

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MAXELL, LTD.,

Patent Owner

Inter Partes Review No.: IPR2024-00717
U.S. Patent No. 11,223,757

JOINT MOTION TO EXPUNGE

Pursuant to 37 C.F.R. § 42.56, and in view of the Board’s Final Written Decision, Petitioners Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (“Petitioners”) and Patent Owner Maxell, Ltd. (“Patent Owner”) file this Joint Motion to Expunge requesting that certain confidential information in the record for this proceeding be expunged or permanently retained as confidential.

Petitioners and Patent Owner request that the full, confidential version of the following document currently under seal be expunged from the record or permanently kept confidential because it contains highly confidential business or technical information of Petitioners and Patent Owner (collectively, the “Confidential Document”):

Ex. 1018 – May 2, 2025, Order on the parties’ pretrial motions in Case No. 5:23-cv-92-RWS, *Maxell, Ltd., v. Samsung Electronics Co., Ltd., et al.*

For the reasons set forth below, the Petitioners and Patent Owner request that the Confidential Document be expunged.

I. APPLICABLE LEGAL STANDARDS

37 C.F.R. § 42.56 provides that “[a]fter a denial of a petition to institute a trial or after final judgment in a trial, a party may file a motion to expunge confidential information from the record.” Similarly, the Consolidated Trial Practice Guide states, in pertinent part, that “[t]here is an expectation that information will be made public where the existence of the information is referred

to in a decision to grant or deny a request to institute a review or is identified in a final written decision following 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.”

Consolidated Trial Practice Guide, p. 22. A party seeking expungement from the record must show good cause by demonstrating “that any information sought to be expunged constitutes confidential information, and that Petitioner’s interest in expunging it outweighs the public’s interest in maintaining a complete and understandable history of this *inter partes* review.” *Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.*, IPR2013-00453, Paper 97 at 2 (P.T.A.B. Apr. 15, 2015).

II. REASONS FOR RELIEF REQUESTED

A. Procedural Background

Exhibit 1018 was filed under seal because it contains Petitioners’ and Patent Owner’s confidential information. Pursuant to the Trial Practice Guide, sensitive information was redacted from this document where possible, and a redacted version of the exhibit is available on the public docket at Exhibit 1017. The present motion pertains only to the sealed copy of this document.

The sealed document, Exhibit 1018, relates to (1) confidential licensing information concerning licenses between third parties and Petitioners and Patent

Owner; (2) sales and revenue information related to products accused of infringement in the parallel litigation; (3) confidential information concerning operation of Samsung's QuickShare application; and (4) confidential information concerning operation of Samsung's SmartThings product. A redacted version of Exhibit 1018, issued by the district court in response to the parties' joint motion to redact filed in the district court, is available to the public at Exhibit 1017, and information regarding the contents of the redacted and sealed information is in the record.

On November 6, 2025, the Board issued its final written decision ("FWD"). Paper 34. The FWD itself does not contain any confidential information. *See* FWD-Public Version, Paper 34. None of the Board's analyses in its FWD are confidential. *Id.*

B. Good Cause Exists for Expunging the Confidential Documents

The Confidential Document contains Petitioners', Patent-Owner's, and third-party highly confidential business information. Exhibit 1018 is a May 2, 2025, order on the parties' pretrial motions. The portions of Exhibit 1018 which were redacted from the public version of that exhibit regarding item (1) above concern the confidential licensing information and third-party information relating to licensees involving Petitioners or Patent Owner. This information was produced under the highest level of confidentiality provided in the district court's protective

order. The Order was sealed by the parties as indicated in Exhibit 1018. Exhibit 1018, which is the confidential version of Exhibit 1017, is the District Court's order on pretrial motions. This confidential information belongs not only to Petitioners and Patent Owner, but also to third parties who are parties to agreements discussed in the Order. These agreements have not been publicly disclosed and, indeed, many of the agreements contain confidentiality provisions explicitly prohibiting public disclosure of the agreements or terms thereof. The parties have preserved the confidentiality of the agreements and its terms by, for example, marking the agreement as "RESTRICTED – ATTORNEYS' EYES ONLY" under the district court's protective order. The confidential information of the terms of the agreements have economic value and the parties to the agreement have legitimate, competitive and business interests in preventing public disclosure. *See Erfindergemeinschaft Uropep GbR v. Eli Lilly & Co.*, No. 2:15-cv-1202, Docket No. 192 at 5 (E.D. Tex. Feb. 1, 2017) (noting that confidential license information is a "categor[y] of information" that is "entitled to protection from disclosure."). Furthermore, the Parties' proposed redactions are limited as narrowly as possible to avoid disclosure of the parties to the agreements, the rights conveyed, and/or the consideration paid. In light of the foregoing, the district court granted a motion to seal this information.

The portions of Exhibit 1018 which were redacted from the public version of that exhibit regarding item (2) above concern financial information related to the sales and revenue of accused products. Samsung has preserved the confidentiality of this information by, for example, producing documents containing such information with a “RESTRICTED – ATTORNEYS’ EYES ONLY” designation under the district court’s protective order. The confidential information related to sales and revenue has economic value and Samsung has a legitimate, competitive and business interests in preventing public disclosure. Further, Samsung’s proposed redactions are limited as narrowly as possible to avoid disclosure of only specific numerical information.

The portions of Exhibit 1018 which were redacted from the public version of that exhibit regarding items (3) and (4) above concern proprietary technical information related to the functionality and operation of the accused products in the parallel litigation, none of which is accused of infringing the ’757 patent at issue in this IPR and none of which involves the subject matter of the ’757 patent at issue in this IPR. Samsung has preserved the confidentiality of this information by, for example, producing documents containing such information with a “RESTRICTED – ATTORNEYS’ EYES ONLY” designation under the district court’s protective order. Samsung has also marked any expert reports produced in this litigation that contain such information as “RESTRICTED – ATTORNEYS’

EYES ONLY.” The confidential information related to the functionality of the accused products has proprietary value and Samsung has a legitimate, competitive and business interests in preventing public disclosure. Further, Samsung’s proposed redactions are limited as narrowly as possible to avoid disclosure of non-publicly available technical information, only.

Given the information available in the record regarding the contents of the Confidential Document, including the public version of Exhibit 1018, and the lack of reliance by the Board on the information that is sought to be expunged, the record provides a “complete and understandable file history for public notices purposes,” so there is no public interest in now making the Confidential Document publicly available. Consolidated Trial Practice Guide at 21-22; *accord* MPEP § 724.05 (Patent Office may expunge information that is not material to patentability). Accordingly, good cause exists for protecting Petitioners’ and Patent-Owner’s confidential information by expunging the Confidential Document.

III. CONCLUSION

Because the Confidential Documents contain Petitioners’ and Patent-Owner’s highly confidential business information, a redacted version of the Confidential Document is available to the public and the Board did not rely on any information from that Confidential Document that is not in the public version of

those documents in this proceeding, Petitioners and Patent Owner respectfully
request that the Board expunge Exhibit 1018 pursuant to 37 C.F.R. § 42.56.

Dated: December 19, 2025

Respectfully submitted,

/Robert G. Pluta/

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CERTIFICATE OF SERVICE

The undersigned certifies that on December 19, 2025, a true and correct copy of the Petitioners' Motion to Expunge was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

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Date: December 19, 2025

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