

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

SIGHTSOUND TECHNOLOGIES, LLC
Patent Owner

Case CBM2013-00020
Patent 5,191,573

Before MICHAEL P. TIERNEY, JUSTIN T. ARBES, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

DECISION
Motions to Seal
37 C.F.R §§ 42.14 and 42.54

INTRODUCTION

The parties filed a Joint Motion to Seal (Paper 54) that seeks to seal certain exhibits and portions of documents that reference the exhibits. Petitioner filed a Motion to Seal (Paper 72) seeking to seal portions of Petitioner's Motion to Exclude (Paper 70, redacted version; Paper 71, unredacted version). The parties also filed a Joint Motion to Seal (Paper 87) seeking to seal portions of Petitioner's Reply in Support of its Motion to Exclude (Paper 88, unredacted version; Paper 89, redacted version). The parties submitted a copy of the Board's default protective order as a proposed protective order (Exhibit 4269) for this proceeding. Paper 54 at 3. Because the parties agree to the terms of the protective order, the Board hereby enters the protective order. As a consequence, the default protective order governs the treatment and filing of confidential information in this proceeding. For reasons discussed below, the Joint Motion to Seal (Paper 54), Petitioner's Motion to Seal (Paper 72), and the Joint Motion to Seal (Paper 87) are *conditionally* granted.

DISCUSSION

There is a strong public policy in favor of making information filed in a covered business method patent review open to the public, especially because the proceeding determines the patentability of claims in an issued patent and, therefore, affects the rights of the public. Under 35 U.S.C. § 326(a)(1) and 37 C.F.R. § 42.14, the default rule is that all papers filed in a covered business method patent review are open and available for access by the public; a party, however, may file a concurrent motion to seal and the information at issue is sealed pending the outcome of the motion. It is, however, only “confidential information” that is protected from disclosure. 35 U.S.C. § 326(a)(7). In that regard, the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012) provides:

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.

...

Confidential Information: The rules identify 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. § 42.54.

The standard for granting a motion to seal is “for good cause.”

37 C.F.R. § 42.54(a). In the Joint Motions to Seal (Paper 54, Paper 87), both

parties bear the burden of proof in showing entitlement to the requested relief. 37 C.F.R. § 42.20(c). The Board needs to know why the information sought to be sealed constitutes confidential information. In the Motion to Seal (Paper 72) filed by Petitioner, Petitioner bears the burden of proof.

Joint Motion to Seal (Paper 54)

In the Joint Motion to Seal (Paper 54), the parties move to seal Exhibits 4157-4163 and states that “each of the Proposed Exhibits. . . contains [Patent Owner’s] confidential trade secret, business, and commercial information.” Paper 54 at 3. Patent Owner has not submitted a redacted version of any of the exhibits that are the subject of the Joint Motion to Seal (Paper 54), instead requesting that each document be sealed in its entirety. The parties also move to seal portions of Petitioner’s Reply (Paper 51, redacted version; Paper 52, unredacted version), the Declaration of Lawrence Kenswil (Exhibit 4256, unredacted version), and the Second Declaration of Dr. John P.J. Kelly (Exhibit 4262, unredacted version). Petitioner has filed redacted versions of Petitioner’s Reply (Paper 51) and the two Declarations, which are publicly available.

In Petitioner's Reply, Petitioner relies on excerpts from Exhibits 4157-4163 to rebut Patent Owner's assertions that secondary considerations indicate non-obviousness of the challenged claims.

As discussed previously, there is a strong public policy for making all information filed in a covered business method patent review open to the public. However, upon review of the documents and considering the stated confidentiality of these exhibits by the parties, rather than denying the Joint Motion to Seal, which would make the exhibits immediately publicly accessible, the Board *conditionally* grants the Joint Motion to Seal (Paper 54) for the duration of this proceeding. If the Board's final written decision substantively relies on any information in a sealed exhibit, that exhibit will be unsealed by an Order of the Board; and if any sealed exhibit contains no information substantively relied on by the Board in the final written decision, then that exhibit will be expunged from the record by an Order of the Board.

We encourage the parties, if possible, to submit summary documents of Exhibits 4157-4163, 4256, and 4262 that contain the information necessary for the parties to make their arguments, so that the Board could refer to the summaries in its final written decision if necessary, rather than

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.