

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CORNING GILBERT INC.,  
Petitioner,

v.

PPC BROADBAND, INC.,  
Patent Owner.

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Case IPR2013-00340  
Patent 8,323,060

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Before JAMESON LEE, JOSIAH C. COCKS, and MICHAEL R. ZECHER,  
*Administrative Patent Judges.*

ZECHER, *Administrative Patent Judge.*

ORDER  
Conduct of Proceeding  
*37 C.F.R. § 42.5*

### Introduction

A telephone conference was held on April 14, 2014, between respective counsel for the parties, and Judges Lee, Cocks, Zecher, and Bonilla, to discuss Patent Owner's Motion to Seal. The parties initiated the conference call to report on their progress in discussing what materials of Petitioner, submitted by Patent Owner, should be subject to a Motion to Seal, and what specific information in those materials should be redacted. The parties discussed this matter with the Board previously in two conference calls held on April 2 and 10, 2014. Papers 34, 38. The issue in dispute still centers around what information the parties believe should be redacted, as well as what Petitioner contends should be designated as confidential information.

### Discussion

Counsel for Petitioner stated, as indicated in a previous call, that Patent Owner agreed to remove six documents from the record, out of thirty documents initially at issue in Patent Owner's original Motion to Seal. In relation to the remaining twenty four documents (all but one being Petitioner's documents), Counsel for Petitioner indicated that the parties had reached a resolution on the issue of what portions of Petitioner's documents should be redacted.

Specifically, according to Counsel for Petitioner, the parties agreed that the entirety of each of Petitioner's documents subject to the Motion to Seal constituted confidential business information. Counsel for Petitioner indicated that both parties agreed that Patent Owner would file, for each

such document, two “non-public” versions, i.e., a redacted version and a non-redacted version, with Patent Owner’s revised Motion to Seal. Counsel for Petitioner indicated that the parties agreed that in each redacted document, the entirety of which would be confidential business information, the non-redacted portion would constitute information that Patent Owner “needs” to make its case, and the redacted portion would constitute information the Patent Owner does not need.

As part of the discussion, Counsel for Petitioner initially suggested that both parties expected redacted versions of Petitioner’s documents to become public. Counsel for Petitioner later stated, however, that Petitioner wanted both versions of its documents to remain under seal during the trial, and that Petitioner intended to file a motion to expunge at the end of the trial regarding all non-redacted versions, as well as all versions (redacted and non-redacted) of any document that the Board did not “rely upon” in a final written decision. Thus, Petitioner essentially requested keeping both versions of its documents confidential, i.e., entirely unavailable to the public, during the trial and afterward, in relation to any document of Petitioner listed in the Motion to Seal that the Board does not mention specifically in a final written decision.

Counsel for Patent Owner responded by indicating a concern for preserving the record for a possible appeal. Specifically, Counsel for Patent Owner stated that, assuming an appeal is needed, it may need to refer to documents at issue in the case, regardless of whether the Board mentions such documents in its final written decision. In response, Counsel for

Petitioner stated that it expected issues relating to a motion to expunge to be resolved before Patent Owner might file a notice of appeal regarding a final written decision.

As an initial matter, we note that confidential information subject to a protective order ordinarily will become public 45 days after the Board issues a final written decision in a trial. *See* Rules of Practice for Trials, 77 Fed. Reg. 48,612, 48,623 (Aug. 14, 2012). Under 37 C.F.R. § 42.56, after the Board issues a final decision, a party may file a motion to expunge confidential information from the record, something the party may wish to do, if at all, before the 45 days have passed. If the Board ultimately grants such a motion in relation to certain documents, those documents will no longer be of record in the case, or available on appeal.

In relation to an appeal to the Federal Circuit, as stated in 37 C.F.R. § 90.3(a), a party must file a notice of appeal with the USPTO Director no later than 63 days after the date of a final written decision. The parties and Board may not necessarily resolve all issues relating to a motion to expunge by that time, however. Moreover, Petitioner's concern about maintaining an adequate record on appeal, even in relation to evidence not expressly and directly cited in a final written decision, has merit.

Based on the foregoing, for each document that counsel for Patent Owner maintains that Patent Owner needs to rely on to present its case, which has been labeled by Petitioner as confidential information, Patent Owner will file a non-redacted version and a redacted version, redacting out the information not needed by Patent Owner. In addition, for the time being,

Patent Owner will designate both versions of the documents as non-public. In its Response to Patent Owner's Motion to Seal, Petitioner must demonstrate why all of the material in both the redacted and non-redacted versions of each of its own documents constitutes confidential business information. Both versions will remain under seal until the Board makes a decision regarding Patent Owner's revised Motion to Seal.

In relation to such a Board decision, however, absent a showing of good cause as to why all information in both redacted and non-redacted versions of documents constitute confidential business information, the Board is likely to designate one or both documents public during the trial itself. Moreover, the Board reminds the parties that information subject to a protective order will become public if identified in a final written decision in this proceeding. In addition, a motion to expunge information will not necessarily prevail over the public interest in maintaining a complete and understandable record, including evidence above and beyond that expressly and directly cited in a final written decision. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012).

Thus, we again encourage the parties to work together to determine which documents, or portions of documents, can be de-designated as confidential information, and therefore, not subject to a Motion to Seal. Such efforts will help ensure that both parties are satisfied with Board decisions on Patent Owner's revised Motion to Seal, as well as any motion to expunge filed by Petitioner at the conclusion of trial.

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Accordingly, it is hereby

ORDERED that Patent Owner will file a Revised Motion to Seal by April 17, 2014, at the same time it files non-public redacted and non-redacted versions of Petitioner's documents discussed in that Motion;

FURTHER ORDERED that Petitioner may file a Response to Patent Owner's Revised Motion to Seal by April 21, 2014; and

FURTHER ORDERED that the Petitioner is provided five additional pages for its Response, such that the Response is limited to twenty pages in length.

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