

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PERSEPHONE GmbH,
Petitioner Application 15/368,221,
Petitioner,

v.

SIMON TECHNOLOGIES LLC,
Respondent Application 14/726,075,
Respondent.

DER2017-00004

Before JAMESON LEE, MICHAEL R. ZECHER, and JUSTIN T. ARBES,
Administrative Patent Judges.

PER CURIAM.

ORDER
Denying Petitioner's Motion to Seal
37 C.F.R. §§ 42.54, 42.412

Petitioner filed a motion to seal Exhibits 1003–1009 and 1023¹ in this proceeding. Paper 31 (“Mot.”). Petitioner requests entry of a proposed

¹ Petitioner filed an updated exhibit list indicating that the document filed as Exhibit 1017 and labeled “Exhibit R – Amended Declaration of Patric Winzenreid” should be numbered as Exhibit 1023. *See* Paper 32, 2. The document will be renumbered in the Board’s electronic filing system.

protective order filed as Paper 33. Mot. 3. Respondent did not file an opposition to the motion to seal or propose a protective order of its own.

Under 37 C.F.R. §§ 42.14 and 42.412, the default rule is that all papers filed in a derivation proceeding are open and available for access by the public unless a patent application not otherwise available to the public is involved; a party, however, may file a concurrent motion to seal and the information at issue is sealed pending the outcome of the motion. Only “confidential information” is protected from disclosure. 37 C.F.R. § 42.54. In that regard, the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) at 19, *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“Trial Practice Guide”), provides:

The rules aim to strike a balance between the public’s interest in maintaining a complete and understandable file history and the parties’ interest in protecting truly sensitive information.

. . .

Confidential Information: The rules 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. 37 C.F.R. § 42.54.

The standard for granting a motion to seal is “for good cause.” 37 C.F.R. § 42.54(a).

“Good cause” for sealing is established by a “sufficient explanation as to why” the “information sought to be sealed is confidential information,” a demonstration that the information is not “excessively redacted,” and a showing that, on balance, the strong “public[] interest in maintaining a complete and understandable record” is outweighed by “the harm to a party, by disclosure of information” and “the need of either party to rely specifically on the information at issue.” Consequently,

a movant to seal must demonstrate adequately that (1) the information sought to be sealed is truly confidential, (2) a concrete harm would result upon public disclosure, (3) there exists a genuine need to rely in the trial on the specific information sought to be sealed, and (4), on balance, an interest in maintaining confidentiality outweighs the strong public interest in having an open record.

Argentum Pharms. LLC v. Alcon Research, Ltd., IPR2017-01053, Paper 27 at 3–4 (PTAB Jan. 19, 2018) (Order—Denying without Prejudice Patent Owner’s Motion to Seal and for Entry of Proposed Protective Order) (informative) (citations omitted) (“*Argentum*”). The filing party bears the burden of proof in showing entitlement to the relief requested in a motion to seal. 37 C.F.R. § 42.20(c).

Petitioner argues that Exhibits 1003–1009 and 1023 contain information that is “highly sensitive and proprietary” and include “proprietary technical specifications and internal [research and development (‘R&D’)] communications that are not publicly available and are closely guarded within Petitioner’s organization.” Mot. 3. According to Petitioner, “[p]ublic disclosure of this information would cause significant competitive harm to Petitioner.” *Id.* Petitioner, however, does not explain with any particularity why the content of each exhibit is “confidential information” under 37 C.F.R. § 42.54. *See id.* Nor does Petitioner provide an explanation as to any of the considerations identified above for establishing good cause to seal material. *See Argentum*, Paper 27 at 3–4. Indeed, we note that at least some content of the exhibits does not appear to constitute “technical specifications” or “R&D communications,” and also is discussed in the Petition, for which no motion to seal was filed. *See, e.g.*, Paper 4, 12, 14–18, 20, 25.

Further, Petitioner’s proposed protective order differs significantly from the Board’s default protective order. *Compare* Paper 33, 1–3, *with* Trial Practice Guide 117–122. But Petitioner provides no explanation as to why its proposed protective order is appropriate or why deviation from the default protective order is necessary under the circumstances. *See* Mot. 3; Trial Practice Guide 99 (“The Board encourages the parties to adopt the Board’s default protective order if they conclude that a protective order is necessary. . . . If the parties choose to propose a protective order deviating from the default protective order, they must submit the proposed protective order jointly along with a marked-up comparison of the proposed and default protective orders showing the differences between the two and explain why good cause exists to deviate from the default protective order.”).

Petitioner will be provided one additional opportunity to file a motion to seal in compliance with the Board’s rules. Exhibits 1003–1009 and 1023 shall remain provisionally sealed under 37 C.F.R. § 42.14 pending the filing of a second motion to seal. If no second motion to seal is filed within a week of the date of entry of this Order, the exhibits will be made public.

Finally, as noted in our previous Order, “[t]he record of a Board proceeding is available to the public, unless a patent application not otherwise available to the public is involved,” under 37 C.F.R. § 42.412(b)(1). Paper 29, 11–12. Because both applications involved in this proceeding have published and are available to the public, the record of this proceeding will be made publicly available in the Board’s electronic filing system. *See id.* Also, documents that were filed as “Parties and Board Only” in the Board’s electronic filing system without any corresponding

motion to seal (Papers 9, 10, 12–16, 21–23, 25–28, and 31–34, and Exhibits 1020–1022 and 2001) will be changed to “Public.” *See* Paper 29, 11–12.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s motion to seal (Paper 31) is *denied*;

FURTHER ORDERED that the document filed as Exhibit 1017 and labeled “Exhibit R – Amended Declaration of Patric Winzenreid” be renumbered to Exhibit 1023;

FURTHER ORDERED that Petitioner is authorized to file a second motion to seal Exhibits 1003–1009 and 1023 within one week of this Order;

FURTHER ORDERED that Exhibits 1003–1009 and 1023 be changed to “Parties and Board Only” in the Board’s electronic filing system;

FURTHER ORDERED that Papers 9, 10, 12–16, 21–23, 25–28, and 31–34, and Exhibits 1020–1022 and 2001, be changed to “Public” in the Board’s electronic filing system; and

FURTHER ORDERED that the record of this proceeding (other than Exhibits 1003–1009 and 1023, which remain provisionally sealed) be made publicly available.

DER2017-00004

Petitioner Application 15/368,221

Respondent Application 14/726,075

FOR PETITIONER:

Michael Cornelison

David M. Tener

CAESAR RIVISE, PC

mcornelison@crbcp.com

dmtener@crbcp.com

FOR RESPONDENT:

Neil G. Ferrari

Jordan C. Strauss

MUNCK WILSON MANDALA, LLP

nferrari@munckwilson.com

jstrauss@munckwilson.com