

Paper No. _____

Date Filed: March 4, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, L.L.C.,
Petitioner

v.

ULTRATEC, INC.,
Patent Owner

Case IPR2015-00637
Patent No. 8,908,838

**PATENT OWNER'S AND PETITIONER'S JOINT MOTION TO
EXPUNGE UNDER 37 C.F.R. § 42.56**

Submitted Electronically Via E2E

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.56 and the Board’s authorization of September 7, 2016 (Paper 98 at 18), Patent Owner, Ultratec, Inc., and Petitioner, CaptionCall, L.L.C., hereby move jointly to expunge sealed Papers 46, 48, 67, 68, 80, and 89 (“Papers”), and sealed Exhibits (“Exhibits”) 2071, 2086, 2091, 2106, 2107, 2121, and 2123.

The Papers and Exhibits were each filed under seal because they contain information the Parties identified as confidential. As discussed in detail below, the Papers and Exhibits concern Patent Owner’s sealed Motion to Dismiss the Petition for Failure to Name All Real Parties-in-Interest. Paper 46 is the Motion to Dismiss, Paper 48 is the associated Motion to Seal, Paper 68 is the Patent Owner’s Reply in Support of its Motion to Dismiss, Paper 67 is the associated Motion to Seal, and the Exhibits 2086, 2091, 2106, and 2107 are documents submitted solely in support of the Motion to Dismiss. Additionally, Exhibit 2121—which was later re-filed as Exhibit 2123—is Patent Owner’s demonstratives containing sealed portions on the subject of Patent Owner’s Motion to Dismiss (Paper 46), and Paper 80 is the associated Motion to Seal. Paper 89 is the sealed hearing transcript as it relates to Patent Owner’s Motion to Dismiss. *See* Paper 83 at 2 (ordering that a portion of the hearing will be closed to the public because Patent Owner expects “discuss[ing] information and exhibits it submitted under seal relative to its Motions to Dismiss”).

Finally, Exhibit 2071 is a sealed September 19, 2014 letter submitted solely in support of Patent Owner's Motion for Additional Discovery under 37 C.F.R. § 42.51(B)(2) (Paper 29) also in relation to its Motion to Dismiss.

II. PROCEDURAL BACKGROUND

On September 7, 2016, the Board issued its Final Written Decision and held that claims 1-30 of U.S. Patent No. 8,908,838 have been shown by Petitioner to be unpatentable. Paper 98 at 119. The Board denied Patent Owner's Motion to Dismiss and the Papers and Exhibits were not relied upon for the Board's unpatentability determinations in the Final Written Decision. *See* Paper 98; Paper 99.

The Board ordered in the Final Written Decision that the Parties may move to expunge confidential information from the record after any appeals concluded. Paper 98 at 18. Patent Owner filed a notice of appeal on November 8, 2016 (Paper 102). On January 18, 2022, Patent Owner filed an unopposed motion to dismiss the appeal, which the Federal Circuit granted on January 19, 2022. *See Ultratec, Inc. v. CaptionCall, LLC*, Dkt. No. 26 in Appeal No. 17-1210 (Fed. Cir.). The Parties thus request that the Board expunge the Exhibits and Papers.

III. APPLICABLE LEGAL STANDARD

47 C.F.R. § 42.56 provides that “[a]fter 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.” The Board has previously explained that a party

moving to expunge has to show that: i) “any information sought to be expunged constitutes confidential information[;]” and ii) the movant’s interest in expunging the information “outweighs the public’s interest in maintaining a complete and understandable file history.” *RPX Corp. v. VirnetX Inc.*, IPR2014-00171, Paper 62 at 3 (P.T.A.B. Sept. 9, 2014). The regulations identify confidential information as “a trade secret or other confidential research, development, or commercial information.” 37 C.F.R. § 42.54(a)(7). The Board must 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).

IV. REASONS FOR THE RELIEF REQUESTED

For the reasons set forth below, good cause exists to expunge the aforementioned Papers and Exhibits from the record because they contain information that the Parties identified as confidential and were sealed on that basis. Additionally, the material that the Parties seek to expunge is not required for a complete understanding of the record.

A. The Papers and Exhibits Contain Confidential Information

Exhibit 2071 is a September 19, 2014 letter containing previously proposed license terms between Patent Owner and Petitioner, which are of a competitively

sensitive nature, are not available to the public, and are treated by the Parties as confidential. It further references information regarding actual licensing provisions between Patent Owner and its business partners. Public knowledge of Patent Owner's licensing strategy and terms could cause serious harm to Patent Owner's licensing negotiations in the future, and therefore, the Parties seek to expunge this letter.

Exhibits 2086 and 2091 were also filed by Patent Owner under seal in support of its Motion to Dismiss (Paper 46), and, as noted in Patent Owner's corresponding Motion to Seal (Paper 48), Petitioner has maintained that said documents and any reference to their contents is confidential. *See* Paper 48 at 3-6 (describing in detail the confidentiality of these Exhibits). In light of this, the Parties seek to expunge Exhibits 2086 and 2091.

Exhibits 2106 and 2107 were produced by Petitioner in the concurrent litigation in the Western District of Wisconsin, *Ultratec, Inc. v. Sorenson Communications, Inc.*, 14-cv-66-jdp (W.D. Wisc.), and are designated "Highly Confidential – Outside Counsel Only Information" under the Protective Order

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.