

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COX COMMUNICATIONS, INC.,  
Petitioner,

v.

AT&T INTELLECTUAL PROPERTY I, L.P.,  
Patent Owner.

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Case IPR2015-01227

Patent 7,907,714

Title: Profile Management System Including User Interface for Accessing and  
Maintaining Profile Data of User Subscribed Telephony Services

**PETITIONER'S MOTION TO EXPUNGE**

## **I. STATEMENT OF PRECISE RELIEF REQUESTED**

Pursuant to 37 C.F.R. § 42.56, Petitioner (“Cox”) respectfully requests that the Board expunge the two confidential exhibits identified below and the confidential versions of both Patent Owner’s Motion for Additional Discovery (Paper 21) and Petitioner’s Opposition to Patent Owner’s Motion for Additional Discovery (Paper 27) before these documents become publicly available. These four documents are referred to collectively herein as the “Confidential Documents.”

If the Board is not inclined to grant this motion, Cox respectfully requests a conference call with the Board to discuss the issues raised in this motion before any information becomes irreversibly public.

<b><u>Exhibit No.</u></b>	<b><u>Description of Confidential Exhibit</u></b>
2026 - Sealed	Transcript of Conference Call Hearing held January 5, 2016.
2031	Letter packet of information received in advance of structured settlement discussions

## **II. STATEMENT OF THE REASONS FOR RELIEF REQUESTED**

### **A. Background**

On January 12, 2016, Patent Owner (“AT&T”) filed Patent Owner’s Motion for Additional Discovery (Paper 21), which was previously authorized by the Board’s Order (Paper 18) and accompanied by Confidential Exhibits 2026 and

2031. These documents contain information relating to confidential structured settlement discussions involving both parties to this proceeding. Accordingly, AT&T designated the confidential Exhibits 2026 and 2031 and its Motion for Additional Discovery for access by the “Parties and Board Only” and concurrently filed a motion to seal these exhibits. (Paper 22.) Redacted, publicly available versions of both Patent Owner’s Motion for Additional Discovery and Exhibit 2026 were also submitted.

On January 20, 2016, Cox filed Petitioner’s Opposition to Patent Owner’s Motion for Additional Discovery (Paper 27) under seal, which included discussion of the confidential information contained in AT&T’s Motion for Additional Discovery and the Confidential Exhibits, already filed under seal. Cox designated its Opposition to Patent Owner’s Motion for Additional Discovery for access by the “Parties and Board Only” and concurrently filed a motion to seal the document. (Paper 25.) A redacted, publicly available version of Petitioner’s Opposition to Patent Owner’s Motion for Additional Discovery was also submitted (Paper 26).

On February 2, 2016, the Board issued Paper 28, granting-in-part Patent Owner’s Motion for Additional Discovery, granting entry of the Board’s default Protective Order, and granting both AT&T’s and Cox’s Motions to Seal the Confidential Documents.

On February 3, 2016, Petitioners entered their “Acknowledgement of Protective Order,” agreeing to the terms of the Default Standing Protective Order. This order requires that “[i]nformation designated as confidential ... shall be clearly marked as ‘PROTECTIVE ORDER MATERIAL’ and shall be produced in a manner that maintains its confidentiality.” (Exhibit 2041.) The Confidential Documents were each properly marked as “Protective Order Material.”

### **B. Legal Standards**

“Confidential information” is protected from disclosure by statute. 35 U.S.C. § 316(a)(7). “Confidential information” is defined as “trade secret or other confidential research, development, or commercial information.” 37 C.F.R. § 42.2. The standard for granting a motion to seal confidential information is “for good cause.” 37 C.F.R. § 42.54. For example, where the details of the confidential business or commercial information are unimportant to the merits of the case and the public’s interest in having access to such information is minimal, such information may be sealed for good cause. *See* 37 C.F.R. § 42.54(a)(7); Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012).

Under 37 C.F.R. § 42.56, information that is confidential may be expunged “after denial of a petition to institute a trial or after final judgment in a trial.” *See also* Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012). A party seeking to maintain the confidentiality of the information may file a motion

to expunge confidential information from the record prior to the information becoming public. *Id.* In determining whether expungement is appropriate, the public interest in availability of the materials is balanced against the extent to which the confidential information is material to the decision. *See* Official Patent Trial Practice Guide, 77 Fed. Reg. at 48,761 (“There is an expectation that information will be made public *where the existence of the information is referred to in a decision* to grant or deny a request to institute a review or is identified in a final written decision following a trial . . . The rule balances the needs of the parties to submit confidential information with the public interest in maintaining a complete and understandable file history....”) (emphasis added).

Critically, where the Final Decision does not rely (or only minimally relies) on the confidential information, the Board has granted the motions to expunge, finding that there is limited public interest in the confidential information and the record is minimally affected. *See e.g.,* Unverferth Mfg. Co. v. J&M Mfg. Co., No. IPR2015-00758, Paper 29 at 2 (P.T.A.B. Sept. 30, 2015) (granting the motion because the final decision did not rely upon the exhibit at issue and “the file and decision remain understandable in the absence of” the exhibit).

