

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GARMIN INTERNATIONAL, INC. ET AL.
Petitioner

v.

CUOZZO SPEED TECHNOLOGIES LLC
Patent Owner

Case IPR2012-00001 (JL)
Patent 6,778,074

Before JAMESON LEE, MICHAEL P. TIERNEY, and JOSIAH C. COCKS,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

DECISION
Revised Motion to Seal
37 C.F.R. §§ 42.14 and 42.54

INTRODUCTION

On March 11, 2013, Cuozzo filed a Motion to Seal requesting to seal the exhibits of the Declaration of Inventor Giuseppe A. Cuozzo, which includes Exhibits A-P within Exhibits 3000 and 4000.¹ (Paper 33.) The exhibits contain factual evidence to support Cuozzo's patentability contention that Inventor Giuseppe A. Cuozzo invented the claimed subject matter before the dates of certain prior art relied on by Garmin.

That initial motion was denied by the Board in a decision dated March 14, 2013. (Paper 34.) In that decision, the Board issued guidance on what should be contained in a proper motion to seal evidence, and provided Cuozzo an opportunity to file a Revised Motion to Seal in accordance with the guidance.

On March 21, 2013, Cuozzo filed a Revised Motion to Seal, limiting the exhibits requested to be sealed to Exhibits B, I, J, K, L, and P contained in Revised Exhibits 3000 and 4000 (labeled as "Protective Order Material"). Cuozzo moved Exhibits A, C-H, and M-O to Revised Exhibits 3001 and 4001 which are open to the public. The Board appreciates Cuozzo's effort to comply with the guidance.

Cuozzo also submitted a copy of the Board's default protective order as the proposed protective order (Exhibit 5000). (Revised Motion, 7: ¶ V.) Because the parties agree to the terms of the protective order, the Board hereby enters the

¹ Patent owner's exhibits should have been numbered in the range of 2001-2999. *See* 37 C.F.R. § 42.63(c). In the interest of efficiency in this case, the Board exercises its discretion to accept the improperly numbered exhibits. 37 C.F.R. §§ 42.1(b) and 42.5(b).

protective order. As a consequence, the default protective order governs the treatment and filing of confidential information of this proceeding.

DISCUSSION

There is a strong public policy for making all information filed in a quasi-judicial administrative proceeding open to the public, especially in an *inter partes* review which determines the patentability of claims in an issued patent and therefore affects the rights of the public. Under 35 U.S.C. § 316(a)(1), the default rule is that all papers filed in an *inter partes* review are open and available for access by the public; and a party may file a concurrent motion to seal and the information at issue is sealed pending the outcome of the motion.

Similarly, 37 C.F.R. § 42.14 provides:

The record of a proceeding, including documents and things, shall be made available to the public, except as otherwise ordered. A party intending a document or thing to be sealed shall file a motion to seal concurrent with the filing of the document or thing to be sealed. The document or thing shall be provisionally sealed on receipt of the motion and remain so pending the outcome of the decision on the motion.

It is, however, only “confidential information” that 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”). In that regard, note the *Office Trial Practice Guide*, 77 *Fed. Reg.* 48756, 48760 (Aug. 14, 2012), which provides:

The 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.

* * *

Confidential Information: The rules identify confidential information in a manner consistent with Federal Rule of Civil Procedure 26(c)(1)(G), which provides for protective orders for trade secret or other confidential research, development, or commercial information. § 42.54.

The standard for granting a motion to seal is “for good cause.” 37 C.F.R. § 42.54. Cuozzo as the moving party has the burden of proof in showing entitlement to the requested relief. 37 C.F.R. § 42.20(c). We need to know why the information sought to be sealed constitutes confidential information.

A motion to seal is required to include a proposed protective order and a certification that the moving party has in good faith conferred or attempted to confer with the opposing party in an effort to come to an agreement as to the scope of the proposed protective order for this *inter partes* review. 37 C.F.R. § 42.54.

Cuozzo represents that it has conferred with Garmin and that Garmin does not oppose Cuozzo's Revised Motion to Seal. (Revised Motion, 5: ¶ III.) We note that the due date for any opposition by Garmin has passed and Garmin has filed no opposition. Cuozzo also represents that in a related district court proceeding the same information was produced under a protective order and designated as confidential. (Revised Motion, 5: ¶ II.) Those representations are by themselves an insufficient showing of good cause but provide an illuminating context. Also

Case IPR 2012-00001
Patent 6,778,074

illuminating is the fact that the Declaration of Inventor Giuseppe A. Cuzzo was submitted by Cuzzo without any portion thereof being covered by a motion to seal and has been available to the public since its submission on March 11, 2013. (Exs. 3001 and 4001.)

