

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

REMBRANDT WIRELESS TECHNOLOGIES, LP,
Patent Owner.

IPR2020-00033 (Patent No. 8,023,580 B2)
IPR2020-00034 (Patent No. 8,023,580 B2)
IPR2020-00036 (Patent No. 8,457,228 B2)
IPR2020-00037 (Patent No. 8,457,228 B2)¹

Before JEFFREY S. SMITH, DAVID C. McKONE, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

ULLAGADDI, *Administrative Patent Judge*.

DECISION

Terminating Due to Settlement Prior to Institution and
Granting Petitioner's Motion to Expunge
37 C.F.R. §§ 42.74, 42.56

¹ This Decision addresses issues that are the same in all identified proceedings. We exercise our discretion to issue one Decision to be filed in each proceeding. The parties, however, are not authorized to use this style heading in subsequent papers.

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I. INTRODUCTION

Petitioner and Patent Owner (collectively referred to as “the Parties”) have requested that the above-identified *inter partes* review proceedings be terminated pursuant to a settlement. On March 23, 2020, we authorized the Parties to file joint motions to terminate the above-identified proceedings. On March 30, 2020, the Parties filed Joint Motions to Terminate the above-identified proceedings. Paper 15 (“Joint Motions”), 1.² Along with the Joint Motions, the Parties filed a Settlement and a License Agreement. Paper 16 (“Settlement Agreement”).^{3,4} The Parties request that the Settlement Agreement be treated as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 15, 1.

Petitioner also filed a Motion to Seal (Paper 4, “Mot. Seal”) Exhibit 1033 and a version of the Petition containing confidential information (Paper 3) on November 5, 2019. The Parties filed a Joint Stipulation Requesting Entry of Default Protective Order on December 27, 2019. Paper 9. With the Joint Motions, Petitioner also filed an unopposed Motion to Expunge Information Under Seal, in which it moves us to expunge Exhibit 1033 and the confidential version of the Petition. Paper 17

² Most citations are to IPR2020-00033 with the understanding that the other proceedings include papers having substantially the same substantive content.

³ The Parties filed the Settlement Agreement as a paper. We deem this to be harmless error, however, the Parties are reminded that evidence must be filed as an exhibit. *See* 37 C.F.R. § 42.63(a) (“Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.”).

⁴ The Settlement Agreement is: Paper 16 in IPR2020-00034; Paper 17 in IPR2020-00036; and Paper 18 in IPR2020-00037.

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(“Mot. Expunge”); *see* fn.2. In the IPR2020-00036 and IPR2020-00037 proceedings, we granted Petitioner’s Motion to Seal and Request for Entry of Default Protective Order. IPR2020-00036, Paper 10; IPR2020-00037, Paper 10.

II. DISCUSSION

A. Motions to Terminate

In the Joint Motions, the Parties represent that they have reached an agreement to terminate the above-identified *inter partes* review proceedings, and that the filed copy of the Settlement Agreement is a true and complete copy. Paper 15, 1–2. The Parties further represent that their Settlement Agreement resolves all currently pending matters before the U.S. Patent and Trademark Office and District Court proceedings between the Parties involving the involving the above-identified patents at issue. *Id* at 2.

The above-identified proceedings are at an early stage, and we have not yet decided whether to institute trials in the proceedings. In view of the early stage of the proceedings and the settlement between the Parties, we determine that good cause exists to dismiss the petitions and terminate the proceedings with respect to the Parties.

The Parties also request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the patents involved in these *inter partes* proceedings. Paper 15, 1. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent

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Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

B. Motions to Seal

“A party seeking to maintain the confidentiality of information . . . may file a motion to expunge the information from the record prior to the information becoming public.” Trial Practice Guide, 77 Fed. Reg. at 48,761; *see* 37 C.F.R. § 42.56. The moving party has the burden to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). “Confidential information that is subject to a protective order ordinarily would become public 45 days after denial of a petition to institute a trial or 45 days after final judgment in a trial.” *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012). This is because “[t]here is an expectation that information will be made public where the existence of the information is referred to in a decision to grant or deny a request to institute a review or is identified in a final written decision following a trial.” *Id.*

Petitioner takes the position that good cause is met to expunge the requested documents because “the public’s interest in having access to such information is very minimal.” Mot. Expunge 3. Petitioner supports its position by arguing “there has been no decision on institution, thus, the confidential information has not been discussed in a Board decision.” *Id.* Petitioner further argues that “Patent Owner has not referenced Exhibit 1033 or the limited portion of [the] Petition discussing the contents of Exhibit 1033 in any of Patent Owner’s submissions.” *Id.*

Exhibit 1033 comprises letters between Petitioner and a third party. According to Petitioner, these letters, as well as the portion of the Petition

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that discusses Exhibit 1033, disclose “information about the third party’s procedures for interacting with Apple.” Mot. Seal 1–2. Petitioner asserts there is good cause to seal Exhibit 1033 and the portion of the Petition that discusses Exhibit 1033, because “[p]ublic disclosure of this information would cause commercial harm to Apple and the third party by revealing competitive information, and potentially affect the business relationship between those companies, as well as between each company and other companies with which they transact business.” *Id.* at 2.

In both the IPR2020-00036 and IPR2020-00037 proceedings, we were persuaded that there was confidential information in the respective exhibits and petitions⁵ and that there was good cause for sealing these documents. IPR2020-00036, Paper 10, 3; IPR2020-00037, Paper 10, 3; *see* 35 U.S.C. § 316(a)(7) (“providing for protective orders governing the exchange and submission of confidential information”); *see* 37 C.F.R. § 42.2 (defining confidential information as “trade secret or other confidential research, development, or commercial information”). We reach a similar conclusion regarding confidential information in the respective exhibits and petitions⁴ of the IPR2020-00033 and IPR2020-00034 for substantially the same reasons. *See* fn.4.

As Petitioner correctly noted, we have granted a motion to expunge a document containing confidential information in the case where a final decision did not rely on the document. Mot. Expunge 2; *see Unverferth*

⁵ In IPR2020-00033 and IPR2020-00036, the documents containing confidential information are Exhibit 1033 and Paper 3. In IPR2020-00034 and IPR2020-00037, the documents containing confidential information are Exhibit 1133 and Paper 3.

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