

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION,
Petitioner,

COMPASS BANK, COMMERCE BANCSHARES, INC., and
FIRST NATIONAL BANK OF OMAHA,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

IPR2014-00587 (Patent No. 6,826,694 B1)
IPR2014-00786 (Patent No. 6,826,694 B1)¹

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

PETRAVICK, *Administrative Patent Judge*.

ORDER

Granting Request to Preserve Record Pending Appeal
37 C.F.R. § 42.56

¹ This Order addresses the same or similar issue in the proceedings listed above. Therefore, we issue one Order to be filed in each proceeding. The parties, however, are not authorized to use this style of filing.

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Patent Owner filed unopposed motions² requesting that the records in these proceedings be preserved pending outcome of possible appeal. *See* Paper 58.³ Petitioners do not oppose the request. *Id.* at 1. The parties were permitted to file certain information under seal, in accordance with 37 C.F.R. § 42.54(a). *See* Paper 36. The 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. Here, Patent Owner asks that the record be preserved as is, *i.e.*, without removal or disclosure to the public of the information filed under seal, pending possible appeal. Under the present circumstances, it is reasonable to maintain the record undisturbed pending outcome of any appeal that is taken.

At the conclusion of any appeal proceeding, or if no appeal is taken, Patent Owner may contact the Board for authorization to file a motion to expunge confidential information. During the course of the trial, testimony of Michah Lerner called into question whether the sealed information regarding AT&T's GeoPlex project was truly confidential. Mr. Lerner testified that he taught college courses and wrote a textbook based upon the technology involved in the GeoPlex project. Ex. 2019 ¶ 4. Any motion to expunge confidential information should address whether the sealed information is truly confidential in light of Mr. Lerner's testimony.

² The filing of the motion was authorized during a conference call held on October 30, 2015. *See* Ex.

³ For the purposes of this Order, IPR2014-00587 is representative and all citations are to papers in IPR2014-00587 unless otherwise noted.

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If Patent Owner does not contact the Board, then the information filed under seal will be made public in due course. *See* 77 Fed. Reg. at 48761.

It is:

ORDERED that within ten business days of the conclusion of any appeal proceeding, or if no appeal is taken within ten business days of the expiration of the period to file a notice of appeal, Patent Owner may contact the Board for authorization to file a motion to expunge confidential information; and

FURTHER ORDERED that the record shall remain undisturbed as discussed herein until such time that a motion to expunge confidential information is filed or, if the Patent Owner fails to contact the Board as required herein, the information filed under seal shall be made public in due course.

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