Entering Protective Orders
37 C.F.R. § 42.54

In both above-identified proceedings, Petitioner filed a *Motion to Seal and Enter a Protective Order* (IPR2019-01497 ("'1497 IPR"), Paper 4, "Motion"; IPR2019-01498 ("'1498 IPR"), Paper 4) and a *Stipulation on Petitioner's Motion to Seal and Enter a Protective Order* ('1497 Paper 9, "Stipulation"; '1498 IPR Paper 9).[1] In these papers, Petitioner seeks to seal '1497 IPR Exhibit 1020 and '1498 IPR Exhibit 1120. Motion 1; '1498 IPR Paper 4, 1; Stipulation 2. Both exhibits are copies of the *Initial Claim Chart* of Arch Chemicals, Inc. in a related district court litigation (C.A. No. 18–2037-LPS, D. Del., "Related Litigation"). Motion 2–3; Stipulation 2; '1497 IPR Exh. 1020, 1; '1498 IPR Exh. 1120, 1. Petitioner argues that this *Claim Chart* contains confidential, technical information concerning formulations for Petitioner's paint products, including detailed component information and amounts. Motion 3. Petitioner further asserts that this confidential information results from "substantial research and development efforts and is highly sensitive technical information." *Id.* Further, according to Petitioner, public disclosure of this confidential information "would provide current and potential competitors with sensitive competitive intelligence related to Petitioner's current and past formulations for its products." *Id.* Patent Owner agrees with Petitioner that '1497 IPR Exhibit 1020 and '1498 Exhibit 1120 should be sealed. Stipulation 1; '1498 IPR Paper 9, 1.[2]

[1] Unless indicated otherwise, we provide page cites to the papers and exhibit-at-issue in IPR2019-01497.

[2] Paper 9 in IPR2019-01498 expressly requests sealing of Exhibit 1020. This appear to be a typographical error because that proceeding has no Exhibit 1020.

Petitioner and Patent Owner also seek the entry in each proceeding of the proposed protective order that is submitted as Exhibit A for the stipulation in each proceeding. Stipulation 2. Petitioner earlier proposed the entry of a slightly different protective order (i.e., Attachment A of the Motion). Motion 4; '1498 IPR Paper 4, 4. In the subsequent stipulations, the parties, however, request entry of Exhibit A for the stipulations. Stipulation 2, '1498 Paper 9, 2. Petitioner argues that the proposed protective orders are modified versions of the protective order entered in the Related Litigation. Motion 4.

The *July 2019 Trial Practice Guide Update*, 84 Fed. Reg. 33,925 (July 16, 2019), sets forth guidance for the entry of proposed protective orders for proceedings involving a related litigation:

> When a proceeding before the Board involves the same parties and subject matter as a parallel district court proceeding, parties may propose that a protective order entered by the district court be adopted by the Board. The Board may enter such a proposed protective order especially if certain provisions commonly found in district court protective orders that are unnecessary or inappropriate in proceedings before the Board are removed before submitting the proposed protective order to the Board. For example, provisions protecting computer source code may be unnecessary because proceedings before the Board rarely, if ever, require analysis of computer source code. Likewise, prosecution bars are rarely appropriate in proceedings before the Board because the disadvantage caused by a prosecution bar to patent owners wishing to make use of amendment or reissue process in most cases outweighs the risk that confidential technical information about existing or future commercial products will be revealed during a proceeding. Finally, all terms of district court protective orders that conflict with Board procedures for filing or otherwise handling confidential

> information should be removed before the proposed order is submitted to the Board.

Id. at 58–59.

Petitioner argues that its proposed protective orders comply with the above guidance. Motion 4–5. Petitioner notes that the subject matter of this proceeding involves the same subject matter and parties as the Related Litigation. *Id.* at 4. Further, Petitioner asserts that "[a]s compared to the district court protective order, Petitioner's proposed protective order omits the prosecution bar and modifies the provisions relating to the filing of confidential information to match the Board's procedures in the Board's default protective order." *Id.* at 4–5.

After reviewing the parties' papers and Exhibits 1020 and 1120, we grant the parties' request to seal '1497 IPR Exhibit 1020 and '1498 IPR Exhibit 1120. We also grant the parties' requests in both proceedings to enter the proposed protective orders attached as Exhibit A to the stipulation filed in each proceeding (i.e.,'1497 Paper 9 Exhibit A and '1498 Paper 9 Exhibit A). In granting the latter requests, however, we clarify that nothing in the entered protective orders shall alter any Board procedure or practice for handling exhibits filed under seal.[3]

We, hereby, further authorize either party to file a motion to expunge confidential information within thirty (30) days of entry of any order terminating a proceeding identified in the caption. *See* 37 C.R.F. §§ 42.5

[3] It does not appear that the parties intended for the proposed protective order to affect any such procedure or practice. But to avoid any possible confusion, we provide this clarification.

(authorizing the Board to set times and proper course of conduct of proceedings), 42.56 (identifying other events that trigger an authorization for the filing of a motion to expunge).

IT IS:

ORDERED that Exhibit 1020 in IPR2019-01497 and Exhibit 1120 in IPR2019-01498 shall be sealed;

FURTHER ORDERED that the proposed protective order attached as Exhibit A for Paper 9 in IPR2019-01497 shall be entered as the protective order in that proceeding;

FURTHER ORDERED that the proposed protective order attached as Exhibit A for Paper 9 in IPR2019-01498 shall be entered as the protective order in that proceeding; and

FURTHER ORDERED that either party may file a motion to expunge confidential information within thirty (30) days of entry of any order terminating a proceeding identified in the caption.

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