

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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THE SHERWIN-WILLIAMS COMPANY,  
Petitioner,

v.

ARCH CHEMICALS, INC.,  
Patent Owner

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Case: IPR2019-01497, IPR2019-01498  
U.S. Patent No. 9,723,842

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**UNOPPOSED MOTION TO EXPUNGE PAPER 18 AND  
REQUEST TO REPLACE**



Pursuant to the Board's authorization of February 26, 2020, Patent Owner respectfully files this Unopposed Motion to Expunge Paper 18 and Request to Replace it with a substitute version of Paper 18. Petitioner has indicated that they do not oppose the Patent Owner's Motion to Expunge Paper 18 and Request to Replace.

### **Background**

On February 18, 2020, Patent Owner filed an Unopposed Request to Keep Subject Matter in February 14, 2020 Decision Confidential ("Request"). A confidential version of this paper was filed under seal and a redacted version (Paper 18) was filed for the public. In the Request, Patent Owner asked that the Board's characterization of the Covenant not to Sue between the parties in its Decision of February 14, 2020 (Paper 15) be kept confidential. In the Request, in the second paragraph on page 2, the Request repeats the Board's characterization of the Covenant not to Sue. This subject matter should have been redacted in the public version of the Request, but was not.

### **Argument**

This error was entirely inadvertent. Indeed, this language is the same language from the Decision of February 14, 2020 that Patent Owner is already asking the Board to keep confidential. (See Request (Paper 18), which included the proposed redactions to the Decision of February 14, 2020 (Paper 15) and Patent Owner's Motion to Seal (Paper 16)).



Attached is a substitute version of the Request, identical to the Request filed on February 18, 2020 except that the language of the second paragraph on page 2 of the Request discussed above is redacted. Patent Owner respectfully requests that the Board expunge Paper 18 and replace it with the attached substitute Request. Patent Owner submits that there is good cause to do so, as (1) the error was inadvertent, (2) it is clear that the subject matter at issue is the same subject matter Patent Owner intended to keep confidential in its papers filed February 18, 2020, (3) as discussed in the Request and the Motion to Seal (Paper 16) there is good cause to keep the information confidential, and (4) Patent Owner reached out to the Board seeking permission to address this error as soon as the error was noticed, two days after filing the Request.

Patent Owner respectfully requests that Paper 18 be expunged and replaced with the attached substitute Request.

Dated: February 26, 2020

Respectfully submitted,

/Deborah Yellin/  
Deborah H. Yellin  
Registration No. 45,904  
Michael H. Jacobs  
Registration No. 41,870  
CROWELL & MORING LLP  
1001 Pennsylvania Avenue, N.W.  
Washington, DC 20004-2595

*Attorneys for Patent Owner*



**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on  
February 26, 2020, a copy of UNOPPOSED MOTION TO EXPUNGE PAPER 18  
AND REQUEST TO REPLACE was served in its entirety by electronic mail on  
Petitioner:

Ryan Schultz (Reg. No. 65,134)  
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Ari B. Lukoff (Reg. No. 71,508)  
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Christopher K. Larus  
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Robins Kaplan LLP  
2800 LaSalle Plaza  
800 LaSalle Avenue  
Minneapolis, MN 55402

Date: February 26, 2020

Respectfully submitted,

/April Marconi/

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Case Manager



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Case: IPR2019-01497, IPR2019-01498  
U.S. Patent No. 9,723,842

Case: IPR2019-01499  
U.S. Patent No: 9,717,250

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**UNOPPOSED REQUEST TO KEEP SUBJECT MATTER IN  
FEBRUARY 14, 2020 DECISION CONFIDENTIAL**



On February 11, 2020, the parties filed a Joint Request to Terminate the captioned proceedings. On February 14, 2020, the Board issued a Decision denying the Joint Motion to Terminate and authorizing the parties to refile the Joint Motion to Terminate by February 18, 2020. In the Decision, the Board indicated that if the parties believed anything in the Decision should be kept confidential, a short paper should be submitted explaining why it should be so designated. Patent Owner Arch Chemicals, Inc. (“Arch”) does so now. Due to its discussion of the confidential information, an unredacted version of this paper is being filed under seal.

In the Decision, the Board characterizes the Covenant Not to Sue as [REDACTED]

[REDACTED]  
[REDACTED] The Parties have certified that there are no collateral agreements. The Covenant Not to Sue is the sum total of the terms between the parties.

Arch contends that the fact that the Parties negotiated an agreement that [REDACTED]

[REDACTED] business confidential information. [REDACTED]

[REDACTED], it could harm Arch’s ability to negotiate agreements in the future. A proposed redacted copy of the Decision is attached.

Arch respectfully requests that the proposed redacted copy, appended here, be



IPR2019-01497, IPR2019-01498, IPR2019-01499  
Patent 9,717,250, U.S. Patent 9,723,842

entered and the unredacted version of the Decision be expunged. Petitioner, The Sherwin-Williams Company, has indicated that it does not oppose this request.

