

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ATLANTA GAS LIGHT COMPANY
Petitioner

v.

BENNETT REGULATOR GUARDS, INC.
Patent Owner

Case IPR2013-00453
Patent 5,810,029

Before JENNIFER S. BISK, JAMES B. ARPIN, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION
Motion to Compel Production
37 C.F.R. § 42.5 and 42.52

In response to our partial grant of Patent Owner's motion for additional discovery (Paper 40, "Order"), Petitioner produced 113 pages of documents. Paper 48, 1. Portions of the produced documents include redactions of material that Petitioner asserts is protected by the attorney-client privilege or common-interest doctrine, and/or is nonresponsive confidential business information. Paper 50, 2. Pursuant to our authorization, Patent Owner filed a motion (Paper 48, "Mot.") on May 8, 2014, to compel production of unredacted documents or, alternatively, to compel production of unredacted documents for *in camera* review. Petitioner filed an opposition (Paper 50, "Opp.") on May 15, 2014. The motion is *denied*.

Attorney-Client Privilege and Common-Interest Doctrine

"The attorney-client privilege is the oldest of the privileges for confidential communications known to the common law. Its purpose is to encourage full and frank communication between attorneys and their clients and thereby promote broader public interests in the observance of law and administration of justice." *Upjohn Co. v. U.S.*, 449 U.S. 383, 389 (1981). The common-interest doctrine derives from the attorney-client privilege and acts as an exception to waiver of the attorney-client privilege "by facilitating cooperative efforts among parties who share common interests." *U.S. Fire Ins. Co. v. Bunge North America, Inc.*, 2006 WL 3715927 at *2 (D. Kan. 2006).

In addressing assertion of the common-interest doctrine by Petitioner, Patent Owner acknowledges that a "written joint defense agreement between the parties is not necessarily required in order to avoid a waiver," but argues that Petitioner is required to establish that an agreement nonetheless exists in some form. Mot. 8. Patent Owner contends that Petitioner "has failed to establish the existence of an

oral or written joint defense agreement or that such an agreement was in place prior to when the first relevant communications occurred.” *Id.*

Petitioner represents that only a single document in its production was redacted solely based on attorney-client privilege, and that the document is “an email communication from Petitioner’s Vice President of Supply Chain & Fleet to in-house counsel in connection with seeking legal advice on the indemnity dispute.” Opp. 5. In addition, Petitioner and McJunkin Red Man Corporation (“MRMC”) were defendants in *Bennett Regulator Guards, Inc. v. Atlanta Gas Light Company*, Civil Action 5:12-cv-1040, pending in the United States District Court for the Northern District of Ohio. *See* Paper 31, 8. Petitioner now represents that, throughout that lawsuit, “communications between counsel for co-defendants [Petitioner] and MRMC were subject to an oral, and later written, Joint Defense Agreement.” Opp. 2–3. Petitioner further represents that it “produced its communications with MRMC regarding the indemnity dispute and redacted the portions protected by the common interest [doctrine],” providing support for its representations through the context of the unredacted portions of the documents. *Id.* at 3–5.

Petitioner’s representations are signed by a registered practitioner, and we credit them as made with the certifications set forth in 37 C.F.R. § 11.18 (b). We conclude that Petitioner has demonstrated adequately that its assertions of attorney-client privilege and common-interest doctrine are consistent with our order (Paper 40).¹

¹ Our decision continues to be guided by application of the factors set forth in *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case No. IPR2012-00001, Paper 26, 6–7 (PTAB, Mar. 5, 2013). *See* Order 4. Patent Owner provides a number of speculative arguments regarding the potential nature of the redacted material: “[S]ince they disagreed about indemnity issues, they also *may* have disagreed

Confidential Business Information

In addition to its assertions of attorney-client privilege and common-interest doctrine, Petitioner redacted “references to specific financial data and a telephone conference login for Petitioner’s counsel.” Opp. 6. Patent Owner contends that Petitioner “has provided no reason to redact business information such as prices or telephone numbers,” noting that the parties have agreed to be bound by the terms of the Board’s default protective order. Mot. 9 (citing Paper 16).

We are not persuaded by Patent Owner’s argument, which does not establish convincingly more than a possibility of finding something useful in the redacted business information. Agreement by the parties to be bound by a protective order does not diminish the relevance of application of the *Garmin* factors. See n.1, *supra*.

It is

ORDERED that Patent Owner’s motion to compel production of unredacted documents or, in the alternative, to compel production of unredacted documents to the Board for *in camera* review is *denied*.

about who would pay for the [*inter partes* review], who would be named as petitioner, and when the [petition] would be filed. [Petitioner] *may* have prepared and filed the [p]etition as a partial contribution to its indemnity obligation to MRMC.” Mot. 4–5 (emphasis added). Such speculative contentions are at least partially connate with arguments that we rejected in our order (Paper 40), and which are insufficient to support *in camera* review of the redacted material.

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