UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

CHINA CHENGDA ENGINEERING CO., LTD.,
Petitioner
v.
DORIAMO LTD.,
Patent Owner.

---

Case No. IPR2023-00365
Patent 8,591,853

---

**PATENT OWNER'S MOTION TO SEAL AND FOR ENTRY OF PROTECTIVE ORDER**

Patent Owner Doriamo Ltd. ("Doriamo") hereby moves for entry of the Default Protective Order appended below as Appendix A. Doriamo also moves to seal portions of the Patent Owner's Preliminary Response ("POPR") as well as Exhibits 2001, 2002, 2004-2016, and 2020-2023 in their entirety. The POPR and the identified Exhibits contain confidential business information (most of it confidential to ***both*** Petitioner and Patent Owner) and should be maintained as confidential, consistent with controlling law and regulations.

In particular, the confidential information relates to a private contract ("the Agreement") that impacts whether the Board should exercise its discretion to institute the present IPR. The information does not specifically relate to patentability of U.S. Patent No. 8,591,852 ("the '852 patent"). Both Parties agree that their "confidential information submitted in this proceeding [including the Agreement] should be filed under seal."

Patent Owner has conferred with Petitioner through counsel via email. The Parties have agreed that the Board's Default Protective Order (attached as Appendix A) shall apply to confidential material in this Proceeding. The Parties further agree that, in accordance with Paragraph 3 of the Default Protective Order, the Parties' outside counsel, including counsel in China and Cyprus that have not appeared in this Proceeding, shall be extended access to confidential information in this Proceeding. Counsel for both Parties have executed the Default Protective Order.

## I. MOTION TO SEAL

In an *inter partes* review, it is the default rule that all filings are publicly available. 35 U.S.C. § 326(a)(1); 37 C.F.R. § 42.14. Where a paper contains confidential information, "a motion to seal with a proposed protective order as to the confidential information" may be filed. 37 C.F.R. § 42.55; *see also* 35 U.S.C. § 326(a)(1). A motion to seal and to enter a protective order will be granted if the movant demonstrates a showing of "good cause." 37 C.F.R. § 42.54(a).

The Board has established a four-pronged test that must be met for a motion to seal to be granted. A movant seeking to seal documents must demonstrate adequately that (1) the information sought to be sealed is truly confidential, (2) a concrete harm would result upon public disclosure, (3) there exists a genuine need to rely in the trial on the specific information sought to be sealed, and (4) on balance, an interest in maintaining confidentiality outweighs the strong public interest in having an open record. *Argentum Pharm. LLC v. Alcon Research, Ltd.*, IPR2017-01053, Paper 27 at 4 (PTAB Jan. 19, 2018) (informative) (citing to *inter alia* 37 C.F.R. § 42.54(a)).

Pursuant to the Default Protective Order, and responsive to the Petition, Patent Owner is filing under seal certain material relating to confidential agreements and confidential communications between the Petitioner and Patent Owner. The confidential information is also contained in the POPR and supporting declarations.

The requested documents sought to be sealed fall into the following four categories identified below.

1. Patent Owner Preliminary Response ("POPR"). The POPR contains sections that incorporate, discuss, and refer to confidential information of both Parties from the following three categories. The POPR as filed is marked "PROTECTIVE ORDER MATERIAL" under the Default Protective Order in this case. Given that the POPR contains confidential information to both parties, Patent Owner proposes that the Parties work together within seven (7) days of filing to provide the Board with a redacted version of the POPR that can be placed on the public docket.

2. Exhibit Nos. 2001 and 2020 are declarations from a representative of the Patent Owner and the inventor, respectively, that describe confidential documents and communications regarding the Agreement that the Parties agreed to keep confidential. These Exhibits as filed are marked "PROTECTIVE ORDER MATERIAL" under the Default Protective Order in this case. The declarations refer extensively to the Exhibits identified in the two categories below.

3. Exhibit No. 2002 is the Agreement between the Parties that contains express confidentiality provisions to which both parties agreed. Exhibit Nos. 2004, 2005, and 2007 are additional agreements and assignments of rights that relate directly to the Agreement that are not publicly available. These Exhibits as filed are

marked "PROTECTIVE ORDER MATERIAL" under the Default Protective Order in this case.

4. Exhibit Nos. 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. Exhibit No. 2023 is a publicly available document, but it contains information that would likely disclose confidential aspects of the Agreement. These Exhibits as filed are marked "PROTECTIVE ORDER MATERIAL" under the Default Protective Order in this case.