Dated: February 18, 2020

Respectfully submitted,

/Deborah Yellin/  
Deborah H. Yellin  
Registration No. 45,904  
Michael H. Jacobs  
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*Attorneys for Patent Owner*



IPR2019-01497, IPR2019-01498, IPR2019-01499  
Patent 9,717,250, U.S. Patent 9,723,842

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on February 18, 2020, a copy of REQUEST TO KEEP SUBJECT MATTER IN FEBRUARY 14, 2020 DECISION CONFIDENTIAL was served in its entirety by electronic mail on Petitioner:

Ryan Schultz (Reg. No. 65,134)  
rshultz@robinskaplan.com

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Christopher K. Larus  
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2800 LaSalle Plaza  
800 LaSalle Avenue  
Minneapolis, MN 55402

Dated: February 18, 2020

/April Marconi/  
Case Manager



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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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THE SHERWIN-WILLIAMS COMPANY.,  
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Case IPR2019-01497 (Patent 9,723,842 B2)  
Case IPR2019-01498 (Patent 9,723,842 B2)  
Case IPR2019-01499 (Patent 9,717,250 B2)

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Before GRACE KARAFFA OBERMANN, CHRISTOPHER G.  
PAULRAJ, and JOHN R. KENNY, *Administrative Patent Judges*.

KENNY, *Administrative Patent Judge*.

DECISION

*Denying Motion to Terminate and Request  
to Keep the Settlement Agreement Separate*  
37 C.F.R. §§ 42.71(a), 42.74



IPR2019-01497 (Patent 9,723,842 B2)  
IPR2019-01498 (Patent 9,723,842 B2)  
IPR2019-01499 (Patent 9,717,250 B2)

The parties filed a *Joint Motion to Terminate the Proceedings* (“Joint Motion”) in each of the above-listed proceedings. IPR2019-01497 (“’1497 IPR”), Paper 12; IPR2019-01498 (“’1498 IPR”), Paper 12; IPR2019-01499 (“’1499 IPR”), Paper 8. The parties also filed a *Covenant Not to Sue* in each of these proceedings. ’1497 IPR Paper 13; ’1498 IPR Paper 13; ’1499 IPR, Paper 9. The Joint Motion requests that the *Covenant Not to Sue* be treated as business confidential information and be kept separate from the file of the involved patents. Joint Motion 4.

We deny the Joint Motion. The parties have not certified that, besides the *Covenant Not to Sue*, there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review. Instead, the parties merely state that “Petitioner and Patent Owner provide a copy of the agreement between them resolving Patent Owner’s infringement allegations against Petitioner.” Joint Motion 3. This statement does not preclude the possibility of unfiled collateral agreements or understandings. Further, it is unclear why the *Covenant Not to Sue* should be deemed confidential. For example, [REDACTED]

[REDACTED] ’1497 IPR Paper 13;  
[REDACTED] ’1498 IPR Paper 13; ’1499 IPR, Paper 9.

We authorize the parties, by February 18th, to refile the Joint Motion with the missing certification<sup>1</sup> and with an explanation as to why the *Covenant Not to Sue* should be deemed confidential (assuming the parties

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<sup>1</sup> Counsel for each party can make that certification if authorized by the party that counsel represents.



IPR2019-01497 (Patent 9,723,842 B2)  
IPR2019-01498 (Patent 9,723,842 B2)  
IPR2019-01499 (Patent 9,717,250 B2)

still seek that designation). We note that the mere fact that the parties have designated the *Covenant Not to Sue* as confidential, or have agreed to treat it as such, is by itself insufficient to establish confidentiality. *See* Joint Motion 3.

Out of an abundance of caution, we will restrict access to this Decision to the Board and parties until February 19th. Nothing in this Decision appears confidential. If either party, however, believes anything in this Decision is confidential, that party has until February 18th to submit a short paper identifying what in the Decision should be deemed confidential and explain why it should be so designated. The party shall submit a proposed redacted version of this Decision with such a paper.

#### ORDER

It is:

ORDERED that the *Joint Motion to Terminate the Proceedings* in each of IPR2019-01497 (Paper 12), IPR2019-01498 (Paper 12) and IPR2019-01499 (Paper 8) is *denied*.

FURTHER ORDERED that the parties may, by February 18th, refile *Joint Motion to Terminate the Proceedings* with the certification discussed above and an explanation as to why the *Covenant Not to Sue* should be deemed confidential (assuming the parties still seek that designation).



IPR2019-01497 (Patent 9,723,842 B2)

IPR2019-01498 (Patent 9,723,842 B2)

IPR2019-01499 (Patent 9,717,250 B2)

FURTHER ORDERED that if either party believes that anything in this Decision should not be made public, that party has until February 18th to submit a short paper identifying what should be deemed confidential and explain why. The party shall submit a proposed redacted version of this Decision with such a paper.

For PETITIONER:

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