

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, L.L.C.,
Petitioner,

v.

ULTRATEC, INC.,
Patent Owner.

IPR2015-00637
Patent 8,908,838 B2

Before WILLIAM V. SAINDON, BARBARA A. BENOIT, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

Per Curiam.

ORDER
Granting Motion to Expunge
37 C.F.R. § 42.56

I. INTRODUCTION

With our authorization, and pursuant to 37 C.F.R. § 42.56, Ultratec, Inc. (“Patent Owner”) and CaptionCall, L.L.C. (“Petitioner”) (jointly, “the parties”) filed a joint motion seeking to expunge sealed Papers 46, 48, 67, 68, 80, and 89 (“Papers”), and sealed Exhibits 2071, 2086, 2091, 2106, 2107, 2121, and 2123 (“Exhibits”). Paper 104 (“Motion” or “Mot.”).

“[A]fter final judgment in a trial, a party may file a motion to expunge confidential information from the record.” *See* 37 C.F.R. § 42.56. On September 7, 2016, we entered a Final Written Decision (Paper 98) (“Decision” or “Dec.”), which was appealed by Patent Owner (Paper 102). On September 8, 2016, we denied Patent Owner’s Motion to Dismiss. Paper 99. On January 19, 2022, the United States Court of Appeals for the Federal Circuit granted Patent Owner’s motion to voluntarily dismiss its appeal of the Final Written Decision, in *Ultratec, Inc. v. CaptionCall, LLC*, Dkt. No. 26 in Appeal No. 17-1210 (Fed. Cir.). Mot. 2. On March 4, 2022, the parties filed this Motion. For the reasons discussed below, the Joint Motion is *granted*.

II. DISCUSSION

A strong public policy exists for making open to the public all information filed in this administrative proceeding. Only “confidential information” is protected from disclosure. 35 U.S.C. § 316(a)(7) (“The Director shall prescribe regulations . . . providing for protective orders governing the exchange and submission of confidential information.”). The Consolidated Trial Practice Guide (“TPG”) states that:

Confidential information that is subject to a protective order ordinarily would become public 45 days after denial of a petition to institute a trial or 45 days after final judgment in a trial. There is an expectation that information will be made public where the

existence of the information is referred to in a decision to grant or deny a request to institute a review or is identified in a final written decision following a trial. A party seeking to maintain the confidentiality of information, however, may file a motion to expunge the information from the record prior to the information becoming public. 37 C.F.R. § 42.56. The rule balances the needs of the parties to submit confidential information with the public interest in maintaining a complete and understandable file history for public notice purposes. The rule encourages parties to redact sensitive information, where possible, rather than seeking to seal entire documents.

Consolidated Trial Practice Guide at 21–22 (Nov. 2019), *available at* <http://www.uspto.gov/TrialPracticeGuideConsolidated>. “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.” *Id.* at 19.

A. Description of Papers

Paper 46 is Patent Owner’s Motion to Dismiss the Petition for Failure to Name All Real Parties-In-Interest. (A redacted version is publicly available in Paper 49.) We granted Patent Owner’s Motion to Seal the redacted portions of Paper 46. Dec. 18. Paper 48 is Patent Owner’s Motion to Seal the following documents: Exhibit 2086 (“Mediation Notice”); the redacted portions of Paper 46 (Motion to Dismiss) that refer to the Mediation Notice, mediation, or previous motions to seal; Exhibit 2091 (an e-mail); and Paper 48 itself. This Motion was granted. Dec. 18. Paper 67 is Patent Owner’s Motion to Seal the Patent Owner’s Reply in Support of its Motion to Dismiss (Paper 68), and Paper 67 itself. This Motion was granted. Dec. 18. Paper 68 is Patent Owner’s Reply in Support of its Motion to Dismiss. We granted Patent Owner’s Motion to Seal the redacted portions of this Paper. *Id.* Paper 80 is Patent Owner’s Motion to Seal Patent

Owner's Demonstratives in Exhibit 2121, and Paper 80 itself. This Motion was granted. *Id.* Paper 89 is the Record of Oral Hearing for a portion of the April 6, 2016 hearing (after 11:37 a.m.), and is labeled "Confidential – Protective Order Material." In this Paper, the discussion is limited to the Motion to Dismiss. A redacted, public version, reporting the portion of the hearing before 11:25 a.m., is in Paper 90. *See* Dec. 2, Paper 83.

B. Description of Exhibits

Exhibit 2071 "is a sealed September 19, 2014 letter submitted solely in support of Patent Owner's Motion for Additional Discovery." Mot. 2. The Exhibit was named in a Motion to Seal (Paper 29, revised in Paper 42), which was granted. Dec. 17. As noted earlier in regard to Paper 48, Exhibit 2086 is a "Notice of Mediation." The Motion to seal this exhibit was granted. *Id.* at 18. As noted earlier in regard to Paper 48, Exhibit 2091 is an e-mail. The Motion to seal this exhibit was granted. *Id.* Exhibit 2106 is titled "Sorenson Holdings, LLC Consolidated Financial Statements." Patent Owner filed a Motion to Seal this exhibit (Paper 57), which was granted (Dec. 18). Exhibit 2107 is titled "Sorenson Holdings, LLC Financial Report for the Quarter Ended March 31, 2015." Patent Owner filed a Motion to Seal this exhibit (Paper 57), which was granted (Dec. 18). Exhibits 2121 and 2123 each are titled "Patent Owner's Demonstratives for Oral Hearing." Exhibit 2123 (and the redacted, public version in Exhibit 2124) was filed to replace Exhibit 2121 (and the redacted, public version in Exhibit 2122). Mot. 1. A Motion to Seal Exhibit 2121 was filed in Paper 80, and the Exhibit number was updated in Paper 85. The Motion to seal both Exhibits 2121 and 2123 was granted. Dec. 18.

C. The Parties' Contentions

The parties contend that for all the named Papers and Exhibits, which were filed under seal and were never made public, “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.” Mot. 3. As to that point, the parties further contend:

First, none of the Papers or Exhibits was relied upon by either the Patent Owner or the Petitioner for any argument concerning the patentability of the claims. Second, the Board did not rely on any of the Papers or Exhibits in issuing its unpatentability determinations in the Final Written Decision. Third, the appeal has concluded; Patent Owner voluntarily moved to dismiss its appeal of the Board’s Final Written Decision, which the Federal Circuit granted on January 19, 2022. [] And Fourth, the Board’s Order denying Patent Owner’s Motion to Dismiss is public in its entirety (Paper 99) and the record includes non-confidential versions of Patent Owner’s Motion to Dismiss the Petition for Failure to Name All Real Parties-in-Interest (Paper 49), and Patent Owner’s Reply in Support of its Motion to Dismiss (Paper 69), thereby maintaining public access to any information relevant to this IPR.

Mot. 7 (citation omitted).

Because we agree with the statements by the parties, we are persuaded by the parties’ contentions that expunging Papers 46, 48, 67, 68, 80, and 89, and Exhibits 2071, 2086, 2091, 2106, 2107, 2121, and 2123, would protect confidential information without harming the public’s interest in maintaining a complete and understandable file history. The redacted, public versions of the identified documents will be retained in the record for public access.

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