## II. GOOD CAUSE EXISTS FOR SEALING PORTIONS OF THE POPR AND EXHIBITS 2001, 2002, 2004-2016 AND 2020-2023 IN THEIR ENTIRETY

In deciding whether to seal documents, the Board must find "good cause" and 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." *Garmin v. Cuozzo*, IPR2012-00001, Paper 36, at 4 (PTAB Apr. 5, 2013). Here, good cause exists for sealing the documents, and the Motion to Seal satisfies the four-factor test in *Argentum*.

First, these Exhibits contain or would reveal non-public confidential information. Portions of the POPR and the Exhibits described above contain or would reveal information of both Parties that Patent Owner has identified as

confidential business information. Those documents have been described by category above and pertain to a confidential agreement between the parties. *See* Section I, *supra*. Patent Owner requests that portions of the POPR be sealed and that the identified Exhibits remained sealed in their entireties.

Second, the Parties agreed to keep the Agreement and related information confidential. Patent Owner has a contractual obligation with Petitioner to maintain the confidentiality of this information. The balance favors protecting the information that the Parties agreed to maintain confidential.

Third, there is no concrete harm to the public in keeping this information confidential. The private communications concerning a contractual dispute between the parties does not impact the public record concerning substantive issues of validity. *See Perfectvision Manufacturing, Inc., v. PPC Broadband, Inc.*, IPR2022-01523, Paper 13, at 4 (PTAB Feb. 24, 2023) (granting Default Protective Order to protect confidential agreement). While impacting whether the Board should exercise its discretion to deny institution of this IPR, the information Patent Owner seeks to protect does not currently impact any substantive arguments pertaining to patentability, the scope of the ’853 patent, or any matter generally impacting the public interest in evaluating the ’853 patent.

Instead, the material relates to certain contracts and business dealings between the Parties to this proceeding. That material is not known to the public. Disclosing

the details of the Parties' confidential agreement and subsequent discussions through its lawyers would harm both Parties by disclosing details of a confidential business Agreement.

Fourth, on balance, the interest in maintaining confidentiality outweighs the public interest in having an *entirely* open record and the Documents should be sealed. Patent Owner respectfully requests that the Board grant this motion to seal. The public interest is well-served in keeping the business information included within or potentially revealed by Exhibits 2001, 2002, 2004-2016, and 2020-2023 confidential. This information was exchanged between the Parties with the expectation that it would remain confidential. The Board should seal this information so that information can be considered for purposes of whether to institute the IPR. Sealing this information is consistent with Board precedent. *See, e.g.*, *Perfectvision*, IPR2022-01523, Paper 13, at 4; *Mylan Pharm Inc. v. Bausch Health Ireland Ltd*, IPR2022-01105, Paper 15 (PTAB Jan. 4, 2023) (granting Default Protective Order with respect to portions of the POPR and related exhibits in their entirety).

Because portions of the POPR and the Exhibits discuss or would reveal these confidential agreements and communications extensively, and the information implicates confidentiality concerns of both the Patent Owner and Petitioner, Patent Owner filed the entirety of the POPR and Exhibits under seal. Patent Owner requests

that the Board grant its motion to seal the Exhibits in their entirety. Patent Owner requests that the Parties confer as to the POPR and promptly provide a redacted version for filing on the public record.

## III. TO THE EXTENT THE BOARD DOES NOT SEAL THE EXHIBITS IN THEIR ENTIRETY, THE BOARD SHOULD GRANT LEAVE FOR THE PARTIES TO CONFER TO SUBMIT REDACTED VERSIONS

Should the Board decline to seal the confidential information in its entirety, it should grant the Parties leave to submit appropriately redacted versions of the Exhibits, to the extent reasonably feasible. *See, e.g., Google, Inc. v. Summit 6 LLC*, IPR2015-00806, Paper 44, at 3-5 (PTAB Mar. 21, 2016) (conditionally granting motion to seal in part, and granting leave to submit redacted versions of exhibits). Patent Owner submits that the Parties be granted leave to submit redacted versions of the Exhibits within seven (7) days of an order from Board.

## IV. MOTION FOR PROTECTIVE ORDER

The agreed-upon Protective Order is identical to the Board's Default Protective Order in Appendix B of the Patent Trial and Appeal Consolidated Trial Practice Guide, November 2019 ("TPG"). Counsel for Petitioner and Patent Owner have executed the Default Protective Order, and confidential material is being served pursuant thereto. Accordingly, pursuant to 37 C.F.R. § 42.54, Patent Owner moves for entry of the attached Protective Order attached as Appendix A.

