

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORNING OPTICAL COMMUNICATIONS LLC,
Petitioner,

v.

DALI WIRELESS, INC.,
Patent Owner.

IPR2021-00762
Patent 9,826,508 B2

Before MELISSA A. HAAPALA, *Vice Chief Administrative Patent Judge*,
and KARL D. EASTHOM and SHARON FENICK, *Administrative Patent
Judges*.

FENICK, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining No Challenged Claims Unpatentable
Granting Petitioner's Motion to Seal
Granting Petitioner's Motion for Entry of Protective Order
35 U.S.C. § 318(a)

I. INTRODUCTION

A. *Background and Summary*

Petitioner Corning Optical Communications LLC filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–12 (the “challenged claims”) of U.S. Patent No. 9,826,508 B2 (“the ’508 patent”). Petitioner filed a Declaration of James A. Proctor (Ex. 1003) and a Declaration of Steven Stravitz (Ex. 1010) with its Petition. Patent Owner Dali Wireless Inc. filed a Preliminary Response. Paper 6. (“Prelim. Resp.”).

After the Institution Decision (Paper 8, “Dec. on Inst.”), Patent Owner filed a Patent Owner Response (Paper 16, “PO Resp.”); Petitioner filed a Reply (Paper 26 (Parties and Board version), Paper 27 (Public version), “Pet. Reply”) and a Supplemental Declaration of James A. Proctor (Ex. 1022); and Patent Owner filed a Sur-reply (Paper 28, “PO Sur-reply”). Thereafter, the parties presented oral arguments via a video hearing on July 13, 2022 and the Board entered a transcript into the record. Paper 36 (“Tr.”).

For the reasons set forth in this Final Written Decision pursuant to 35 U.S.C. § 318(a), we determine that Petitioner has not demonstrated by a preponderance of evidence that the challenged claims are unpatentable.

B. *Real Parties in Interest*

Petitioner identifies itself, Corning Inc., and Corning Research & Development Corp. as real parties in interest. Pet. 6. Patent Owner identifies only itself as a real party in interest. Paper 4 (Patent Owner’s Mandatory Notices), 1.

C. Related Matters

The parties identify *Dali Wireless, Inc. v. Corning, Inc. et al.*, No. 6:20-cv-01108-ADA (W.D. Tex.) (“the related litigation”) as a related matter. Pet. 7; Paper 4, 1.

D. The '508 Patent (Ex. 1001)

The '508 patent is titled “Neutral Host Architecture for a Distributed Antenna System,” and generally relates to a remote radio head unit (RRU) for use in a distributed antenna system (DAS). Ex. 1001, codes (54), (57). The RRU is a “small single unit that can be deployed in a location remote from the remaining distributed wireless network base station unit or units.” *Id.* at 1:21–23. In one embodiment, an RRU includes an RRU access module and RRU band modules; the RRU access module routes high speed data, for example, from a base transceiver station, to the appropriate RRU band module for transmission over a specific radio frequency band. *Id.* at 5:3–11, 5:42–56, Figs. 4, 5. The outputs of the RRU band modules in one RRU are combined and sent to an antenna for transmission. *Id.* at 5:15–17. The '508 patent describes the RRU as “field reconfigurable.” *Id.* at 2:48.

E. Illustrative Claims

Claim 1, reproduced below, is the sole independent claim of the '508 patent.

1. A remotely reconfigurable remote radio head unit for transporting radio frequency signals, the remotely reconfigurable remote radio head unit comprising:
 - at least one remotely reconfigurable access module adapted to receive reconfiguration parameters from a remote location,
 - a plurality of band modules, each of the plurality of band modules having separately reconfigurable parameters in response to the reconfiguration parameters received from

the at least one remotely reconfigurable access module, each of the plurality of band modules supporting one of a plurality of frequency bands of the radio frequency signals being transported, and

an interface adapted to provide:

electrical and mechanical connection for mounting of the plurality of band modules; and

bidirectional digital communication between the at least one remotely reconfigurable access module and each of the plurality of band modules.

Ex. 1001, 6:59–7:11.

F. Evidence

Petitioner relies on the following references (Pet. 9–10):

ADC FLEXWAVE™ PRISM HOST, REMOTE AND EMS 5.1, SYSTEM REFERENCE, ADCP-77-073, Iss. 2 (Ex. 1005) (“FlexWave Prism Manual”).

Wala et al., US 8,737,454 B2, iss. May 27, 2014 (Ex. 1006) (“Wala”).

Batruni, US 2009/0029664 A1, pub. Jan. 29, 2009 (Ex. 1007) (“Batruni”).

Rhy et al., US 2010/0008669 A1, pub. Jan. 14, 2010 (Ex. 1008) (“Rhy”).

G. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–12 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1–5, 8, 10–12	103	FlexWave Prism Manual, Wala

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103 for applications filed on or after March 16, 2013. Petitioner argues that August 17, 2010 is the earliest possible effective date of the ’508 patent, and its expert uses this date in his analysis. Pet. 9, 18; Ex. 1003 ¶¶ 30, 32, 33; *see* Ex. 1001, code (60). Patent Owner does not contest the use of this date, and in the related

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
6, 7	103	FlexWave Prism Manual, Wala, Batruni
9	103	FlexWave Prism Manual, Wala, Rhy

II. ANALYSIS

A. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring [*inter partes*] review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden never shifts to Patent Owner. See *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Furthermore, Petitioner must explain with particularity how the prior art would have rendered the challenged claims unpatentable. 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.104 (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”). Under 35 U.S.C. § 103(a), a claimed invention is unpatentable if the differences between the claimed subject

litigation, Patent Owner similarly argued that the priority date for the ’508 patent is August 17, 2010. Ex. 2009, 2. We apply the pre-AIA version of 35 U.S.C. § 103. Our analysis and determination remain the same under either the pre- or post-AIA versions of 35 U.S.C. § 103.

matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

A claim is unpatentable under 35 U.S.C. § 103 if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR*, 550 U.S. at 406. The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations.² *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Relying on the testimony of Mr. Proctor, Petitioner contends that a [person of ordinary skill in the art] at the time of the claimed invention would have had: (1) a bachelor's degree in electrical engineering; and (2) a minimum of 3–4 years of industry experience in wireless communications networks and engineering. However, an individual with an advanced degree in electrical engineering would require less industry experience (e.g., 1–2 years).

