

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMIT AGARWAL,
Petitioner,

v.

IMMERSION CORPORATION,
Patent Owner.

Case IPR2016-00807
Patent No. 8,773,356

**PATENT OWNER'S MOTION TO SEAL
PURSUANT TO 37 C.F.R. §§ 42.54 AND 42.14**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. INTRODUCTION

Pursuant to 37 C.F.R. §§ 42.54 and 42.14, Patent Owner Immersion Corp. (“Immersion”) hereby moves to seal the transcript of the conference call of May 20, 2016 (the “Transcript”), Ex. 2003, filed concurrently with this motion.

As per 37 C.F.R. § 42.20 (b), the motion to seal was authorized by the Board in the conference call. *See* Ex 2003 at 30. Petitioner did not oppose this motion during the conference call. *Id.*

The conference call concerned Immersion’s proposed motion for relief for alleged ethical violations of the Petitioner in connection with his employment at Irell & Manella, the law firm representing Immersion. The Transcript therefore records a discussion of the privileged and confidential communication between Immersion and its counsel at issue on the motion, including communications regarding both its interpretation of the prior art at issue in this proceeding, and the role of this prior art in the context of Immersion’s broader patent strategy. Immersion is discussing this information with the Board (and in the Transcript) only because of the necessity of having to seek authorization to file a motion based in part on Petitioner’s receipt of the confidential information discussed in the Transcript. Good cause therefore exists to seal the Transcript.

II. GOOD CAUSE EXISTS FOR THIS MOTION TO SEAL

In deciding whether to seal documents, the Board must find “good cause,” striking “a balance between the public’s interest in maintaining a complete and understandable file history and the parties’ interest in protecting truly sensitive

information.” *Garmin v. Cuozzo*, IPR2012-00001, Paper 36 (April 5, 2013).

The Board has acknowledged in previous decisions that good cause to seal exists when material discloses a party’s confidential business information or confidential business strategy. *See, e.g., Unified Patents Inc. v. Dragon Intellectual Property, LLC*, IPR2014-01252, Paper 40 at 5-6 (February 27, 2015) (granting motion to seal information relevant to business strategy); *Wright Med. Tech. v. Biomedical Enter. Inc.*, IPR2015-00786, Paper 37 (May 3, 2016) (similar); *Ameriforge Inc. v. Worldwide Oilfield Machine, Inc.*, IPR2015-00233, Paper 37 at 35-36 (May 16, 2016) (similar).

Here, there is good cause to seal the Transcript. The Transcript discusses the subjects of privileged and confidential communications between Immersion and its counsel regarding its interpretation of prior art relevant to multiple patents in its portfolio. These communications took place in the context of strategic discussions regarding Immersion’s patent portfolio and potential claims that Immersion might assert against entities that are not parties to this proceeding. *See, e.g., Ex. 2003* at 9:7 – 12:5, 16:12 – 19:12, 21:17-20, 21:25 – 23:4, 28:8-21. The communications discussed at length in the Transcript are themselves indisputably confidential, which itself weighs in favor of sealing the Transcript. *Cf. Nissan North Am., Inc., v. Diamond Coating Techs., LLC*, IPR2014-01546, Paper 50 at 3-4 (April 20, 2016) (granting motion to seal a document, when party filed motion to seal the document “solely” because it discussed materials previously designated confidential).

As the discussion in the Transcript does not address either party's view of the merits of the arguments advanced by Petitioner in his petition, the burden on the public from sealing the Transcript is minimal. *See, e.g., Masterimage 3D Inc. v. Reald Inc.*, IPR2015-00040, Paper 85 at 76 (April 14, 2016) (granting motion to seal after balancing "Patent Owner's assertion of confidentiality with the public's interest in a sufficiently understandable record *with respect to the substantive decisions made regarding patentability*") (emphasis added); *see also id.* at 75 (burden on public "minimal" when reference to sealed materials was not needed "to address the issues" in a final written decision).

III. CERTIFICATION OF NON-PUBLICATION

On behalf of Immersion, the undersigned counsel certifies the information sought to be sealed by this motion to seal has not been published or otherwise made public.

IV. CERTIFICATION OF CONFERENCE WITH OPPOSING PARTY PURSUANT TO 37 C.F.R. § 42.54

Pursuant to 37 C.F.R. § 42.54, counsel for Immersion sought in good faith to confer with Petitioner regarding a motion to seal the communication between Immersion and its counsel discussed in the Transcript and the corresponding PowerPoint slide deck containing the underlying information, and a proposed protective order, on May 13, 2016. Petitioner responded to the email on May 15, 2016 by not opposing such a motion and agreeing to the protective order. During the conference call, Mr. Fleming pointed out that information in the privileged and confidential PowerPoint slide deck was disclosed and discussed. Ex. 2003 at 29.

Mr. Fleming requested authorization to file a motion to seal the transcript. Ex. 2003 at 29-30. In addition, Mr. Fleming pointed out that Petitioner had agreed to the protective order. *Id.* Petitioner did not object to the motion or the protective order. *Id.* After hearing the request, the Board granted authorization to file the motion to seal. *Id.*

V. PROPOSED PROTECTIVE ORDER

Petitioner and Immersion have agreed to entry of the Standing Protective Order found in Appendix B of the Trial Practice Guide, filed concurrently with this motion. Ex. 2002.

Respectfully submitted,

Dated: May 25, 2016

By: /Michael Fleming/

IRELL & MANELLA LLP
Michael R. Fleming (Reg. No. 67,933)
MFleming@irell.com
Babak Redjaian (Reg. No. 42,096)
bredjaian@irell.com
1800 Avenue of the Stars, Suite 900
Los Angeles, California 90067
Telephone: (310) 277-1010
Facsimile: (310) 203-7199

Attorneys For Immersion Corporation

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.