

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

CANON KABUSHIKI KAISHA,
Patent Owner.

IPR2020-00341 (Patent 8,078,767 B2)
IPR2020-00342 (Patent 8,346,986 B2)
IPR2020-00343 (Patent 8,713,206 B2)
IPR2020-00355, IPR2020-00357 (Patent 7,746,413 B2)
IPR2020-00358, IPR2020-00359 (Patent 7,810,130 B2)¹

Before BART A. GERSTENBLITH, JOHN D. HAMANN, and
JASON W. MELVIN, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
Granting Petitioner's Motion to Seal
Granting Petitioner's Request to Enter Protective Order
37 C.F.R. §§ 42.74, 42.14, 42.54

¹ This Order addresses issues that are identical in each of the above-identified proceedings. The parties are not authorized to use this style heading without prior authorization.

IPR2020-00341 (Patent 8,078,767 B2)
IPR2020-00342 (Patent 8,346,986 B2)
IPR2020-00343 (Patent 8,713,206 B2)
IPR2020-00355, IPR2020-00357 (Patent 7,746,413 B2)
IPR2020-00358, IPR2020-00359 (Patent 7,810,130 B2)

I. DISCUSSION

A. *Settlement*

In an e-mail dated June 1, 2020, we authorized the parties to file joint motions to terminate the instant proceedings, true copies of their settlement agreement, and joint requests to treat the filed copies of their agreement as business confidential information under 37 C.F.R. § 42.74(c). On June 4, 2020, the parties filed a Joint Motion to Terminate Proceeding Pursuant to 37 C.F.R. § 42.71 and 35 U.S.C. § 317,² a copy of a written Settlement Agreement,³ and a Joint Request to Treat Agreement as Business Confidential Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)⁴ in each proceeding.⁵

The parties indicate that they have settled their dispute concerning the challenged patents, a motion to dismiss all claims in related district court litigation has been filed and granted, and the parties have agreed to terminate these proceedings. Term. Motion 2. The parties filed what they represent is a true and correct copy of their confidential settlement agreement as Exhibit 2018, and indicate that there are no collateral agreements. *Id.* at 1–2.

² IPR2020-00341, Paper 20 (“Term. Motion”). The Joint Motion to Terminate is Paper 17 in each of the other proceedings.

³ The Settlement Agreement is Exhibit 2018 in each proceeding.

⁴ IPR2020-00341, Paper 21 (“Request”). The Joint Request is Paper 18 in each of the other proceedings.

⁵ The parties Motions, Requests, and Settlement Agreement are identical in each proceeding. Citations are to IPR2020-00341 unless otherwise indicated.

IPR2020-00341 (Patent 8,078,767 B2)
IPR2020-00342 (Patent 8,346,986 B2)
IPR2020-00343 (Patent 8,713,206 B2)
IPR2020-00355, IPR2020-00357 (Patent 7,746,413 B2)
IPR2020-00358, IPR2020-00359 (Patent 7,810,130 B2)

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) (“An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)”); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“Consolidated Guide”) at 86, available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf> (“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” (citing 35 U.S.C. §§ 317(a), 327)). Here, trials have not yet been instituted and the merits of the proceedings not yet decided. Accordingly, we are persuaded that, under these circumstances, termination of these proceedings is appropriate.

Additionally, we grant the parties’ Requests to treat their settlement agreement as business confidential information and to keep the agreement separate from the files of the challenged patents. Request 1; *see* 35 U.S.C. § 317(b) (“At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made

IPR2020-00341 (Patent 8,078,767 B2)
IPR2020-00342 (Patent 8,346,986 B2)
IPR2020-00343 (Patent 8,713,206 B2)
IPR2020-00355, IPR2020-00357 (Patent 7,746,413 B2)
IPR2020-00358, IPR2020-00359 (Patent 7,810,130 B2)

available only to Federal Government agencies on written request, or to any person on a showing of good cause.”); *see also* 37 C.F.R. § 42.74(c) (same).

This Decision does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

B. Petitioner’s Motions to Seal

Petitioner filed an unopposed Motion to Seal on May 26, 2020, in each proceeding.⁶ Petitioner’s Motions to Seal request that we seal Petitioner’s Preliminary Reply to Patent Owner’s Preliminary Response Addressing the Issue of Discretionary Denial Under 314(a)⁷ and Petitioner’s Responses to Patent Owner’s Interrogatories (Nos. 1–2).⁸ Seal Motion 1.

The record for an *inter partes* review shall be made available to the public, except as otherwise ordered, and a document filed with a motion to seal shall be sealed provisionally until the motion is decided. *See* 35 U.S.C. § 316(a)(1); 37 C.F.R. § 42.14. The standard for granting a motion to seal is good cause. *See* 37 C.F.R. § 42.54(a). There is a strong public policy that favors making information filed in *inter partes* review proceedings open to the public. *See Garmin Int’l v. Cuozzo Speed Techs., LLC*, IPR2012-00001, Paper 34 at 1–2 (PTAB Mar. 14, 2013). The moving party bears the burden of showing that the relief requested should be granted. *See* 37 C.F.R. § 42.20(c).

⁶ The Motion to Seal (“Seal Motion”) is Paper 14 in each proceeding.

⁷ Petitioner’s sealed Preliminary Reply is Paper 16 in each proceeding.

⁸ Petitioner’s sealed Interrogatory Responses is Exhibit 1040 in each proceeding.