Pet. 18 (citing Ex. 1003 ¶ 32).

² With the exception of a mention of “substantial recognition” received by Patent Owner, not tied to any particular product or feature (PO Resp. 8), the record does not include allegations or evidence of objective indicia of nonobviousness.

We adopted this as the level of ordinary skill in the art in our Institution Decision, for the purposes of that decision. Dec. on Inst. 14–15.

Patent Owner does not comment on or dispute Petitioner’s proposed level of skill.

Petitioner argues that Mr. Stravitz is a person of ordinary skill in the art, in light of his years of experience of approximately 30 years (*see* Ex. 1010 ¶¶ 5, 10–11, Exh. A.), as this experience includes the stated minimum of 3–4 years of industry experience. Pet. Reply 11.

Our determination regards obviousness to an ordinarily skilled person rather than “to the judge, or to a layman, or to those skilled in remote arts, or to geniuses in the art at hand.” *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 697 (Fed. Cir. 1983)). We therefore remove the open-ended term “a minimum of” from Petitioner’s proposal, and adopt for this decision the following definition: “a person of ordinary skill in the art at the time of the claimed invention would have had: (1) a bachelor’s degree in electrical engineering; and (2) 3–4 years of industry experience in wireless communications networks and engineering. However, an individual with an advanced degree in electrical engineering would require less industry experience (e.g., 1–2 years).”

This level of skill comports with the teachings of the ’508 patent and the asserted prior art.

C. Claim Construction

In an *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b), including construing the claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art and the prosecution history

pertaining to the patent. 37 C.F.R. § 42.100(b). We apply the claim construction standard as set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Claim terms are generally given their ordinary and customary meaning as would be understood by one with ordinary skill in the art in the context of the specification, the prosecution history, other claims, and even extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic evidence is less significant than the intrinsic record. *Phillips*, 415 F.3d at 1312–17. Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315.

Only those terms that are in controversy need be construed, and only to the extent necessary to resolve the controversy. *Nidec Motor Corp.*, 868 F.3d at 1017 (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

No claim terms require construction to resolve the controversy before us. *See Nidec*, 868 F.3d at 1017.

D. Status of FlexWave Prism Manual as a Printed Publication

Petitioner asserts that claims 1–12 are unpatentable under various combinations of art, each including FlexWave Prism Manual.

Petitioner argues that FlexWave Prism Manual “is prior art under at least §102(a) as it was published by at least December 3, 2009 on the FCCs website, over 8 months before the earliest effective filing date of the ’508 patent in the United States.” Pet. 9. In the Petition, Petitioner cites the date (“11/2009”) on the cover and Mr. Stravitz’s declaration. *Id.* at 9–10 (citing Ex. 1005, cover (Bates number 001), 2 (Bates number 016); Ex. 1010 ¶¶ 38–64). Mr. Proctor’s supplementary declaration is also cited in the Reply as

supporting the public accessibility of FlexWave Prism Manual. Reply 15–17 (citing Ex. 1022 ¶¶ 24–29).

1. *Legal Standards*

Only “prior art consisting of patents or printed publications” may form “the basis of” an *inter partes* review. 35 U.S.C. § 311(b). The determination of whether a document is a “printed publication” under 35 U.S.C. § 102 “involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.” *Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018) (citing *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004)). Public accessibility is the “touchstone in determining whether a reference constitutes a printed publication,” and a reference is considered publicly accessible only if it was “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (quoting *SRI Int’l, Inc. v. Internet Sec. Sys. Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008)); *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)).

Because a case-by-case inquiry must be made, we summarize the facts and conclusions of certain cases decided by the Federal Circuit, including two cases the parties specifically argue are especially apposite.

Lister involved databases that permitted searches of titles of documents by keyword. *In re Lister* 583 F.3d 1307, 1315 (Fed. Cir. 2009). The Federal Circuit affirmed the Board’s finding that a manuscript relating to expediting a golf game and making it easier for causal players was publicly accessible as it could be found by executing a keyword search for “golf” in combination with the word “handicap.” *Id.* Our reviewing court

was not persuaded by an argument that the search would have found “hundreds or thousands of irrelevant results” and did not include certain relevant documents, but rather found that a reasonably diligent researcher would have found the publication at issue, possibly by attempting several searches using a variety of keyword combinations. *Id.* at 1315–16.

Voter Verified involved a patent with claims directed to automated voting systems featuring self-verification by which machine and human error might be detected. *Voter Verified, Inc. v. Premier Election Sols., Inc.*, 698 F.3d 1374, 1377 (Fed. Cir. 2012). The art at issue was a web-based reference “from an online periodical concerned with computer safety and security.” *Id.* at 1379. “[T]he record [wa]s devoid of evidence” of indexing of the online periodical prior to the critical date, but *Voter Verified* held that “indexing is not ‘a necessary condition for a reference to be publicly accessible,’; it is but one among many factors that may bear on public accessibility.” *Id.* at 1380–81 (quoting *Lister*, 583 F.3d at 1312). The Federal Circuit cited unrebutted testimony in the record that the periodical was “well known to the community interested in the risks of computer automation, including those concerned with electronic voting technologies” and noted that the periodical website included a search tool. *Id.* at 1380–81. Thus, while there was no evidence that the website itself was indexed (and thus locatable) through external search engines, the Federal Circuit found that the article was publicly available, based on the evidence that a person of ordinary skill would have been aware of the website, and upon accessing it would have found the article using the website’s search tools. *Id.* at 1381.

In *Blue Calypso*, a publication was argued to be available via a hyperlink on a personal webpage of a graduate student. *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016). The Federal Circuit

found that the reference was not shown to be publicly available as there was no evidence that a person interested in the relevant subject would be independently aware of the web address for the personal page and no evidence that the webpage was indexed for search or locatable by a search page. *Id.* at 1349–50.

In *Acceleration Bay*, a publication had been uploaded to a website, but the Federal Circuit found that the publication was not publicly available as the website was not meaningfully indexed. *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 772–75 (Fed. Cir. 2018). Available reports on the website were indexed only by author and year and could only be found by “skimming through potentially hundreds of titles in the same year, with most containing unrelated subject matter, or by viewing all titles in the database listed by author, when the authors were not particularly well known. *Id.* at 773–74. *Acceleration Bay* held the Board’s finding that the article was not “*meaningfully indexed*,” was “supported by substantial evidence.” *Id.* at 774.

