

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POLYGROUP LIMITED (MCO),
Petitioner,

v.

WILLIS ELECTRIC CO., LTD.,
Patent Owner.

Cases IPR2016-01615, IPR2016-01616, and IPR2016-01617
Patent 8,936,379 B1¹

Before WILLIAM V. SAINDON, JEREMY M. PLENZLER, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

DECISION
Joint Supplemental Motions to Seal
37 C.F.R. § 42.54

¹ This Order addresses the same issues in the *inter partes* reviews listed in the Appendix. Therefore, we issue one Order to be filed in all of the cases. The parties, however, are not authorized to use this style of filing in subsequent papers.

I. INTRODUCTION

Polygroup Limited (MCO) (“Petitioner”) requested an *inter partes* review of claims 1–6, 8, 10–17, 28, 29, and 32 (“challenged claims”) of U.S. Patent No. 8,936,379 B1 (*see, e.g.*, IPR2016-01615, Ex. 1001, “the ’379 patent”)² in a series of three Petitions. IPR2016-01615, Paper 2; IPR2016-01616, Paper 2; IPR2016-01617, Paper 2. Willis Electric Company, Limited (“Patent Owner”) filed a Patent Owner Response in each of the instant proceedings. IPR2016-01615, Paper 32; IPR2016-01616, Paper 31; IPR2016-01617, Paper 33. Petitioner filed a Reply in each of the instant proceedings. IPR2016-01615, Paper 47; IPR2016-01616, Paper 47; IPR2016-01617, Paper 50.

With each of its Replies, Petitioner submitted supporting evidence, including deposition transcripts and a declaration designated as confidential. *Id.*³ Petitioner also filed Motions to Seal the evidence designated as confidential. *See, e.g.*, IPR2016-01615, Paper 46 (“Mot.”).⁴ We denied Petitioner’s Motions to Seal without prejudice to Petitioner submitting public versions of Exhibits designated as confidential listed in the Appendix for each of the proceedings and re-filing in each of the instant proceedings a Joint Motion to Seal to address the deficiencies set forth herein by March 20,

² The ’379 Patent also was filed as Exhibit 1001 in IPR2016-01616 and IPR2016-01617 and will be referred to as “Exhibit 1001” or “Ex. 1001” throughout.

³ The exhibit numbers of the transcripts and declaration designated as confidential are in the Appendix.

⁴ Further citations will be to IPR2016-01615, unless otherwise noted. Petitioner’s Motions to Seal also are listed in the Appendix.

2018. *See, e.g.*, IPR2016-01615, Paper 95 (“Dec. on Mot.”). On March 19, 2018, the parties filed a Joint Supplemental Motion to Seal Exhibits 1105, 1106, 1119, and 1120. *See, e.g.*, IPR2016-01615, Paper 96 (“Supp. Mot.”). On the same day, Petitioner also filed public, redacted versions of Exhibits 1105, 1106, 1119, and 1120. *See, e.g.*, IPR2016-01615, Exs. 1105, 1106, 1119, 1120.

II. JURISDICTION

Our Final Written Decisions were entered February 26, 2018. *See, e.g.*, IPR2016-01615, Paper 94. Petitioner filed Notices of Appeal to the U.S. Court of Appeals for the Federal Circuit on March 29, 2018. *See, e.g.*, IPR2016-01615, Paper 97. The general rule is that the Board is divested of jurisdiction when either party files a notice of appeal to the Federal Circuit. *In re Allen*, 115 F.2d 936, 939 (CCPA 1940) (“We have no doubt that when a notice of appeal and reasons of appeal in an appealable case are duly filed with the Commissioner of Patents, jurisdiction of the cause is transferred to this court. There is nothing left for the commissioner to do other than to certify the record and transmit it to this court.”). A limited number of exceptions to this general rule have been recognized and are generally viewed as purely ministerial functions. *See In re Grier*, 342 F.2d 120, 123 (CCPA 1965); *see also In re Graves*, 69 F.3d 1147, 1149–50 (Fed. Cir. 1995). As set forth in *Grier*, an exception must be an “exercise [of] a purely ministerial function” that does not make a “new or different determination of an issue” and “exercise[s] no judicial function.” *Grier*, 342 F.2d at 123. In the instant proceedings, prior to the filing of the Notice of Appeal, the Parties filed Supplemental Motions per our Order (*see, e.g.*, Supp. Mot.). Our Decision here does not substantively affect any decision we have made

that is subject to judicial review; we merely confirm that those papers submitted to us during the proceeding are under seal, rather than provisionally under seal. *See* 37 C.F.R. § 42.14 (“A party intending a document or thing to be sealed shall file a motion to seal concurrent with the filing of the document or thing to be sealed. The document or thing shall be provisionally sealed on receipt of the motion and remain so pending the outcome of the decision on the motion”). Thus, it is our view that the record would be adequately supplemented, via the purely ministerial function of entering into the record our Decision on the Parties’ Supplemental Motions to Seal.

III.DISCUSSION

The parties assert “[a]s an initial matter, Exhibit 1104, the deposition transcript of Stuart B. Brown, does not contain confidential information and the Parties therefore agree that it should be made publicly accessible.” Supp. Mot. 1. The parties also assert that “[a] non-confidential description of the confidential information in Exhibits 1105, 1106, 1119, and 1120 is provided herein and redacted versions will be filed concurrently with this Motion.” *Id.* at 2. On March 19, 2018, redacted versions of Exhibits 1105, 1106, 1119, and 1120 were filed in IPR2016-01615, IPR2016-01616, and IPR2016-01617. In IPR2016-01616, only a redacted version of Exhibit 1105 was filed, no confidential version has been filed at any time in that proceeding.

We do not rely on Exhibits 1105, 1106, 1119, and 1120 in our Final Written Decision. *See, e.g.*, IPR2016-01615, Paper 94. As such, the public would have little interest in Exhibits 1105, 1106, 1119, and 1120. Additionally upon review of the non-redacted versions of Exhibits 1105,

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1106, 1119, and 1120, as well as the parties' explanation that disclosure of the redacted information could reveal product development strategies, business relationships, and other sensitive business and financial information, we are persuaded that the proposed redacted versions are tailored sufficiently to redact only confidential information. Accordingly, the parties' Joint Supplemental Motion to Seal Exhibits 1105, 1106, 1119, and 1120 are granted, with the only exception being that a confidential version of Exhibit 1105 was not filed in IPR2016-01616.

IV. ORDER

In view of the foregoing, it is hereby:

ORDERED that the parties Joint Supplemental Motions to Seal (IPR2016-01615, Paper 96; IPR2016-01616, Paper 98; IPR2016-01617, Paper 101) are granted, except with respect to Exhibit 1105 in IPR2016-01616 as such confidential version was not filed; and

FURTHER ORDERED that Exhibit 1104 in IPR2016-01615, IPR2016-01616, and IPR2016-01617 shall hereby be re-designated as public and not confidential.

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