UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHINA CHENGDA ENGINEERING CO., LTD.,
Petitioner

v.
DORIAMO LTD.,
Petitioner.

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

PETITIONER'S MOTION TO SEAL

Petitioner China Chengda Engineering Co., Ltd. ("China Chengda") hereby moves to seal portions of the Petitioner's Preliminary Reply on Alleged Procedural Defects ("Reply") and Exhibit 1017. The Reply and the identified Exhibit contain confidential business information 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"), on which Patent Owner relies in its Preliminary Patent Owner Response ("POPR") and for which Patent Owner has a pending Motion to Seal and for Entry of Protective Order before the Board. Paper No. 7. Both Parties agree that their "confidential information submitted in this proceeding [including the Agreement] should be filed under seal." *Id*.

Parties have conferred and agreed that the Board's Default Protective Order shall apply to confidential material in this Proceeding. *Id*. 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. *Id*. 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)).

As authorized by the Board in an email dated April 26, 2023, and pursuant to the Default Protective Order, Petitioner is filing a Reply to Patent Owner's POPR 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 communication between the parties through their counsel. The requested documents sought to be sealed fall into the following categories identified below.

1. Petitioner's Reply. The Reply contains sections, in response to the POPR, that incorporate, discuss, and refer to confidential information of both Parties, inter alia, from the Agreement that contains express confidentiality provisions. The Reply as filed is marked "PROTECTIVE ORDER MATERIAL" under the Default Protective Order in this case. Given that the Reply contains confidential information to both parties, Petitioner proposes that the Parties work together within seven (7) days of filing to provide the Board with a redacted version of the Reply that can be placed on the public docket.

2. Exhibit No. 1017 is an email amongst counsel in regard to confidential documents and communications regarding the Agreement that the Parties agreed to keep confidential. This Exhibit as filed is marked "PROTECTIVE ORDER MATERIAL" under the Default Protective Order in this case.

II. GOOD CAUSE EXISTS FOR SEALING PORTIONS OF THE REPLY AND EXHIBIT 1017

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 documents contain or would reveal non-public confidential information. Portions of the Reply and the Exhibit described above contain or would reveal information that both Parties has identified as confidential business information. Those documents pertain to a confidential agreement between the Parties. *See* Section I, *supra*. Petitioner requests that portions of the Reply and the identified Exhibit be sealed.

Second, the Parties agreed to keep the Agreement and related information confidential. Petitioner has a contractual obligation 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).

Instead, the material relates to certain contracts and alleged business dealings between the Parties. That material is not known to the public. Disclosing the details of the confidential agreement and subsequent discussions through its lawyers would harm both Parties.

Fourth, on balance, the interest in maintaining confidentiality outweighs the public interest in having an *entirely* open record. Petitioner 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 Exhibit 1017. This information was exchanged between the Parties with the expectation that it would remain confidential. 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 Reply and the Exhibit discuss or would reveal these confidential agreements and communications, and the information implicates confidentiality concerns of both the Petitioner and Patent Owner, Petitioner filed the entirety of the Reply and Exhibit 1017 under seal. Petitioner requests that the Parties confer as to the Reply and Exhibit 1017 and promptly provide a redacted version for filing on the public record.

III. REQUEST FOR CONFERENCE CALL WITH THE BOARD

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

IV. CONCLUSION

The undersigned counsel for Petitioner 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 Petitioner's motion to seal under the Default Protective Order.

Date: May 5, 2023

Respectfully submitted,

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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 "PETITIONER'S MOTION TO SEAL" via the PTAB's P-TACTS system and sent via email as detailed below.

Date of service: May 5, 2023

Documents served: PETITIONER'S MOTION TO SEAL

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