

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

AMERICAN HONDA MOTOR CO., INC.,
Petitioner,

v.

NEO WIRELESS, LLC,
Patent Owner.

Case IPR2023-00797
Patent 10,771,302 B2

**PATENT OWNER'S REQUEST FOR REHEARING
OF SEALED ORDER RE: EX PARTE COMMUNICATION (PAPER 19)**

SUBJECT TO MOTION TO SEAL

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Neo Wireless, LLC (“Patent Owner”) respectfully requests rehearing of the sealed December 27, 2023 Order (Paper 19) sealing Exhibit 3101.^{1,2}

Consistent with the sealing of the Exhibit and the sealing of the Order, and in compliance with 37 C.F.R. § 42.14, a motion to seal is being concurrently filed.

I. THE PRESENT REQUEST FOR REHEARING IS AUTHORIZED.

The Order issued *sua sponte*, and does not expressly make clear on whose behalf it issued. Its cover indicates that it issued from the Director’s Office, and is signed by Jeri Youngblood, identified as a “Legal Administrative Specialist.” The Order sets forth conclusions of the “Office,” “the Board,” and “[t]he Director.”

If the Order is on behalf of the Director in her capacity as Director, then it is requested that the Director rehear the decision. Paper 18 (ordering Director Review); USPTO Revised Director Review Process (last updated Sep. 18, 2023), § 5.C.ii.³

¹ The P-TACTS public docket identifies the order as “Order Re: Ex Parte Communication” and Paper 19. It is hereinafter identified as the “Order.”

² This is one of two substantially identical requests for rehearing of substantially similar orders in two cases, IPR2023-00763 and IPR2023-00797.

³ www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process.

If the Order is on behalf of the Director in her capacity as a Board member, then it is requested that the assigned Board panel rehear the decision. *See* 37 C.F.R. § 42.71(b) (“If a decision is not a panel decision, the party may request that a panel rehear the decision.”).

If the Order is on behalf of the assigned Board panel, then it is requested that the assigned Board panel rehear the decision. *Id.* § 42.71(d).

II. EXHIBIT 3101 SHOULD BE MADE PUBLIC.

The Order was filed with an exhibit (the “Exhibit”), which the Order states will be sealed. The Exhibit is filed available to the Board and parties only.

However, the Exhibit does not contain any confidential information, does not purport to contain any confidential information, and was publicly disseminated without confidentiality restrictions nearly a week before the Order. Moreover, to the extent the Exhibit is relevant to these proceedings, there is a strong policy in favor of making it public. The Exhibit should be made available to the public.

The one-page Order states:

The U.S. Patent and Trademark Office has become aware of an ex parte communication that has not been properly filed as an authorized paper in the above-listed proceeding. Because this communication potentially relates to the above-listed proceeding, the Board is making it available to the parties and as part of the record under seal.

The “communication” in question is a letter (hereinafter “the Letter”) addressed to Director Vidal and stating that it is from the Alliance for Automotive Innovation, the Computer and Communications Industry Association, the High Tech Inventors Alliance, the National Retail Federation, the Software & Information Industry Association, and US*MADE. The three-page,⁴ single-spaced Letter references IPR2023-00763 and IPR2023-00797, the two cases (of which this is one) challenging Patent Owner’s patent rights in which petitions for Director Review were filed and granted on December 21, 2023.

The Letter asks the Director to grant the petitioners’ petitions for Director Review in those cases and that the “cases present an important opportunity for the Office to correct a policy” which it says was “adopted in *Valve Corp. v. Electronic Scripting Prods., Inc.*, IPR2019-00062 (Apr. 2, 2019),” a precedential-designated decision of the Board. The Letter further asserts, *inter alia*, that “*Valve Corp.* was condemned by a broad cross-section of American industry” and that “[i]t is long past time for the USPTO to reconsider the *Valve Corp.* policy.”

