UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND SAMSUNG ELECTRONICS AMERICA, INC.
Petitioners,

v.

MANUFACTURING RESOURCES INTERNATIONAL, INC.
Patent Owner

Case IPR2023-00221
Patent 11,013,142

JOINT MOTION FOR PRESERVATION OF THE RECORD PENDING APPEAL

Pursuant to the Board's authorization by email of August 2, 2024, Patent Owner Manufacturing Resources International, Inc. ("MRI") and Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. ("Samsung") (collectively, "the Parties") respectively submit this Joint Motion for Preservation of the Record Pending Appeal.

I. STATEMENT OF RELIEF REQUESTED

The Parties respectfully request that the entire docket in IPR2023-00199, -00220, -00221, -00254, and -00255 be preserved until at least 45 days after conclusion of all appeals concerning the five proceedings, including preservation of all sealed documents in non-public form. The Parties further request that the Board authorize each party to file a motion to expunge confidential information after the conclusion of all such appeals.

If the Board denies this Motion, the Parties request that the Board allow each party at least five business days from the order denying the Motion, to file a motion to expunge confidential information before any documents currently under seal are made public.

II. BACKGROUND

After institution of this proceeding, Patent Owner and Petitioners agreed to "additional discovery" pursuant to 37 C.F.R. § 42.51(b)(2)(i). Specifically, Patent Owner and Petitioners each agreed to produce in this proceeding certain confidential

and competitively sensitive documents and testimony that were produced previously in ITC Investigation No. 337-TA-1331. Several of the materials designated as confidential were submitted by Patent Owner and Petitioners as evidence relating to secondary considerations, and described in the Patent Owner Response, Petitioners' Reply, and Final Written Decision. On December 27, 2023, Patent Owner and Petitioners jointly moved for entry of a Protective Order over confidential information that was filed as exhibits or described in briefing. *See* Paper 31.

Pursuant to the Board's instructions in Paper 25, Patent Owner and Petitioners filed separate motions to seal their respective confidential information on January 12, 2024. *See* Paper 32; Paper 34. Patent Owner moved to seal the following exhibits as containing confidential and commercially sensitive information:

- Exhibit 1030
- Exhibit 1040
- Exhibit 2044
- Exhibit 2045
- Exhibit 2046
- Exhibit 2048
- Exhibit 2049
- Exhibit 2050
- Exhibit 2051

- Exhibit 2052

See Paper 32. Petitioners moved to seal the following exhibits as containing confidential and commercially sensitive information:

- Exhibit 1030
- Exhibit 1035
- Exhibit 2029
- Exhibit 2030
- Exhibit 2031
- Exhibit 2032
- Exhibit 2038
- Exhibit 2040
- Exhibit 2041
- Exhibit 2042
- Exhibit 2043

See Paper 34. Both Parties additionally moved to seal certain confidential descriptions of those exhibits in Patent Owner's Response and Petitioners' Reply. Paper 32, Paper 34.

On March 1, 2024, the Board granted the Parties' request that the proposed Protective Order be entered. Paper 46. On the same day, the Board granted Patent Owner's and Petitioners' motions to seal. Paper 47. The Board found good cause

existed to permit Patent Owner and Petitioners to file the materials under seal and accessible by Parties and Board only.

The Board subsequently held an oral hearing and issued a Final Written Decision. Paper 54. That decision discussed and cited to certain confidential exhibits sealed under the Board's orders. *See* Paper 55; Paper 47; Paper 46. Specifically, the Final Written Decision cites to and describes Exhibits 2029, 2031, 2032, 2038, 2040, 2041, 2042, 2043, 2049, 2050, 2051, and 2052. The Board explained that "[a]ccordingly, [the Board] entered the Decision in the Board's P-TACTS system as 'Board and Parties Only' to afford the parties an opportunity to identify any confidential information to which [the Board has] referred in the Decision." Paper 55, at 2. The Board ordered the Parties to confer and file a proposed redacted version of the Final Written Decision. *Id.* The Parties publicly filed their Joint Proposed Redactions to the Final Written Decision on July 3, 2024. Paper 56.

Patent Owner intends to appeal the Final Written Decision to the Federal Circuit within the time provided under 35 U.S.C. § 142 and 37 C.F.R. § 90.3(a)(1).

III. REASONS FOR REQUESTED RELIEF

Patent Owner and Petitioners request that the Board maintain under seal, in non-public form pending the outcome of all appeals, the unredacted and under seal papers filed in this proceeding. The Trial Practice Guide provides that "[c]onfidential information that is subject to a protective order ordinarily will become public . . . 45

days after final judgment in a trial. . . . A party seeking to maintain the confidentiality of information, however, may file a motion to expunge the information from the record prior to the information becoming public. 37 C.F.R. § 42.56." Consolidated Trial Practice Guide (Nov. 2019), at 21-22.