Revised Exhibits 3000 and 4000 (labeled as “Protective Order Material”), under seal provisionally, contain the following:

Exhibit B is the New Jersey driving record of Giuseppe A. Cuzzo, the named inventor of Cuzzo’s involved patent in this *inter partes* review;

Exhibit I is a communication from Invention Submission Corporation to an attorney who performed an initial patentability search based on Giuseppe A. Cuzzo’s invention disclosure, forwarding the remarks of Inventor Giuseppe A. Cuzzo with regard to the patents listed on the initial search report;

Exhibit J is a formal Patentability Search Report provided by an attorney to Inventor Giuseppe A. Cuzzo;

Exhibit K is an agreement executed between Inventor Giuseppe A. Cuzzo and Invention Submission Corporation;

Exhibit L includes a copy of a cashier’s check payable to Invention Submission Corporation and copies of Invention Submission Corporation’s receipts of check and case payments from Inventor Giuseppe A. Cuzzo; and

Exhibit P is a copy of a personal check made payable to the United States Patent and Trademark Office for the filing fee of Cuzzo’s involved Patent 6,778,074.

Upon consideration of Cuozzo's Revised Motion to Seal, we determine that there is good cause for granting the Revised Motion to Seal with respect to Exhibits B, K, L, and P, but not Exhibits I and J.

Personal Confidential Information That Has No Relevance

Exhibit B, Inventor Giuseppe A. Cuozzo's driving record in the state of New Jersey as of August 30, 2012, is confidential personal information and does not have much, if anything, to do with the merits of this case. The entirety of the record was submitted by Cuozzo to support the assertion in the Declaration of Inventor Giuseppe Cuozzo (Exs. 3001 and 4001, 3: ¶ 8) that he was ticketed for speeding on November 29, 1999. As for the specific speeding ticket on November 29, 1999, that is disclosed already in ¶ 8 of the Declaration of Inventor Giuseppe A. Cuozzo. The public's interest in having access to Exhibit B is minimal, if any.

Exhibit L includes a copy of a cashier's check remitted by Inventor Giuseppe A. Cuozzo to Invention Submission Corporation and copies of Invention Submission Corporation's receipts of check and cash payments from the inventor. With regard to this exhibit, Cuozzo's revised motion states:

This exhibit constitutes confidential personal financial information that potentially would cause the inventor embarrassment if published. The manner and amount of his payments to ISC [Invention Submission Corporation] under their agreement reveals information about his personal financial status.

(Revised Motion, 4: ¶ D.)

The payment amounts as well as the manner of payment, *e.g.*, check or cash, are already described in the Declaration of Inventor Giuseppe Cuozzo. (Exs. 3001

Case IPR 2012-00001
Patent 6,778,074

and 4001: 7: ¶ 19.) Paragraph 19 of the Declaration of Inventor Giuseppe Cuozzo (Ex. 3001 and Ex. 4001) reveals even more information on the manner of payment, including the source account of some of the money used to make a payment. The public's interest in having access to Exhibit L is little to none.

Exhibit P is a copy of a personal check in the amount of \$370 made payable to the United States Patent and Trademark Office. With regard to this exhibit, Cuozzo's revised motion states:

The exhibit constitutes confidential personal financial information of the inventor's family member including checking account and bank information. Publication of this information may cause embarrassment, oppression, and possibly would expose the inventor's family to criminal attempts to access their personal financial accounts.

(Revised Motion, 5: ¶ E.)

We agree with Cuozzo that bank and account number information is confidential and if revealed, potentially may cause harm effected via criminal means. We also see no relevance of the bank name and account number information to the merits of this case. As for the amount of the payment, name of family member writing the check, and identification of the payee, that information is already revealed in ¶ 23 of the Declaration of Inventor Giuseppe A. Cuozzo (Exs. 3001 and 4001). The public's interest in having access to the information in Exhibit P is none.

As discussed previously, there is a strong public policy for making all information filed in an *inter partes* review open to the public. Factual evidence

submitted in a trial to support a party's case for patentability must be made available to the public, unless there is good cause for protecting the evidence. 35 U.S.C. § 316(a); 37 C.F.R. § 42.14. A moving party has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20.

