

Filed on behalf of SurfCast, Inc.

By: Richard G. A. Bone ([RBone@VLPLawGroup.com](mailto:RBone@VLPLawGroup.com))

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION  
Petitioner

v.

SURFCAST, INC.  
Patent Owner

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Case IPR2013-00292<sup>1</sup>  
Patent 6,724,403

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SURFCAST, INC.'S  
PATENT OWNER MOTION TO SEAL EXHIBITS  
UNDER 37 C.F.R. § 42.14

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<sup>1</sup> Cases IPR2013-00293, IPR2013-00294, and IPR2013-00295 have been consolidated with the instant proceeding.

Patent Owner's authorization to file this Motion to Seal was given by the Board at a conference call between the Board and the parties' counsel, on Tuesday February 4, 2014.

## **Procedure**

When Patent Owner timely filed its Patent Owner Response under 35 U.S.C. § 316(a)(8), on January 24, 2014, (paper No. 27), it marked a number of the accompanying exhibits as "confidential". A list of those exhibits whose confidentiality is being requested is attached hereto as Appendix A, and is referred to herein as "the Confidential Exhibits". Patent Owner further designated the "Availability" of the Confidential Exhibits as "Parties and Board Only" when uploading them into the Board's Patent Review Processing System (PRPS).

Patent Owner understands the Board to have taken the position that the Confidential Exhibits have been covered by the Board's default protective order, with retroactive effect to January 24, 2014.

Petitioner's counsel kindly informed Patent Owner's counsel, by e-mail letter on January 29, 2014, that Petitioner agreed to maintain the confidentiality of the Confidential Exhibits until Patent Owner either filed a Motion to Seal or waived their confidentiality.

Patent Owner files herewith copies of each exhibit, from the list of Confidential Exhibits, in redacted form for public view, and in unredacted form

(save for redactions necessary to maintain privilege) for the Board's and Parties' eyes only.

Patent Owner notes further that the following Exhibits that were originally marked as "confidential" have been de-designated and thus fall outside of the scope of this motion to seal: Exhibits 2013, 2014, 2019, 2031, 2032, 2042 – 2044, 2047, and 2048.<sup>2</sup> Those exhibits are submitted herewith in unredacted form only, and for public view.

### **Need for Confidentiality**

The confidentiality of the Confidential Exhibits should be preserved by the Board and the parties and their counsel at least because they represent confidential documents created by Patent Owner, and also include confidential and privileged communications between Patent Owner and Patent Owner's counsel during preparation of the patent application that issued as U.S. Patent No. 6,724,403, ("the '403 patent") whose *inter partes* review is being conducted in the instant proceeding. Thus, the Confidential Exhibits fall into categories as follows:

1. Communications between Patent Owner and Counsel at Pennie & Edmonds LLP: Exhibits 2009, 2015, 2016, 2017, 2018, 2020, 2021,

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<sup>2</sup> The numbers of Exhibits 2043 and 2044 have been interchanged to conform them to their respective citations within the Declarations submitted by Patent Owner, January 24, 2014.

2022, and 2034.

2. Confidential Business documents belonging to Patent Owner. Exhibit 2023, 2037 – 2041, 2045, and 2046.
3. Other documents generated by Patent Owner’s Counsel: Exhibits 2010, 2033, 2035, 2049, and 2050.
4. Documents that include privileged information as between Patent Owner’s counsel and other clients of Patent Owner’s counsel’s firm: Exhibit 2035.
5. Communications between one or both inventors, with or without other Patent Owner personnel. Exhibits 2011, 2012, 2024 – 2030, 2036, 2067, and 2068.
6. Other documents: Exhibit 2023, 2051, 2052, and 2065.

Patent Owner understands that there is a “strong public policy for making all information filed in” an *inter partes* review open to the public because the review “determines the patentability of claims in an issued patent and therefore affects the rights of the public.” IPR 2012-00001 at Paper No. 34. Nevertheless, Patent Owner has maintained consistently that the Confidential Exhibits are confidential, and has previously obtained a protective order assuring their confidentiality in a concurrent litigation involving the ’403 patent. (*SurfCast, Inc. v. Microsoft Corp.*, in U.S. District Court for the District of Maine, Docket No. 2:12-cv-00333-JAW).

## **Protective Order**

Patent Owner has conferred with counsel for Petitioner regarding the form of a possible Protective Order that can be applied to the Confidential Exhibits, a copy of which is attached hereto as Appendix B, and in redline form as Appendix C. It differs from the Board's default order (Trial Practice Guide, Appendix B, 77 Fed. Reg. 48770) only in that it limits Petitioner's in-house counsel who may access the Confidential Exhibits to two (2) named individuals (see amendment to Section 2(E), and the commensurate deletion of Section 2(A), as not applicable in the instant situation). The parties have agreed to these terms.