The Letter states that it is copied to persons including counsel for all parties to the cases, including the undersigned. Consistent with this, the undersigned

⁴ A fourth page identifies the parties to whom copies of the letter were distributed.

received by email a copy of the Letter on December 21, 2023.⁵

That email was not marked as confidential and did not purport to include

⁵ The email received by the undersigned on December 21, 2023 states,

I wanted to copy you on a joint coalition letter submitted to Director Vidal this afternoon. You were cc'd on the letter to Director Vidal but I wanted to get to you electronically asap. I serve as Director of US*Made, one of the signatories to the letter.

Thank you.

David Crane

Principal

Bose Public Affairs Group.

The email includes an earlier, forwarded message, evidently sent to a “Ms.

Ramdat” in the Director’s office, dated December 21, 2023, with the subject

“Need for Director Review of Valve Corp.,” and which states:

Attached for Director Vidal’s consideration please find a letter concerning recent USPTO policies that is signed by the Alliance for Automotive Innovation, the High Tech Inventors Alliance, US MADE, the National Retail Federation, the Computer and Communications Industry Association, and the Software and Information Industry Association.

Thank you,

David Crane

confidential information. The Letter is not marked as confidential and does not purport to be confidential or to contain any confidential information.

The copy of the Letter filed as the Exhibit should not have been sealed, and should be made available to the public, for at least the reasons set forth below.

First, the Letter is public. As noted above, the Letter contains no indications of confidentiality, and no information that is confidential. Nor does the Order identify any confidential information in the Exhibit.

Furthermore, the Letter was publicly distributed nearly a week before the Order, without any confidentiality restrictions, as shown above. Nor does the Order identify any assertion that the Letter was sent on a confidential basis. The public dissemination of the Letter undermines any reason it might have been appropriate to seal it that might have been present otherwise. *See, e.g., Uniloc 2017 LLC v. Apple, Inc.*, 964 F.3d 1351, 1358 (Fed. Cir. 2020) (“once the information is disclosed, the ‘cat is out of the bag’”) (cleaned up).

Third, even if the Letter had not been publicly distributed, its sealing is improper. The Exhibit is relevant to public assessment of this presumptively public quasi-judicial proceeding. As already discussed in the preceding section, a strong public policy supports public access to judicial records in court proceedings. The Exhibit is a judicial record subject to this strong presumption of public access. *See, e.g., In re Sealing & Non-Disclosure*, 562 F. Supp. 2d 876, 890 (S.D. Tex.

2008) (“judicial records” including “exhibits, and other materials . . . admitted into evidence by the court . . . are ***presumptively open for public inspection and copying***, although various federal rules permit such documents to be filed in redacted form, under seal, or both [upon a showing of ***good cause***]”) (emphasis added). While “[not] all filed documents have equal public interest,” “documents that influence or underpin the judicial decision[] are open to public inspection unless they meet the definition of trade secrets or other categories of bona fide long-term confidentiality.” *Id.* (cleaned up). The Exhibit underpins the Order. Moreover, it urges the Director to grant Director Review in these very proceedings. Whatever the outer boundaries of the general right to public access of judicial records, this document is near its core.

As the Supreme Court has stated, for example:

It is clear that the courts of this country recognize a general right to inspect and copy public records and documents, including judicial records and documents. . . . American decisions generally do not condition enforcement of this right on a proprietary interest in the document or upon a need for it as evidence in a lawsuit. The interest necessary to support the issuance of a writ compelling access has been found, for example, in the citizen’s desire to keep a watchful eye on the workings of public agencies, . . . and in a newspaper publisher’s intention to publish information concerning the operation of government.

Nixon v. Warner Commun 's, 435 U.S. 589, 597-598 (1978); *see Uniloc*, 964 F.3d at 1358. There is no good reason to exempt this Letter from this general right to public access, in the record of this proceeding. Nor does the Order articulate one.

The Order, without mentioning the general right to public access, states:

The Director has not reviewed this communication, and was not aware of it when granting Director Review on December 21, 2023. Furthermore, the Director will not review or consider this communication in reaching a decision on Director Review. See 37 C.F.R. § 42.5(d).

