

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PNC BANK, N.A.,
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Patent Owner.

IPR2022-00050
Patent 10,402,638 B1

Before MICHAEL R. ZECHER, TERRENCE W. McMILLIN, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motion to Expunge Confidential Information
37 C.F.R. § 42.56

United Services Automobile Association (“Patent Owner”), filed un-redacted and redacted versions of its Preliminary Response (Papers 11 and 12), along with a first Joint Motion to Seal Exhibit 2006 and certain portions of the Preliminary Response that reference Exhibit 2006 (Paper 9). PNC Bank, N.A. (“Petitioner”), filed un-redacted and redacted versions of a Preliminary Reply (Papers 14 and 16), along with a second Joint Motion to Seal certain portions of the Preliminary Reply that reference Exhibit 2006 (Paper 13). And Patent Owner filed un-redacted and redacted versions of a Preliminary Sur-reply (Papers 18 and 20), along with a third Joint Motion to Seal certain portions of the Preliminary Sur-reply that reference Exhibit 2006 (Paper 17).

We granted the joint motions to seal (Papers 9, 13, 17), sealing Exhibit 2006 and the portions of the Preliminary Response, Preliminary Reply, and Preliminary Sur-reply that reference Exhibit 2006. Paper 22 (Institution Decision), 36–38. The confidential information was related to an argument regarding the real party in interest, and we determined that we did not need to consider that argument. *Id.* at 36–37. As a result, the Institution Decision did not reference or rely upon the confidential information. *Id.* We issued a Decision Denying Institution of *Inter Partes* Review on May 11, 2022 (Paper 22) and denied Petitioner’s Request for Rehearing of the Decision Denying Institution on January 13, 2023 (Paper 26).

Petitioner moves to expunge Exhibit 2006 and Papers 11, 14, and 18. Paper 27 (“Mot. to Expunge”). “[A]fter 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 Trial Practice Guide (Nov. 2019)

(“Consolidated Practice Guide”)¹ at 21–22 (“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.”).

Granting a motion to seal “confidential information” requires a showing of “good cause” during a proceeding. 37 C.F.R. § 42.54. A parallel rule implies the same standard to a motion to expunge “confidential information” “[a]fter denial of a petition to institute a trial or after final judgment in a trial.” 37 C.F.R. § 42.56. The movant generally has the burden of proof in showing entitlement to the requested relief. 37 C.F.R. § 42.20(c). In this case, Petitioner must show that any information sought to be expunged constitutes confidential information, and that Petitioner’s interest in expunging it outweighs the public’s interest in maintaining a complete and understandable history of this *inter partes* review.

Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc., IPR2013-00453, Paper 97 at 2 (PTAB Apr. 15, 2015).

Petitioner contends that the information it seeks to expunge is the confidential information of a third party, and that, should the information become public, “Petitioner submits that it would be placed in a competitive and strategic disadvantage.” Mot to Expunge 4. Moreover, Petitioner

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

argues, “[w]ere confidential information produced voluntarily under a joint protective order to be disclosed publicly, a producing party would have little incentive to engage in voluntary discovery of confidential information in proceedings before the Board.” *Id.* at 4–5. Petitioner notes that redacted versions of Papers 11, 14, and 18 have been filed (although Exhibit 2006 has been redacted in its entirety). *Id.* at 3–4.

Patent Owner has not filed an opposition to Petitioner’s Motion to Expunge filed on February 17, 2023, and the opposition period has passed. *See* 37 C.F.R. § 42.25(a)(1) (“An opposition is due one month after service of the motion.”).

We agree with Petitioner that good cause exists to expunge Papers 11, 14, and 18 and Exhibit 2006. As Petitioner observes (Mot. to Expunge 3), in granting the parties’ joint motions to seal, we found good cause to seal Exhibit 2006 and portions of the parties’ briefs discussing that exhibit. Paper 22, 37. Thus, we have already found that the information at issue is confidential. In addition, the record includes Papers 12, 16, and 20, which are the public versions of Papers 11, 14, and 18 with minimal and narrowly tailored redactions of the confidential information. Also, the confidential information relates only to an argument regarding real party in interest, and the public will have full access to the unpatentability issues raised pre-institution via Papers 12, 16, and 20. Finally, the real party in interest argument was raised pre-institution, and it was not addressed in the Institution Decision. As a result, we determine that expunging this confidential information will have little to no impact on the public’s interest in maintaining a complete and understandable history of this proceeding. Balancing the potential harm to Petitioner of this information becoming

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public against the public's interest in maintaining a complete and understandable record of this proceeding, we find that good cause exists to expunge Exhibit 2006 and Papers 11, 14, and 18.

IV. ORDER

Accordingly, it is hereby:

ORDERED that Motion to Expunge Confidential Information (Paper 27) is *granted*; and

FURTHER ORDERED that Exhibit 2006 and Papers 11, 14, and 18 are expunged.

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