The Federal Circuit again addressed the availability of references on a website and the indexing on that website in *M & K Holdings, Inc. v. Samsung Electronics Co., Ltd.*, 985 F.3d 1376 (Fed. Cir. 2021). Two references were presented in meetings of a standards task force and were available on the task force’s web site on the page of the relevant meeting, where such meeting pages had repositories of relevant documents, and offered title-search functionality. *Id.* at 1380. These references had descriptive titles. *Id.* Although full content searching was not available, the Federal Circuit held that the title-search functionality, in light of the descriptive titles of the references, meant that the references were meaningfully indexed. *Id.* at 1381–82.

2. *Mr. Stravitz's Declaration Regarding Public Availability*

Petitioner's declarant Mr. Stravitz testifies that FlexWave Prism Manual "can be located by performing advanced searches" on the FCC's Equipment Authorization Electronic System (EAS) "using the Equipment Authorization System Search functionality." Ex. 1010 ¶¶ 38–39. Mr. Stravitz testifies that a transmitting radio frequency (RF) device is required to be authorized prior to being marketed or imported and that the FCC administers a program to authorize such devices. *Id.* ¶¶ 14–15. According to Mr. Stravitz, submitting information for certification is part of the process and once a decision is made to certify the product, supporting information is uploaded to the FCC's EAS database. *Id.* ¶¶ 19–20.

Mr. Stravitz testifies that, in performing a search on the EAS database, "[a]t the outset, I wanted to use a search strategy that would not return too many results while still providing useful information about the real world products being submitted to the FCC for approval." *Id.* ¶ 41. Thus, Mr. Stravitz testifies that his initial search was limited to documents where the "Applicant Name" field matched "ADC Telecommunications" and the "Application Purpose" field was "Original Grant." *Id.* ¶¶ 40–41. This search resulted in 323 entries; reproduced immediately below is "[a] portion of [the] first page of the search results in HTML (10 Records at a Time) format" included in Mr. Stravitz's declaration, which is a table of search results, indicating the search criteria used as a header, and presenting each search result in a separate row. *Id.* ¶ 44.

323 results were found that match the search criteria:
 Application Purpose: **Original Grant** Applicant Name: **ADC Telecommunications**

Displaying records 1 through 10 of 323.

View	Form	Display Exhibits	Display Grant	Display Correspondence	Applicant Name	Address	City	State	Country	Zip Code	FCC ID	Application Purpose	Final Action Date	Lower Frequency In MHz	Upper Frequency In MHz
	Detail				ADC Telecommunications Inc	501 Shenandoah Drive	Shakopee	MN	United States	55379	F81-PACESTR	Original Equipment	06/13/1996		
	Summary				ADC Telecommunications Inc	501 Shenandoah Drive	Shakopee	MN	United States	55379	F811900CL	Original Equipment	01/16/1998	1850.0	1910.0
	Detail				ADC Telecommunications Inc	501 Shenandoah Drive	Shakopee	MN	United States	55379	F811900CL	Original Equipment	01/16/1998	1930.0	1990.0
	Summary				ADC Telecommunications Inc	501 Shenandoah Drive	Shakopee	MN	United States	55379	F8161401002	Original Equipment	05/25/1994	869.0	892.0
	Detail				ADC Telecommunications Inc	501 Shenandoah Drive	Shakopee	MN	United States	55379	F8161403002	Original Equipment	10/04/1993	880.0	894.0
	Summary				ADC Telecommunications Inc	501 Shenandoah Drive	Shakopee	MN	United States	55379	F8161405001	Original Equipment	08/08/1994	869.0	892.0
	Detail				ADC Telecommunications Inc	501 Shenandoah Drive	Shakopee	MN	United States	55379	F8161410000	Original Equipment	11/29/1995	869.0	891.5
	Summary				ADC Telecommunications Inc	501 Shenandoah Drive	Shakopee	MN	United States	55379	F8161411000	Original Equipment	11/29/1995	880.0	894.0
	Detail				ADC Telecommunications Inc	501 Shenandoah Drive	Shakopee	MN	United States	55379	F8161451000	Original Equipment	07/20/1995	824.0	846.5
	Summary				ADC Telecommunications Inc	501 Shenandoah Drive	Shakopee	MN	United States	55379	F8161451000	Original Equipment	07/20/1995	869.0	891.5

Show Next 10 Rows

[Perform Search Again](#)

Each entry of the 10 rows shown differs only in the fields labelled “FCC ID,” “Final Action Date,” “Lower Frequency in MHz” and “Upper Frequency in MHz.” *Id.* Mr. Stravitz also provides, as Attachment 5 to his declaration, a printout of the entire results of the search, in which the entries differ in the same way, with some additional variations in the address fields given for the applicant. *Id.* ¶ 45, Attachment 5.

Mr. Stravitz testifies that he then performed a second search in the EAS database using the same terms, and further limiting the search to dates between August 17, 2008 and August 17, 2010, the latter being the earliest effective filing date. *Id.* ¶ 48; *see supra* at note 1. This produced 53 records. *Id.* ¶ 49. Mr. Stravitz testifies that “[t]o further limit the number of search results, I next added frequency ranges . . . used or being considered for use by the carriers for 3G and/or 4G transmissions in the relevant time frame.” *Id.* ¶ 51. Four ranges were used, a first resulted in one result, a second in eight results, and each of the third and fourth in fourteen results. *Id.* ¶ 52.

