

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

IPR2019-00991
Patent 8,602,287 B2

Before JOSIAH C. COCKS, ZHENYU YANG, and
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

ORDER
Denying without Prejudice
Patent Owner's Motion to Expunge
37 C.F.R. § 42.56

Patent Owner filed a Motion to Expunge, seeking to expunge certain documents filed under seal containing confidential information from the record. Paper 47 (“Mot.”). Patent Owner’s Motion is denied without prejudice.

Previously, we granted the parties’ motions to seal in their entirety Exhibits 2007, 2010–2153, 2155–2163, 2165–2182, 2184–2210, 2213–2264, 2266, 2268–2298, 2300, 2301, and 2303, and the unredacted version of Patent Owner’s Response (Paper 17), Petitioner’s Reply (Paper 26), Patent Owner’s Sur-reply (Paper 35), and Exhibits 1020, 1021, 1023, 2003–2005, 2008, 2009, 2267 and 2299. Paper 48, 43–45; Paper 49. We also issued a confidential version of the Final Written Decision (Paper 43). In addition, Patent Owner filed an updated exhibit list under seal (Paper 45).

In its Motion to Expunge, “Patent Owner requests that sealed versions of Paper Nos. 17, 26, 35, 43, and 45 and Exhibits 1020, 1021, 1023, 2003, 2004, 2005, 2007–2153, 2155–2163, 2165–2182, 2184–2210, 2213–2264, 2266–2301, and 2303 be expunged from the record.” Mot. 1. According to Patent Owner, “[t]he public has little, if any, need to know the specific information the Patent Owner seeks to expunge from the record.” *Id.* at 6.

Confidential information that is subject to a protective order ordinarily becomes public 45 days after final judgment in a trial. Patent Trial and Appeal Board Consolidated Trial Practice Guide 21–22. A party seeking to maintain the confidentiality of the information may file a motion to expunge the information from the record prior to the information becoming public. 37 C.F.R. § 42.56.

In this case, however, Patent Owner has filed a Notice of Appeal, seeking appellate review of the Final Written Decision. Paper 50. We are of the view that the record must be preserved in its entirety, including any

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sealed portions, for the Federal Circuit Court of Appeals to fully consider the issues discussed in the Final Written Decision. We hereby authorize Patent Owner to renew its Motion to Expunge within 45 days of the conclusion of all appeals.

ORDER

Accordingly, it is

ORDERED that Patent Owner's Motion to Expunge is denied without prejudice;

FURTHER ORDERED that the record in this proceeding will be preserved and the documents filed under seal will not be expunged or made public until after the completion of all appeals; and

FURTHERED ORDERED that Patent Owner may renew its Motion to Expunge within 45 days after the conclusion of all appeals; and

FURTHERED ORDERED that in the event that Patent Owner does not timely renew its Motion to Expunge, the documents filed under seal in this proceeding will be unsealed 45 days after the conclusion of all appeals.

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