None of these statements provides a justification for sealing the copy of the Letter in the record of this case. It is for the public to judge the significance or lack thereof of this publicly distributed document in the case file. That is the very reason, and rationale, for the longstanding strong public policy in favor of access to judicial records, as reflected in the statute, rules, and past decisions that bear on the power and propriety of sealing documents in the file.

To quote a recent court of appeals decision that rejected a trial court's sealing of judicial records over a party's objection:

The public has an interest in transparent court proceedings that is independent of the parties' interests. This right serves to promote trustworthiness of the judicial process, to curb judicial abuses, and to provide the public with a more complete understanding of the judicial

system, including a better perception of its fairness. Accordingly, we heavily disfavor sealing information placed in the judicial record.

June Med. Servs., L.L.C. v. Phillips, 22 F.4th 512, 519-520 (5th Cir. 2022).

(cleaned up, paragraph breaks omitted). Therefore, “the working presumption is that judicial records should not be sealed,” and “courts should be ungenerous with their discretion to seal judicial records.” *Id.*, 521 (cleaned up). And to justify such sealing “the court must undertake a ‘document-by-document,’ ‘line-by-line’ balancing of the public’s common law right of access against the interests favoring nondisclosure.” *Id.* (cleaned up). Here, in contrast, the entire Exhibit was sealed without any discussion of balancing or of the public’s rights.

Even if the information would “qualif[y] for a protective order” in a discovery context, such protection “says **nothing** about whether it should be sealed once it is placed in the *judicial record*.” *Id.* (first emphasis added).

The rationale for public access is even greater where, as here, the question involves matters of particularly public interest.... In the context of publicly available documents, those already belong to the people, and a judge cannot seal public documents merely because [they are added] to the judicial record. [Courts] require information that would normally be private to become public by entering the judicial record. How perverse it would be to say that what was once public must become private—simply because it was placed in the courts that belong to the public. . . . Publicly available information cannot be sealed.

Id., 520 (cleaned up); *see id.* (“In so holding, we align with the Supreme Court and our sister circuits.”)

Finally, as the Federal Circuit has explained, in the public agency context the general right to public access to judicial records

supports ‘the citizen’s desire to keep a watchful eye on the workings of public agencies.’ There is a strong presumption in favor of access to documents filed with a court. The presumption of access is based on the need for federal courts, although independent—indeed, particularly because they are independent—to have a measure of accountability and for the public to have confidence in the administration of justice.

Uniloc, 964 F.3d at 1358 (quoting *Warner*) (cleaned up). Here, public access to this record in accordance with the strong presumption of such access will promote public confidence in the administration of justice, and sealing will impair it.

The Exhibit should be made available to the public.

III. THE ORDER (PAPER 19) SHOULD BE MADE PUBLIC.

The Order does not state that it is confidential or that it should be sealed, and it is not labeled as sealed. Nevertheless, it is available only to the parties and the Board, not to the public. *See* P-TACTS public docket. The Order should be made available to the public.

The power of the Office and the Director to seal information in the file of any IPR is limited. Congress authorized the Director to prescribe regulations providing that the file of any IPR “shall be made available to the public, **except** that any . . . document filed with the intent that it be sealed shall, if accompanied by a motion to seal, be treated as sealed pending the outcome of the ruling on the motion[.]” 35 U.S.C. § 316(a)(1) (emphasis added). The rules prescribed provide that “[t]he record of a proceeding, including documents and things, shall be made available to the public, except as otherwise ordered.” 37 C.F.R. § 42.14. Under this statute and rules, “confidential information” may be granted protection from disclosure, 35 U.S.C. § 316(a)(7), only “for good cause,” 37 C.F.R. § 42.54(a), subject to the “strong public policy in having an open record,” *Argentum Pharms. LLC v. Alcon Res., Ltd.*, IPR2017-01053, Paper 27, 4 (PTAB Jan. 19, 2018) (informative); see also *Garmin Int’l, Inc. v. Cuozzo Speed Tech. LLC*, IPR2012-00001, Paper 34, 1-3 (PTAB Mar. 14, 2013) (The moving party must overcome the “strong public policy for making **all** information filed in a quasi-judicial administrative proceeding open to the public, **especially** in an inter partes review”) (emphases added). Moreover, in general, if “documents filed in this proceeding” are to be even partially sealed, “redactions must be limited to isolated passages consisting entirely of confidential information, and the thrust of the underlying argument or evidence must remain clearly discernible.” *Edwards*

