

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
Renewed 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.

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

INTRODUCTION

On May 13, 2014, SurfCast, Inc. (“Patent Owner”) filed a Renewed Motion to Seal, requesting to seal Exhibits 2011, 2039, 2040, 2045, and 2046 and requesting authorization to file corrected versions of Exhibits 2009, 2043, and 2044. Paper 64. Exhibits 2011, 2039, 2040, 2045, and 2046 contain confidential financial information relating to valuation, fundraising goals, and budgetary estimates, and Exhibit 2046 further contains confidential salary information for Patent Owner’s officers and staff in 1999/2000. *Id.* at 3-5.

MOTION TO SEAL

There is a strong public policy for making all information filed in a quasijudicial 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.

Cases IPR2013-00292, IPR2013-00293,
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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 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.

The confidential financial information in Exhibits 2011, 2039, 2040, 2045, and 2046 has nothing to do with the merits of this case. Accordingly, the public

Cases IPR2013-00292, IPR2013-00293,
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has little, if any, interest in having access to the unredacted versions of Exhibits 2011, 2039, 2040, 2045, and 2046.

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 confidential information and the public's interest in maintaining a complete and understandable file history of this *inter partes* review of the '403 patent. Based on our review as discussed above, we determine that there is good cause for protecting Exhibits 2011, 2039, 2040, 2045, and 2046 by placing them under seal because the information is 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.

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

REQUEST FOR AUTHORIZATION TO FILE CORRECTED EXHIBITS

Patent Owner seeks to replace Exhibit 2009 with a less redacted version of the same document such that the date shows on pages 1, 2, and 3 of the exhibit. Paper 64, 5-6. Patent Owner represents that the original redactions were the result of a clerical error made in good faith. *Id.*

Patent Owner also seeks to re-file Exhibit 2043 as Exhibit 2044, and to re-file Exhibit 2044 as Exhibit 2043. *Id.* at 6-7. Patent Owner represents that the two exhibits were inadvertently swapped during filing as the result of a clerical error made in good faith. *Id.*

Cases IPR2013-00292, IPR2013-00293,
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The Board authorizes Patent Owner to file Corrected Exhibits 2009, 2043, and 2044 with the changes described in Patent Owner's request. *Id.* at 5-7.

ORDER

It is

ORDERED that Exhibits 2011, 2039, 2040, 2045, and 2046 will be kept under seal; and

FURTHER ORDERED that Patent Owner is authorized to file Corrected Exhibits 2009, 2043, and 2044 with the changes described.

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

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