

Party sanctioned for providing confidential transcript of deposition taken in PTAB proceeding with counsel at same firm who were working on parallel district court litigation

DECEMBER 16, 2021

One World Technologies, Inc. d/b/a Techtronic Industries Power Equipment v. Chervon (HK) Ltd., Case Nos. IPR2020-00884, IPR2020-00886, IPR2020-00887, IPR2020-00888 (PTAB Apr. 22, 2021).

Before: Horner, Grossman, Mayberry, Finamore.

In parallel district court litigation, Patent Owner's counsel produced to Petitioner's counsel a copy of a deposition transcript Patent Owner had taken in the IPR proceedings. Patent Owner had included the transcript as an exhibit to the Patent Owner Response along with a motion to seal the transcript exhibit pursuant to the Board's Default Protective Order. At the time of the district court production, the Board had not yet ruled on the motion to seal. The transcript produced in the district court was marked "highly confidential – attorneys' eyes only" pursuant to the district court's protective order. Patent Owner never provided the transcript to anyone outside of the law firms for patent owner and petitioner. Nonetheless, this still entailed production to persons who were not counsel of record in the PTAB proceeding.

The Board granted petitioner's motion for sanctions. The Board first found that there was a violation of the Default Protective Order because the Patent Owner used the protected information for a purpose other than the *inter partes* review proceedings. Producing the transcript to petitioner's counsel with a confidentiality designation pursuant to the district court's protective order did not absolve Patent Owner's counsel. This was because the issue was not whether patent owner reasonably protected the confidentiality of the transcript, but whether Patent Owner improperly used information obtained in the IPR proceedings for a purpose other than the IPR proceedings. And producing the transcript in the district court litigation constituted a "use" of the protected information.

The Board also determined that the Petitioner had suffered harm for two reasons. First, even though the transcript was produced under the district court's protective order, the Board has no control over that protective order and, thus, the production wrests the control from the Board. Second, Patent Owner's misuse erodes the confidence of Petitioner and other parties that the Board will protect its confidential information.

The Board also found that Petitioner's requested sanctions were proportionate to the harm. Accordingly, the Board sanctioned Patent Owner by 1) admonishing Patent Owner to comply with the Default Protective Order, 2) ordering Patent Owner to remove the unredacted transcript, including the index, from the district court production, 3) ordering Patent Owner to identify to Petitioner all individuals who had access to or received the unredacted

transcript or index, and 4) ordering Patent Owner to identify all individuals who signed the acknowledgement in the Default Protective Order.

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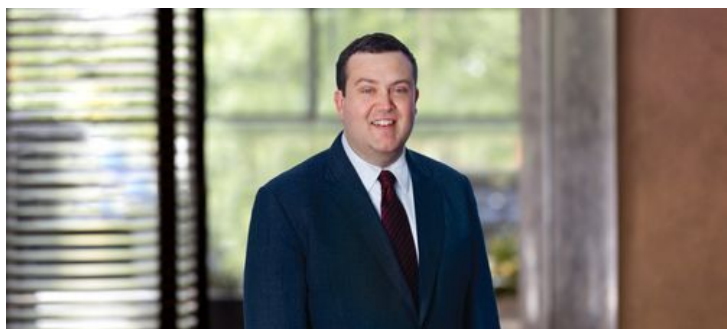
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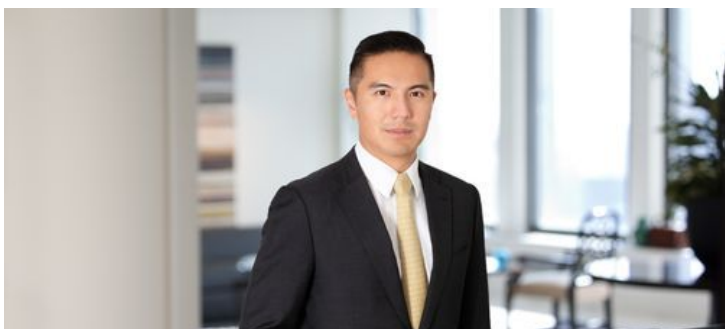
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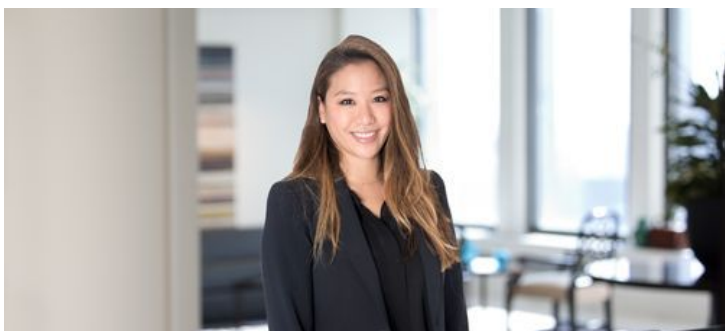
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