## V. REQUEST FOR CONFERENCE CALL WITH THE BOARD

Should the Board not be inclined to grant the present Motion to Seal and Entry of Protective Order, the Parties hereby request a conference call with the Board to discuss any concerns prior to the Board issuing a decision on the Motion.

## VI. CONCLUSION

The undersigned counsel for Patent Owner certifies that the information sought to be sealed by this Motion to Seal has not been published or otherwise made public. For the reasons stated above, the Board should grant Patent Owner's motion to seal and for entry of the Default Protective Order submitted herewith.

Respectfully submitted,

Dated: April 11, 2023

*/Matthew J. Dowd/*
Matthew J. Dowd
Reg. No. 47,534
Robert J. Scheffel
Reg. No. 43,090
Dowd Scheffel PLLC
1717 Pennsylvania Avenue, NW
Suite 1025
Washington, D.C. 20006
T: (202) 559-9175
F: (202) 204-5877
mdowd@dowdscheffel.com
rscheffel@dowdscheffel.com

Joshua Goldberg
Reg. No. 44,126
Nath, Goldberg & Meyer

112 S. West Street
Alexandria, VA 22314
T: (703) 548-6284
F: (703) 683-8396
jgoldberg@nathlaw.com

*Counsel for Patent Owner Doriamo Ltd.*

**CERTIFICATION OF SERVICE ON PATENT OWNER**

The undersigned hereby certifies that a copy of the foregoing MOTION TO SEAL AND FOR ENTRY OF PROTECTIVE ORDER was served on April 11, 2023 via electronic mail upon the following counsel for Petitioner:

Eliot D. Williams
eliot.williams@bakcrbotts.com

Jennifer C. Tempesta
jennifer.tempesta@bakerbotts.com

Frank Zhu
frank.zhu@bakerbotts.com

Boyang Zhang
boyang.zhang@bakerbotts.com

*/Matthew J. Dowd/*
Matthew J. Dowd
Reg. No. 47,534
Dowd Scheffel PLLC
1717 Pennsylvania Avenue, NW
Suite 1025
Washington, D.C. 20006
T: (202) 559-9175
F: (202) 204-5877
mdowd@dowdscheffel.com

*Counsel for Patent Owner*
*Doriamo Ltd.*

# APPENDIX A

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

CHINA CHENGDA ENGINEERING, CO. LTD.
Petitioner

v.

DORIAMO, LTD.
Patent Owner

---

Case No. IPR2023-00365
Patent 8,591,852

---

**DEFAULT PROTECTIVE ORDER**

This protective order governs the treatment and filing of confidential information, including documents and testimony.

1. Confidential information shall be clearly marked "PROTECTIVE ORDER MATERIAL."

2. Access to confidential information is limited to the following individuals who have executed the acknowledgment appended to this order:

(A) Parties. Persons who are owners of a patent involved in the proceeding and other persons who are named Parties to the proceeding.

(B) Party Representatives. Representatives of record for a party in the proceeding.

(C) Experts. Retained experts of a party in the proceeding who further certify in the Acknowledgement that they are not a competitor to any party, or a consultant for, or employed by, such a competitor with respect to the subject matter of the proceeding.

(D) In-house counsel. In-house counsel of a party.

(E) Support Personnel. Administrative assistants, clerical staff, court reporters and other support personnel of the foregoing persons who are reasonably necessary to assist those persons in the proceeding shall not be required to sign an Acknowledgement, but shall be informed of the terms

and requirements of the Protective Order by the person they are supporting who receives confidential information.

(F) The Office. Employees and representatives of the United States Patent and Trademark Office who have a need for access to the confidential information shall have such access without the requirement to sign an Acknowledgement. Such employees and representatives shall include the Director, members of the Board and their clerical staff, other support personnel, court reporters, and other persons acting on behalf of the Office.

3. Employees (e.g., corporate officers), consultants, or other persons performing work for a party, other than in-house counsel and in-house counsel's support staff, who sign the Acknowledgement shall be extended access to confidential information only upon agreement of the Parties or by order of the Board upon a motion brought by the party seeking to disclose confidential information to that person. The party opposing disclosure to that person shall have the burden of proving that such person should be restricted from access to confidential information.

4. Persons receiving confidential information shall use reasonable efforts to maintain the confidentiality of the information, including:

(A) Maintaining such information in a secure location to which

persons not authorized to receive the information shall not have access;

(B) Otherwise using reasonable efforts to maintain the confidentiality of the information, which efforts shall be no less rigorous than those the recipient uses to maintain the confidentiality of information not received from the disclosing party;

(C) Ensuring that support personnel of the recipient who have access to the confidential information understand and abide by the obligation to maintain the confidentiality of information received that is designated as confidential; and

(D) Limiting the copying of confidential information to a reasonable number of copies needed for conduct of the proceeding and maintaining a record of the locations of such copies.

