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.: IPR2024-00777
U.S. Patent No. 11,017,815

PETITIONERS' UNOPPOSED 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") file this Motion to Expunge requesting that certain confidential information in the record for this proceeding be expunged or permanently retained as confidential.

Petitioners request that the full, confidential versions of the following documents currently under seal be expunged from the record or permanently kept confidential because they contain highly confidential business or technical information of Petitioners (collectively, the "Confidential Documents"):

Ex. 1076 – Excerpt from the May 19, 2025 Trial Transcript in Case No. 5:23-cv-92-RWS, *Maxell, Ltd., v. Samsung Electronics Co., Ltd., et al.* (confidential version only)

Ex. 1079 – September 18, 2025 Order on Motion for Judgment as a Matter of Law and Motion for a New Trial in Case No. 5:23-cv-92-RWS, *Maxell, Ltd., v. Samsung Electronics Co., Ltd., et al.*

Petitioners have conferred with Patent Owner and Patent Owner does not oppose this Motion.

For the reasons set forth below, Petitioners request that the Confidential Documents 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

Exhibits 1076 and 1079 were filed under seal because they contain Petitioners' confidential information. Pursuant to the Trial Practice Guide,

sensitive information was redacted from these documents where possible, and redacted versions of exhibits are available on the public docket. The present motion pertains only to the sealed copies of these documents.

The sealed documents, Exhibits 1076 and 1079, relate to trial testimony concerning Petitioner's source code and information about the configuration of certain third-party applications on Petitioners' smart phones, respectively. Redacted versions of Exhibits 1076 and 1079 are available to the public, and information regarding the contents of the redacted and sealed information is in the record.

On October 31 2025, the Board issued its final written decision ("FWD"). Paper 52. The FWD itself does not contain any confidential information. *See* FWD-Public Version, Paper 52. None of the Board's analyses in its FWD are confidential. *Id.*

B. Good Cause Exists for Expunging the Confidential Documents

The Confidential Documents contain Petitioners' and third-party highly confidential business information. Exhibit 1076 is a transcript of certain testimony from the parallel district court trial concerning the '815 patent at issue in this IPR. The portions of Exhibit 1076 which were redacted from the public version of that exhibit concern the operation of confidential source code for Samsung's Gallery application, which was produced to Maxell under the highest level of

confidentiality provided in the district court's protective order. The testimony concerning this source code in the transcript itself was sealed by the district court as indicated in Exhibit 1076. Exhibit 1079, which is the confidential version of Exhibit 1080, is the District Court's order on post-trial motions. The redacted portions of Exhibit 1079 contain confidential information from an agreement between Samsung and third-party Netflix. This confidential information belongs not only to Samsung, but also to Netflix who is a party to the agreement. The terms of the Netflix-Samsung agreement have not been publicly disclosed and, indeed, the agreement itself contains a confidentiality provision explicitly prohibiting public disclosure of the terms thereof. Samsung has preserved the confidentiality of this agreement 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 this agreement has 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."). In light of the foregoing, the district court granted a motion to seal this information.

Given the information available in the record regarding the contents of the Confidential Documents, including the public version of Exhibit 1076 and Exhibit 1080, 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 Documents 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' confidential information by expunging the Confidential Documents.

III. CONCLUSION

Because the Confidential Documents contain Petitioners' highly confidential business information, redacted versions of all of the Confidential Documents are available to the public and the Board did not rely on any information from that Confidential Documents that is not in the public version of those documents in this proceeding, Petitioners respectfully request that the Board expunge Exhibits 1076 and 1079 pursuant to 37 C.F.R. § 42.56.

Date: December 12, 2025

Respectfully submitted,

/s/ James M. Heintz

James Heintz
Reg. No. 41828
DLA Piper LLP
One Fountain Square
11911 Freedom Drive, Suite 300

Reston, VA 20190-5602
Phone: + 1 703 773 4000
Fax: + 1 703 773 5000
jim.heintz@us.dlapiper.com

Gianni Minutoli
Reg. No. 41198
DLA Piper LLP
One Fountain Square
11911 Freedom Drive, Suite 300
Reston, VA 20190-5602
Phone: + 1 703 773 4000
Fax: + 1 703 773 5000
Gianni.minutoli@us.dlapiper.com

Attorney for Petitioners

CERTIFICATE OF SERVICE

The undersigned certifies that on December 12, 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:

rpluta@mayerbrown.com

maxell-samsung-service@mayerbrown.com

Date: December 12, 2025

Respectfully submitted,

/s/ James M. Heintz

James Heintz
Reg. No. 41828
DLA Piper LLP
One Fountain Square
11911 Freedom Drive, Suite 300
Reston, VA 20190-5602
Phone: + 1 703 773 4000
Fax: + 1 703 773 5000
jim.heintz@us.dlapiper.com

Gianni Minutoli
Reg. No. 41198
DLA Piper LLP
One Fountain Square
11911 Freedom Drive, Suite 300
Reston, VA 20190-5602
Phone: + 1 703 773 4000
Fax: + 1 703 773 5000
Gianni.minutoli@us.dlapiper.com

Attorneys for Petitioners