For each record, Mr. Stravitz indicates that by selecting the “Summary” link, a list of documents provided to the FCC for the product is provided. *Id.* ¶ 54. Mr. Stravitz provides one such list for a product, the OET Exhibits Summary List, reproduced below, which is a table including a

listing of exhibits associated with the FCC ID number, each in a separate row. *Id.*

OET Exhibits Summary List

29 Matches found for FCC ID FBI-PRSM070C

Exhibit Type	File Type	File Size	Description	Submission Date	Permanent Confidential	Short-Term Confidential	Date Available
Block Diagram	Adobe Acrobat PDF	35281	Block Diagram	06/03/2010	Yes	No	
Cover Letter(s)	Adobe Acrobat PDF	17818	Confidentiality request	06/03/2010	No	No	06/03/2010
External Photos	Adobe Acrobat PDF	278724	External photos	06/03/2010	No	No	06/03/2010
ID Label/Location Info	Adobe Acrobat PDF	21674	ID Label	06/03/2010	No	No	06/03/2010
ID Label/Location Info	Adobe Acrobat PDF	88023	ID Label location	06/03/2010	No	No	06/03/2010
Internal Photos	Adobe Acrobat PDF	255577	Internal photo 5	06/03/2010	No	No	06/03/2010
Internal Photos	Adobe Acrobat PDF	275839	Internal photo 7	06/03/2010	No	No	06/03/2010
Internal Photos	Adobe Acrobat PDF	537650	Internal photo 2	06/03/2010	No	No	06/03/2010
Internal Photos	Adobe Acrobat PDF	668870	Internal photo 1	06/03/2010	No	No	06/03/2010
Internal Photos	Adobe Acrobat PDF	789683	Internal photo 4	06/03/2010	No	No	06/03/2010
Internal Photos	Adobe Acrobat PDF	790038	Internal photo 3	06/03/2010	No	No	06/03/2010
Internal Photos	Adobe Acrobat PDF	1300529	Internal photo 6	06/03/2010	No	No	06/03/2010
Operational Description	Adobe Acrobat PDF	15375	Technical Description	06/03/2010	Yes	No	
Operational Description	Adobe Acrobat PDF	102824	Technical Description 2	06/03/2010	Yes	No	
Parts List/Tune Up Info	Adobe Acrobat PDF	14264	BOM 3	06/03/2010	Yes	No	
Parts List/Tune Up Info	Adobe Acrobat PDF	14359	BOM 2	06/03/2010	Yes	No	
Parts List/Tune Up Info	Adobe Acrobat PDF	19220	BOM 1	06/03/2010	Yes	No	
Parts List/Tune Up Info	Adobe Acrobat PDF	21999	BOM 8	06/03/2010	Yes	No	
Parts List/Tune Up Info	Adobe Acrobat PDF	25332	BOM 4	06/03/2010	Yes	No	
Parts List/Tune Up Info	Adobe Acrobat PDF	26411	BOM 6	06/03/2010	Yes	No	
Parts List/Tune Up Info	Adobe Acrobat PDF	26836	BOM 5	06/03/2010	Yes	No	
Parts List/Tune Up Info	Adobe Acrobat PDF	41726	BOM 7	06/03/2010	Yes	No	
Parts List/Tune Up Info	Adobe Acrobat PDF	17033	Tune up	06/03/2010	No	No	06/03/2010
Schematics	Adobe Acrobat PDF	4774908	Schematics	06/03/2010	Yes	No	
Test Report	Adobe Acrobat PDF	679646	Test report	06/03/2010	No	No	06/03/2010
Test Report	Adobe Acrobat PDF	97634	Test report suppl	06/03/2010	No	No	06/03/2010
Users Manual	Adobe Acrobat PDF	4942183	User manual	06/03/2010	No	No	06/03/2010
Users Manual	Adobe Acrobat PDF	3306409	User manual 3	06/03/2010	No	No	06/03/2010
Users Manual	Adobe Acrobat PDF	4508961	User manual 2	06/03/2010	No	No	06/03/2010

Certain exhibits are not made available to the public; the ones that are available are listed upon selection of the “Detail” link for each record. *Id.*

¶ 56. The list of available documents for the same product is provided by Mr. Stravitz and reproduced below, again as a table including a listing of exhibits associated with the FCC ID number, each in a separate row. *Id.*

¶ 52.

OET Exhibits List

17 Matches found for FCC ID **F8I-PRSM070C**

View Attachment	Exhibit Type	Date Submitted to FCC	Display Type	Date Available
Confidentiality request	Cover Letter(s)	06/03/2010	pdf	06/03/2010
External photos	External Photos	06/03/2010	pdf	06/03/2010
ID Label	ID Label/Location Info	06/03/2010	pdf	06/03/2010
ID Label location	ID Label/Location Info	06/03/2010	pdf	06/03/2010
Internal photo 1	Internal Photos	06/03/2010	pdf	06/03/2010
Internal photo 2	Internal Photos	06/03/2010	pdf	06/03/2010
Internal photo 3	Internal Photos	06/03/2010	pdf	06/03/2010
Internal photo 4	Internal Photos	06/03/2010	pdf	06/03/2010
Internal photo 5	Internal Photos	06/03/2010	pdf	06/03/2010
Internal photo 6	Internal Photos	06/03/2010	pdf	06/03/2010
Internal photo 7	Internal Photos	06/03/2010	pdf	06/03/2010
Tune up	Parts List/Tune Up Info	06/03/2010	pdf	06/03/2010
Test report	Test Report	06/03/2010	pdf	06/03/2010
Test report suppl	Test Report	06/03/2010	pdf	06/03/2010
User manual	Users Manual	06/03/2010	pdf	06/03/2010
User manual 2	Users Manual	06/03/2010	pdf	06/03/2010
User manual 3	Users Manual	06/03/2010	pdf	06/03/2010

Mr. Stravitz testifies that FlexWave Prism Manual was provided as part of the documentation for four products for which records are included in the frequency-limited searches discussed above. *Id.* ¶¶ 58–60. Mr. Stravitz testifies that the three attachments of Exhibit Type “User Manual” in this entry are three linkable portions, together making up the complete FlexWave Prism Manual. *Id.* ¶ 60. Mr. Stravitz testifies that the dates indicate that the manual was available as of June 3, 2010 with respect to the PRSM070C product. *Id.* ¶ 59. Mr. Stravitz testifies that FlexWave Prism Manual was available as of July 1, 2010 with respect to a second product, and as of December 3, 2009 with respect to the other two products he identifies. *Id.* Thus, Mr. Stravitz concludes that FlexWave Prism Manual was publicly available on or shortly after December 3, 2009. *Id.* ¶¶ 61–64.

Mr. Stravitz was deposed and the deposition transcript, Exhibit 2012, is additionally referenced by the parties in arguments regarding public availability. PO Resp. 10–17, 20; Pet. Reply 7–8, 10–11, 14–16; PO Sur-reply 1–2, 6–8, 12–14, 20–21.

3. *Parties' Arguments Regarding Public Accessibility*

Petitioner argues that it has presented evidence that shows that FlexWave Prism Manual was publicly available as of August 17, 2010, and as early as December 3, 2009.