Patent Owner therefore hereby requests that the Board accept the instant motion to Seal, and maintains the confidentiality of Patent Owner's Confidential Exhibits, as listed hereto.

Respectfully submitted by:

/Richard G. A. Bone/

Dated: February 10, 2014

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Attorney for SurfCast, Inc.

**Appendix A**  
**Patent Owner Exhibits Marked as “Parties and Board Only”**

<b>Exhibit No.</b>	<b>Description</b>
2009*	Letter from Andrew J. Gray IV, Esq. to Ovid Santoro, dated prior to June 29, 1999 referencing presentation (partially redacted)
2010	Pennie & Edmonds billing invoice, November 16, 1999 (partially redacted)
2011	E-mail from Tom Dechaene to Ovid Santoro and Klaus Lagermann
2012	August 1999 e-mails between Klaus Lagermann and Ovid Santoro (partially redacted)
2015	September 19, 1999 e-mail from Ovid Santoro to Paul Destefano, Andrew Gray, Tom Dechaene, and Klaus Lagermann
2016	September 20, 1999 e-mail from Ovid Santoro to Tom Dechaene, Klaus Lagermann, Paul DeStefano, and Andrew Gray
2017	October 1999 e-mails between Ovid Santoro, Bob Carberry, and Pennie & Edmonds regarding review of draft application
2018	August 10, 1999 e-mail from Klaus Lagermann to Richard Bone
2020	August 19, 1999 e-mail from Klaus Lagermann to Richard Bone
2021	Attachment to August 19, 1999 e-mail from Klaus Lagermann to Richard Bone (partially redacted)
2022	August 24, 1999 e-mail from Klaus Lagermann to Richard Bone (partially redacted)
2023	Ovid Santoro Notebook
2024	E-mails between Klaus Lagermann, Dixon Dick and Ovid Santoro prior to June 29, 1999 (partially redacted)
2025	E-mails between Klaus Lagermann and Ovid Santoro dated prior to June 29, 1999 (partially redacted)
2026	E-mails between Klaus Lagermann and Ovid Santoro dated prior to June 29, 1999 (partially redacted)
2027	E-mails between Klaus Lagermann and Ovid Santoro dated prior to June 29, 1999 (partially redacted)
2028	E-mails between Klaus Lagermann and Ovid Santoro dated prior to June 29, 1999 (partially redacted)
2029	E-mails between Klaus Lagermann and Ovid Santoro dated prior to June 29, 1999 (partially redacted)
2030	July 11, 1999 e-mail from Klaus Lagermann to Ovid Santoro

<b>Exhibit No.</b>	<b>Description</b>
2033	Coversheet and Engagement Letter with Pennie & Edmonds LLP, dated April 12 – 21, 1999
2034	August 22, 1999 e-mail from Ovid Santoro to Paul DeStefano, Klaus Lagermann, and Tom Dechaene, providing description of SurfCast product (partially redacted)
2035	Time entry logbook of Richard Bone, June – October, 1999 (partially redacted)
2036	E-mails between Klaus Lagermann and Ovid Santoro prior to June 29, 1999 (partially redacted)
2037	Written summary of work on the SurfCast software product, from prior to June 29, 1999 (partially redacted)
2038	Written summary of work on the SurfCast software product, from prior to June 29, 1999 (partially redacted)
2039	Revised version of Executive Summary, September 1999
2040	SurfCast Executive Summary 1999 – 2000
2041	Photographs from 1999 meeting showing flip chart
2045	SurfCast Business Plan 1999 – 2000
2046	SurfCast Executive Summary 1999 – 2000
2049	Pennie & Edmonds LLP bills for legal services, dated August 14, 1999 (partially redacted)
2050	FAX transmission within Pennie & Edmonds LLP regarding SurfCast bills for legal services (partially redacted)
2067	E-mail and attachment from Ovid Santoro to Klaus Lagermann regarding SurfCast summary, dated prior to June 29, 1999 (partially redacted)
2068	E-mail and attachment from Ovid Santoro to Klaus Lagermann regarding SurfCast summary dated prior to June 29, 1999 (partially redacted)

\* Exhibit 2009 was originally filed on January 24, 2014, largely redacted, with no confidentiality designation. It is resubmitted herewith, with less redaction and designated as confidential.

**APPENDIX B**  
**Protective Order**

This protective order governs the treatment and filing of confidential information, including documents and testimony.

