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571-272-7822

Paper 30
Date: December 11, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MANUFACTURING RESOURCES INTERNATIONAL, INC.
Patent Owner.

IPR2023-00199 (Patent 8,854,595 B2)
IPR2023-00220 (Patent 9,173,322 B2)
IPR2023-00221 (Patent 11,013,142 B2)
IPR2023-00254 (Patent 10,506,740 B2)
IPR2023-00255 (Patent 9,629,287 B2)[1]

Before JAMESON LEE, JO-ANNE M. KOKOSKI, and
JOHN A. HUDALLA, *Administrative Patent Judges.*

Opinion for the Board filed by LEE, *Administrative Patent Judge*.

Opinion Concurring-in-Part and Dissenting-in-Part filed by HUDALLA, *Administrative Patent Judge*.

LEE, *Administrative Patent Judge*.

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[1] These proceedings have not been consolidated. Because the matter addressed is common to these proceedings, we issue a combined decision. The parties are not authorized to use this combined caption. Specific citations herein are made to the papers and exhibits filed in IPR2023-00254, except as otherwise noted.

DECISION
Denying Motion to Seal and Entry of Modified Protective Order
37 C.F.R. §§ 42.14, 42.54

I. INTRODUCTION

Petitioner and Patent Owner filed a Joint Motion for Entry of a Protective Order. Paper 15 ("Joint Motion" or "Joint Mot."). The proposed protective order is a modified version of the default protective order made available by the Board. *Id.* For reasons discussed below, the Joint Motion is *denied without prejudice*.

Patent Owner also filed a Motion to Seal, which is unopposed by Petitioner. Paper 18 ("Sealing Motion" or "Mot. to Seal"). This motion seeks to place under seal portions of the Patent Owner Response (Paper 17) and the entirety of each of the following exhibits: Exhibit 2016, Exhibit 2029, Exhibit 2030, Exhibit 2031, Exhibit 2032, Exhibit 2038, Exhibit 2040, Exhibit 2041, Exhibit 2042, Exhibit 2043, Exhibit 2044, Exhibit 2045, Exhibit 2046, Exhibit 2048, Exhibit 2049, Exhibit 2050, Exhibit 2051, and Exhibit 2052. A redacted public version of the Patent Owner Response has been filed as Paper 19.[2]

For reasons discussed below, we find that the Sealing Motion does not provide a meaningful balancing of the public's interest in having a complete

[2] Exhibit 2016 in IPR2023-00199 and IPR2023-00220 is not the same as Exhibit 2016 in IPR2023-00254. Patent Owner does not seek to seal Exhibit 2016 in IPR2023-00199 or IPR2023-00220. However, Patent Owner does seek to seal Exhibit 2011 in IPR2023-00199 and IPR2023-00220. Our treatment of Exhibit 2011 in IPR2023-00199 and IPR2023-00220 is the same as our treatment of Exhibits 2038 and 2040–2043 in IPR2023-00254.

and understandable file history of the proceeding with the parties' need to have all of the information sought to be sealed remain confidential, and that the requested sealing is excessive. Accordingly, the Sealing Motion is *denied without prejudice*. Patent Owner may file a renewed motion to seal that includes a specific and meaningful balancing of the parties' need to keep the information confidential and the public's interest in knowing the evidence relied on by the parties for and against patentability.

II. ANALYSIS

A. Protective Order Motion

The Joint Motion states that the parties have agreed to "additional discovery" under 37 C.F.R. § 42.51(b)(2)(i), and that the parties have agreed to produce in this proceeding certain confidential documents and testimony that were produced previously in ITC Investigation No. 337-TA-1331 (the "ITC investigation") concerning the patent at issue. Joint Mot. 1. The Joint Motion also states that these materials are subject to a protective order entered in the ITC investigation and are designated as "Confidential Business Information Subject to Protective Order" under the terms of the ITC Protective Order. *Id.*

The Joint Motion explains:

> To maintain confidentiality of the materials exchanged under the ITC Protective Order, the parties have conferred and agreed upon entry of the Stipulated Protective Order appended as Appendix A. The Stipulated Protective Order contains certain modifications to the Board's default protective order that would govern access to these confidential and competitively sensitive materials produced by the parties. A redlined version showing the changes from the Board's default protective order is

> appended as Appendix B and these modifications are explained in further detail as follows.

