

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SEALED AIR CORPORATION,  
Petitioner,

v.

PREGIS INNOVATIVE PACKAGING, INC.,  
Patent Owner.

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Cases: IPR2013-00554 (Patent No. RE38,745)  
IPR2013-00555 (Patent No. RE38,745)  
IPR2013-00556 (Patent No. 6,607,803)  
IPR2013-00557 (Patent No. 7,047,705)  
IPR2013-00558 (Patent No. 7,047,705)<sup>1</sup>

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Before MICHAEL J. FITZPATRICK, CHRISTOPHER L. CRUMBLEY,  
JON B. TORNQUIST, and JENNIFER M. MEYER, *Administrative Patent Judges.*

CRUMBLEY, *Administrative Patent Judge.*

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

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<sup>1</sup> This order summarizes a consolidated initial conference call pertaining to five related cases. We exercise our discretion to issue one decision to be entered in each case. The parties are not authorized to use this style heading in their papers.

IPR2013-00554 (Patent RE38,745)  
IPR2013-00555 (Patent RE38,745)  
IPR2013-00556 (Patent 6,607,803)

IPR2013-00557 (Patent 7,047,705)  
IPR2013-00558 (Patent 7,047,705)

An initial conference call was held on March 27, 2014, at approximately 2:00 p.m., among Jason Cooper representing Petitioner Sealed Air Corporation, Chidambaram Iyer representing Patent Owner Pregis Innovative Packaging, Inc., and Judges Fitzpatrick, Crumbley, Tornquist, and Meyer. Both parties provided lists of proposed motions to the Board prior to the call. Papers 16 and 17.<sup>2</sup> The following matters were discussed.

*Scheduling Order.* Neither party expressed any concerns with the dates set in the Scheduling Orders entered on March 6, 2014. Paper 14.

*Protective Order.* Neither party indicated that a protective order was required at this stage of the proceeding. Pregis expressed its view that the Board's default protective order (*see Office Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,769 (Aug. 14, 2012) (Appendix B)) would be acceptable in this case. The parties were reminded that a proposed protective order must be filed with the Board before it will be entered, even if the parties have agreed to use the Board's default protective order. 37 C.F.R. § 42.54(a).

*Objections to Evidence and Supplemental Evidence.* Sealed Air requested guidance regarding the Board's procedure for filing supplemental evidence pursuant to 37 C.F.R. § 42.64(b)(2). As Sealed Air correctly noted, the Board's Rules permit the service of supplemental evidence on an opposing party in response to an evidentiary objection under 37 C.F.R. § 42.64(b)(1). The Rules, however, do not provide for such evidence to be filed with the Board. Sealed Air inquired as to the proper procedure for making the Board aware of supplemental evidence.

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<sup>2</sup> Unless otherwise noted, all citations are to the record in IPR2013-00554 and are considered representative of all five cases.

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In some cases, the Board anticipates that a party's objection to evidence may be overcome by later-served supplemental evidence. In such situations, the objection would not become the basis of a motion to exclude evidence under 37 C.F.R. § 42.64(c), and the Board need not be made aware of the objection or the supplemental evidence. For this reason, the Rules do not provide for the filing of evidentiary objections or supplemental evidence during the initial stages of a proceeding.

If the parties are unable to resolve an evidentiary dispute, the objecting party may file a motion to exclude evidence. In such situations, the other party is entitled to file an opposition to the motion to exclude, which may be accompanied by exhibits containing any previously-served supplemental evidence. The Board is, therefore, made aware of supplemental evidence only in situations in which an evidentiary dispute between the parties cannot be resolved.

During the call, the Board noted that Pregis had previously filed its evidentiary objections with the Board. Paper 15. In light of the Board's explanation summarized above, Pregis agreed to withdraw the filing of its objections. The filings will be expunged from the records of these proceedings.

*Motion to Expunge Exhibit 1008.* Sealed Air requested authorization to file motions in IPR2013-00554 and IPR2013-00555 to expunge Exhibit 1008, a copy of the file history of Patent RE38,749. According to Sealed Air, the version that was filed with its petitions contains confidential information protected by the attorney-client privilege or work product doctrine. Paper 17, 2. Sealed Air offered to replace the exhibit with a certified copy of the publically available file history.

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The parties agreed to work together to identify any potentially privileged information in as-filed Exhibit 1008, and propose a redacted version of the previously-filed copy, thereby preserving the page numbers in the previous exhibit. The Board gave the parties five business days to agree to redactions or request another conference call with the Board to discuss any remaining disagreements.

*Motion to Amend Claims.* Pregis indicated that it is contemplating a motion to amend claims, but had not yet made a final determination whether to file such a motion. The Board counseled Pregis to review the Board's prior decisions, in particular *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027 (PTAB June 11, 2013) (Papers 26, 66) and *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00423 (PTAB Mar. 7, 2014) (Paper 27), which discuss the requirements of a motion to amend. Pregis agreed to request another conference call with the Board if it intends to file a motion to amend, to satisfy the confer requirement of 37 C.F.R. § 42.121(a).

*Other Motions.* Pregis' motions list included two additional motions. First, Pregis requested authorization to consolidate cross-examination of declarants in the five proceedings into one deposition. Paper 16, 1. The parties agreed to discuss the efficient scheduling of the depositions without the Board's involvement, and, therefore, authorization for such a motion was not granted.

Second, Pregis requested authorization for additional discovery relating to materials reviewed by, provided to, or produced by Sealed Air's expert witnesses. *Id.* at 2. Pregis admitted during the call, however, that it had not discussed any of this additional discovery with counsel for Sealed Air. The Board reminded the parties that they are permitted to agree to additional discovery under 37 C.F.R. § 42.51(b)(2)(i), and encouraged the parties to do so prior to requesting the Board's

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involvement. The Board did not authorize a motion for additional discovery at this time.

In light of the foregoing, it is

ORDERED that the following improperly-filed objections to evidence are to be expunged from the record:

IPR2013-00554, Paper 15;  
IPR2013-00555, Paper 14;  
IPR2013-00556, Paper 13;  
IPR2013-00557, Paper 14;  
IPR2013-00558, Paper 12;

FURTHER ORDERED that the parties are to inform the Board on or before April 4, 2014, that they have agreed to a substitute Exhibit 1008, or request a conference call with the Board to discuss any remaining disagreement; and

FURTHER ORDERED that Pregis shall confer with the Board pursuant to 37 C.F.R. § 42.121(a) prior to filing a motion to amend claims.

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FOR PETITIONER:

Jason P. Cooper  
Kirk T. Bradley  
Christopher Kelly  
ALSTON & BIRD LLP  
jason.cooper@alston.com  
kirk.bradley@alston.com  
chris.kelly@alston.com

FOR PATENT OWNER:

Henry Lebowitz  
Richard M. Koehl  
FRIED, FRANK, HARRIS, SHRIVER  
henry.lebowitz@friedfrank.com  
richard.koehl@friedfrank.com

Chidambaram S. Iyer  
SUGHRUE MION, PLLC  
ciyer@sughrue.com