

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 IPR2015-01355
Patent No. 5,974,116

**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 order of January 26, 2017 (Paper 76 at 2-3), Patent Owner, Ultratec, Inc., and Petitioner, CaptionCall, L.L.C., hereby move jointly to expunge sealed Papers 29, 31, 41, and 42 ("Papers"), and sealed Exhibits 2010, 2086, 2091, 2093, and 2094 ("Exhibits").

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 29 is the Motion to Dismiss, Paper 31 is the associated Motion to Seal, Paper 42 is the Patent Owner's Reply in Support of its Motion to Dismiss, Paper 41 is the associated Motion to Seal, and the Exhibits 2086, 2091, 2093, and 2094 are documents submitted solely in support of the Motion to Dismiss. Additionally, Exhibit 2010 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 16) also in relation to Patent Owner's Motion to Dismiss.

II. PROCEDURAL BACKGROUND

On December 14, 2016, the Board issued its Final Written Decision and held that claims 1-13, 15, and 18 of U.S. Patent No. 5,974,116 were shown by Petitioner to be unpatentable. Paper 75 at 78. 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 73; Paper 75.

The Board ordered that the records in IPR2015-01355 be preserved for appeal and that the sealed documents remain under seal at least until 45 days after the expiration of any period for appeal. Paper 75 at 77; Paper 76 at 2-3. Patent Owner filed a notice of appeal on February 14, 2017 (Paper 77). On January 14, 2022, Patent Owner filed an unopposed motion to dismiss the appeal, which the Federal Circuit granted on January 18, 2022. *See Ultratec, Inc. v. CaptionCall, LLC*, Dkt. Nos. 30, 31 in Appeal No. 17-1659 (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

Good cause exists to expunge the Papers and Exhibits from the record because they contain information that the Parties identified as confidential. 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 2010 contains 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. In light of this, the Parties seek to expunge Exhibit 2010.

Exhibits 2093 and 2094 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 entered in that matter.¹ After seeking and obtaining an Order from the district court for relief from the Protective Order’s restrictions (Exhibits 2087, 2088, and 2095) and obtaining leave from the Board (Paper 35), Patent Owner filed the information under seal in this proceeding on March 14, 2016. (Paper 37).

Both Exhibits 2093 and 2094 contain sensitive, non-public financial information of Petitioner’s related entities. *See* Paper 37 at 2. Neither Petitioner nor any of the entities related to it are public companies. The document entitled Sorenson Holdings, LLC’s Financial Report for the Quarter Ended March 31, 2015 (Exhibit 2094) states that it is confidential and was prepared solely for use by any note holders or related investors. The document entitled Sorenson Holdings, LLC Consolidated Financial Statements December 31, 2014 and 2013 (Exhibit 2093)

¹ The Court’s Order re-designated the information “Highly Confidential - Outside Counsel Only Information,” removing the prosecution bar restriction. Ex. 2095 at 1.

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