Joint Mot. 1–2.

The proposed modified protective order includes numerous modifications to the Board's default protective order. We find that two such proposed modifications are not acceptable.

The first appears in Paragraph 3 of the proposed modified protective order, which provides that employees, consultants, or other persons performing work for a party, other than those specifically identified in modified Paragraph (2)(A)-(C), shall be extended access to confidential information *only upon agreement of the parties*. In contrast, the Board's default protective order additionally includes the option "*or by order of the Board upon a motion brought by the party seeking to disclose confidential information to that person*." Consolidated Trial Practice Guide (Nov. 2019) ("TPG")[3] at 109. The Joint Motion does not explain why this modification is necessary, especially in light of the ability of the parties to oppose such a motion. *See* Joint Mot. at Exh. A ¶ 3 ("The party opposing disclosure to that person shall have the burden of proving that such person should be restricted from access to confidential information.").

The second appears in Paragraph 5 of the proposed modified protective order, which eliminates the language "*A party may challenge the confidentiality of the information by opposing the Motion to Seal*." Information that is not confidential should not be sealed. The parties do not

[3] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated

explain why the Board would have an adequate basis to determine whether certain information is truly confidential if a party is without the option of challenging the confidentiality of any information sought to be sealed by opposing a motion to seal. Further, in our view, a party has a duty to inform the Board if it is aware that certain information sought to be sealed by the other party is, in fact, in the public domain and thus not confidential.

For the foregoing reasons, the Joint Motion for Entry of a Protective Order is *denied without prejudice*. The parties may file a renewed Joint Motion with a proposed Protective Order that does not remove the provisions discussed above.

B. Sealing Motion

1. Elements of Consideration and the Good Cause Standard

The Board recognizes "a strong public policy for making all information filed in a quasi-judicial administrative proceeding open to the public, especially in an *inter partes* review which determines the patentability of claims in an issued patent and therefore affects the rights of the public." *Garmin International, Inc. v. Cuozzo Speed Technologies LLC*, IPR2012-00001, Paper 34, 1–2 (PTAB March 14, 2013). "Under 35 U.S.C. § 316(a)(1), the default rule is that all papers filed in an *inter partes* review are open and available for access by the public; and a party may file a concurrent motion to seal and the information at issue is sealed pending the outcome of the motion." *Id.* at 2. Similarly, 37 C.F.R. § 42.14 provides:

> The record of a proceeding, including documents and things, shall be made available to the public, except as otherwise ordered. A party intending a document or thing to be sealed shall file a motion to seal concurrent with the filing of the document or thing to be sealed. The document or thing shall be provisionally sealed on receipt of the motion and remain so pending the outcome of the decision on the motion.

Only "confidential information" is protected from disclosure. 35 U.S.C. § 316(a)(7) ("The Director shall prescribe regulations . . . providing for protective orders governing the exchange and submission of confidential information"). In that regard, the Consolidated 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.

TPG at 19.

The standard for granting a motion to seal is "for good cause." 37 C.F.R. § 42.54. This "good cause" standard "reflects the strong public policy for making all information in an *inter partes* review open to the

public." *Argentum Pharmaceuticals LLC v. Alcon Research, Ltd.*, IPR2017-01053, Paper 27 at 3 (PTAB January 19, 2018) (informative). Confidential information may be made public where the information is identified in a subsequent written decision. *See id*. at 8 ("This Order shall place both parties on notice that a movant to seal in this proceeding shall assume the risk that its confidential information will become public if relied upon in a final written decision."); TPG at 22 ("There is an expectation that information will be made public where the existence of the information is referred to in a final written decision following a trial."). As the moving party, Patent Owner has the burden of proof in showing entitlement to the requested relief. 37 C.F.R. § 42.20(c).