IPR2020-00341 (Patent 8,078,767 B2)
IPR2020-00342 (Patent 8,346,986 B2)
IPR2020-00343 (Patent 8,713,206 B2)
IPR2020-00355, IPR2020-00357 (Patent 7,746,413 B2)
IPR2020-00358, IPR2020-00359 (Patent 7,810,130 B2)

Petitioner’s Preliminary Reply and Responses to Patent Owner’s Interrogatories contain “confidential and commercially sensitive business information of Petitioner and third-party TCL,” and specifically, information regarding a non-public agreement between them. Seal Motion 2. Petitioner contends it and TCL “face concrete harm if their confidential information is released to the public” because “competitors and other third-parties could exploit the information for their own benefit or to gain improper leverage over” Petitioner and TCL. *Id.* Petitioner represents that “[t]his information is not publicly available, and has been and continues to be intended to remain confidential.” *Id.* Petitioner also represents that redacted, non-confidential versions of Petitioner’s Preliminary Reply and Interrogatory Responses have been filed in each proceeding.⁹ *Id.* at 2–3.

For the reasons explained by Petitioner, we find there is good cause for sealing the material referenced above. Additionally, Petitioner’s redactions to its Preliminary Reply and Exhibit 1040 are narrowly tailored to exclude only that information for which good cause has been shown to seal. Accordingly, Petitioner’s Motions to Seal are *granted*.

C. Petitioner’s Requests for Entry of a Protective Order

Petitioner’s Motions to Seal also request entry of the protective order, attached as Appendix A to the Motions to Seal. Seal Motion at 3–5. The proposed protective order matches, with two exceptions, the default

⁹ In each proceeding, Petitioner filed its unsealed Interrogatory Responses with the same exhibit number (i.e., Ex. 1040) as the sealed versions.

IPR2020-00341 (Patent 8,078,767 B2)
IPR2020-00342 (Patent 8,346,986 B2)
IPR2020-00343 (Patent 8,713,206 B2)
IPR2020-00355, IPR2020-00357 (Patent 7,746,413 B2)
IPR2020-00358, IPR2020-00359 (Patent 7,810,130 B2)

protective order appearing in the Consolidated Guide at pages 117 through 122. In particular, the proposed protective order “contains an additional designation ‘PROTECTIVE ORDER MATERIAL – OUTSIDE ATTORNEYS’ EYES ONLY’ for confidential material and restricts the material to Outside Counsel, Experts, Office Staff and Support Personnel” and adds “support personnel of outside counsel of record for a party in the proceeding” to the definition of “Support Personnel.” *Id.* at 4; *see id.* at App. A, A-2–A-3.

Petitioner asserts that good cause exists for these restrictions and the more limited access provided by the additional designation “is necessary to protect [Petitioner’s] confidential information from potential use by other companies and/or potential exposure to the public, and to protect the confidential information of third-party TCL.” *Id.* at 4. Additionally, Petitioner represents that the parties “have agreed to the additional designation.”

In light of the parties’ agreement and the above representations, Petitioner has shown good cause for entry of the protective order filed as Appendix A to the Motion to Seal. *See* 37 C.F.R. § 42.54(a).

II. ORDER

Accordingly, it is

ORDERED that the parties’ Joint Motion to Terminate Proceeding Pursuant to 37 C.F.R. § 42.71 and 35 U.S.C. § 317 (IPR2020-00341, Paper 20; IPR2020-00342, Paper 17; IPR2020-00343, Paper 17; IPR2020-

IPR2020-00341 (Patent 8,078,767 B2)
IPR2020-00342 (Patent 8,346,986 B2)
IPR2020-00343 (Patent 8,713,206 B2)
IPR2020-00355, IPR2020-00357 (Patent 7,746,413 B2)
IPR2020-00358, IPR2020-00359 (Patent 7,810,130 B2)

00355, Paper 17; IPR2020-00357, Paper 17; IPR2020-00358, Paper 17; and IPR2020-00359, Paper 17) is *granted*;

FURTHER ORDERED that the parties' Joint Request to Treat Agreement as Business Confidential Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (IPR2020-00341, Paper 21; IPR2020-00342, Paper 18; IPR2020-00343, Paper 18; IPR2020-00355, Paper 18; IPR2020-00357, Paper 18; IPR2020-00358, Paper 18; and IPR2020-00359, Paper 18) is *granted*;

FURTHER ORDERED that the Settlement Agreement (Exhibit 2018) be treated as business confidential information, kept separate from the file of the above-referenced patents, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c);

FURTHER ORDERED that Petitioner's Motion to Seal (Paper 14) is *granted*;

FURTHER ORDERED that Petitioner's request to enter the Protective Order (Paper 14, App. A) is *granted*;

FURTHER ORDERED that the Protective Order (Paper 14, App. A) is hereby entered; and

FURTHER ORDERED that each of these proceedings is terminated.

IPR2020-00341 (Patent 8,078,767 B2)
IPR2020-00342 (Patent 8,346,986 B2)
IPR2020-00343 (Patent 8,713,206 B2)
IPR2020-00355, IPR2020-00357 (Patent 7,746,413 B2)
IPR2020-00358, IPR2020-00359 (Patent 7,810,130 B2)

FOR PETITIONER:

Scott A. McKeown
Christopher Bonny
Kyle Tsui
ROPES & GRAY LLP
scott.mckeown@ropesgray.com
Christopher.bonny@ropesgray.com
Kyle.tsui@ropesgray.com

FOR PATENT OWNER:

Joseph E. Palys
Naveen Modi
PAUL HASTINGS LLP
josephpalys@paulhastings.com
naveenmodi@paulhastings.com