

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

SPEAKWARE, INC.,
Patent Owner.

IPR2019-00495
Patent 6,397,186 B1

Before DEBRA K. STEPHENS, DAVID C. MCKONE, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

ORDER
Denying Petitioner's Motion to Expunge
37 C.F.R. § 42.56

I. INTRODUCTION

The parties previously filed a Joint Motion to Terminate *Inter Partes* Review (Paper 13), along with a copy of a Confidential Agreement (Paper 15, “Agreement”). The parties also previously filed a Joint Request that the Agreement be treated as business confidential information and kept separate from the patent file. Paper 14. We granted the Motion and Joint Request. Paper 16, 2–3. Petitioner subsequently filed a Motion to Expunge the Agreement. Paper 17 (“Mot.”). For the reasons discussed below, the Motion to Expunge is *denied*.

II. ANALYSIS

Petitioner requests that we expunge the Agreement from the record because it “contains both Petitioner’s and Patent Owner’s highly confidential business information.” Mot. 1. Petitioner points out that according to the Office Patent Trial Practice Guide, “[t]here is an expectation that information will be made public where the existence of the information is referred to . . . in a final written decision following a trial.” *Id.* Petitioner asserts that “[t]here is no public interest in now making the [Agreement] publicly available” because it “does not relate to the merits of the case.” *Id.* at 2–3.

We are not persuaded that the Agreement should be expunged from the record. First, 35 U.S.C. § 317(b) requires that any agreement between the patent owner and a petitioner made in connection with the termination of an *inter partes* review “shall be filed in the Office before the termination.” Because the parties filed the Agreement to comply with this requirement of § 317(b) (*see* Paper 13, 1), it would not be appropriate to now expunge the Agreement from the record.

Second, Petitioner's concern that the Agreement will be made public is unwarranted. We previously granted the parties' Joint Request to treat the Agreement as business confidential information to be kept separate from the patent file. Paper 16, 3. As a result, under § 317(b), the Agreement will be maintained under seal and will "be made available only to Federal Government agencies on written request, or to any person on a showing of good cause."

III. CONCLUSION

For the foregoing reasons, we decline to expunge the Agreement from the record.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion to Expunge is *denied*.

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