To establish "good cause" for sealing information from the public, the movant must demonstrate adequately each of the following four elements:

(1) the information sought to be sealed is truly confidential;

(2) a concrete harm to the party to whom the information is confidential upon public disclosure of that information;

(3) there exists a genuine need by the party submitting the information sought to be sealed to rely, at trial, on the specific information sought to be sealed; and

(4) on balance, the interests in maintaining confidentiality outweighs the strong public interest in having an open record.

Argentum, IPR2017-01053, Paper 27 at 4. For a motion to seal, the moving party needs to adequately demonstrate these four elements as to each document or a reasonably narrow related group of documents for all

information it seeks to have sealed, whether or not the other party opposes the motion to seal, because the Board has the public's interest to protect.

To meaningfully discuss the fourth element, the movant must explain why the harm from disclosure of the information outweighs the public's interest in knowing the information. For example, a party seeking to seal information regarding objective indicia of nonobviousness should explain why the party's need to keep the information confidential outweighs the public's interest in knowing the information which, according to Patent Owner, tends to show nonobviousness.[4]

2. Exhibits 2016, 2029–2032, 2038, 2040–2046, 2048–2052

In the Sealing Motion, Patent Owner seeks to seal Exhibits 2016, 2029–2032, 2038, 2040–2046, and 2048–2052, all of which were filed entirely under seal with no redacted versions. Mot. to Seal 3–4. Patent Owner also seeks to seal portions of its Patent Owner Response. *Id.* at 4. Patent Owner filed a confidential version of the Patent Owner Response, and a public version of the Patent Owner Response which includes redactions of the material it seeks to seal. Patent Owner addresses the exhibits in three groups: (1) Exhibits 2016 and 2029–2032; (2) Exhibits 2038 and 2040–2043; and (3) Exhibits 2044–2046 and 2048–2052. Mot. to Seal 5–7.

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[4] The dissent refers to "our charge to 'secure the just, speedy, and inexpensive resolution of [this] proceeding.'" But that goal should not be achieved at the expense of sacrificing the public interest. The public is not represented by counsel in this proceeding. That is more reason why we should be watchful in protecting the public interest.

a) Exhibits 2016 and 2029–2032

These exhibits contain excerpts from the depositions of Sung Ki Kim, Sungsu Lee, and Wunkil Lee (Exs. 2029–2031), which Patent Owner argues should be kept under seal because they "include sensitive and proprietary technical information and business information relating to Samsung's internal design, development, and management of its products." Mot to Seal 5. This first group of exhibits also contains excerpts from the depositions of John Palmer and Christopher Bolton (Exs. 2016, 2032), which Patent Owner asserts "include third party, non-public information relating to product development and management." Mot. to Seal 5.

Absent from Patent Owner's explanation, however, is the significance of these exhibits to Patent Owner's arguments and positions in this proceeding. For example, Patent Owner does not address whether Patent Owner has a genuine need to rely on this information. Patent Owner also has not shown that the interest in maintaining confidentiality of the entirety of these exhibits outweighs the strong public interest in maintaining an open record. *See* TPG 22 (discussing how 37 C.F.R. § 42.56 "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" and also "encourages parties to redact sensitive information, where possible, rather than seeking to seal entire documents."). In addition, Patent Owner does not establish that these exhibits include *only* confidential

information.[5] Merely saying that the exhibits include confidential information does not mean they are without non-confidential information. Information that is not confidential should not be sealed.

Further, Patent Owner merely speculates as to any harm that may result to third parties by disclosure of information in Exhibits 2016 and 2032, by its use of the language "may put these third parties at competitive disadvantage." Mot. to Seal 5.

b) Exhibits 2038 and 2040–2043

As to these exhibits, Patent Owner asserts that the documents include "confidential and non-public sales information" (Ex. 2040), as well as sensitive and proprietary: "technical information and business information" (Ex. 2041); "information relating to technical information and marketing" (Ex. 2038); and "business information relating to Samsung's internal technical analysis" (Ex. 2042; Ex. 2043). Mot. to Seal 6.