Here, when determining whether Cuozzo has established good cause for sealing the evidence, we balance Cuozzo's needs in protecting the above-identified personal confidential information and the public's interest in maintaining a complete and understandable file history of this *inter partes* review of the '074 patent. Based on our review as discussed above, we determine that there is good cause for protecting Exhibits B, K, L, and P by placing them under seal because the information is personal confidential and has little relevance to the merits of any substantive issue. We see little harm to the public's interest in restricting access to the information.²

Unimportant Business Confidential Information

Exhibit K is an agreement or business contract between Inventor Giuseppe A. Cuozzo and Invention Submission Corporation with regard to commercializing

² To minimize cost, delay, and burden on the parties and Board, parties should not submit confidential personal information which clearly has little relevance to the merits of the case, such as account number on a check, social security number, and full driving record. Non-useful personal confidential information in a document should be redacted when the document is submitted and the submission should be accompanied by a paper noting the reasons for the redaction. Similarly, moving to seal information when that information is contained in a public document filed by the moving party also leads to inefficient use of resources and should be avoided.

and patenting the inventor's disclosed invention and the associated fees. The details of this agreement are unimportant to the merits of this case. Cuozzo characterizes this exhibit as confidential business information. We agree. The public's interest in having access to Exhibit K is minimal. Upon consideration of the foregoing, we determine there is good cause to grant the motion to seal with respect to Exhibit K.

Waived Attorney-Client Privilege Information

Exhibits I and J are communications between Inventor Giuseppe A. Cuozzo and his attorney. Cuozzo correctly notes that ordinarily, with respect to these exhibits, attorney-client privilege applies. However, these exhibits were submitted on Cuozzo's own initiative to support Cuozzo's contention that its claims are patentable over the cited prior art. In particular, they were submitted by Cuozzo to show pre-filing conception and diligence toward constructive reduction to practice.

Cuozzo understands that as to these two exhibits, it has waived the attorney-client privilege with respect to the issues of pre-filing conception and diligence toward constructive reduction to practice. Nevertheless, Cuozzo contends that others may argue, however incorrectly, that the waiver is broad and therefore attorney-client communication in this proceeding and in related civil action on other issues should become discoverable. According to Cuozzo, making these two exhibits available to the public could impose a heavy burden on Cuozzo to defend against the broad-waiver argument which, although without merit, likely would be raised by other parties.

We are unpersuaded by Cuozzo's arguments. In support of a substantive argument, Cuozzo on its own volition filed Exhibits I and J, thus waiving attorney-client privilege and the confidentiality associated with such privilege. The public has an interest in knowing what information Cuozzo believes is important in determining a substantive issue in the case. There is a strong public policy for making all information filed in an *inter partes* review in support of a substantive argument open to the public so that a complete and understandable file history is maintained. Only "confidential information" is protectable from public disclosure upon a showing of good cause. *See* 35 U.S.C. §§ 316(a)(1) and (a)(7).

The contention that others will make a general waiver argument against Cuozzo if the Board does not seal Exhibits I and J is speculative. The Board should not undermine the public's interest in having open access to pertinent information, simply for the purpose of making Cuozzo's litigation strategy of choice less costly to Cuozzo.

Cuozzo broadly represents that the same information is subject to a protective order and designated confidential in a related district court litigation. However, it is not known whether in that unidentified litigation, the information of Exhibits I and J were submitted by Cuozzo for the same purpose as that for which those exhibits have been submitted in this case, *i.e.*, to prove pre-filing conception and reasonable diligence toward constructive reduction to practice.

Balancing Cuozzo's alleged burden with the strong public interest in having open access to factual evidence submitted by a party in support of a substantive contention, we determine that the public interest outweighs Cuozzo's alleged

burden. Therefore, Cuozzo failed to establish that there is good cause to seal Exhibits I and J.

CONCLUSION

For the foregoing reasons, Cuozzo's Revised Motion to Seal is *granted-in-part*. It is

ORDERED that with respect to Exhibits B, K, L, and P, the motion is *granted*; these exhibits will be kept under seal; the protective order (Exhibit 5000) is entered and governs the treatment and filing of the confidential information of this proceeding;

FURTHER ORDERED that with respect to Exhibits I and J, the motion is *denied*; and

FURTHER ORDERED that within one week of the date of this decision Cuozzo shall either (1) request rehearing of this decision, or (2) move Exhibits I and J in Revised Exhibits 3000 and 4000 (currently designated as private) to within the publically available Exhibits 3001 and 4001, the same way it had previously moved Exhibits A, C-H, M, and O from private to public, after which time all but the latest version of Exhibits 3000 and 4000 and Exhibits 3001 and 4001 will be expunged from the record.

Case IPR 2012-00001
Patent 6,778,074

For PETITIONER

Jennifer C. Bailey
Scott Brown
HOVEY WILLIAMS LLP
jbailey@hoveywilliams.com
jcrawford@hoveywilliams.com

For PATENT OWNER

John R. Kasha
Kelley Kasha
Kasha Law LLC
john.kasha@kashalaw.com
kelly.kasha@kashalaw.com