

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUMINEX INTERNATIONAL COMPANY LTD.,

Petitioner,

v.

SIGNIFY HOLDINGS B.V.,
Patent Owner.

Case IPR2024-00101
Patent 10,299,336

PATENT OWNER'S UNOPPOSED MOTION TO SEAL

PATENT OWNER'S LIST OF EXHIBITS UNDER SEAL

Exhibit Number	Exhibit Description
2046	Emails Between Menard and Luminex (August 17, 2021)
2047	Menard Letter (September 12, 2022)

I. Introduction

Pursuant to 37 C.F.R. §§ 42.14 and 42.54 and the Stipulated Protective Order agreed to between the parties (“Stipulated Protective Order”; Ex.2048), Patent Owner respectfully submits this Motion to Seal.

II. Protective Order

The Stipulated Protective Order agreed to by the parties, which is being submitted herewith, as Ex.2048, tracks the protective order used in the counterpart litigation, per Petitioner’s request. The Stipulated Protective Order sets forth an additional tier of confidential material— “Attorneys’ Eyes Only”—relative to the Default Protective Order found in the Consolidated Trial Practice Guide (November 2019). Changes to the Default Protective order are permitted by the Trial Practice Guide, as explained at Appendix B, Paragraph J.

III. Documents to be Sealed: Patent Owner Response and Exhibits 2046-47

Patent Owner moves to seal the Patent Owner Response (“POR”) and Exhibits 2046-47. Exhibits 2046 and 2047 are communications between Menard and Luminex produced in the counterpart litigation with the designation “Attorneys’ Eyes Only.”

The POR contains quotations and references to Exhibits 2046 and 2047, which the parties have agreed to treat as “Attorneys’ Eyes Only” materials pursuant to the Stipulated Protective Order. Patent Owner will file a public, redacted, non-confidential version of the POR after consultation with Petitioner.

IV. Good Cause Exists for Sealing the POR and Exhibits 2046 and 2047

“The Board may, for good cause, issue an order to protect a party or person from disclosing confidential information . . .” 37 C.F.R. § 42.54(a). In *Argentum Pharmaceuticals LLC v. Alcon Research, Ltd.*, IPR2017-01053, Paper 27 (Jan. 19, 2018), the Board set forth the standard for sealing confidential information:

[A] movant to seal must demonstrate adequately that (1) the information sought to be sealed is truly confidential, (2) a concrete harm would result upon public disclosure, (3) there exists a genuine need to rely in the trial on the specific information sought to be sealed, and (4) on balance, an interest in maintaining confidentiality outweighs the strong public interest in having an open record.

Id. at 3. While there is a presumption in favor of public disclosure, and the burden is on the movant to seal, application of the foregoing factors should be tempered by reasonableness, which is the touchstone of good cause. Overly harsh or stringent application of the “good cause” requirement would be contrary to Congress’ intent that IPRs be conducted in a “timely, fair, and efficient manner” as an alternative to expensive court litigation of patent validity. Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“Trial Practice Guide”), p. 2.

The *Argentum* factors confirm that the information Patent Owner seeks to protect from public disclosure based on Petitioner’s assertions of confidentiality

should indeed be sealed in this Proceeding.

Truly Confidential. The POR contains quotations and references to Exhibits 2046 and 2047, which has been designated by Petitioner and Menard as Stipulated Protective Order material. Thus, this information requires confidentiality. Specifically, Exhibits 2046 and 2047 are communications between Menard and Luminex, including communications with counsel, which Menard and Luminex have agreed to be submitted in this proceeding under the condition that Patent Owner, Signify, treat the same as “Attorneys’ Eyes Only” material under the Stipulated Protective Order.

Concrete Harm. By designating the documents Stipulated Protective Order material, Luminex and Menard have indicated that public disclosure would cause harm for the reason set forth in the previous paragraph.

Genuine Need to Rely Upon. Patent Owner relies on the documents, among other evidence, to assert that Menard is an RPI and/or privy of Petitioner Luminex, and therefore that the Petition is time-barred under 35 U.S.C. §315(b). The documents are not available from any non-confidential sources and are highly relevant to Patent Owner’s arguments. As a result, Patent Owner has a genuine need to rely on the documents.

Balancing. Through negotiations concerning the use of Exhibits 2046 and 2047, and the agreement to designate the same Stipulated Protective Order

material, Petitioner has articulated why it believes the need for confidentiality outweighs the public's interest in having a fully open record. In particular, the communications involved counsel for Luminex. Moreover, Petitioner allowed Patent Owner to produce the documents under the agreement that suitable steps would be taken to maintain the confidentiality of the documents.

Further, Patent Owner will submit a redacted version of the POR, which removes the confidential information while revealing to the public as much as possible, striking an appropriate balance of the public's qualified interest in having an open record, on the one hand, and the interest in maintaining a third party's confidential information on the other.

V. Conclusion

Patent Owner respectfully requests that the Board grant this Motion to Seal.

Dated: December 23, 2024

Respectfully submitted,

/Justin J. Oliver/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that this Patent Owner's Motion to Seal was served to Petitioner by serving the correspondence email addresses of record as follows:

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Dated: December 23, 2024

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