

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTUITIVE SURGICAL, INC.,  
Petitioner,

v.

ETHICON LLC,  
Patent Owner.

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Case IPR2019-00880  
U.S. Patent No. 7,490,749 B2

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**PATENT OWNER'S MOTION TO EXPUNGE  
CONFIDENTIAL INFORMATION FROM THE RECORD  
AND FILE REDACTED VERSION OF EXHIBITS**

## **I. Introduction**

Pursuant to 37 C.F.R. § 42.56, Patent Owner (Ethicon) respectfully submits this motion to expunge from the record certain documents filed under seal that contain confidential information. Specifically, Patent Owner moves to expunge unredacted sealed versions of Exhibits 2001-2009, 2012, 2017, and 2019, as well as the unredacted sealed versions of Patent Owner's Response (Paper No. 16), Petitioner's Reply (Paper No. 26), Patent Owner's Sur-Reply (Paper No. 31), Petitioner's Motion to Exclude (Paper No. 36), Patent Owner's Opposition to Petitioner's Motion to Exclude (Paper No. 38), and Petitioner's Reply in support of its Motion to Exclude (Paper No. 41).<sup>1</sup>

Patent Owner further moves to file redacted public versions of Ex. 2008, Ex. 2009, Ex. 2012, and Ex. 2017. These updated redacted versions of Ex. 2008, Ex. 2009, Ex. 2012, and Ex. 2017, along with the redacted versions of Ex. 2019, Patent Owner's Response (Paper No. 15), Petitioner's Reply (Paper No. 27) Patent Owner's Sur-Reply (Paper No. 32), Petitioner's Motion to Exclude (Paper No. 35),

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<sup>1</sup> Patent Owner notes that its deadline to appeal the Board's Final Written Decision has yet to pass. Accordingly, Patent Owner requests that the Board reserve judgment concerning the present motion until any such appeal has been resolved.

Patent Owner's Opposition to the Motion to Exclude (Paper No. 39), and Petitioner's Reply regarding the Motion to Exclude (Paper No. 42) that were previously filed, may remain in the record if the sealed versions are expunged and leave the thrust of the Board's final decision understandable and available to the public.

## **II. Background**

In support of its Response, Patent Owner relied on the sealed declarations of Christopher Schall (Ex. 2008), Chad Boudreaux (Ex. 2009), Dean Garner (Ex. 2012), Geoffrey Hueil (Ex. 2017), and Dr. Shorya Awtar (Ex. 2019). Each of these declarations describe highly confidential and proprietary research and development information of Patent Owner, including information contained in Exhibits 2001-2007, which were also filed under seal. If publicly disclosed, the information in Exhibits 2001-2009, 2012, 2017, and 2019 would substantially harm Patent Owner's competitive position in the surgical instrument industry and ongoing work directed to, *inter alia*, surgical stapling instruments.

Numerous filings in this proceeding also reference Patent Owner's highly confidential information disclosed in Exhibits 2001-2009, 2012, 2017, and 2019. On January 14, 2020, Patent Owner submitted its Response to the Petition, including redacted (Paper No. 15) and sealed (Paper No. 16) versions. On April 17, 2020, Petitioner filed its Reply to Patent Owner's Response, including sealed

(Paper No. 26) and redacted (Paper No. 27) versions. On May 21, 2020, Patent Owner submitted its Sur-Reply to Petitioner’s Reply, including redacted (Paper No. 32) and sealed (Paper No. 31) versions. On June 12, 2020, Petitioner filed a motion to exclude, including sealed (Paper No. 36) and redactions (Paper No. 35) versions. On June 19, 2020, Patent Owner filed its opposition to Petitioner’s motion to exclude, including sealed (Paper No. 38) and redactions (Paper No. 39) versions. Finally, on June 26, 2020, Petitioner filed its Reply in support of its motion to exclude, including sealed (Paper No. 41) and redacted (Paper No. 42) versions.

On October 1, 2020, the Board entered its Final Written Decision. Paper No. 45. In its Final Written Decision, the Board did not discuss or address any confidential information contained in Exhibits 2001-2007 or the sealed version of Exhibit 2019. Moreover, the Board only briefly referenced content in Ex. 2008, Ex. 2009, Ex. 2012, and Ex. 2017. *See* Paper 45 at 8-9. Aside from these discrete references to Exhibits 2008, 2009, 2012, and 2017, the Final Written Decision did not discuss or address confidential information disclosed in any of Patent Owner’s exhibits.

### **III. Good Cause Exists to Expunge Exhibits Containing Patent Owner’s Confidential Information**

“After 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.” 37

C.F.R. § 42.56; *see also* Consolidated Office Patent Trial Practice Guide at pp 21-22 (Nov. 2019). “The Board has held [that] the expungement of confidential information is subject to the same ‘good cause’ standard for granting a motion to seal under 37 C.F.R § 42.54.” *Corning Optical Commc’ns RF, LLC v. PPC Broadband, Inc.*, IPR2013-00346, Paper 94, p. 3 (PTAB Oct. 2, 2018) (the “good cause” standard for granting a motion to seal equally applies to a motion to expunge). 37 C.F.R. § 42.54 identifies confidential information in a manner consistent with Federal Rule of Civil Procedure 26(c)(1)(G), which provides for protective orders for trade secret or other confidential research, development, or commercial information. Consolidated Office Patent Trial Practice Guide at p. 19; *see also Gnosis, et al. v. South Alabama Med. Science Found.*, IPR2013-00117, Paper 39, p. 2 (PTAB Oct. 31, 2013) (stating the same).

Patent Owner moves to expunge the unredacted, sealed version of Exhibits 2001-2009, 2012, 2017, and 2019, as well as Paper No. 16, Paper No. 26, Paper No. 31, Paper No. 36, Paper No. 38, and Paper No. 41. These documents contain highly confidential research and development and/or non-public business information of Patent Owner. In other *inter partes* review proceedings, the Board has held that confidential research, development, trade secret, or business information should remain under seal. *See, e.g., Vizio, Inc. v. Nichia Corp.*, IPR2017-01623, Paper No. 77, pp. 3-4 (April 25, 2019); *Hendrickson USA LLC, et*

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