First, Petitioner argues that FlexWave Prism Manual was accessible on the EAS database as product documentation for four devices. Pet. Reply 1, 15–16 (citing Ex. 1010 ¶¶ 19–20, 29, 52, 53, 58, 59; Ex. 2012, 41:20–42:19; Ex. 1022 ¶ 29). Petitioner argues that the EAS database shows that FlexWave Prism Manual was publicly accessible as of the “Final Action Date” for the four products, which in each case was before August 17, 2010. *Id.*

Petitioner argues that one of ordinary skill would have found FlexWave Prism Manual on the EAS database site by exercising reasonable diligence. Pet. Reply 7–21. Petitioner characterizes the EAS database as one that “houses a collection of documentation related to a limited subject matter, namely, documentation for transmitting RF devices.” *Id.* at 7. Petitioner argues that it has shown that workers in the telecommunications field used the EAS database to search for and obtain documentation for RF devices being introduced to the US market. *Id.* at 7–8.

Petitioner defends the search conducted by Mr. Stravitz, arguing that the search parameters Mr. Stravitz used were not “unconventional” and that a person of ordinary skill would have used them to obtain documentation for RF devices being introduced into the U.S. market. *Id.* at 10–15. Petitioner argues that the evidence supports the determination that one of ordinary skill would have known to search for ADC Telecommunications (“ADC”), as a “known provider of broadband communications network infrastructure products” that was “involved in the development and sale of [DAS systems]

in the 2006–2010 time frame.” *Id.* at 10 (citing Ex. 1010 ¶¶ 42–43; Ex. 2012, 12:2–18). Petitioner argues that Mr. Stravitz was a person of ordinary skill according to the definition applied in the Institution Decision. *Id.* at 11. Petitioner additionally cites the fact that many results were obtained for “ADC Telecommunications” in the EAS “from 1993 through the date of the search” indicates that ADC was active in certifying RF devices “and therefore, would likely have been known to POSAs.” *Id.* Petitioner additionally cites testimony of Patent Owner’s CEO regarding his knowledge of ADC. *Id.* at 12–14 (citing Ex. 1014, 6:5–25:10; Ex. 1015, 166:10–21³). Petitioner argues that this testimonial evidence, along with a research report referred to by Patent Owner in its Response which describes ADC’s successor in interest as a top-five DAS vendor in 2015, shows that “there have been a small number of competitors who accounted for a large portion of the DAS market,” which “suggests that POSAs would have been familiar” with ADC. *Id.* at 13–14 (citing PO Resp. 8; Ex. 2001 ¶ 4; Ex. 1016).

With respect to the other search parameters, Petitioner argues that the frequency range limitations applied by Mr. Stravitz were “[w]ell-[k]nown.” *Id.* at 14 (citing Ex. 1010 ¶¶ 35–36). Relying on attorney argument, Petitioner argues that date restrictions would be used by a person of ordinary skill in the art to find relevant resources when searching for “the state of the art at any particular date.” *Id.* at 15. Petitioner additionally argues that a copy of FlexWave Prism Manual in Patent Owner’s files was “likely

³ Patent Owner cites page 146 of Exhibit 1015, which is unrelated; we assume this to be a typographical error.

retrieved” from the EAS database, due to emails dated ten months after the critical date. Pet. Reply 18–19⁴ (citing Ex. 1017, Ex. 1019).

Patent Owner argues that Petitioner does not demonstrate that one of ordinary skill would have located FlexWave Prism Manual on the EAS. PO Resp. 8–20; PO Sur-reply 3–17. Patent Owner argues that Mr. Stravitz’s testimony and search is “unconventional” and does not prove meaningful indexing. PO Resp. 9–10. Mr. Stravitz, Patent Owner argues, does not show that one of ordinary skill would have been able to locate FlexWave Prism Manual on the EAS, but rather located the document because of his “*a priori* knowledge of search parameters provided by Petitioner’s counsel.” *Id.* at 10, 12–13; PO Sur-reply 6–7 (citing Ex. 2012, 27:7–13, 77:12–16, 78:15–20). Patent Owner argues that Mr. Stravitz provides no testimony about how one of ordinary skill in the art would have searched the EAS database, and that Mr. Stravitz’s personal experience was far beyond that established for one of ordinary skill in the art at the time he used the EAS database. PO Resp. at 13–14 (citing Ex. 2012, 17:3–12, 20:1–12, 24:6–13, 74:17–76:1). With respect to the use of “ADC Telecommunications” as a search term, Patent Owner argues that Mr. Stravitz does not discuss why one of ordinary skill in the art would have chosen this search term. *Id.*; PO Sur-reply 8–9 (citing Ex. 2012, 77:12–16, 78:15–20). Patent Owner argues that

⁴ This portion of the Petitioner’s Reply and the supporting portions of the Exhibits are redacted from the public version of these documents because they contain Patent Owner’s confidential information. *See infra* § III. Our description of this redacted material does not reveal any information not made public by Patent Owner. *See* PO Sur-reply 17–18; Paper 34 (Patent Owner’s Demonstratives for Oral Argument), 33–34; Paper 21 (Patent Owner’s Opposition to Petitioner’s Motion for Additional Discovery), 1–2, App’x 2.

Mr. Stravitz did not describe a reason for the two-year window used as a parameter on the searches he performed. PO Resp. 15; PO Sur-reply 11. Patent Owner additionally argues that Mr. Stravitz chose to limit his search to certain frequency bands without understanding the relevance of these frequencies to the subject matter of the '508 patent. PO Resp. 15–16; PO Sur-reply at 15–16 (citing Ex. 2012, 82:4–83:15; 85:13–17).

4. *Analysis*

Our key inquiry is whether Petitioner sufficiently shows that FlexWave Prism Manual was made available to the extent that persons interested and ordinarily skilled in the subject matter of the patent or in the art would have been able to locate it. *In re Klopfenstein*, 380 F.3d at 1350.

