

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAHLE BEHR CHARLESTON INC.,
Petitioner,

v.

FRANK AMIDIO CATALANO,
Patent Owner,

Patent No. RE47,494 to Catalano
Issue Date: July 9, 2019

Title: ELECTROLYSIS PREVENTION DEVICE AND METHOD OF USE

Inter Partes Review No.: IPR2023-00861

PETITIONER'S UNOPPOSED MOTION TO EXPUNGE

Pursuant to 37 C.F.R. § 42.56, MAHLE Behr Charleston Inc. (“Petitioner”) moves to expunge Exhibits 1018–1020. Petitioner’s counsel conferred by email with counsel for Electrolysis Prevention Solutions LLC (“EPS”), which represents that it “is the exclusive licensee . . . with all substantial rights to the ’494 Reissue Patent including the exclusive right to enforce, sue, and recover damages for past and future infringements” (EX1002, 4), and EPS does not oppose this motion.

I. Legal Standard

37 C.F.R. § 42.56 provides that following “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.” Similarly, the Trial Practice Guide states that 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.” Trial Practice Guide, 77 Fed. Reg. at 48,761. A party seeking expungement from the record must show good cause by demonstrating “that any information sought to be expunged constitutes confidential information, and that Petitioner’s interest in expunging it outweighs the public’s interest in maintaining a complete and understandable history of [the] inter partes review.” *Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.*, IPR2013-00453, Paper 97 at 2 (P.T.A.B. Apr. 15, 2015).

II. Good Cause Exists to Expunge Exhibits 1018–1020

A. Exhibits 1018–1020 Reflect Confidential Information

Petitioner filed a Motion to File Under Seal (“Motion to Seal”) in this inter partes review on June 20, 2023. Paper 6. The Board granted Petitioner’s Motion to Seal, finding that Petitioner established good cause to seal Exhibits 1018–1020. Paper 8 at 3.

Exhibit 1018 is a letter which includes confidential, non-public communications from Daimler Trucks North America LLC to Petitioner regarding *Electrolysis Prevention Solutions LLC v. Daimler Trucks North America LLC*, 3:21-cv-171 (W.D.N.C.) (Nov. 22, 2022). Petitioner asserts that the entirety of Exhibit 1018 comprises confidential information, and as such, a redacted public version has not been submitted.

Exhibit 1019 are purchase order terms and conditions of Daimler Trucks North America LLC, which Petitioner understands are confidential and non-public. Petitioner does not have the authority to disclose confidential and non-public information that Daimler Trucks North America LLC has made available to Petitioner. At least term 27 (“USE AND PROTECTION OF INFORMATION”) prevents Petitioner from disclosing the content of Exhibit 1019. Petitioner asserts that the entirety of Exhibit 1019 comprises confidential information, and as such, a redacted public version has not been submitted.

Exhibit 1020 is a letter from MAHLE Industries, Inc. to Daimler Trucks North America LLC, which is labeled “CONFIDENTIAL” and includes confidential, non-public communications to Daimler Trucks North America LLC regarding *Electrolysis Prevention Solutions LLC v. Daimler Trucks North America LLC*, 3:21-cv-171 (W.D.N.C.) (Nov. 22, 2022). Petitioner asserts that the entirety of Exhibit 1020 comprises confidential information, and as such, a redacted public version has not been submitted.

Neither the foregoing information, nor Exhibits 1018–1020, have been published or otherwise made public by Petitioner, and Petitioner has undertaken efforts to maintain the confidentiality of this information.

Accordingly, as the Board previously found in granting Petitioner's Motion to Seal, Exhibits 1018–1020 contain confidential information that should not be made publicly available.

***B. The Documents Requested to Be Expunged are Not Necessary
to Understanding the Board's Institution Decision***

Petitioner's interest in expunging Exhibits 1018–1020 outweighs the public's interest in maintaining a complete and understandable history of this inter partes review because the Board did not rely on Exhibits 1018–1020 in the Institution Decision. Exhibits 1018–1020 were only discussed by Petitioner to establish that DTNA is not a real party-in-interest, an issue the Board did not reach (*see* Paper 13,

at 2). The Petition itself is filed on the public docket and is available in its entirety (*see generally* Paper 1).

Accordingly, Exhibits 1018–1020 are not necessary to understanding the Board's decision not to institute this inter partes review. By extension, expunging Exhibits 1018–1020, which the Board has already found to contain confidential information, while maintaining the Petition and all other materials that the Board actually relied on in the public record, “stri[k]es an appropriate balance between the public policy for an open record and the legitimate need to protect confidential information from disclosure.” *Atlanta Gas Light*, Paper 97 at 3-4.

III. Conclusion

For the foregoing reasons, the Board should find good cause to expunge the requested documents and grant this Motion.

Respectfully submitted,

Dated: August 7, 2024

By: / Jeanne M. Gills /

Jeanne M. Gills, Reg. No. 44,458
Counsel for Petitioner
FOLEY & LARDNER LLP
321 North Clark Street, Suite 3000
Chicago, IL 60654
312-832-4500
jmgills@foley.com

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Petitioner's Unopposed Motion to Expunge was caused to be served electronically on August 7, 2024 to Patent Owner's counsel:

Charles Austin Ginnings
Nelson Bumgardner Albritton PC
15020 S. Ravinia Avenue, Suite 29
Orland Park, Illinois 60462
austin@nbafirm.com

Brent Bumgardner
Nelson Bumgardner Albritton PC
3131 West 7th Street, Suite 300
Fort Worth, Texas 76107
817.377.3486 (telephone)
brent@nbafirm.com

Robert A. Delafield II
Nelson Bumgardner Albritton PC
3131 West 7th Street, Suite 300
Fort Worth, Texas 76107
817.377.3486 (telephone)
bobby@nbafirm.com

Timothy E. Grochocinski
Nelson Bumgardner Albritton PC
15020 S. Ravinia Avenue, Suite 29
Orland Park, Illinois 60462
708.675.1974 (telephone)
tim@nbafirm.com

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By: / Jeanne M. Gills /

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Reg. No. 44,458

Counsel for Petitioner