UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHINA CHENGDA ENGINEERING CO., LTD.,
Petitioner

v.

DORIAMO LTD.,
Patent Owner

IPR2023-00365
Patent No. 8,591,852

PETITIONER'S MOTION TO EXPUNGE

UNDER 37 C.F.R. § 42.56

I. Statement of Precise of Relief Request Under § 42.22(a)(1)

Pursuant to 37 C.F.R. § 42.56, Petitioner moves to expunge the confidential version of Patent Owner's Preliminary Response (Paper 6), Petitioner's Authorized Reply to Patent Owner's Preliminary Response (Paper 8), Patent Owner's Sur-reply (Paper 12), the Board's decision granting institution of *Inter Partes* Review (Paper 13), and confidential Exhibits 1017, 2001, 2002, 2006, 2008–2016, and 2020–2022 from the record, which have been filed under seal in this proceeding. If the Board denies in whole or in part Petitioner's Motion to Expunge, Petitioner respectfully requests that any document(s) the Board previously ordered sealed but does not order expunged be kept confidential. Petitioner and Patent Owner have conferred, and Patent Owner indicated that it has no objection to Petitioner's Motion.

II. Statement of Reasons for Relief Requested Under § 42.22(a)(2)

A. Applicable Legal Standards

37 C.F.R. § 42.56 provides: "After denial of a petition to institute a trial or after final judgment in a trial, a party may file a motion to expunge confidential information from the record." *See also* Consolidated Trial Practice Guide ("TPG"), 21-22 ("A party seeking to maintain the confidentiality of information [] may file a motion to expunge the information from the record prior to the information becoming public."). The Board has previously explained that a party moving to expunge must show that (i) "any information sought to be expunged constitutes

confidential information" and (ii) the movant's interest in expunging the information "outweighs the public's interest in maintaining a complete and understandable file history." *RPX Corp. v. Virnetx Inc.*, IPR2014-00171, Paper 62 at 3 (P.T.A.B. Sept. 9, 2014). The Board must 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." TPG, 19; 37 C.F.R. § 42.54(a).

B. Expungement of Documents Filed Under Seal

Good cause exists to expunge the confidential exhibits, which contain unredacted confidential information of the parties. The information at issue has been found to be confidential when the Board previously determined that good cause existed to seal these exhibits and granted the parties' motions to seal. *See* Paper 13; *Unified Patents LLC. v. Monarch Networking Solutions LLC*, IPR2020-01258, Paper 47 at 2 (P.T.A.B. Sept. 21, 2023) ("In granting Petitioner's Motion to Seal, we found good cause to seal these documents, so we have already found that the information at issue is confidential."). The confidential information is not available to the public and designated as "PROTECTIVE ORDER MATERIAL" under the Protective Order as explained in the parties' motions to seal. *See* Papers 7, 9, and 13. Expunging these documents is thus necessary to protect Petitioner's and Patent Owner's interests in maintaining the confidentiality.

Petitioner seeks to expunge Exhibits 1017, 2001, 2002, 2006, 2008–2016, and 2020–2022.

Exhibit 1017 is an email amongst counsel with regard to confidential documents and communications regarding a private contract between the parties ("the Agreement") that the parties agreed to keep confidential. The Board did not refer to or cite Exhibit 1017 in the Institution Decision or the Adverse Judgment. *See* Papers 13 and 19.

Exhibits 2001 and 2020 are declarations from a representative of Patent Owner and the named inventor of the '852 Patent, respectively, that describe confidential documents and communications regarding the Agreement that the parties agreed to keep confidential. The Board did not refer to or cite Exhibit 2001 in the Institution Decision or the Adverse Judgment. *See* Papers 13 and 19. Although the Board cited to Exhibit 2020 in the Institution decision, the Board did not quote or rely on that exhibit specifically. *See* Paper 13.

Exhibits 2006, 2008-2016, 2021, and 2022 contain confidential communications and discussions between the parties and counsel concerning the Agreement, which have not been published or otherwise been made public. The Board did not refer to or cite these exhibits in the Institution Decision or the Adverse Judgment. *See* Papers 13 and 19.

Exhibit 2002 is the Agreement between the parties that contains express confidentiality provisions to which both parties agreed. This document contains highly confidential business information, and both parties will suffer harm from its public disclosure. Although this exhibit was cited in the Board's Institution Decision, the confidential information included there was relevant only to rejecting Patent Owner's argument that the Board should exercise its discretion under 35 U.S.C. § 314(a) to deny institution and does not relate to any substantive issues regarding patentability. *See* Paper 13. Moreover, the Board entered an adverse judgment because of "Patent Owner's failure to file substantive papers in this proceeding," without making any reference to Exhibit 2002. *Id.* Thus, the existing public record provides a complete and understandable file history regarding the patentability of the '852 Patent, and good cause exists to expunge Exhibit 2002.

C. Papers 6, 8, 12, 13

Petitioner moves to expunge Papers 6, 8, 12, and 13. These papers, or the confidential portions thereof, contain discussions of the confidential documents and communications between the parties. *See* Papers 7 and 9. The Board previously determined that good cause existed to seal these papers and granted the Motions to Seal. *See* Paper 13. The parties prepared redacted versions of the papers, where the proposed redactions are narrowly tailored to remove the confidential information. *See* Papers 10, 11, 15, and 16. Petitioner does not request to expunge the public

version of these papers and they will be available for the public to review. The redacted confidential information does not relate to any substantive issues regarding patentability. *See, e.g.*, Paper 13. Moreover, the Board entered an adverse judgment because of "Patent Owner's failure to file substantive papers in this proceeding," without making any reference to the confidential information contained in these papers. Thus, the existing public record provides a complete and understandable file history regarding the patentability of the '852 Patent, and good cause exists to expunge the confidential version of these papers.

III. Conclusion

For the foregoing reasons, Petitioner respectfully requests that the Board grant the motion to expunge Papers 6, 8, 12, and 13 and Exhibits 1017, 2001, 2002, 2006, 2008–2016, and 2020–2022.

Date: December 12, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.205(a), this is to certify that I caused to be served a true and correct copy of the foregoing document via the PTAB's P-TACTS system and sent via email as detailed below.

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Respectfully submitted,

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