

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTERNATIONAL BUSINESS MACHINES CORPORATION,  
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,  
Patent Owner.

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IPR2014-00587  
Patent No. 6,826,694 B1

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Before JAMES T. MOORE, MEREDITH C. PETRAVICK, and  
BENJAMIN D. M. WOOD, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

ORDER

Expunging Sealed Information after Final Written Decision  
*37 C.F.R. § 42.56*

Patent Owner filed an unopposed motion requesting to expunge sealed Exhibits 2006, 2007, 2010, 2011, 2012, and 2013 and Paper 29 from the record, pursuant to 37 C.F.R. § 42.56. Paper 60, 1 (“Mot.”). The motion indicates that Petitioner does not oppose the request. *Id.*

Sealed information ordinarily becomes publicly available after final judgment. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756,

48761 (Aug. 14, 2012). A party may file a motion to expunge confidential information from the record, however, if wishing to preserve its confidentiality. 37 C.F.R. § 42.56.

A strong public policy exists for making information filed in an *inter partes* review publicly available. 37 C.F.R. § 42.12; *see also* 77 Fed. Reg. at 48760–61. We must balance the public’s interest in maintaining a complete and understandable file history with the party’s interest in protecting truly sensitive information. 77 Fed. Reg. at 48760.

In our decision of February 5, 2015, we determined that good cause existed to seal Exhibit 2006 (Declaration of Partha Dutta), Exhibits 2007, 2010, 2011, 2012, and 2013 (collectively, “the AT&T documents”) and corresponding portions of Paper 29 (unredacted Patent Owner’s Response), because they contain confidential information related to the development of the GeoPlex product by AT&T. *See* Paper 36, 2–3.

During the subsequent course of the trial, however, testimony of Michah Lerner called into question whether the sealed information was truly confidential. *See* Paper 59, 2. Dr. Lerner testified that he taught college courses and wrote a textbook based upon the technology involved in the GeoPlex project. Ex. 2019 ¶ 4. We, thus, informed Patent Owner that any motion to expunge confidential information after the final judgement should address whether the sealed information is truly confidential. Paper 59, 2.

In this regard, Patent Owner proffers additional testimony of Dr. Lerner explaining that the information contained exclusively in the AT&T documents is confidential and was not used in college courses or in the preparation of his book. Ex. 2024 ¶ 8. We are satisfied by Dr. Lerner’s explanation that the information did not become public through his actions

and determine that good cause exists to continue to treat the AT&T documents and the corresponding portions of the Declaration of Partha Dutta and the Patent Owner's Response as confidential. *See* Paper 36; *see also* Mot. 1–4 (addressing the confidentiality of the AT&T documents).

Patent Owner proffered the AT&T documents to corroborate the testimony of Mr. Dutta regarding an issue of prior invention. *See* Paper 54, 13. In our Final Written Decision,<sup>1</sup> we were not persuaded that the information in the AT&T documents sufficiently corroborated Mr. Dutta's testimony and relied upon other evidence as providing sufficient corroboration to establish prior invention. *Id.* at 13–15. Our decision, thus, does not rely upon the confidential information in the AT&T documents and the corresponding portions of the Declaration of Partha Dutta and the Patent Owner's Response and the confidential information is not necessary to understand our decision. As such, any public interest in making this confidential information available is minimal. *See* Mot. 4–5.

Upon consideration of the above, we are persuaded by Patent Owner that the public's interest in maintaining a complete and understandable file history does not outweigh the need to protect the confidential information in the AT&T documents. Accordingly, the AT&T documents, the unredacted Patent Owner's Response, and the Declaration of Partha Dutta are expunged from the record.

Unlike for the Patent Owner's Response, the record does not contain a redacted version of the Declaration of Partha Dutta. Only portions of the Declaration refer to the confidential information in the AT&T documents

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<sup>1</sup> The time period to appeal our Final Written Decision, pursuant to 35 U.S.C. § 141(c) has expired without any appeal being filed. *See* Mot. 3.

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and, thus, only those portions should be removed from the record. In its Motion, Patent Owner indicates that it is willing to file such a redacted copy of the Declaration. Mot. 5. No later than April 1, 2016, Patent Owner must file a copy of the Declaration of Parth Dutta having only the confidential information redacted.

Our decision of February 5, 2015 also sealed Exhibits 2008 and 2009. *See* Paper 36, 2–3. Patent Owner does not request that we expunge Exhibits 2008 and 2009 and indicates that Dr. Lerner used materials from these exhibits in his college courses and textbook. *See* Mot. 1, 4. Accordingly, Exhibits 2008 and 2009 are unsealed.

It is:

ORDERED that Patent Owner's Motion to Expunge is *granted* and Exhibits 2006, 2007, 2010, 2011, 2012, and 2013 and Paper 29 are *expunged*;

FURTHER ORDERED that Exhibits 2008 and 2009 are unsealed; and

FURTHER ORDERED that, no later than April 1, 2016, Patent Owner should file a copy of Exhibit 2006 with the confidential information redacted.

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