We focus our inquiry on whether persons interested and ordinarily skilled in the subject matter or art would have been able to find FlexWave Prism Manual in the EAS database without *a priori* knowledge of the reference. While his testimony is at times ambiguous, Petitioner's declarant Mr. Stravitz addresses what someone would need to do to find FlexWave Prism Manual on the EAS database, after knowing the associated product manufacturer and other details about the product described or having FlexWave Prism Manual in hand to start with. Ex. 1010 ¶¶ 39–41; Ex. 2012, 21:13–22:22; 77:12–78:20; 90:1–91:12. Petitioner argues that it is irrelevant that counsel told Mr. Stravitz what reference to look for. Tr. 17:7–22; Paper 33 (Petitioner's Oral Hearing Demonstratives), 17. But controlling precedent indicates that it is not sufficient that, knowing the details of the reference or having a copy of the reference, one of skill in the art could have located that reference at the relevant time. If it were, then, for example, indexing by author name alone would have been deemed sufficient in prior cases. *See, e.g., Acceleration Bay*, 908 F.3d at 768 n.4, 772–74

(distinguishing keyword searching of titles from searching listings by author or year, in locating a technical report with a known author); *In re Cronyn*, 890 F.2d 1158, 1161 (Fed. Cir. 1989) (no public accessibility where student theses indexed by author's name). Thus, we determine whether the evidence before us shows persons interested in and ordinarily skilled in the subject matter or art, exercising reasonable diligence, would have been able to locate FlexWave Prism Manual in the EAS database without *a priori* knowledge of the reference.

a) Use of “ADC Telecommunications” as a Search Parameter

We determine Petitioner does not establish “an interested researcher” of ordinary skill would have found FlexWave Prism Manual as Mr. Stravitz did, by using the EAS database's search functions. *Voter Verified*, 698 F.3d at 1381.

Mr. Stravitz's searches each yielded a list of entries relating to the original grant for certification of a product. Ex. 1010 ¶¶ 15–20, 40, 41, 44–45, 48–53. For each entry, a list of exhibits could be obtained by selecting a “Detail” link; Mr. Stravitz testifies that four of the thirty-seven products in the smallest result set from his searches each had three exhibits of type “User Manual” on the Detail list that could be retrieved through a link and that when concatenated yielded FlexWave Prism Manual. *Id.* ¶¶ 56, 58, 60. These searches are the only ones provided that show how FlexWave Prism Manual might be located on EAS; we thus examine Mr. Stravitz's searches to determine whether they would have been performed by a person interested in, and ordinarily skilled in, the subject matter or art of the '508 patent.

Each of Mr. Stravitz's searches includes the selection of an applicant name of “ADC Telecommunications” as a starting search parameter.

Ex. 1010 ¶¶ 40–41, 48, 51. With respect this parameter, Mr. Stravitz’s declaration testimony is that “ADC Telecommunications” was selected in order to “not return too many results while still providing useful information about the real world products being submitted to the FCC for approval” and that ADC was a “company that provided broadband communications network infrastructure products and related services.” Ex. 1010 ¶¶ 41–42. Mr. Stravitz testifies that he recognizes ADC as a company that was involved in the development of DAS products “in the 2006–2010 time frame” and that he knew of ADC in 2008 for his employer. *Id.* ¶ 43; *see* Ex. 2012, 11:20–12:1. However, he does not testify as to what *one of ordinary skill in the art* at the time of the invention would have known with respect to ADC or whether they would have known to use ADC as a search parameter. While Mr. Stravitz’s deposition testimony is that someone with a year of industry experience would have been able to “locate something like this” “*if you knew what you were looking for*” and would use “the name of the company” to do so, this testimony does not reach the use of “ADC Telecommunications” in a search query by one of ordinary skill in the art at the time. Ex. 2012, 16:18–19:16 (emphasis added). Mr. Stravitz describes his understanding of ADC from the standpoint of a “veteran” or “expert” in the field. Ex. 1010 ¶ 43; Ex. 2012, 74:17–76:17. Furthermore, Mr. Stravitz describes selecting “ADC Telecommunications” as a search parameter because, “[*i*]t was what the attorneys were interested in in [*sic*] finding information out on.” Ex. 2012, 77:12–78:20 (emphasis added).

Petitioner argues that Mr. Stravitz was (and is) a person of ordinary skill, and thus his testimony regarding his knowledge of ADC is relevant. Pet. Reply 10. As addressed above, section II.B, a person of ordinary skill is not a person of extraordinary skill. Mr. Stravitz’s level of experience means

he is qualified to testify from the vantage point of one of ordinary skill. *See Kyocera Senco Indus. Tools Inc. v. Int'l Trade Comm'n*, 22 F.4th 1369, 1376–77 (Fed. Cir. 2022). However, in this case, there is no indication that he did so, and in fact, it appears Mr. Stravitz did not know about or consider the level of ordinary skill in preparing his declaration. Ex. 2012, 16:12–24:13; Tr. 18:8–19:15 (Petitioner’s counsel stating that there is “nothing directly from Mr. Stravitz” regarding the knowledge of one of ordinary skill in the art about ADC).

Petitioner argues that additional evidence shows that one of ordinary skill would have considered searching for ADC filings in the EAS database. Petitioner argues that Mr. Stravitz’s searches show that “from 1993 through the date of the search [2021], three hundred and twenty-three . . . search results were obtained” for ADC filings. Pet. Reply 11 (citing Ex. 1010 ¶ 45, Attachment 5). However, this is not supported by any context regarding this number of results or other evidence to support Petitioner’s bare argument that “this search result shows that ADC was a company that was active in certifying transmitting RF devices for use in the U.S. market, and therefore, would likely have been known to [persons of ordinary skill in the art].” *Id.* Petitioner does not provide, for example, any argument or evidence regarding the number of results for searches on other filing entities to compare with the number of results obtained from a search on ADC as filing entity; it is impossible on this record to evaluate any argument relying on the number of search results obtained from Mr. Stravitz’s first search. Additionally, as this first search by Mr. Stravitz includes filings for more than a decade after the critical date, even were we able to draw the conclusions Petitioner urges regarding ADC as of the date of Mr. Stravitz’s

search, without more we would not be able to reach a conclusion regarding ADC's status at the relevant time.

