From: Trials
To: cortneyalexander@kentrisley.com; rbrunelli@sheridanross.com
Cc: michael@kiklisclark.com; kimani@kiklisclark.com; Trials
Subject: IPR2023-00707, -708, -709, -711 - Attention Requested
Date: Tuesday, December 19, 2023 9:05:32 AM

Counsel,

From the Board –

In each of the above-referenced proceedings, Patent Owner filed a Renewed Motion to Seal an exhibit that includes an email chain between Petitioner and DODOcase (the predecessor-in-interest of the challenged patents). *E.g.*, IPR2023-00707, Paper 37 ("Renewed Motion"); *see, e.g.*, IPR2023-00707, Ex. 2034 (email chain; "Exhibit"). However, in the Renewed Motion, Patent Owner contends that the Exhibit does *not* include confidential information and that there is *not* "good cause to redact [it] or file it under seal." Renewed Motion 2. Instead, "*Petitioner* has indicated that it believes that [the Exhibit] should be sealed." *Id.* (emphasis added). The Renewed Motion provides a three-sentence summary of Petitioner's position, which references a district court protective order, and is accompanied by Petitioner's proposed redactions to the Exhibit. *Id.*

The Renewed Motion is unacceptable. First, the movant contends that there is not, in fact, good cause for relief. *But see* 37 C.F.R. § 42.20(c) ("The moving party has the burden of proof to establish that it is entitled to the requested relief."); *e.g.*, IPR2023-00707, Paper 29 at 2 ("Order on Original Motions to Seal") (explaining that "the default rule is that all papers filed in an *inter partes* review are open and available for access by the public," but a document will be given confidential treatment if a party files a motion to seal showing "good cause"). Second, although there is an apparent dispute between the parties, the parties fail to adequately brief their respective positions: Petitioner's position is poorly explained, and Patent Owner fails to provide any response to it.

The Board authorized "the parties" to file a renewed motion to seal the Exhibit because both parties had asserted that this document includes confidential information. Order on Original Motions to Seal 4–5. Clearly, that is no longer the case. For any and all disagreements between the parties, including the application of the district court protective order, the Board expects the parties to meaningfully meet and confer prior to contacting the Board to ensure that each party understands the other's position before those positions are presented to the Board. In fact, parties must meet and confer telephonically or in person to attempt to reach agreement before contacting the Board. *See* IPR2023-00707, Paper 28 at 2 ("Scheduling Order"). The Board expects that, when ordered to meet and confer, the parties will make all reasonable efforts to reach agreement, and will only seek the Board's guidance if a genuine impasse arises.

Accordingly, on or before **Friday, January 5, 2024**, lead counsel for both parties must meaningfully participate in a telephonic (or in person) meet and confer regarding the Renewed Motion and this email. During that meet and confer, counsel shall discuss whether the Exhibit (i.e., Exhibit 2034 in IPR2023-00707 and -708 and Exhibit 2024 in IPR2023-00709 and -711) includes confidential information. If so, counsel shall negotiate an agreed proposed redacted version of the document. In addition, during the meet and confer, counsel shall discuss an appropriate modification to the

protective order to avoid similar problems in the future. To that end, the parties are reminded that, "[w]hen confidential information is to be entered into the record, it is the responsibility of the party whose confidential information is at issue, not necessarily the proffering party, to file the motion to seal." *See, e.g.*, Scheduling Order 2–3; *accord* Order on Original Motions to Seal 3 n.4.

By **Monday, January 8, 2024**, the parties must send an email to the Board at trials@uspto.gov. In that email, counsel shall certify compliance with this requirement, identify all participants in and date and time of the meet and confer, briefly summarize the agreement reached, and provide a copy of the modified protective order.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office