The Scheduling Order indicates that it is the responsibility of the party whose confidential information is at issue, not necessarily the proffering party, to file the motion to seal, unless the party whose confidential

[5] To the extent further guidance is necessary, we make the following observations. Few, if any, exhibits should ever be confidential in their entirety, without good cause to show that all of the information contained therein is truly sensitive. *See* 37 C.F.R. § 42.54(a). For example, deposition transcripts, declarations, and papers containing a party's arguments will generally contain substantial non-confidential portions. In all cases, a motion to seal must *set forth the reasons why the information redacted from the non-confidential version is confidential and should not be made publicly available*. TPG at 111.

information is at issue is not a party to the proceeding. Paper 12, 3. Because these exhibits contain Petitioner's information, *Petitioner* is responsible for filing the motion to seal confidential information in Exhibits 2038 and 2040–2043, and has the burden of proof to establish that it is entitled to the requested relief, i.e., sealing of the documents. *See* 37 C.F.R. § 42.20(c). To the extent that Patent Owner's Response contains information confidential to Petitioner, Petitioner is responsible for moving to seal that information. Patent Owner's assertions to seal these exhibits are unpersuasive because Patent Owner does not have first-hand knowledge about such information. In any event, the corresponding submission in the Sealing Motion shares the same inadequacies as discussed above.

3. Exhibits 2044–2046, 2048, and 2049–2052

As to these exhibits, Patent Owner asserts that the documents include Patent Owner's "confidential and non-public sales information" (Exhibits 2044–2046), "confidential and non-public business arrangements" (Exhibit 2048), and "confidential and non-public financial terms" (Exhibits 2049–2052). *Id*. at 6–8. Patent Owner's discussion of these documents have the same inadequacies as those identified with respect to the first group of exhibits, i.e., Exhibit 2016 and Exhibits 2029–2032, already discussed above, except for the above-identified speculation as to third party harm. *Id*.

4. Patent Owner Response

Patent Owner submitted a public, redacted copy of its Patent Owner Response (Paper 19), with respect to which Patent Owner represents it redacted "only those portions . . . that reflect competitively-sensitive information." Mot. to Seal 8. Patent Owner argues "that the thrust of its

underlying arguments and evidence remain clearly discernable from the redacted, public versions of its filings." *Id*. It appears, however, that the meaningful and specific evidence of nonobviousness is redacted. It is also questionable whether all of the material redacted from the Patent Owner Response, if disclosed to the public, would result in *serious* harm to either party or a third party.

Moreover, the seriousness of the alleged harm resulting from disclosure of the redacted text has not been adequately explained. For example, with respect to the redactions on page 57 of the Patent Owner Response, we are uncertain of the seriousness of the resulting harm if the public were to know when Samsung began developing outdoor LCD displays, the general time frame in which Samsung launched its first outdoor display, and the general time frame in which Samsung first introduced its OHD product. Also, confidentiality of the dates and time periods does not justify redacting entire sentences including the dates and time periods. Additionally, it is unclear why when Samsung launched or introduced its products to the market is confidential.

With respect to the redactions on pages 66–67 of the Patent Owner Response, we are uncertain of the nature and extent of the resulting harm if Dr. Palmer's testimony regarding whether and, if so, why, Samsung's products were requested by customers were made public. Similarly, we are uncertain of the nature and extent of the resulting harm if the public were to know why Patent Owner believes Patent Owner's technology is a critical feature of Samsung's products, and what Samsung said (or did not say)

about its products. It is also unclear why what Samsung said to the public in marketing its products is confidential.

We are also uncertain of the seriousness of the resulting harm if the identity of licensees were revealed. Note that in the public version of the Patent Owner Response in IPR2023-00255, the identity of a licensee is revealed. Likewise, we are uncertain of the seriousness of the resulting harm if the public were to know Samsung's market share before entering the outdoor display market, Samsung's market share in 2017, and Samsung's market share in 2020.

We ask that any renewed motion to seal include a certification that the redacted material, to the extent Patent Owner is aware, is not in the public domain.

