

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SCRAMOGE TECHNOLOGY LTD.,
Patent Owner.

IPR2022-00241 (Patent 9,825,482 B2)
IPR2022-00284 (Patent 9,997,962 B2)
IPR2022-00385 (Patent 9,843,215 B2)¹

Before JAMESON LEE, KARL D. EASTHOM, BRIAN J. McNAMARA,
and AARON W. MOORE, *Administrative Patent Judges*.²

LEE, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

¹ This Order addresses the same issue for the above-identified proceedings.

² This is not an expanded panel. Judges Lee, Easthom, and Moore are the panel for IPR2022-00241 and IPR2022-00284. Judges Lee, Easthom, and McNamara are the panel for IPR2022-00385.

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I. INTRODUCTION

On September 13, 2022, a conference call was held in the above-identified proceedings. In each of these proceedings, Petitioner entities Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Samsung”) were terminated on August 29, 2022, by reason of settlement. The participants to the conference call were lead and backup counsel for Petitioner (Messrs. John Kappos, Cameron Westin, and Phillip Citroen), lead counsel for Patent Owner (Mr. Brett Cooper), a representative of RPX Corporation (Mr. Steve Chiang) who is not a party and who was invited to the conference call by Petitioner and Patent Owner, and Judges Jameson Lee, Karl Easthom, Brian McNamara, and Aaron Moore.

Mr. Kappos informed the Board (1) that the Escrow Agreement filed in these proceedings, i.e., Exhibit 1034 in IPR2022-00385, Exhibit 1019 in IPR2022-00241, and Exhibit 1029 in IPR2022-00284, which is a part of the parties’ agreement leading to termination of Samsung, was filed with redactions, (2) that neither party (including Samsung) nor counsel for the parties (including Samsung’s counsel) knew the subject matter redacted or possessed an unredacted copy because the redacted material pertains to third party payments, (3) that RPX Corporation is the only entity which possesses an unredacted version of the Escrow Agreement, and (4) that the parties including terminated Samsung do not object to RPX Corporation sending the Board a copy of the unredacted version of the Escrow Agreement for entry into the record of these proceedings with access status set to “Board only.” Mr. Cooper, on behalf of Patent Owner, concurred. The parties asked only that the unredacted Escrow Agreement be treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. 42.74(c).

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Mr. Chiang, representing RPX Corporation, stated that RPX Corporation is willing to file an unredacted copy of the Escrow Agreement at issue in these proceedings. The Judges expressed that assuming that such an unredacted copy of the Escrow Agreement were filed, the Board grants the parties' request to treat the unredacted Escrow Agreement as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The subject matter of the call changed to related proceedings, all pre-institution, some already terminated and some not, which also involve Samsung as Petitioner and Scramoge as Patent Owner, and which may share the same issue of redactions in the Escrow Agreement filed at the Board. Those proceedings are IPR2022-00478, IPR2022-00636, IPR2022-00643, IPR2022-00653, IPR2022-00683, IPR2022-00939, IPR2022-01052, IPR2022-01053, IPR2022-01054, IPR2022-01055, IPR2022-01056, IPR2022-01057, and IPR2022-01058. The parties proposed the same course of action as proposed for IPR2022-00241, IPR2022-00284, and IPR2022-00385, assuming that there is a redacted Escrow Agreement filed at the Board, subject to verification. Mr. Chiang expressed agreement, also subject to verification of the proceeding numbers. Hereinafter, we refer to these cases as the second group of proceedings.

Judges Michelle Wormmeester and Kristina Kalan were also present on the call. All of the panel members for each proceeding in the second group of proceedings were present on the call. The Board agreed that if an unredacted version of the Escrow Agreement were filed in the proceedings in the second group of proceedings, the Board grants the parties' request to treat the unredacted Escrow Agreement as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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II. DISCUSSION

Although the parties, RPX Corporation, and the Board agreed in principle to the foregoing, a problem lies in execution. RPX Corporation, as a non-party, is unable to file any paper in these proceedings. We have verified that only counsel for a party or an inventor acting pro se may file papers in the Board's automated filing system P-TACTS. The parties proposed that RPX Corporation would send the unredacted Escrow Agreement to the Board as an attachment to an email, and the Board would enter the unredacted Escrow Agreement into P-TACTS as "Board only." But that leaves the issue of the attachment copy after it has been uploaded into P-TACTS. It will not be monitored and we are uncertain that as a government record it can or should be deleted. We are uncertain that we would authorize that approach, absent further deliberation on the matter.

We asked the parties and RPX Corporation to consider having a copy of the unredacted Escrow Agreement sent either to counsel for Petitioner or to counsel for Patent Owner, possibly on an "outside counsel only" basis, for filing in P-TACTS. The parties and RPX Corporation can negotiate what happens to the copy after it is uploaded into P-TACTS.

III. ORDER

For the reasons discussed above, it is

ORDERED that the parties will initiate another call with the Board before September 16, 2022, to inform the Board how it has decided to have filed an unredacted copy of the Escrow Agreement in P-TACTS; and

FURTHER ORDERED that a copy of this Order will be entered in each of the proceedings in the second group of proceedings identified above, as a 3000 series exhibit.

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