

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE SHERWIN-WILLIAMS COMPANY,
Petitioner,

v.

ARCH CHEMICALS, INC.,
Patent Owner.

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

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

KENNY, *Administrative Patent Judge*.

DECISION

*Request to Treat Settlement Agreement as Business Confidential
Information, Confidentiality Request, Motion to Expunge
37 C.F.R. §§ 42.71(a), 42.74*

On February 11, 2020, the parties filed a *Joint Motion to Terminate
the Proceedings* (“Joint Motion”) in each of the above-listed proceedings.

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IPR2019-01497, Paper 12 (“1497 Paper 12”); IPR2019-01498, Paper 12 (“1498 Paper 12”); IPR2019-01499, Paper 8 (“1498 Paper 8”). With the Joint Motion, the parties also filed a *Covenant Not to Sue* in each proceeding. ’1497 Paper 13, ’1498 Paper 13, ’1499 Paper 9. In the Joint Motion, the parties requested the above proceedings be terminated and that the *Covenant Not to Sue* be treated as business confidential information and be kept separate from the files of the involved patents. Joint Motion 4.¹ On February 14, we issued a decision (“February 14 Decision”) denying the Joint Motion, but permitting the parties to refile it. ’1497 Paper 15, ’1498 Paper 15, ’1499 Paper 10. On February 18, the parties filed a new version of their Joint Motion (“Renewed Joint Motion”) in each proceeding (’1497 Paper 19, ’1498 Paper 19, ’1499 Paper 14) and refiled the *Covenant Not to Sue* (’1497 Paper 20, ’1498 Paper 20, ’1499 Paper 15). (On February 19, we terminated the above proceedings. ’1497 Paper 21, ’1498 Paper 21, ’1499 Paper 16.)

On February 18, Patent Owner also filed under seal a *Request to Keep Subject Matter in February 14, 2020 Decision Confidential* (“Confidentiality Request”). ’1497 Paper 17, ’1498 Paper 17, ’1499 Paper 12. On the same day, Patent Owner filed a redacted, public version of that paper (“February 18 Redacted Paper”). ’1497 Paper 18, ’1498 Paper 18, ’1499 Paper 13. On February 26, Patent Owner moved to expunge (“Motion to Expunge,” ’1497 Paper 22, ’1498 Paper 22, ’1499 Paper 17) its February 18 Redacted Paper and replace it with a new redacted paper

¹ Unless otherwise noted, we cite to the papers in IPR2019-01497.

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(“February 26 Redacted Paper”), which is attached to the Motion to Expunge.

In this Decision, we address: (i) the parties’ request in the Renewed Joint Motion to have the *Covenant Not to Sue* be treated as business confidential information, (ii) Patent Owner’s Confidentiality Request, and (iii) Patent Owner’s Motion to Expunge.

In the Renewed Joint Motion, the parties provide some additional analysis as to why the *Covenant Not to Sue* should be deemed confidential. Renewed Joint Motion 5–6. In particular, Patent Owner represents that it would be harmed by that covenant’s disclosure. *Id.* The parties previously represented that they are obligated to treat the *Covenant Not to Sue* as confidential. Joint Motion 3. Although the parties’ analysis could have been more detailed, on balance, we grant the parties’ request to treat the *Covenant Not to Sue* as business confidential information and keep it separate from the files of the above patents.

We also grant Patent Owner’s Confidentiality Request. Patent Owner provides essentially the same analysis for this request as for its request regarding the *Covenant Not to Sue*. Confidentiality Request 2–3. We grant this Confidentiality Request for the reasons discussed above. A public, redacted version of our February 14 Decision is attached to Patent Owner’s Motion to Expunge.

We grant in part the Motion to Expunge. Patent Owner explains that it moves to expunge its February 18 Redacted Paper because, in that paper, Patent Owner inadvertently did not redact a sentence that it believes is confidential. Motion to Expunge 2–3. We will permit the omitted

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redaction, but see no reason to expunge the February 18 Redacted Paper to do so. The confidential information in that redacted paper is also contained in the *Covenant Not to Sue*, which will not be expunged. Instead, we designate the February 18 Redacted Paper as confidential and designate the February 26 Redacted Paper as the public version of Patent Owner's Confidentiality Request.²

ORDER

It is:

ORDERED that the request in the Refiled Joint Motion, in each of the above proceedings ('1497 Paper 19; '1498 Paper 19; '1499 Paper 14), to treat the *Covenant Not to Sue* as business confidential information and keep it separate from the files of the involved patents is *granted*;

FURTHER ORDERED that Patent Owner's Confidentiality Request in each of the above proceedings ('1497 Paper 17, '1498 Paper 17, '1499 Paper 12) is *granted*, and Patent Owner's Motion to Expunge in each of the above proceedings ('1497 Paper 22, '1498 Paper 22, '1499 Paper 17) is *granted in part*;

² After Patent Owner requested authorization to file its Motion to Expunge, access to the February 18 Redacted Paper was restricted to the Board and parties pending resolution of that motion.

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FURTHER ORDERED that the *Covenant Not to Sue* filed in each of the above proceedings ('1497 Papers 13 and 20, '1498 Papers 13 and 20, '1499 Papers 9 and 15) shall be treated as business confidential information and shall be kept separate from the files of the involved patents;

FURTHER ORDERED that our February 14 Decision in each of the above proceedings ('1497 Paper 15, '1498 Paper 15, '1499 Paper 10) shall be treated as confidential and that the public, redacted version of that February 14 Decision is attached to Patent Owner's Motion to Expunge; and

FURTHER ORDERED that the redacted version of Patent Owner's Confidentiality Request filed on February 14 in each of the above proceedings ('1497 Paper 18, '1498 Paper 18, '1499 Paper 13) shall be treated as confidential and that the public, redacted version of Patent Owner's Confidentiality Request is attached to Patent Owner's Motion to Expunge.

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