

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

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

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

MOTION TO EXPUNGE

I. INTRODUCTION

Patent Owner submits this motion to expunge the Board-and-Parties-Only version of the Unopposed Request to Keep Subject Matter in February 14, 2020 Decision Confidential (Paper 17 in IPRs2019-01497 and -01498 and Paper 12 in IPR2019-01499). Petitioner does not oppose this motion.

II. ARGUMENT

Where confidential information is not relied on by the Board, that information will generally be expunged. *Volkswagen Grp. of Am. v. Emerachem Holdings, LLC*, IPR2014- 01556, Paper No. 61, at 2 (expunging confidential papers where “our consideration of the Subject Papers and Exhibits was not necessary for our determination of whether the challenged claims of the ’911 patent were patentable.”). In other *inter partes* review proceedings, the Board has held that confidential research, development, or commercial information should remain under seal. *See Otter Products, LLC, Petr.*, IPR2014-01464, Paper No. 28, pp. 2-4 (PTAB Aug. 27, 2015); *Greene’s Energy Grp., LLC, Inc. v. Oil States Energy Svcs., LLC*, IPR2014- 00216, Paper 27, at 5 (PTAB Sept. 23, 2014); *Gnosis, et al. v. South Alabama Med. Science Found.*, IPR2013-00117, Paper 39, at 2 (PTAB Oct. 31, 2013); *Unified Patents Inc. v. Dragon Intellectual Property, LLC*, IPR2014-01252, Paper 40, at 7 (PTAB Feb. 27, 2015); *Microsoft Corp. v. SurfCast, Inc.*, IPR2013-00292, Paper 58, at 4 (PTAB Apr. 24, 2014). In *Greene’s Energy Group*, the Board

held that portions of an exhibit containing confidential financial information should remain under seal where the proposed redactions were reasonable and the thrust of the underlying argument or evidence was clearly discernible from the redacted versions. *Greene's Energy Grp.*, IPR2014-00216, Paper 27, at 5. Moreover, in *Otter Products*, the Board held that it was appropriate to expunge select exhibits in support of redacted papers where the public release of such exhibits “has not been published or other made available to the public,” and where public disclosure of the exhibits “would be commercially harmful.” *Otter Products*, IPR2014-01464, Paper No. 28, at 4.

Patent Owner request that the Unopposed Request to Keep Subject Matter in February 14, 2020 Decision Confidential (“Request”) (Paper 17/Paper 12) be expunged. This information is not publicly available.

The information Patent Owner sought to seal in the Request relates to the contents of the covenant not to sue, which was the basis for the termination of the captioned proceedings due to settlement.

Subject matter from the Request should be kept confidential. The Board has already agreed to keep this same subject matter as set out in other papers confidential. The subject matter at issue here is the very same content that gave rise to the Confidentiality Request, which the Board granted in its Decision of March

13, 2020 (Paper 25 for IPRs2019-01497, -01498 and Paper 20 for IPR2019-01499).

To that end, in its Decision, the Board indicated that both its February 14, 2020 Decision and Paper 18 (in -01497 and -01498) and Paper 13 (-01499), containing the same content, would be kept confidential.

Moreover, as argued by Patent Owner in the Request, disclosure of the contents of the covenant not to sue could provide competitors with an unfair advantage in their efforts to compete, and therefore would be harmful to Patent Owner. The harm to Patent Owner outweighs any public interest in maintaining a complete file history.

Accordingly, Patent Owner requests that the sealed version of the Unopposed Request to Keep Subject Matter in February 14, 2020 Decision Confidential (Paper 17/Paper 12) be expunged.

III. CONCLUSION

Patent Owner respectfully requests that the Board protect Patent Owner's highly confidential business information and expunge the Unopposed Request to Keep Subject Matter in February 14, 2020 Decision Confidential (Paper 17/Paper 12).

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Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on April 3, 2020, a copy of the MOTION TO EXPUNGE was served in its entirety by electronic mail on Petitioner:

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Dated: April 3, 2020

/April Marconi/
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