

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NANOCO TECHNOLOGIES LIMITED,
Patent Owner.

IPR2021-00186 (Patent 8,524,365 B2)

**PETITIONER'S RESPONSE TO PATENT OWNER'S MOTION TO
SEAL AND TO ENTER DEFAULT PROTECTIVE ORDER PURSUANT
TO 37 C.F.R. § 42.54**

I. INTRODUCTION

Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioner”) respectfully submit this response to Patent Owner Nanoco Technologies Ltd.’s (“Patent Owner”) Motion to Seal and to Enter Default Protective Order Pursuant to 37 C.F.R. § 42.54 (“Motion”). That motion seeks to seal portions of Patent Owner’s Response, portions of Exhibit 2030 (Declaration of Brandi Cossairt Ph.D.), and the entirety of Exhibits 2032 (Excerpts of the June 10, 2021 Rebuttal Expert Report of Mounji Bawendi, Ph.D.) and 2034 (Excerpts of the June 16, 2021 Deposition Transcript of Mounji G. Bawendi, Ph.D.). *See* Paper 27 at 1 (P.T.A.B. Aug. 12, 2021).

Patent Owner based its Motion on the incorrect premise that Petitioner never responded to Patent Owner’s communications regarding the confidentiality of these exhibits. *See* Paper 27 at 1-2, 4. However, Patent Owner did respond to Petitioner’s communications. Indeed, Patent Owner admits that Petitioner “did respond promptly to [Petitioner’s] request to de-designate. [Patent Owner is] looking into why this correspondence did not reach any of the attorneys working on the IPR, but assume that the problem was on our [*i.e.*, Patent Owner’s] side.” App. 1.

In any event, the parties have now conferred and agreed upon a plan of action that moots this Motion. Specifically, the parties have agreed that (1) Patent Owner’s Response and Exhibits 2030 and 2034 do not contain confidential information and

therefore do not need to be sealed; and (2) that the parties jointly request that the Board replace existing Exhibit 2032 with an agreed-upon redacted version that can be filed publicly. *See id.*; App. 2. This obviates the need for a protective order to be entered in this case or any information to be sealed and thus moots Patent Owner’s Motion. Therefore, Petitioner respectfully requests that the Board (1) deny the Motion as moot if it agrees to expunge and replace existing Exhibit 2032 with a redacted version, or (2) grant the Motion as to Exhibit 2032, enter the modified default protective order attached as Appendix A to this response, and deny the remainder of the Motion as moot.

II. THE MOTION SHOULD BE DENIED AS MOOT

The parties agree that Patent Owner’s Response and Exhibits 2030 and 2034 do not contain confidential information and do not need to be sealed. Therefore, the Board should deny Patent Owner’s motion as moot as it relates to those documents. Patent Owner also relied on Exhibit 2032, which was designated “Confidential—Outside Attorneys’ Eyes Only” during the related district court proceeding, *Nanoco Technologies Ltd. v. Samsung Electronics Co., Ltd.*, No. 2:20-cv-00038-JRG (E.D. Tex.), pursuant to the protective order entered in that litigation. While Exhibit 2032 contains some confidential business information, Patent Owner does not rely on the confidential portion in its Patent Owner’s Response and neither does the declaration of Dr. Cossairt (Exhibit 2030). Therefore, the parties have agreed that the originally-

filed version of Exhibit 2032 should be expunged and it should be replaced with an agreed-upon redacted version. The parties have already made this joint request to the Board. App. 2. If the Board grants that request or a subsequent motion to expunge and replace Exhibit 2032, that action will obviate the need for a protective order to be entered in this case and for any information to be sealed and thus moot Patent Owner's Motion.

III. ALTERNATIVELY, THE MOTION SHOULD BE GRANTED AS TO EXHIBIT 2032 UNDER A MODIFIED PROTECTIVE ORDER

However, if the Board does not allow Exhibit 2032 to be expunged and replaced with a redacted version, then Petitioner respectfully requests that Patent Owner's Motion to seal be granted as to that exhibit only. "The Board may, for good cause, issue an order to protect a party or person from disclosing confidential information." 37 C.F.R. § 42.54(a); *see also* Trial Practice Guide at 48,760. The Trial Practice Guide requires that the parties "identify confidential information in a manner consistent with Federal Rule of Civil Procedure 26(c)(1)(G), which provides for protective orders for trade secret or other confidential research, development, or commercial information." Trial Practice Guide at 48,760.

Good cause exists for sealing Exhibit 2032. Exhibit 2032 contains confidential information of Petitioner and a third-party manufacturer of certain quantum dots, Hansol Chemical. Specifically, Exhibit 2032 contains confidential technical information and details regarding the trade-secret recipes used by Hansol

to make certain quantum dots for Petitioner Samsung Electronics Co., Ltd., including ingredients used in those trade-secret recipes. The confidential information in Exhibit 2032 has not previously been published or made public. Public disclosure of the confidential information increases the likelihood of harm to Petitioner and Hansol, including by exposing this information to their competitors, would give those competitors an unfair advantage in knowing certain details about Hansol's quantum dot recipes even though Petitioner and Hansol did not have corresponding information about their competitors.

Moreover, the public's interest in maintaining a complete and understandable record in this proceeding is not harmed by preserving the confidential information in Exhibit 2032 under seal. Because none of the parties rely on the confidential portion of Exhibit 2032, full disclosure of that exhibit to the public is unnecessary to the issues in this case. Indeed, the parties agreed on a version of Exhibit 2032 that redacts the confidential information, which Petitioner will file as a separate exhibit if Patent Owner's Motion is granted as to Exhibit 2032 to ensure the public interest will be served through the complete and understandable record of the allegations in this proceeding.

Finally, to the extent Exhibit 2032 is not simply expunged and replaced with a redacted version, Petitioner respectfully requests that the Board enter its Default Protective Order, as modified and attached as Appendix A, to govern confidential

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