

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, L.L.C.,
Petitioner,

v.

ULTRATEC, INC.,
Patent Owner.

IPR2015-01355
Patent 5,974,116

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 29, 31, 41, and 42 (“Papers”), and sealed Exhibits 2010, 2086, 2091, 2093, and 2094 (“Exhibits”). Paper 79 (“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 December 14, 2016, we entered a Final Written Decision (Paper 75) (“Decision” or “Dec.”), which was appealed by Patent Owner (Paper 77). On September 8, 2016, we denied Patent Owner’s Motion to Dismiss. Paper 73. On January 18, 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. Nos. 30, 31 in Appeal No. 17-1659 (Fed. Cir.). Mot. 2. On March 4, 2022, the parties filed this Motion. For the reasons discussed below, the 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 29 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 32.) We granted Patent Owner’s Motion to Seal this Paper. Dec. 77. Paper 31 is Patent Owner’s Motion to Seal the following documents: Exhibit 2086 (“Mediation Notice”); the redacted portions of Paper 29 (Motion to Dismiss) that refer to the Mediation Notice, mediation, or previous motions to seal; Exhibit 2091 (an e-mail); and Paper 31 itself. This Motion was granted. Dec. 77. Paper 41 is Patent Owner’s Motion to Seal the Patent Owner’s Reply in Support of its Motion to Dismiss (Paper 42), and Paper 41 itself. This Motion was granted. Dec. 77. Paper 42 is Patent Owner’s Reply in Support of its Motion to Dismiss. We granted Patent Owner’s Motion to Seal this Paper, as requested in Paper 42. Dec. 77.

B. Description of Exhibits

Exhibit 2010 “is a sealed September 19, 2014 letter submitted solely in support of Patent Owner’s Motion for Additional Discovery.” Mot. 1. As noted earlier in regard to Paper 31, Exhibit 2086 is a “Notice of Mediation.” The Motion to seal this exhibit was granted. Dec. 77. As noted earlier in regard to Paper 31, Exhibit 2091 is an e-mail. The Motion to seal this exhibit was granted. Dec. 77. Exhibit 2093 is titled “Sorenson Holdings, LLC Consolidated Financial Statements, December 31, 2014 and 2013.” Patent Owner filed a Motion to Seal this exhibit (Paper 37), which was granted (Dec. 77). Exhibit 2094 is titled “Sorenson Holdings, LLC Financial Report for the Quarter Ended March 31, 2015.” Patent Owner filed a Motion to Seal this exhibit (Paper 37), which was granted (Dec. 77).

C. The Parties’ Contentions

The parties contend that for all the named Papers and Exhibits, which were filed under seal, and thus 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 18, 2022. [] And Fourth, the Board’s Order denying Patent Owner’s Motion to Dismiss is public in its entirety (Paper 73), and the record includes non-

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confidential versions of Patent Owner's Motion to Dismiss the Petition for Failure to Name All Real Parties-in-Interest (Paper 32), and Patent Owner's Reply in Support of its Motion to Dismiss (Paper 43), thereby maintaining public access to any information relevant to this IPR.

Mot. 6 (citation omitted).

Because we agree with the statements by the parties, we are persuaded by the parties' contentions that expunging Papers 29, 31, 41, and 42, and Exhibits 2010, 2086, 2091, 2093, and 2094, 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.

III. ORDER

Accordingly, it is

ORDERED that the Joint Motion to Expunge Papers 29, 31, 41, and 42, and Exhibits 2010, 2086, 2091, 2093, and 2094, is *granted*.

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