5. Persons receiving confidential information shall use the following procedures to maintain the confidentiality of the information:

(A) Documents and Information Filed With the Board.

(i) A party may file documents or information with the Board along with a Motion to Seal. The Motion to Seal should provide a non-

confidential description of the nature of the confidential information that is under seal, and set forth the reasons why the information is confidential and should not be made available to the public. A party may challenge the confidentiality of the information by opposing the Motion to Seal. The documents or information shall remain under seal unless the Board determines that some or all of it does not qualify for confidential treatment.

(ii) Where confidentiality is alleged as to some but not all of the information submitted to the Board, the submitting party shall file confidential and non-confidential versions of its submission, together with a Motion to Seal the confidential version setting forth the reasons why the information redacted from the non-confidential version is confidential and should not be made available to the public. A party may challenge the confidentiality of the information by opposing the Motion to Seal. The non-confidential version of the submission shall clearly indicate the locations of information that has been redacted. The confidential version of the submission shall be filed under seal. The redacted information shall remain under seal unless the Board determines that some or all of the redacted information does not qualify for confidential treatment.

(B) Documents and Information Exchanged Among the Parties.

Documents (including deposition transcripts) and other information designated as confidential that are disclosed to another party during discovery or other proceedings before the Board shall be clearly marked as "PROTECTIVE ORDER MATERIAL" and shall be produced in a manner that maintains its confidentiality.

6. Within 60 days after the final disposition of this action, including the exhaustion of all appeals and motions, each party receiving confidential information must return, or certify the destruction of, all copies of the confidential information to the producing party.

/Eliot D. Williams/
Eliot D. Williams
Reg. No. 50,822
BAKER BOTTS L.L.P.
700 K Street, N.W.
Washington, D.C. 20001-5692
United States
T: (202) 639-1334
F: (202) 639-1167
eliot.williams@bakcrbotts.com

Jennifer C. Tempesta
Reg. No. 59,021
BAKER BOTTS L.L.P.
30 Rockefeller Plaza
New York, NY 10112
T: (212) 408-2500
F: (212) 259-2500
jennifer.tempesta@bakerbotts.com

*/Matthew J. Dowd/*
Matthew J. Dowd
Reg. No. 47,534
Robert J. Scheffel
Reg. No. 43,090
Dowd Scheffel PLLC
1717 Pennsylvania Avenue, NW
Suite 1025
Washington, D.C. 20006
T: (202) 559-9175
F: (202) 204-5877
mdowd@dowdscheffel.com
rscheffel@dowdscheffel.com

Joshua Goldberg
Reg. No. 44,126
Nath, Goldberg & Meyer
112 S. West Street
Alexandria, VA 22314
T: (703) 548-6284

Frank Zhu
Reg. No. 71,214
BAKER BOTTS L.L.P.
30 Rockefeller Plaza
New York, NY 10112
T: (212) 408-2500
F: (212) 259-2500
frank.zhu@bakerbotts.com

Boyang Zhang
Reg. No. 77,498
BAKER BOTTS L.L.P.
401 South l51 Street
Suite 1300
Austin, Texas 78704
T: (512) 322-2500
F: (512) 322-2501
boyang.zhang@bakerbotts.com

*Counsel for Petitioner*

F: (703) 683-8396
jgoldberg@nathlaw.com

*Counsel for Patent Owner Doriamo Ltd.*

**EXHIBIT A**

**CHINA CHENGDA ENGINEERING CO., LTD.**

**v.**

**DORIAMO, LTD.**

**Case No. IPR2023-00365**
**U.S. Patent 8,591,852**

**Standard Acknowledgment for Access to Protective Order Material**

I, _____, affirm that I have read the Protective Order; that I will abide by its terms; that I will use the confidential information only in connection with this proceeding and for no other purpose; that I will only allow access to support staff who are reasonably necessary to assist me in this proceeding; that prior to any disclosure to such support staff I informed or will inform them of the requirements of the Protective Order; that I am personally responsible for the requirements of the terms of the Protective Order and I agree to submit to the jurisdiction of the Office and the United States District Court for the Eastern District of Virginia for purposes of enforcing the terms of the Protective Order and providing remedies for its breach.

Executed on _____, 2023.

_____