

Filed on behalf of SurfCast, Inc.

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

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

SURFCAST, INC.
Patent Owner

Case IPR2013-00292¹
Patent 6,724,403

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

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

Patent Owner files herewith the deposition transcripts (the “Transcripts”) of Patent Owner witnesses Ovid Santoro and Tom Dechaene, with the designation “for the Board’s and Parties’ eyes only”, accompanied by public versions that are partially redacted.

Patent Owner’s counsel conferred with Petitioner’s counsel, who agreed not to oppose the attendant Patent Owner’s Motion to Seal, and to maintain the confidentiality of the Transcripts until Patent Owner filed a Motion to Seal.

Indeed Petitioner has filed versions of unsigned copies of the Transcripts marked as “Confidential”, and marked with Petitioner’s Exhibit numbers, accompanying the Petitioner’s Reply, on March 31, 2014.

Need for Confidentiality

The confidentiality of the Transcripts should be preserved by the Board and the parties and their counsel at least because they contain confidential information of a personal nature for the two respective witnesses. Thus, the material that Patent Owner has redacted from the Transcripts and requests to be maintained as confidential is as follows:

- Ovid Santoro: the witness’s testimony regarding his personal health; and
- Tom Dechaene: the witness’s testimony regarding his personal finances.

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 believes that the information redacted from the Transcripts is not material to the patentability of the claims of the ’403 Patent and therefore that there should be no objection to keeping the redacted material out of the public record.

Protective Order

Patent Owner has previously established a Protective Order in the instant *Inter Partes* Review (Paper No. 33). Patent Owner’s counsel has conferred with Petitioner’s counsel to solicit agreement that the Protective Order already of record will apply to the items now filed under seal.

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 in the aggregate hereto.

Respectfully submitted by:

/Richard G. A. Bone/

Dated: April 3rd, 2014

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Appendix A
Cumulative List of
Patent Owner Exhibits Marked as “Parties and Board Only”

Exhibit No.	Description
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

Exhibit No.	Description
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)
2074 (NEW)	Deposition Transcript of Ovid Santoro (signed), dated February 27, 2014
2076 (NEW)	Deposition Transcript of Tom Dechaene (signed), dated March 11, 2014

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

It is hereby certified that on this 3rd day of April, 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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