The dissent states that "the panel will have an opportunity to review—and potentially reject—any redactions the parties seek to our Final Written Decision." Any such opportunity is not a realistic one, because (1) the general expectation is that redaction of material is proper if the Board has granted a motion to seal on that information, and (2) any such review necessarily would be post-issuance of the Final Written Decision. The Board should not have to issue a non-public Final Written Decision and then initiate a process to determine if any redaction should be made to provide a public version of the Final Written Decision. Neither the rules nor the TPG identifies a procedure for authorizing redactions separate from the process we already have for a motion to seal.

III. ORDER[6]

For the foregoing reasons, it is

ORDERED that the Joint Motion for Entry of a Protective Order is *denied without prejudice*;

FURTHER ORDERED that parties are authorized to file a renewed joint motion for entry of a protective order;

FURTHER ORDERED that Patent Owner's Motion to Seal is *denied without prejudice*;

FURTHER ORDERED that Patent Owner is authorized to file a renewed motion to seal consistent with the applicable statute and rules as well as the additional guidance provided herein, within three weeks from the entry date of this Order;

FURTHER ORDERED that Exhibits 2016, 2029–2032, 2038, 2040–2046, and 2048–2052, and the unredacted version of the Patent Owner Response remain *provisionally* sealed until Patent Owner's timely filing of a renewed motion to seal directed to such material; and

[6] Although we do not believe this Decision reveals any information Patent Owner regards as confidential, out of an abundance of caution and due to redaction by Patent Owner of what appears to be non-confidential text in the same sentences as confidential information, we issue this Decision as confidential and non-public. The parties shall inform the Board, within one week of the date of this Decision, whether this Decision can be designated as "Public" and "Non-Confidential," and, if not, why. We intend to make this Decision public after one week of the date of entry of this Decision.

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IPR2023-00220 (Patent 9,173,322 B2)
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IPR2023-00254 (Patent 10,506,740 B2)
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FURTHER ORDERED that any document filed with restricted public access not addressed in a granted or pending motion to seal and not sought to be expunged by December 31, 2023, will be designated as public.

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HUDALLA, *Administrative Patent Judge*, *Concurring-in-Part* and *Dissenting-in-Part*.

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[7] These proceedings have not been consolidated. Because the matter addressed is common to these proceedings, we issue a combined decision. The parties are not authorized to use this combined caption. Specific citations herein are made to the papers and exhibits filed in IPR2023-00254, except as otherwise noted.

I concur with my colleagues on Part A of the Order regarding the parties' proposed protective order. The proposed protective order is unacceptable because it strips away the parties' ability to challenge confidential designations and the Board's ability to review such designations.

I respectfully dissent from my colleagues' decision in Part B of the Order to deny Patent Owner's motion to seal without prejudice.[8] Although my colleagues are correct that Patent Owner could have better accounted for the public interest in its motion, I still find that Patent Owner's showing evidences good cause to grant the motion. In particular, I take Patent Owner at its word that the subject information is proprietary and that disclosure of the subject information would cause competitive harm. The information Patent Owner seeks to seal—which generally relates to copying and commercial success as secondary considerations of nonobviousness—is commonly protected in our proceedings.

Importantly, the motion is unopposed. I also note that the parties' intended protection in this case echoes the manner the information is being treated in the International Trade Commission (ITC). Although we are not bound by ITC protective orders, I understand the parties' desire at this juncture to be consistent with the ITC protective order as a matter of expediency. As such, I believe granting the motion is consistent with our

[8] Consistent with my concurrence on Part A of the Order, my comments regarding Patent Owner's motion to seal are contingent on the entry of an acceptable protective order.

charge to "secure the just, speedy, and inexpensive resolution of [this] proceeding." 37 C.F.R. § 42.1(b). Furthermore, the panel will have an opportunity to review—and potentially reject—any redactions the parties seek to our Final Written Decision. *See* Paper 12, 3 ("[I]nformation subject to a protective order may become public if identified in a final written decision in this proceeding.").

Finally, my colleagues object to the fact that Patent Owner seeks to seal *Petitioner's* confidential information in Patent Owner's motion. I am not troubled by this given the unopposed nature of the motion, which makes the motion similar to a joint motion. I also note that Patent Owner is apparently following the existing designations and terms of the ITC protective order.

For these reasons, I respectfully dissent from Part B of the Order.

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