1. Confidential information shall be clearly marked “PROTECTIVE ORDER MATERIAL.”
2. Access to confidential information is limited to the following individuals who have executed the acknowledgment appended to this order:
  - (A) Party Representatives. Representatives of record for a party in the proceeding.
  - (B) Experts. Retained experts of a party in the proceeding who further certify in the Acknowledgement that they are not a competitor to any party, or a consultant for, or employed by, such a competitor with respect to the subject matter of the proceeding.
  - (C) In-house counsel. Two (2) designated in-house counsel for Microsoft as named below may have access to PROTECTIVE ORDER MATERIAL, provided that each in-house attorney who is given access to such information has executed the below Acknowledgement. The two designated in-house counsel for Microsoft are: Stacy Quan and Andrew Culbert.



- (D) Other Employees of a Party. Employees, consultants or other persons performing work for a party, other than in-house counsel and in-house counsel's support staff, who sign the Acknowledgement shall be extended access to confidential information only upon agreement of the parties or by order of the Board upon a motion brought by the party seeking to disclose confidential information to that person. The party opposing disclosure to that person shall have the burden of proving that such person should be restricted from access to confidential information.
- (E) The Office. Employees and representatives of the Office who have a need for access to the confidential information shall have such access without the requirement to sign an Acknowledgement. Such employees and representatives shall include the Director, members of the Board and their clerical staff, other support personnel, court reporters, and other persons acting on behalf of the Office.
- (F) Support Personnel. Administrative assistants, clerical staff, court reporters and other support personnel of the foregoing persons who are reasonably necessary to assist those persons in the proceeding shall not be required to sign an Acknowledgement, but shall be informed of the terms and requirements of the Protective Order by the person they are supporting who receives confidential information.

3. Persons receiving confidential information shall use reasonable efforts to maintain the confidentiality of the information, including:

- (A) Maintaining such information in a secure location to which persons not authorized to receive the information shall not have access;
- (B) Otherwise using reasonable efforts to maintain the confidentiality of the information, which efforts shall be no less rigorous than those the recipient uses to maintain the confidentiality of information not received from the disclosing party;
- (C) Ensuring that support personnel of the recipient who have access to the confidential information understand and abide by the obligation to maintain the confidentiality of information received that is designated as confidential; and
- (D) Limiting the copying of confidential information to a reasonable number of copies needed for conduct of the proceeding and maintaining a record of the locations of such copies.

4. Persons receiving confidential information shall use the following procedures to maintain the confidentiality of the information:

- (A) Documents and Information Filed With the Board.

- (i) A party may file documents or information with the Board under seal, together with a non-confidential description of the nature of the confidential information that is under seal and the reasons why the information is confidential and should not be made available to the public. The submission shall be treated as confidential and remain under seal, unless, upon motion of a party and after a hearing on the issue, or *sua sponte*, the Board determines that the documents or information do not to qualify for confidential treatment.
- (ii) Where confidentiality is alleged as to some but not all of the information submitted to the Board, the submitting party shall file confidential and non-confidential versions of its submission, together with a Motion to Seal the confidential version setting forth the reasons why the information redacted from the non-confidential version is confidential and should not be made available to the public. The nonconfidential version of the submission shall clearly indicate the locations of information that has been redacted. The confidential version of the submission shall be filed under seal. The redacted information shall remain under seal unless, upon motion of a party and after a hearing on the issue, or *sua sponte*, the Board determines that some or all of the redacted information does not qualify for confidential treatment.

(B) Documents and Information Exchanged Among the Parties. Information

designated as confidential that is disclosed to another party during discovery or other proceedings before the Board shall be clearly marked as

“PROTECTIVE ORDER MATERIAL” and shall be produced in a manner that maintains its confidentiality.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Case IPR2013-00292<sup>1</sup>

Patent 6,724,403

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STANDARD ACKNOWLEDGMENT FOR ACCESS TO PROTECTIVE  
ORDER MATERIAL

I \_\_\_\_\_, affirm that I have read the Protective Order; that I will abide by its terms; that I will use the confidential information only in connection with this proceeding and for no other purpose; that I will only allow access to support staff who are reasonably necessary to assist me in this proceeding; that prior to any disclosure to such support staff I informed or will inform them of the requirements of the Protective Order; that I am personally responsible for the requirements of the terms of the Protective Order and I agree to submit to the jurisdiction of the Office and the United States District Court for the Eastern District of Virginia for purposes of enforcing the terms of the Protective Order and providing remedies for its breach.

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[Signature]

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<sup>1</sup> Cases IPR2013-00293, IPR2013-00294, and IPR2013-00295 have been consolidated with the instant proceeding.