An exception to the requirement to expunge or make public arises when there is an appeal pending the Board's decision. *Illumina v. Columbia University*, IPR2012-00006, Paper 133 (PTAB Apr. 25, 2014). Patent Owner intends to appeal from the Final Written Decisions in this proceeding. The Federal Rules of Appellate Procedure and the Federal Circuit Rules require that the record of these proceedings be retained by the Board pending the appeals. Fed. Cir. R. 17(a) ("The agency must retain the record"), 17(d)(2) ("A party or counsel for a party must be permitted to inspect and copy material contained in the record governed by a protective order of an agency in accordance with that order.").

Federal Circuit Rule 25.1(c)(1) further requires that "any portion of the record that was subject to a protective order in the trial court or agency ***must remain subject to that order*** on appeal or review" (emphasis added). The Parties respectfully submit that the Board should grant the Parties' request to preserve the entire record of these proceedings until after the conclusion of all appeals, with the sealed documents being preserved in non-public form under the protective order. For the same reasons set forth in the Parties' motions to seal (Papers 32, 34) that the Board has agreed

established good cause to seal the confidential information (Paper 47, granting motions to seal), the Parties would be prejudiced if the confidential information that the appellate rules require to be retained in the record were made public while appeals are pending.

The Board has maintained the confidentiality of the record pending appeal in other proceedings. *See, e.g.*, *Google LLC v. Singular Computing LLC*, IPR2021-00165, Paper 65 (Jun. 23, 2022); *LSI Corp. v. Regents of the Univ. of Minnesota*, IPR2017-01068, Paper 60 (May 19, 2021); *Illumina, Inc. v. Trs. of Columbia Univ. in the City of New York*, IPR2018-00797, Paper 68 (Oct. 9, 2019); *Sanofi-Aventis U.S. LLC v. Immunex Corp.*, IPR2017-01879, Paper 90 (Apr. 3, 2019); *Merck Sharp & Dohme Corp. v. Mayne Pharma Int'l Pty Ltd.*, IPR2016-01186, Paper 75 (Feb. 8, 2018); *Mylan Labs. Ltd. v. Aventis Pharma S.A.*, IPR2016-00712, Paper 102 (Nov. 14, 2017); *Kayak Software Corp. v. Int'l Bus. Machines Corp.*, IPR2016-00608, Paper 67 at 43-44 (Aug. 7, 2017); *Arctic Cat, Inc. v. Polaris Indus., Inc.*, IPR2014-01427, Paper 62 at 2-3 (Mar. 8, 2016); *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, IPR2013-00128, Paper 93 (Sept. 10, 2014); *Illumina, Inc. v. Trs. of Columbia Univ. in the City of New York*, IPR2012-00006, Paper 133 (Apr. 25, 2014).

To preserve the record for appeal and to preserve the Parties' opportunity to expunge confidential information from the record, the Parties request that the Board preserve the entire record in its present form, including preserving all currently

sealed documents, until at least 45 days after conclusion of all appeals, as has been the Board's practice in other cases. *See, e.g.*, *Singular Computing*, IPR2021-00165, Paper 65, at 2; *Sanofi-Aventis*, IPR2017-01879, Paper 90 at 2; *Illumina*, IPR2018-00797, Paper 68 at 3; *Kayak*, IPR2016-00608, Paper 67 at 43-44; *Arctic Cat*, IPR2014-01427, Paper 62 at 2-3 (preserving record and extending due date for motion to expunge until 45 days from filing of mandate from appeal).

IV. CONCLUSION

For the foregoing reasons, Patent Owner and Petitioners jointly request that the record be retained and that confidential documents remain subject to the Protective Order, the entire record of this proceeding be preserved in its present form until at least 45 days after conclusion of all appeals concerning IPR2023-00199, -00220, -00221, -00254, and -00255, including preservation in sealed, non-public form the documents that are currently under seal. The Parties further request that the Board authorize each party to file a motion to expunge confidential information after the conclusion of all such appeals.

If the Board denies this Motion, the Parties request that the Board allow each party at least five business days from the order denying the Motion to file a motion to expunge confidential information before any documents currently under seal are made public.

Dated: August 2, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the date below a copy of this **JOINT MOTION FOR PRESERVATION OF THE RECORD PENDING APPEAL** was served on Petitioners by filing through the P-TACTS System and by electronic delivery via email to the following:

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