Lifesciences Corp. v. Boston Scientific Scimed, Inc., IPR2017-00060, Paper 56, 4 (PTAB Feb. 9, 2018). No rules or statutes appear to grant the Director additional powers to seal beyond those set forth above or to displace the strong public policy in having an open record.

The legal principles above do not support sealing the Order. First, no order, including the Order itself, directs that the Order not be made available to the public. It therefore “shall be made available to the public.” 37 C.F.R. § 42.14.

Since the Order does not specify that it should be sealed, it is even possible that its sealing was inadvertent. If it was inadvertent, the error should be corrected.

If the Order is intentionally sealed, its sealing is legally erroneous. “What transpires in the court room is public property.” *Craig v. Harney*, 331 U.S. 367, 374 (1947). Congress, the rules, and court and Office decisions provide that the file of this case must be made available to the public except in strictly limited circumstances, as shown above. But it is especially rarely permissible in any circumstances to seal the fact of sealing a document or the reasons for sealing it. *See, e.g.*, R. T. Reagan, *Sealing Court Records And Proceedings*, Federal Judicial Center (2010),⁶ at 21 (“There should be a public record of what is sealed and why, consistent with the reason for sealing.”) (collecting cases). The Order is a decision

⁶ https://www.fjc.gov/sites/default/files/2012/Sealing_Guide.pdf

in a quasi-judicial Office proceeding, and is therefore at the apex of the strong policy in favor of public access to the file.

In the top drawer of judicial records are documents authored or generated by the court itself in discharging its public duties, including opinions, orders, judgments, docket sheets, and other information related to the court's public functions. Unlike [some other forms of judicial records], this drawer *is **hardly ever closed to the public.***

In re Sealing & Non-Disclosure, 562 F. Supp. 2d at 891 (emphasis added); *cf., e.g., Craig*, 331 U.S. at 374 (“There is no special perquisite of the judiciary which enables it, as distinguished from other institutions of democratic government, to suppress, edit, or censor events which transpire in proceedings before it.”); *Binh Hoa Le v. Exeter Fin. Corp.*, 990 F.3d 410, 419 (5th Cir. 2021) (“when materials enter the court record, the standard for shielding records from public view is far more arduous” than for unfiled materials); *Company Doe v. Public Citizen*, 749 F.3d 246, 271 (4th Cir. 2014) (“Public confidence [in the judiciary] cannot long be maintained where important judicial decisions are made behind closed doors and then announced in conclusive terms to the public, with the record supporting the court’s decision sealed from public view.”).

As the Seventh Circuit wrote, ordering the unsealing of a trial court’s orders: Judges deliberate in private but issue public decisions after public arguments based on public records. . . . Any step that withdraws an

element of the judicial process from public view makes the ensuing decision look more like fiat and requires rigorous justification.

Hicklin Eng'g, L.C. v. Bartell, 439 F.3d 346, 348 (7th Cir. 2006) (per Easterbrook, J.). Here, sealing the Order itself deprives the public of the basis for the agency's actions, and is not supported by reasoning. The Order should be made public.

IV. CONCLUSION

It is respectfully requested that the Order be reconsidered and that the Exhibit and Order be made available to the public.

Respectfully submitted,

 / Kenneth J. Weatherwax /

Kenneth J. Weatherwax, Reg. No. 54,528
Lowenstein & Weatherwax LLP

Date: January 10, 2024

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served by electronic service, by agreement between the parties, on the date signed below:

PATENT OWNER'S REQUEST FOR REHEARING OF SEALED ORDER RE: EX PARTE COMMUNICATION

The names and address of the parties being served are as follows:

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