## APPENDIX C

### Changes to Standing Protective Order

This ~~standing~~ protective order governs the treatment and filing of confidential information, including documents and testimony.

1. Confidential information shall be clearly marked “PROTECTIVE ORDER MATERIAL.”

2. Access to confidential information is limited to the following individuals who have executed the acknowledgment appended to this order:

(A) ~~Parties. Persons who are owners of a patent involved in the proceeding and other persons who are named parties to the proceeding.~~

~~(B)~~ Party Representatives. Representatives of record for a party in the proceeding.

~~(C)~~ Experts. Retained experts of a party in the proceeding who further certify in the Acknowledgement that they are not a competitor to any party, or a consultant for, or employed by, such a competitor with respect to the subject matter of the proceeding.

~~(D)~~ In-house counsel. ~~In-house counsel of a party. Two (2) designated in-house counsel for Microsoft as named below may have access to PROTECTIVE ORDER MATERIAL, provided that each in-house attorney who is given access to such information has executed the below~~

Acknowledgement. The two designated in-house counsel for Microsoft are:  
Stacy Quan and Andrew Culbert.

(~~D~~E) Other Employees of a Party. Employees, consultants or other persons performing work for a party, other than in-house counsel and in-house counsel's support staff, who sign the Acknowledgement shall be extended access to confidential information only upon agreement of the parties or by order of the Board upon a motion brought by the party seeking to disclose confidential information to that person. The party opposing disclosure to that person shall have the burden of proving that such person should be restricted from access to confidential information.

(~~E~~F) The Office. Employees and representatives of the Office who have a need for access to the confidential information shall have such access without the requirement to sign an Acknowledgement. Such employees and representatives shall include the Director, members of the Board and their clerical staff, other support personnel, court reporters, and other persons acting on behalf of the Office.

(~~F~~G) Support Personnel. Administrative assistants, clerical staff, court reporters and other support personnel of the foregoing persons who are reasonably necessary to assist those persons in the proceeding shall not be required to sign an Acknowledgement, but shall be informed of the terms and

requirements of the Protective Order by the person they are supporting who receives confidential information.

3. Persons receiving confidential information shall use reasonable efforts to maintain the confidentiality of the information, including:

- (A) Maintaining such information in a secure location to which persons not authorized to receive the information shall not have access;
- (B) Otherwise using reasonable efforts to maintain the confidentiality of the information, which efforts shall be no less rigorous than those the recipient uses to maintain the confidentiality of information not received from the disclosing party;
- (C) Ensuring that support personnel of the recipient who have access to the confidential information understand and abide by the obligation to maintain the confidentiality of information received that is designated as confidential; and
- (D) Limiting the copying of confidential information to a reasonable number of copies needed for conduct of the proceeding and maintaining a record of the locations of such copies.

4. Persons receiving confidential information shall use the following procedures to maintain the confidentiality of the information:



(A) Documents and Information Filed With the Board.

- (i) A party may file documents or information with the Board under seal, together with a non-confidential description of the nature of the confidential information that is under seal and the reasons why the information is confidential and should not be made available to the public. The submission shall be treated as confidential and remain under seal, unless, upon motion of a party and after a hearing on the issue, or *sua sponte*, the Board determines that the documents or information do not to qualify for confidential treatment.
- (ii) Where confidentiality is alleged as to some but not all of the information submitted to the Board, the submitting party shall file confidential and non-confidential versions of its submission, together with a Motion to Seal the confidential version setting forth the reasons why the information redacted from the non-confidential version is confidential and should not be made available to the public. The nonconfidential version of the submission shall clearly indicate the locations of information that has been redacted. The confidential version of the submission shall be filed under seal. The redacted information shall remain under seal unless, upon motion of a party and after a hearing on

the issue, or *sua sponte*, the Board determines that some or all of the redacted information does not qualify for confidential treatment.

(B) Documents and Information Exchanged Among the Parties. Information designated as confidential that is disclosed to another party during discovery or other proceedings before the Board shall be clearly marked as “PROTECTIVE ORDER MATERIAL” and shall be produced in a manner that maintains its confidentiality.

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STANDARD ACKNOWLEDGMENT FOR ACCESS TO PROTECTIVE  
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[Signature]

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<sup>1</sup> Cases IPR2013-00293, IPR2013-00294, and IPR2013-00295 have been consolidated with the instant proceeding.

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)(4)

It is hereby certified that on this 10 day of February, 2014, a copy of the foregoing

PATENT OWNER MOTION TO SEAL EXHIBITS  
UNDER 37 C.F.R. § 42.14

was served via Electronic Mail upon the following:

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By:

/Richard G. A. Bone/  
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