

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner

v.

RAYTHEON COMPANY,
Patent Owner

Case IPR2016-00209

Patent 5,591,678

**PATENT OWNER'S UNOPPOSED MOTION
FOR PRESERVATION OF THE RECORD**

INTRODUCTION

The record in this proceeding contains information that is confidential and subject to strict regulations, including the International Traffic in Arms Regulations (“ITAR”), 22 C.F.R. Parts 120-130. Patent Owner is currently considering whether to appeal the Board’s Final Written Decision in this proceeding, and for the reasons stated herein, respectfully moves for an order that the record be preserved pending appeal.

I. BACKGROUND

On November 30, 2016, the Board entered Final Written Decisions in IPR2015-001201 and IPR2016-00209, two IPRs that had a consolidated hearing. IPR2015-001201, Paper 59; IPR2016-00209, Paper 45. In both proceedings, the Board entered modified protective orders because, *inter alia*, Patent Owner filed confidential information, including information governed by ITAR. IPR2015-001201, Paper 19 at pp. 4-5, 11; IPR2016-00209, Paper 39. Patent Owner files the present motion to (1) ensure that the record in this proceeding stays intact for a potential appeal of the IPRs and (2) to ensure that confidential information, including information governed by ITAR, is not released to the public as a result of the Board’s Final Written Decision.

II. PATENT OWNER REQUESTS THE RECORD TO BE PRESERVED FOR APPEAL

Patent Owner respectfully requests that the entire docket in this proceeding be preserved pending a possible appeal, including preservation of all sealed documents in non-public form. Other Board panels have granted similar requests. *See International Business Machines Corp. v. Intellectual Ventures II LLC*, IPR2014-00587, Paper 59 at 2-3 (P.T.A.B. Nov. 20, 2015); *LKQ Corp. v. Clearlamp, LLC*, IPR2013-00020, Paper 77 at 2 (P.T.A.B. Dec. 19, 2014); *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, IPR2013-00128, Paper 93 at 2-3 (P.T.A.B. Sep. 10, 2014); *Illumina, Inc. v. Columbia Univ.*, IPR2012-00006, Paper 133 at 3-4 (P.T.A.B. April 25, 2014). Petitioner does not oppose.

Sealed confidential information subject to a protective order will ordinarily become public 45 days after final judgment in a trial unless a motion to expunge is filed. 77 Fed. Reg. 48761; *see also* 37 C.F.R. § 42.56. Here, the date 45 days after final judgment was entered is January 14, 2017. However, the Parties have until 63 days from the final Board decision, February 1, 2017, to file a notice of appeal. *See* Paper 59; 37 C.F.R. § 90.3(a)(1) (“The notice of appeal filed pursuant to 35 U.S.C. 142 must be filed with the Director of the United States Patent and Trademark Office no later than sixty-three (63) days after the date of the final Board decision.”).

The Federal Rules of Appellate Procedure and the Federal Circuit Rules require that the record be retained by the Board pending appeal. Specifically, Federal Circuit Rule 17(a) states that “[t]he agency must retain the record.” Federal Circuit Rule 17(d), titled “Access of Parties and Counsel to Original Record” also requires that the parties and their counsel have access to both the sealed and unsealed portions of the record “[w]hen a petition for review or notice of appeal is filed.” No notice of appeal has yet been filed, and the deadline for filing a notice of appeal, as noted above, is February 1, 2017.

Moreover, the information that was filed under seal in IPR2015-001201 was discussed at length by the parties in their briefs (*see, e.g.*, Paper 23 at 6-19, 24-31; Paper 50 at 9-30) and was cited to by the Board in its Final Written Decision (*see, e.g.*, Paper 2071 at 15-17, 19-27). If the record is not preserved in its entirety including any sealed portions and an appeal is taken, the Federal Circuit may not be able to fully consider the issues discussed in the Final Written Decision, which would cause prejudice to the Parties.

III. ALTERNATIVELY, PATENT OWNER MOVES TO EXPUNGE

As sealed information is normally released to the public 45 days after final written decision, a motion to expunge should ordinarily be filed before that time. 77 Fed. Reg. 48761; 37 C.F.R. § 42.56. In this case, the deadline to file a motion

to expunge is therefore January 14, 2017. For the reasons stated in section II above, Patent Owner respectfully submits that the proper course of action is to preserve the record pending appeal. However, in an abundance of caution, due to the obligations under ITAR to prevent the public release of government-regulated confidential information, to the extent that the Board denies the motion to preserve, Patent Owner must alternatively move to expunge all sealed portions of the record in this proceeding.

Date: January 10, 2017

Respectfully submitted

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