

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

SIGHTSOUND TECHNOLOGIES, LLC
Patent Owner

Case CBM2013-00023
Patent 5,966,440

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 48) that seeks to seal certain exhibits and portions of documents that reference the exhibits. Petitioner filed a Motion to Seal (Paper 68) seeking to seal portions of Petitioner's Motion to Exclude (Paper 66, redacted version; Paper 67, unredacted version). The parties also filed a Joint Motion to Seal (Paper 83) seeking to seal portions of Petitioner's Reply in Support of its Motion to Exclude (Paper 84, unredacted version; Paper 85, redacted version). The parties submitted a copy of the Board's default protective order as a proposed protective order (Exhibit 4468) for this proceeding. Paper 48 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 48), Petitioner's Motion to Seal (Paper 68), and the Joint Motion to Seal (Paper 83) 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 48, Paper 83), 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 68) filed by Petitioner, Petitioner bears the burden of proof.

Joint Motion to Seal (Paper 48)

In the Joint Motion to Seal (Paper 48), the parties move to seal Exhibits 4358-4364 and states that “each of the Proposed Exhibits. . . contains [Patent Owner’s] confidential trade secret, business, and commercial information.” Paper 48 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 48), instead requesting that each document be sealed in its entirety. The parties also move to seal portions of Petitioner’s Reply (Paper 50, redacted version; Paper 49, unredacted version), the Declaration of Lawrence Kenswil (Exhibit 4414, unredacted version), and the Second Declaration of Dr. John P.J. Kelly (Exhibit 4420, unredacted version). Petitioner has filed redacted versions of Petitioner’s Reply (Paper 50) and the two Declarations, which are publicly available.

In Petitioner's Reply, Petitioner relies on excerpts from Exhibits 4358-4364 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 48) 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 4358-4364, 4414, and 4420 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

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