

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BOX, INC., and DROPBOX, INC.,  
Petitioners

v.

TOPIA TECHNOLOGY, INC.,  
Patent Owner.

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Case No. IPR2023-00432  
U.S. Patent No. 10,754,823

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**PETITIONERS' UNOPPOSED MOTION TO  
EXPUNGE CONFIDENTIAL INFORMATION UNDER 37 CFR § 42.56**

Pursuant to 37 CFR § 42.56 and authorization received via email from the Board on September 21, 2023, Petitioners Box, Inc. and Dropbox, Inc. (“Petitioners”) respectfully move for an order expunging confidential documents filed under seal in this proceeding. Petitioners conferred with Patent Owner Topia Technology, Inc. (“Patent Owner”) and confirmed that Patent Owner does not oppose this motion.

In its email authorizing the filing of this motion, the Board stated that the motion should state “whether there will be further requests for review” of the Board’s decision in this proceeding. Petitioners respond that they will not be filing any requests for review of the Board’s institution denial.

## **I. Background**

On June 8, 2023, Petitioners filed an unopposed motion to enter a Protective Order in this proceeding and seal portions of Exhibit 1029 (Declaration of Heidi L. Keefe in Support of Petitioners’ Preliminary Reply) and Exhibit 1030 (Joint Defense and Information Sharing Agreement), because the exhibits contained Petitioners’ and/or third parties’ confidential information. *See* Paper 8. Petitioners filed a substantively identical unopposed motion to seal in other *inter partes* review proceedings on the same date, including IPR2023-00427.

On June 22, 2023, Patent Owner filed an unopposed motion to seal portions of its Sur-Reply to Petitioners’ Preliminary Reply (Paper 13) and portions of the

Official Transcript of the Deposition of Heidi L. Keefe, taken on June 20, 2023 (Exhibit 2018), because the exhibits contained Petitioners' and/or third parties' confidential information. *See* Paper 12. Patent Owner filed a substantively identical unopposed motion to seal in other *inter partes* review proceedings on the same date, including IPR2023-00427.

On August 4, 2023, the Board in IPR2023-00427 (Paper 17) granted motions to seal that were identical to those filed in this proceeding by Petitioners (Paper 8) and Patent Owner (Paper 12) and which sought to seal the same portions of the same documents. The Board stated:

We have reviewed these motions and the documents at issue and have considered the explanations of the confidential nature of the materials for which sealing is sought. We find there is good cause and therefore we grant the motions to seal and the associated request to enter the parties' agreed protective order.

IPR2023-00427 (Paper 17) at 46.

On August 7, 2023, the Board issued its Decision Denying Institution of *Inter Partes* Review (Paper 16) in the instant proceeding.

## **II. The Confidential Documents Filed Under Seal In This Proceeding Should Be Expunged**

Petitioners request that the confidential versions of Paper 13 and Exhibits

1029 and 2018 and the entirety of Exhibit 1030 be expunged from the record. The confidential nature of the documents and minimal impact expungement would have on the public's understanding of the file history weigh in favor of granting this motion.

According to Patent Trial and Appeal Board practice, and as noted by the Board, “[c]onfidential information that is subject to a protective order ordinarily would become public 45 days after” the August 7, 2023, Decision Denying Institution of *Inter Partes* Review (Paper 16). See Patent Trial and Appeal Consolidated Trial Practice Guide (November 2019) (“CTPG”) at 21-22. However, “[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.” CTPG, 22; see 37 C.F.R. § 42.56. In deciding whether to expunge confidential information, the Board must balance “the needs of the parties to submit confidential information with the public interest in maintaining a complete and understandable file history.” CTPG, 22.

The information sought to be expunged constitutes confidential information. Exhibit 1030 is a Joint Defense and Information Sharing Agreement (“JDA”). Petitioners respectfully request to expunge in full Exhibit 1030 as it comprises confidential information of third parties and in view of Petitioners’ contractual obligations to use all reasonable efforts to maintain confidentiality of the document.