Petitioner argues that Patent Owner's CEO and certain vendors knew about or discussed ADC and its patents, citing excerpts from trial testimony at an infringement trial. *Id.* at 12–13 (citing Ex. 1014, 1015). However, Petitioner does not argue that the individual testifying or those he discusses are of ordinary skill or properly address the time referred to in these statements, described as being “between 2010 and 2015,” “before . . . 2016,” and “at a time [before ADC was acquired by another company].” *Id.* Petitioner additionally cites a summary of a research report that describes ADC's successor-in-interest as a top five DAS vendor in 2015. *Id.* at 13 (citing Ex. 1016). Petitioner concludes that the trial testimony and research report demonstrate that there were a small number of competitors in the DAS market, and “[t]his suggests that [persons of ordinary skill in the art] would have been familiar with the primary competitors in the DAS market, including ADC.” *Id.* at 13–14. However, Petitioner also does not address the discrepancy between the date of the summary and the critical date, provides no evidence that a person of skill in the art would have been familiar with this research document and only, at most, asserts that the research document *suggests* a person of skill would have been familiar with the primary competitors. Furthermore, Petitioner merely cites evidence that the top five vendors accounted for two-thirds of the market, not that there were “a small number of competitors.” *See id.* at 13.

Petitioner additionally argued during the hearing that one of ordinary skill would have investigated ADC filings on the EAS database because ADC was the assignee appearing on the face of Wala. Ex. 1006, code (73); Tr. 7:26–8:4, 17:23–18:7, 30:19–31:13, 68:2–68:21. This argument does not

appear in Petitioner’s briefs, and thus is improper to present for the first time at an oral hearing.⁵ Petitioner stated that its argument was supported by testimony from Mr. Proctor. Tr. 68:7–21 (Petitioner stating that the support would be in “Mr. Proctor’s testimony about motivation to combine Wala with the FlexWave Prism Manual.”). Petitioner cites Mr. Proctor’s declaration in support of the argument that one of ordinary skill would have combined the two references. Pet. 22 (citing Ex. 1003 ¶ 71); Pet. Reply 25–26 (citing Ex. 1003 ¶ 72). The cited portions of the declaration mention that Wala is assigned on its face to ADC and state that “the teachings of Wala further describe the capabilities of a remote unit like the one described in the FlexWave Prism manual which explicitly refers to ADC’s patented technology.” Ex. 1003 ¶¶ 71–72. To the extent we consider this evidence, it at best describes why one in possession of FlexWave Prism Manual (with its “explicit refer[ence] to ADC’s patented technology”) might search for patents to ADC and discover Wala, but does not provide support for the public availability of FlexWave Prism Manual or the use of ADC as a search term by one of ordinary skill in a search such as that conducted by Mr. Stravitz.

b) Use of EAS Database

Petitioner argues that the record shows that “the EAS database was well-known to the community interested in the subject matter” and that “workers in the telecommunications field could and did regularly use the

⁵ “During an oral hearing, a party may rely upon appropriate demonstrative exhibits as well as evidence that has been previously submitted in the proceeding, but may only present arguments relied upon in the papers previously submitted.” Patent Trial and Appeal Board Consolidated Trial Practice Guide, 85–86 (Nov. 2019) (“CTPG”) (available at www.uspto.gov/TrialPracticeGuideConsolidated).

FCC’s EAS database search functionality to search for and obtain documentation for RF devices being introduced to the U.S. market.” Pet. Reply 7–8 (citing Ex. 1010 ¶¶ 24, 30; Ex. 2012, 29:15–30:14). But the cited evidence does not describe whether the EAS database was well known to workers of a specific (ordinary) level of skill, only to “workers in the telecommunications field, like [Mr. Stravitz]” generally (Ex. 1010 ¶¶ 24, 30) or to Mr. Stravitz himself (or someone having unspecified “industry knowledge and understanding”) (Ex. 2012, 29:15–30:14). While Petitioner argues that Mr. Proctor’s evidence shows that he “[u]nderstood the FlexWave Prism Manual [t]o [b]e [p]rior [a]rt,” his declaration does not provide any evidence regarding the understanding of one of ordinary skill in the art regarding the EAS database, but rather focuses on his experience with submitting documents to the FCC and searching the EAS database. Pet. Reply 16–18; Ex. 1022 ¶¶ 24–29; Ex. 2013, 34:12–39:24. Thus, on the present record, we do not determine that the EAS database was known to one of ordinary skill in the art.

c) Conclusion

After considering this record evidence, Petitioner has not shown that one of ordinary skill would have performed the searches Mr. Stravitz performed on the EAS database. Mr. Stravitz’s searches appear to have been performed at the direction of counsel to discover whether and how FlexWave Prism Manual could be retrieved from the EAS database by someone who knew about FlexWave Prism Manual, without consideration of whether one of ordinary skill would have performed the searches absent a search directed towards FlexWave Prism Manual or would have known about the EAS database. Thus, Petitioner has not shown that one interested

in and ordinarily skilled in the art relating to the '508 patent would have found FlexWave Prism Manual using the EAS database.

Petitioner and Patent Owner argue over the applicability of *Voter Verified* and *Acceleration Bay*, with respect to whether a reference might be publicly available if found through a search in the FCC's EAS database – whether the limitations in search functions reflect “meaningful indexing” and whether such meaningful indexing is required if the EAS database was well-known. PO Resp. 8–10, 18–20; Pet. Reply 5–7; PO Sur-reply 2, 18–21. Petitioner argues that meaningful indexing is not necessary if the EAS database was well-known and provides documentation concerning a limited subject matter area; Patent Owner argues that such indexing is necessary and a search for ADC as an applicant on the EAS database is similar to a search on an “not particularly well known” author's name as in *Acceleration Bay*. *Acceleration Bay*, 908 F.3d at 765; Pet. Reply 9–10; PO Sur-reply 21. These questions need not be settled by us, however. The record here does not reflect evidence that one of ordinary skill in the art would have performed the searches on EAS database, each for grants to ADC, that Mr. Stravitz performed to obtain FlexWave Prism Manual. Mr. Stravitz did not opine on, and the record evidence does not show, whether one of ordinary skill in the art or one interested in the subject matter would have used “ADC Telecommunications” as a search term, absent *a priori* knowledge of FlexWave Prism Manual. Thus, the evidence does not show that FlexWave Prism Manual was made available via the EAS database to the extent that persons interested and ordinarily skilled in the subject matter of the patent or in the art would have located it.

