

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO. LTD.,  
SAMSUNG ELECTRONICS AMERICA, INC. and APPLE INC.,  
Petitioner,

v.

NEONODE SMARTPHONE LLC,  
Patent Owner.

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IPR2021-00145  
Patent 8,812,993 B2

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Before KARA L. SZPONDOWSKI and CHRISTOPHER L. OGDEN,  
*Administrative Patent Judges.*

OGDEN, *Administrative Patent Judge.*

ORDER  
Denying Petitioner's Motion to Expunge  
*37 C.F.R. § 42.56*

Petitioners Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”)<sup>1</sup> filed a Motion to Expunge requesting that the following sealed documents be expunged from the record of this case: Paper 29 (Patent Owner’s Response), Exhibit 2015 (an expert declaration supporting Paper 29), Exhibit 2025 (a confidential agreement affecting parties to this proceeding), and Exhibit 2028 (Patent Owner’s Sur-reply). *See* Paper 72 (“Mot.”), 1. Patent Owner Neonode Smartphone LLC (“Neonode”) filed an Opposition. Paper 73 (“Opp.”). Samsung did not file a reply.

According to Samsung, the Board’s Final Written Decision (Paper 71 (public version)) “does not contain any confidential information” and “[n]one of the Board’s analyses in its [Final Written Decision] are confidential.” Mot. 3. Thus, Samsung argues that there is no public interest in making the sealed information available to the public. Mot. 4. Samsung also contends that the Board has already determined, in its order sealing the documents, that there is good cause to keep them confidential. Mot. 3–4 (citing Papers 31 (Samsung’s Motion to Seal), 53 (Order Granting Motion to Seal)).

In its Opposition, Neonode informs us that it “intends to file a Notice of Appeal” (Opp. 1), and we confirm that Neonode filed a Notice of Appeal on August 15, 2022. Paper 74. According to Neonode, “[t]he documents that Samsung seeks to expunge constitute material evidence in support of [Neonode]’s argument that objective factors of non-obviousness demonstrate the patentability of the challenged claims.” Opp. 1. Neonode notes that the

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<sup>1</sup> Petitioner Apple Inc. did not join in the motion, but does not oppose. Paper 73, 1.

Board’s Final Written Decision found that Neonode had not “produced evidence showing a nexus between the evidence of industry respect or licensing and the features of the challenged claims.” Opp. 2 (quoting Paper 68, 49–50). But Neonode states that it intends to argue on appeal that the Board’s finding “is not supported by substantial evidence.” Opp. 2.

Neonode also directs our attention to the non-precedential case *Apple Inc. v. Uniloc 2017 LLC*, IPR2019-01667, Paper 52, 2021 WL 1700859 (PTAB Apr. 29, 2021), in which the Board denied a similar motion to expunge without prejudice to refile the motion after the final disposition of all appeals. Opp. 2–3. Neonode states that it “would not oppose entry of a similar order in this proceeding.” Opp. 3.

Ordinarily, “[c]onfidential information that is subject to a protective order would . . . become public 45 days after denial of a petition to institute a trial or 45 days after final judgment in a trial,” particularly “where the existence of the information is . . . identified in a final written decision.” PTAB Consolidated Trial Practice Guide 21–22 (Nov. 2019), <https://go.usa.gov/xpvPF>. But a party may file a motion to expunge the confidential information under 37 C.F.R. § 42.56. *Id.* at 22. This rule “balances the needs of the parties to submit confidential information with the public interest in maintaining a complete and understandable file history for public notice purposes.” *Id.* As with any motion, the moving party, in this case Samsung, “has the burden of proof to establish that it is entitled to the requested relief.” 37 C.F.R. § 42.20(c).

Under the circumstances, Samsung’s motion is premature. Although the Final Written Decision does not rely on the information that Samsung seeks to expunge from the record, these documents may be relevant to

Neonode's appeal, and it would be inappropriate for the Board to expunge the documents at this time.

Thus, we deny Samsung's Motion without prejudice, and extend the time period for filing a renewed motion to expunge no later than 45 days after the final disposition of any appeals or remand proceedings from any such appeals. In the meantime, the record for this proceeding will be preserved in its entirety, and the confidential information will remain under seal.

Accordingly, it is

ORDERED that Samsung's Motion to Expunge is *denied without prejudice*;

FURTHER ORDERED that Samsung may file a renewed motion to expunge any material in the record no later than 45 days after the final disposition of any appeals from this proceeding, including any proceedings on remand from any such appeals; and

FURTHER ORDERED that information subject to the Protective Order in this proceeding (Paper 52; Paper 50, App'x A) will remain under seal until further notice.

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