

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TETRA TECH CANADA INC.,
Petitioner,

v.

GEORGETOWN RAIL EQUIPMENT COMPANY,
Patent Owner.

IPR2019-00619
Patent 7,616,329 B2

Before HUBERT C. LORIN, BENJAMIN D. M. WOOD, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

ORDER
Granting-In-Part Motion to Expunge
37 C.F.R. § 42.56

With our authorization and pursuant to 37 C.F.R. § 42.56, Patent Owner filed a motion seeking to expunge the unredacted versions of Exhibits 1062, 1063, 2008, 2012, and 2013 and the unredacted versions of Patent Owner’s Response (Paper 16) and Sur-Reply (Paper 27) (collectively, the “Identified Documents”). Paper 44 (“Motion”). Patent Owner represents that Petitioner does not oppose the Motion. *Id.* at 1.

“[A]fter final judgment in a trial, a party may file a motion to expunge confidential information from the record.” *See* 37 C.F.R. § 42.56. On August 25, 2020, we entered a Final Written Decision in this proceeding, which Patent Owner appealed. Papers 42, 43. On January 22, 2021, the U.S. Court of Appeals for the Federal Circuit dismissed the appeal. *Georgetown Rail Equipment Company v. Tetra Tech Canada Inc.*, 2021–1108, 2021–1109, 2021–1110 (Fed. Cir. Jan. 22, 2021), Order (motion granted upon consideration of the joint motion to voluntarily dismiss)).

A strong public policy exists for making open to the public all information filed in this administrative proceeding. Only “confidential information” is protected from disclosure. 35 U.S.C. § 316(a)(7) (“The Director shall prescribe regulations . . . providing for protective orders governing the exchange and submission of confidential information.”). The Consolidated Office Patent Trial Practice Guide¹ states that, “[t]he rules aim to strike a balance between the public’s interest in maintaining a complete and understandable file history and the parties’ interest in protecting truly sensitive information.” Accordingly, a party seeking expungement of material from the record must show good cause by demonstrating that “any

¹ Patent Trial and Appeal Board Consolidated Patent Trial Practice Guide at 19 (Nov. 2019), <http://www.uspto.gov/TrialPracticeGuideConsolidated>.

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 (PTAB Apr. 15, 2015).

As discussed in our Order granting Patent Owner's and Petitioner's Motions to Seal, we determined that the Identified Documents contain confidential information and that good cause was shown such that we granted the Motions to Seal. Paper 42, 111–114; *see also* Papers 36 (Petitioner's Motion to Seal), 14 (Patent Owner's Motion to Seal); Motion 3–5.

Our Decision did not rely upon Exhibit 2013 or the confidential portions of Exhibits 1062, 1063, and 2012. Motion 8 (citing Paper 42, 91–96, 100–101); Paper 42 *passim* (relying upon Exhibits 1062, 44:3-45:7, 52:1-54:7, 56:15-60:10, 64:1–72:23, 73:17-74:16, 79:11-18, 81:7-21, 83:15-84:15, 119:12–120; 1063, 27:20-28:4, 30:15-34:1, 47:19-48:7, 55:19-61:21; and, 2012 ¶¶ 8, 16–18, 20, none of which includes confidential information).

Accordingly, we are persuaded by Patent Owner's unopposed contentions that expunging the unredacted versions of these documents would protect confidential information without harming the public's interest in maintaining a complete and understandable file history. Motion 5–9. We determine that the confidential information in Exhibits 1062, 1063, 2012 and 2013 is not necessary to present a complete and understandable file history.

The motion also seeks to expunge the unredacted version of Exhibit 2008. *Id.* at 1.

However, our Decision states: “Specifically, Patent Owner relies on the declaration of John Kainer, which concludes that ‘Aurora includes every claimed element.’ [Paper 17] at 59–60 [sic, 62] (citing Ex. 2008 ¶¶ 4–17, 24–32).” Paper 42, 91. Notwithstanding the quote can be surmised from statements made at paragraphs 24–32 of Ex. 2008, which are not confidential, the decision nevertheless includes Patent Owner’s citation to “¶¶ 4–17” of Ex. 1008. *See* Paper 17, 62. Paragraphs 7–15 are indicated as confidential. Ex. 2008.

Expunging the unredacted version of Ex. 2008 would deprive the record of paragraphs 7–15 that the PO Response and Decision rely on/cite to for the quote “Aurora includes every claimed element” (Paper 17, 62; Paper 42, 91).

Accordingly, although expunging Ex. 2008 would protect confidential information, it would harm the public’s interest in maintaining a complete and understandable file history. We determine that the confidential information in Exhibit 1008 is necessary to present a complete and understandable file history.

Regarding the unredacted versions of Patent Owner’s Response (Paper 16) and Sur-Reply (Paper 27), we are concerned that expunging these papers would deprive the record of the analysis and reasoning provided by Patent Owner in support of its Response and Sur-Reply arguments, and the analysis and reasoning provided by the Board in rendering its Final Decision (Paper 42). Accordingly, notwithstanding the provisions of our Trial Practice Guide, Papers 16 and 27 shall remain under seal, but they shall not be expunged from the record.

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Accordingly, it is:

ORDERED that Patent Owner's Motion (Paper 44) is *granted* as to the unredacted versions of Exhibits 1062, 1063, 2012, and 2013; the unredacted versions of Exhibits 1062, 1063, 2012, and 2013 shall be expunged from the record; and, Patent Owner's Motion (*id.*) is *denied* as to the unredacted versions of Exhibit 2008, Patent Owner's Response (Paper 16) and Sur-Reply (Paper 27).

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