

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 January 24, 2014, SurfCast, Inc. (“Patent Owner”) filed its Patent Owner Response (Paper 27) and accompanying Exhibits 2003-2062, and 2064-2071. When uploading the exhibits into PRPS, Patent Owner designated the exhibits “Parties and Board Only.”

On February 10, 2014, SurfCast, Inc. (“Patent Owner”) filed a Motion to Seal (“First Motion to Seal”) requesting to seal Exhibits 2009-2012, 2015-2018, 2020-2030, 2033-2041, 2045, 2046, 2049, 2050, 2067, and 2068. Paper 33.

Patent Owner also filed two more versions of each of Exhibits 2009-2012, 2015-2018, 2020-2030, 2033-2041, 2045, 2046, 2049, 2050, 2067, and 2068, “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.” *Id.* at 1-2. Patent Owner indicated that one version of Exhibit 2009 was intended to replace the version of Exhibit 2009 uploaded on January 24, 2014. *Id.* at 6, n. *.

Patent Owner also de-designated several exhibits previously stamped as “confidential”: Exhibits 2013, 2014, 2019, 2031, 2032, 2042-44, 2047, and 2048. *Id.* at 2.

Patent Owner also re-filed as Exhibit 2044 the document originally filed as Exhibit 2043, and re-filed as Exhibit 2043 the document originally filed as Exhibit 2044. *Id.* at 2, n. 2.

Patent Owner also submitted a joint proposed protective order (*id.* at 7-12), and a redline showing how the proposed protective order differs from the Board’s default protective order (*id.* at 13-18). The Board hereby enters the protective order. As a consequence, the proposed protective order governs the treatment and filing of confidential information in this proceeding.

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 -- . . . 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

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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.

Confidential information will be made public where the existence of the information is identified in a final written decision following a trial. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012)).

Upon consideration of Patent Owner’s Motion to Seal, we determine that Patent Owner has not shown good cause for granting the Motion to Seal. Patent Owner categorizes the exhibits into six categories:

1. Communications between Patent Owner and Counsel at Pennie & Edmonds LLP (Exs. 2009, 2015-2018, 2020-2022, and 2034)
2. Confidential Business documents belonging to Patent Owner (Exs. 2023, 2037-2041, 2045, and 2046)
3. Other documents generated by Patent Owner’s Counsel (Exs. 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 (Ex. 2035)²

5. Other documents (Exs. 2023, 2051, 2052, and 2065)³

Paper 33, 2-3. Categorizing the documents, however, does tell the Board why the information sought to be sealed constitutes confidential information. Patent Owner also indicates that it (1) has maintained consistently that the Exhibits are confidential; and (2) previously obtained, in the related district court proceeding, a protective order assuring the confidentiality of these documents in that proceeding. *Id.* at 3. Those representations, by themselves, are insufficient to show good cause for granting the Motion to Seal.

Patent Owner should file a renewed Motion to Seal that explains, with specificity, why the information sought to be sealed constitutes confidential information. For example, Exhibit 2009 is a partially redacted letter from Andrew J. Gray IV, Esq., to Ovid Santoro. In its Motion to Seal, Patent Owner must explain why the non-redacted information in that exhibit constitutes confidential information. Patent Owner has two weeks to file a renewed Motion to Seal.

In addition, it is unclear which version of each exhibit Patent Owner seeks to seal. Patent Owner was authorized to file a belated Motion to Seal the exhibits uploaded on January 24, 2014. Paper 34, 2. Patent Owner then uploaded two

² We note that Exhibit 2035 also is identified in category 3.

³ We note that Exhibit 2023 also is identified in category 2 and that none of Exhibits 2051, 2052, or 2065 are listed in the table appended to Patent Owner's Motion to Seal. Paper 33 at 5-6.

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additional versions of each exhibit with the same name, such that the record now contains three versions of each of Exhibits 2009-2012, 2015-2018, 2020-2030, 2033, 2034, 2036-2041, 2045, 2046, 2049, 2050, 2067, and 2068, and contains four versions of Exhibit 2035. In some cases, the three versions are identical. *See, e.g.*, Exs. 2012, 2015, 2016. In other cases, the three versions are each uniquely redacted. *See, e.g.*, Ex. 2024. In other cases, two versions match and the third is more redacted. *See, e.g.*, Exs. 2010, 2017. In other cases, two versions match and the third is less redacted. *See, e.g.*, Ex. 2009. In other cases, both versions uploaded on February 10, 2014, are less redacted than the version uploaded on January 24, 2014. *See, e.g.*, Ex. 2011. In some cases, none of the versions are unredacted. *See, e.g.*, Ex. 2009. Because Patent Owner was not authorized to upload additional versions of the exhibits, and because the additional exhibits have left the record unclear as to which version of each exhibit Patent Owner seeks to seal, we expunge all of the exhibits uploaded by Patent Owner on February 10, 2014.

To the extent that Patent Owner seeks to replace Exhibit 2009 with a corrected version of Exhibit 2009 that has less redaction and is designated confidential, it should request authorization to file a corrected version of Exhibit 2009. To the extent that Patent Owner seeks to re-file Exhibit 2043 as Exhibit 2044 and to re-file Exhibit 2044 as Exhibit 2043, it should request authorization to file corrected versions of Exhibits 2043 and 2044.

CONCLUSION

For the foregoing reasons, Patent Owner's Motion to Seal is *denied without prejudice*.

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ORDER

It is ORDERED that the protective order is entered and governs the treatment and filing of the confidential information of this proceeding;

FURTHER ORDERED that the Motion to Seal is *denied without prejudice*;

FURTHER ORDERED that the versions of Exhibits 2009-2012, 2015-2018, 2020-2030, 2033-2041, 2045, 2046, 2049, 2050, 2067, and 2068 uploaded to PRPS on February 10, 2014, are expunged;

FURTHER ORDERED that within two weeks of the date of this decision, Patent Owner shall file a renewed Motion to Seal that explains, for each exhibit that Patent Owner moves to seal, why the exhibit should be sealed; and

FURTHER ORDERED that, if Patent Owner does not file a renewed Motion to Seal within two weeks of this decision, all of Exhibits 2009-2012, 2015-2018, 2020-2030, 2033-2041, 2045, 2046, 2049, 2050, 2067, and 2068 will be made public.

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