Exhibit 1030, § 2.2.4. The confidential information includes confidential business information and details about the membership and nature of the JDA that, to Petitioners' knowledge, have been maintained in confidentiality by all parties to the agreement. Public disclosure of the JDA would cause a concrete harm to the parties to the agreement, as explained in the JDA itself. *Id.*, §§ 2.2.4, 2.3. Aside from addressing Patent Owner's arguments regarding the nature of the JDA, the terms of the JDA have no relevance to these proceedings or the public's interest in these proceedings. Petitioners' interests in maintaining confidentiality therefore outweigh the strong public interest in having an open record. For the foregoing reasons, Petitioners sought to designate the JDA as "HIGHLY CONFIDENTIAL – ATTORNEYS' EYES ONLY" pursuant to the Protective Order.

Exhibit 1029 is the Declaration of Heidi L. Keefe in Support of Petitioners' Preliminary Reply and paragraph 6 contains quotations and detailed descriptions of the confidential information contained in Exhibit 1030 and, for the same reasons above, Petitioners seeks to expunge paragraph 6 of Exhibit 1029, which has been designated as "HIGHLY CONFIDENTIAL – ATTORNEYS' EYES ONLY" pursuant to the Protective Order.

Patent Owner's Sur-Reply to Petitioners' Preliminary Reply (Paper 13) and portions of the Official Transcript of the Deposition of Heidi L. Keefe, taken on June 20, 2023 (Exhibit 2018), quote and/or discuss confidential information of Petitioners

and third parties in the form of confidential business arrangements between members of the JDA and between attorneys and their clients. For the same reasons above, Petitioners seeks to expunge the confidential versions of these documents.

The information sought to be expunged is not necessary to understand the Board's reasoning in denying institution—indeed, the Board did not cite any of the information sought to be expunged, and Petitioners do not seek to expunge any portion of the Board's decision denying institution. There is “an expectation that [confidential] information will be made public” only when “the existence of the information is referred to in a decision to grant or deny a request to institute review or is identified in a final written decision following a trial.” CTPG, 22. The Board has previously granted motions to expunge confidential documents where the expunged documents were not necessary to understand the Board's decisions. *See Unverferth Mfg. Co., Inc. v. J&M Mfg. Co., Inc.*, IPR2014-00758, Paper 29, 2 (PTAB Sept. 30, 2015) (granting motion to expunge because the final written decision did not rely on the expunged document and “the file and decision remain understandable in the absence of” the expunged document); *Apple Inc. v. Rembrandt Wireless Techs., LP*, IPR2020-00033, Paper 18, 5-6 (PTAB April 1, 2020) (granting motion to expunge because “no decision relied on the documents containing confidential information” and “the record would not be less understandable if the requested documents were expunged”). In these situations, the “public interest in

maintaining a complete and understandable file history” is not compromised. CTPG, 22.

These documents have been sealed from the public for the duration of this proceeding and were designated “HIGHLY CONFIDENTIAL – ATTORNEYS’ EYES ONLY” pursuant to the Protective Order in this proceeding. As noted above, the Board already determined in another proceeding that there was “good cause” to maintain the same documents under seal. There is equally good cause to keep these exhibits from the public record, especially where the documents were not relied on by the Board in its decision.

Accordingly, Petitioners respectfully submit that good cause exists here and request the Board expunge from the record the confidential versions of Paper 13 and Exhibits 1029 and 2018 and the entirety of Exhibit 1030.

### **III. Conclusion**

For the reasons set forth above, Petitioners respectfully request that the Motion to Expunge Confidential Information be granted.

Dated: September 21, 2023

Respectfully submitted,

**COOLEY LLP**

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## **CERTIFICATE OF SERVICE**

I hereby certify, pursuant to 37 C.F.R. Section 42.6, that a complete copy of the attached **PETITIONERS' UNOPPOSED MOTION TO EXPUNGE CONFIDENTIAL INFORMATION UNDER 37 CFR § 42.56** is being served on the 21st day of September, 2023, via electronic mail upon counsel of record for the Patent Owner as follows:

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DATED: September 21, 2023

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