Petitioner's arguments that a copy of FlexWave Prism Manual in Patent Owner's's files was “likely retrieved” from the EAS database are also

unavailing. *See* Pet. Reply 18–19 (citing Ex. 1017, Ex. 1019). To the extent that this argument is one of actual dissemination and that such an argument is proper in reply,⁶ the timing of the dissemination, ten months after the critical date, does not establish public accessibility. To the extent that Petitioner argues that this copy of FlexWave Prism Manual shows that one of ordinary skill would have been able to find FlexWave Prism Manual in the EAS database or elsewhere, the record does not include any information on the manner in which that copy of FlexWave Prism Manual was discovered, and the level of skill of the person who discovered it is not alleged or shown by Petitioner.

For these reasons, our determination is that FlexWave Prism Manual has not been shown to be publicly available.

E. Conclusion

For the reasons given above, Petitioner has not met its burden to show that FlexWave Prism Manual was disseminated or otherwise made available to the extent that persons of ordinary skill in the art, exercising reasonable diligence, could have located it.

All instituted grounds of unpatentability rely on FlexWave Prism Manual. Pet. 23–77; *see* Dec. on Inst. 17–29. Therefore, Petitioner fails to demonstrate by a preponderance of the evidence that any of the challenged claims are unpatentable based on the instituted grounds.

⁶ A “[p]etitioner may not submit new evidence or argument in [a] reply that it could have presented earlier, e.g.[,] to make out a prima facie case of unpatentability.” CTPG, 73 (citing *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077–78 (Fed. Cir. 2015)).

III. PETITIONER'S MOTION TO SEAL AND MOTION FOR ENTRY OF THE DEFAULT PROTECTIVE ORDER

Petitioner filed a Motion to Seal Petitioner's Reply Brief and Exhibits 1017, 1019, and 1023 and also requested entry of an agreed Protective Order (Exhibit 1025). Paper 25 ("Motion" or "Mot."). As described above, Petitioner filed a complete version of its Reply as Paper 26 and a redacted version of as Paper 27. With its Motion, Petitioner filed a redacted version of Exhibit 1017 (as Exhibit 1018), a redacted version of Exhibit 1019 (as Exhibit 1020), and a redacted version of exhibit 1023 (as Exhibit 1024). Patent Owner did not file an opposition.

The record for an *inter partes* review shall be made available to the public, except as otherwise ordered, and a document filed with a motion to seal shall be sealed provisionally until the motion is decided. *See* 35 U.S.C. § 316(a)(1); 37 C.F.R. § 42.14. Additionally, "[a] party may file a motion to seal where the motion to seal contains a proposed protective order, such as the default protective order set forth in the Office Patent Trial Practice Guide." 37 C.F.R. § 42.54(a).

There is a strong public policy that favors making information filed in *inter partes* review proceedings open to the public. *See Garmin Int'l v. Cuozzo Speed Techs., LLC*, IPR2012-00001, Paper 34 at 1–2 (PTAB Mar. 14, 2013). The standard for granting a motion to seal is good cause. *See* 37 C.F.R. § 42.54(a). The Board has stated that

a movant to seal must demonstrate adequately that (1) the information sought to be sealed is truly confidential, (2) a concrete harm would result upon public disclosure, (3) there exists a genuine need to rely in the trial on the specific information sought to be sealed, and (4), on balance, an interest in maintaining confidentiality outweighs the strong public interest in having an open record.

Argentum Pharms. LLC v. Alcon Research, Ltd., IPR2017-01053, Paper 27 at 4 (PTAB Jan. 19, 2018) (informative) (citing 37 C.F.R. § 42.54(a)). The Consolidated Trial Practice Guide explains 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.” CTPG 19. Further, the moving party bears the burden of showing that the relief requested should be granted. See 37 C.F.R. § 42.20(c).

We have reviewed the redactions to the Reply and to Exhibits 1017, 1019, and 1023 and we find that Petitioner has established good cause for its Motion to Seal. In particular, Exhibits 1017 and 1019 are Patent Owner’s internal emails containing business discussions relating to competition, received by Petitioner during discovery in this proceeding. Mot. 1, 4. Exhibit 1023 contains Petitioner’s proprietary technical information, included as part of Patent Owner’s infringement contentions in the related litigation. *Id.* 1, 3–4. Petitioner’s Reply refers to and includes information from these exhibits. *Id.* at 1, 5.

With respect to the public’s interest in a complete and understandable file history, we note that, as seen in the corresponding public versions, Exhibits 1017 and 1019 contain portions of FlexWave Prism Manual. Ex. 1018, 1020. Further, in addition to the unredacted material in the public version of the Petitioner’s Reply, Patent Owner has characterized the redacted portions in a brief filed without restriction as “Lemson’s email[s],” as “emails attaching the FlexWave [Prism] Manual . . . sent to [Patent Owner] engineers,” as “not indicat[ing] when or where Mr. Lemson obtained the FlexWave Prism [M]anual,” and as “emails . . . dated ten months after the critical date.” PO Sur-reply 17–18 & n.9; *see also* Paper 34

(Patent Owner's Demonstratives for Oral Argument), 33–34; Paper 21 (Patent Owner's Opposition to Petitioner's Motion for Additional Discovery), 1–2, App'x 2; Tr. 58:17–60:1. Thus, material facts regarding these exhibits are available to the public, yielding a materially complete and understandable file history even given the redactions.

Accordingly, for these reasons, and as detailed in the Motion, Petitioner has established good cause to seal the Reply and to Exhibits 1017, 1019, and 1023.

As noted above, Petitioner and Patent Owner have agreed to the proposed protective order in this matter, Exhibit 1025. Mot. 1, 6. Petitioner's Motion additionally requests entry of this protective order. After review of this proposed protective order, we find that entry of the proposed protective order, Exhibit 1025, is appropriate. Accordingly, we hereby enter Exhibit 1025 as the Protective Order governing the treatment and filing and confidential information in this proceeding.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–12 are not unpatentable based on the instituted grounds of unpatentability;

FURTHER ORDERED that that Petitioner's Motion to Seal is granted;

FUTHER ORDERED that Exhibit 1025 is entered as a protective order governing the confidential information in this hearing; and

FURTHER ORDERED that because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1–5, 8, 10–12	103	FlexWave Prism Manual, Wala		1–5, 8, 10–12
6, 7	103	FlexWave Prism Manual, Wala, Batruni		6, 7
9	103	FlexWave Prism Manual, Wala, Rhy		9
Overall Outcome				1–12

IPR2021-00762
Patent 9,826,508 B2

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