

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

Before MICHAEL P. TIERNEY, JONI Y. CHANG, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

DECISION
Motion to Seal
37 C.F.R. §§ 42.14 and 42.54

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

INTRODUCTION

On April 3, 2014, SurfCast, Inc. (“Patent Owner”) filed a Motion to Seal requesting to seal the unredacted deposition transcripts of Ovid Santoro and of Tom Dechaene, which were filed as Exhibits 2074 and 2076, respectively. Paper 49. The exhibits are deposition transcripts that include, *inter alia*, testimony about personal health and personal financial matters. *Id.* at 1. Patent Owner also filed public versions of the exhibits that are partially redacted. *Id.*

DISCUSSION

There is a strong public policy for making all information filed in a quasi-judicial administrative proceeding open to the public, especially in an *inter partes* review which determines the patentability of claims in an issued patent and therefore affects the rights of the public. Under 35 U.S.C. § 316(a)(1), the default rule is that all papers filed in an *inter partes* review are open and available for access by the public; and a party may file a concurrent motion to seal and the information at issue is sealed pending the outcome of the motion.

Similarly, 37 C.F.R. § 42.14 provides:

The record of a proceeding, including documents and things, shall be made available to the public, except as otherwise ordered. A party intending a document or thing to be sealed shall file a motion to seal concurrent with the filing of the document or thing to be sealed. The document or thing shall be provisionally sealed on receipt of the motion and remain so pending the outcome of the decision on the motion.

It is, however, only “confidential information” that is protected from disclosure. 35 U.S.C. § 316(a)(7)(“The Director shall prescribe regulations -- . . .

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providing for protective orders governing the exchange and submission of confidential information”). In that regard, note the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012), which provides:

The rules aim to strike a balance between the public’s interest in maintaining a complete and understandable file history and the parties’ interest in protecting truly sensitive information.

* * *

Confidential Information: The rules identify confidential information in a manner consistent with Federal Rule of Civil Procedure 26(c)(1)(G), which provides for protective orders for trade secret or other confidential research, development, or commercial information. § 42.54.

The standard for granting a motion to seal is “for good cause.” 37 C.F.R. § 42.54. Patent Owner, as the moving party, has the burden of proof in showing entitlement to the requested relief. 37 C.F.R. § 42.20(c). We need to know why the information sought to be sealed constitutes confidential information. A motion to seal is required to include a proposed protective order and a certification that the moving party has, in good faith, conferred or attempted to confer with the opposing party in an effort to come to an agreement as to the scope of the proposed protective order for this *inter partes* review. 37 C.F.R. § 42.54.

Patent Owner represents that it has conferred with Petitioner and that Petitioner does not oppose Patent Owner’s Motion to Seal. Paper 49, 1-2.

Exhibit 2074, the deposition transcript of Ovid Santoro, includes testimony regarding confidential person health issues that have nothing to do with the merits of this case. Accordingly, the public has no interest in having access to the unredacted version of Exhibit 2074.

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Exhibit 2076, the deposition transcript of Tom Dechaene, includes testimony regarding confidential personal finances that have little, if any, bearing on the merits of this case. Accordingly, the public's interest in having access to an unredacted version Exhibit 2076 is minimal, if any.

Upon consideration of Patent Owner's Motion to Seal, we determine that there is good cause for granting the Motion to Seal. When determining whether Patent Owner has established good cause for sealing the evidence, we balance Patent Owner's needs in protecting the above-identified personal confidential information and the public's interest in maintaining a complete and understandable file history of this *inter partes* review of the '430 patent. Based on our review as discussed above, we determine that there is good cause for protecting Exhibits 2074 and 2076 by placing them under seal because the information is personal confidential and has little relevance to the merits of any substantive issue. We see little harm to the public's interest in restricting access to the information

CONCLUSION

For the foregoing reasons, Patent Owner's Motion to Seal is *granted*.

ORDER

It is ORDERED that Exhibits 2074 and 2076 will be kept under seal.

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IPR2013-00294, and IPR2013-00295
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