### **C. The Confidential Documents Should Be Expunged Because The Board Did Not Rely On Them In Entering Final Judgment**

Where the Board has found no need to rely on documents sought to be protected as sealed in terminating a proceeding, it has expunged those documents

upon entry of judgment. *See* LG Elecs., Inc. v. Cypress Semiconductor Corp., No. IPR 2014-01405, Paper 25, at 2-3 (P.T.A.B. Aug. 6, 2015) (“In entering judgment, we find it unnecessary to rely on documents the Patent Owner seeks to maintain as sealed, and, therefore, we expunge from the record the sealed documents and dismiss the Patent Owner’s motions to seal.” (footnote omitted)).

Here, the Board issued its Final Written Decision without relying on any of the Confidential Documents. Indeed, the Confidential Documents are only directed to an alleged Real Party in Interest theory that AT&T later chose not to pursue in this proceeding, following close of the Additional Discovery period. AT&T expressly withdrew this issue at oral hearing:

JUDGE McSHANE: Put another way, you are withdrawing that issue?

MR. O'BRIEN: We have, Your Honor. We have not briefed it, so I think that's the net effect.

*Record of Oral Hearing, Paper 65, 153:20 – 155:9.*

Because the Board did not rely on the Confidential Documents, where those Confidential Documents were only relevant to a withdrawn issue, it is appropriate to expunge from the record these four sealed Confidential Documents.

**D. The Confidential Documents Contain Sensitive Information That Would Cause Harm If Made Public**

The Parties’ interests in expunging the limited confidential information at issue outweigh the public’s interest in retaining it. In an effort to acknowledge the

public's interest in retaining certain information in the record, the Parties have already filed redacted versions of three of the four Confidential Documents in this proceeding, which redact only the sensitive information at issue. Only Exhibit 2031, which is confidential in its entirety, was filed under seal without a corresponding redacted version. However, Cox submits that the confidential information, either redacted or sealed at present, is unnecessary for maintaining a complete and understandable file history of this *inter partes* review. See Patent Trial Practice Guide, 77 Fed. Reg. at 48,761 (weighing the needs of the parties to submit confidential information against the public interest); *Nichia Corp. v. Emcore Corp.*, No. IPR2012-00005, Paper 70 at 2 (PTAB Apr. 23, 2015) (finding that the redacted public version of the exhibit at issue "provide[d] sufficient information for the public to understand the procedural posture and file history"). Moreover, expunging the Confidential Documents poses no prejudice to either Party.

***1. Exhibit 2026 - Sealed – Transcript of Conference Call Hearing held January 5, 2016***

The sealed version of Exhibit 2026 is a transcript of the conference call hearing held January 5, 2016 between the Parties and the Board in which AT&T sought leave to file a motion for additional discovery. During the conference, certain statements were made regarding details of confidential structured settlement discussions. AT&T moved to seal portions of the transcript and the

Board granted that motion. The public has no interest in these confidential statements, nor did these statements become relevant to the issues in this proceeding. Under these circumstances, Cox submits that it is proper to expunge the sealed version of Exhibit 2026.

**2. *Exhibit 2031 – Letter packet of information received in advance of structured settlement discussions***

Exhibit 2031 is a letter packet of information received in advance of structured settlement discussions. The information describes expectations and procedures prior to, at, and after such discussions, including confidentiality. AT&T moved to seal portions this confidential document and the Board granted that motion. The public has no interest in this confidential material, nor is the document relevant to the issues in this proceeding. Under these circumstances, Cox submits that it is proper to expunge Exhibit 2031.

**3. *AT&T's Motion for Additional Discovery***

AT&T's contemporaneously-filed Motion for Additional Discovery discussed the confidential information reflected in Exhibit 2026 and Exhibit 2031. AT&T moved to seal portions of its Motion for Additional Discovery and the Board granted that motion. The public has no interest in these confidential portions, nor are these portions relevant to the issues in this proceeding. Under these circumstances, Cox submits that it is proper to expunge the sealed version of this Motion (Paper 21).



**4. *Cox's Opposition to Patent Owner's Motion for Additional Discovery***

Cox's Opposition to Patent Owner's Motion for Additional Discovery also discussed the confidential information reflected in Exhibit 2026 and Exhibit 2031, as well as in AT&T's sealed Motion for Additional Discovery. Cox moved to seal portions of its Opposition and the Board granted that motion. The public has no interest in these confidential portions, nor are these portions relevant to the issues in this proceeding. Under these circumstances, Cox submits that it is proper to expunge the sealed version of this Opposition (Paper 27).

**CONCLUSION**

For the foregoing reasons, Cox respectfully requests that the Confidential Documents be expunged from the record of this proceeding.

Dated: December 14, 2016

Respectfully submitted,

By: /Steven M. Bauer/  
Steven M. Bauer, Reg. No. 31,481  
Proskauer Rose LLP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*Inter Partes* Review Case No. IPR2015-01227

*Inter Partes* Review of: U.S. Patent No. 7,907,714

Title: Profile Management System Including User Interface for Accessing and Maintaining Profile Data of User Subscribed Telephony Services

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

Dear Sir:

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on December 14, 2016, I caused a complete copy of PETITIONER'S MOTION TO EXPUNGE to be served on the Patent Owner of the subject *Inter Partes* Review via electronic mail.

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