

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 MOTION TO FILE UNDER SEAL

37 C.F.R. §42.54

Pursuant to 37 C.F.R. §42.54, MAHLE Behr Charleston Inc. ("Petitioner")

hereby submits this Motion to Seal. Previously filed are unredacted versions of Exhibits 1018–1020 designated as available to the Filing Party and Board only. It is understood that, once a Protective Order has been agreed upon, both parties will be provided with access to the confidential information, subject to the provisions of the Protective Order. Petitioner's proposed Protective Order has been filed as Exhibit 1022, with a version showing redlines as against the Board's Default Protective Order filed as Exhibit 1023.

I. Good Cause Exists for Sealing Certain Confidential Information

The Office Patent Trial Practice Guide provides that "the rules aim to 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." 77 Fed. Reg. 48756, 48760 (Aug. 14, 2012). These rules "identify confidential information in a manner consistent with Federal Rule of Civil Procedure 26(c)(1)(G), which provides for protective orders for trade secret or other confidential research, development, or commercial information." *Id.* (citing 37 C.F.R. § 42.54).

Here, good cause exists to support the sealing of Exhibits 1018–1020, as detailed below. In an effort to strike an appropriate balance with the public's interest in maintaining a complete and understandable file history, Petitioner has avoided

express inclusion of this material in the petition itself, and instead cites to the exhibit containing the confidential information in question.

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-

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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.

Petitioner submits that (1) the confidential information in Exhibits 1018–1020 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. *See Argentum v. Alcon*, IPR2017-01053, Paper 27, p. 4 (PTAB Jan. 19, 2018) (informative).

II. Certification of Non-Publication

On behalf of Petitioner, the undersigned counsel certifies that, to the best of their knowledge, the information sought to be sealed by this Motion to Seal has not been published or otherwise made public. Efforts to maintain the confidentiality of this information have been undertaken by Petitioner in the related proceedings noted above.

III. Proposed Protective Order

Petitioner proposes that the confidential information referenced herein be subject to the Proposed Protective Order attached hereto as Exhibits 1018–1020. The Proposed Protective Order includes modifications to the Default Protective Order from the Trial Practice Guide. A version of the Proposed Protective Order of

Exhibit 1022 showing redline changes as compared to the Board default protective order is provided as Exhibit 1023.

IV. Conclusion

For the reasons stated above, Petitioner respectfully requests that Exhibits 1018–1020 remain under seal.

Respectfully submitted,

Dated: June 20, 2023

By: / Jeanne M. Gills /

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Motion to Seal
was served on June 20, 2023 to counsel of record for Patent Owner:

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