

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION

Petitioner

v.

SECURITY FIRST INNOVATIONS, LLC

Patent Owner

Case No. IPR2025-01201

U.S. Patent No. 8,904,194

PETITIONER'S UNOPPOSED MOTION TO SEAL:
(1) EXHIBITS 1028 AND 1029; AND (2) PETITIONER'S OPPOSITION TO
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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PETITIONER’S TABLE OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 8,904,194 (“’194 Patent”)
1002	Declaration of Dr. Erez Zadok
1003	PCT Patent Application Publication No. 01/022322 (“Dickinson”)
1004	U.S. Patent No. 6,363,481 (“Hardjono”)
1005	Claudia Canali <i>et al.</i> , <i>Performance Comparison of Distributed Architectures for Content Adaptation and Delivery of Web Resources</i> , 25 IEEE Int’l Conf. on Distributed Comput. Sys. Workshops 331 (2005) (“Canali”)
1006	File History of U.S. Patent No. 8,904,194 (“’194 File History”)
1007	File History of U.S. Patent Application Serial No. 11/258,839 (“’839 App. File History”)
1008	Reserved
1009	U.S. Provisional Application Serial No. 60/622,146 (“Provisional Application No. 60/622,146”)
1010	U.S. Provisional Application Serial No. 60/718,185 (“Provisional Application No. 60/718,185”)
1011	Microsoft Computer Dictionary
1012	Bruce Schneier, <i>Applied Cryptography</i> , 2nd ed., 1996, excerpts (“Schneier”)
1013	Highlighted Comparison Between Dickinson and the ’194 Patent
1014	Yitzhak Birk, “Random RAIDs with Selective Exploitation of Redundancy for High Performance Video Servers,” IEEE 1997 (“Birk”)
1015	U.S. Patent Publication No. 2003/0016596A1 (“Chiquoine”)
1016	Curriculum Vitae of Dr. Erez Zadok
1017	John Kubiatoiwicz, et al., “OceanStore: An Architecture for Global-Scale Persistent Storage,” ACM 2000 (“Kubiatoiwicz”)
1018	U.S. Patent Publication No. 2001/0034795 (“Moulton”)
1019	U.S. Patent Publication No. 2003/0046551 (“Brennan”)
1020	U.S. Patent Publication No. 2002/0049655 (“Bennet”)

Exhibit No.	Description
1021	<i>Google, LLC v. Sec. First Innovations, LLC</i> , IPR2024-00212, Exhibit 1043 (Patent Owner’s Proposed Claim Constructions In <i>Sec. First Innovations, LLC v. Google, LLC</i> , No. 2:23-cv-00097 (E.D. Va.)) (“PO’s Google Litigation Construction”)
1022	<i>Sotera</i> Stipulation
1023	Cisco and IBM Joint Press Release, “Cisco and IBM Work Together to Accelerate the ASP Ecosystem” (Oct. 18, 1999)
1024	TechMonitor Article, “IBM Announces Software Consulting Initiative for ASPs” (Oct. 26, 1999)
1025	Press Release, <i>Emerging ASP Market Standardizing on Citrix Platform</i> (epixtech, inc., Jan. 19, 2000)
1026	Spencer E. Ante, “IBM Sells the Next Big Thing in E-Business,” <i>BusinessWeek</i> (Nov. 5, 2002)
1027	“Study: IBM and EDS Lead Web Hosting Market,” <i>Computerworld</i> (May 30, 2003)
1028	2014 Statement of Work (PROTECTIVE ORDER MATERIAL)
1029	2017 Statement of Work (PROTECTIVE ORDER MATERIAL)
1030	U.S. Patent No. 9,338,140 (“the ’140 Patent”)
1031	U.S. Patent No. 10,452,854 (“the ’854 Patent”)
1032	U.S. Patent No. 11,068,609 (“the ’609 Patent”)
1033	U.S. Patent No. 11,178,116 (“the ’116 Patent”)
1034	Declaration of Pankaj Parekh in Support of Approval of Disclosure Statement and Confirmation of Plan of Reorganization, <i>In re Sec. First Corp.</i> , No. 20-12053 (BLS) (Bankr. D. Del. Oct. 13, 2020)
1035	<i>Sec. First Innovations, LLC v. Google LLC</i> , No. 2:23-cv-97 (E.D. Va.), Dkt. 1.
1036	USPTO Order Granting Ex Parte Reexamination of U.S. Patent No. 9,338,140 (Control No. 90/019,836)
1037	<i>Google LLC v. Sec. First Innovations, LLC</i> , IPR2024-00215, Paper 43 (PTAB May 16, 2025) (Final Written Decision)
1038	<i>Google LLC v. Sec. First Innovations, LLC</i> , IPR2024-00214, Paper 44 (PTAB May 16, 2025) (Final Written Decision)
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Exhibit No.	Description
1040	Docket Navigator Report – List of Cases Involving the '194 Patent
1041	<i>Sec. First Innovations, LLC v. Google LLC</i> , No. 2:23-cv-97 (E.D. Va.), Dkt. 254-1
1042	<i>Sec. First Innovations, LLC v. IBM</i> , No. 1:25-cv-00514-CMH-WEF (E.D. Va.), Dkt. 88 (Aug. 20, 2025)
1043	Comparison Of Specification In PCT Patent Application Publication No. 01/022322 (EX1003) And U.S. Patent No. 7,187,771 (EX2030)
1044	Declaration of Mr. Michael Loria (“Loria Decl.”)

I. INTRODUCTION

Pursuant to 37 C.F.R. §§ 42.14 and 42.54, Petitioner International Business Machines Corporation (“IBM”) hereby respectfully moves to seal Exhibits 1028 and 1029, and Petitioner’s Opposition to Patent Owner’s Request for Discretionary Denial, all filed concurrently herewith, designated as PROTECTIVE ORDER MATERIAL pursuant to the Default Protective Order¹. Patent Owner does not oppose.

II. MOTION TO SEAL

A. DOCUMENTS TO BE SEALED

1. Exhibits 1028 and 1029 (Statements of Work)

Exhibits 1028 and 1029 are Statements of Work between IBM and the prior owner of the ’194 patent, Security First Corporation (“SFC”), containing confidential business terms, including (without limitation) pricing/payment terms, deliverables, and allocations of rights and obligations.

2. Petitioner’s Opposition to Patent Owner’s Request for Discretionary Denial

IBM’s Opposition to Patent Owner’s Request for Discretionary Denial refers to and quotes confidential information in Exhibits 2015 and 2020 designated

¹ Patent Owner filed an unopposed motion for entry of the Default Protective Order on October 6, 2025, which is pending. *See* Paper 13.

PROTECTIVE ORDER MATERIAL by SFI and is currently subject to a motion to seal (*see* Paper 12). IBM submits a public, redacted version of the Opposition that redacts only those passages that would disclose confidential terms from Exhibits 2015 and 2020.

B. GOOD CAUSE EXISTS FOR SEALING IDENTIFIED DOCUMENTS

For each exhibit and paper that IBM seeks to seal, IBM submits 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).

1. Exhibits 1028 and 1029 (Statements of Work)

Confidential Information To Be Sealed: IBM seeks to seal Exhibits 1028 and 1029. These exhibits are Statements of Work signed by IBM and SFC. These Statements of Work contain highly sensitive information of IBM throughout, including pricing/payment terms and provisions establishing the parties' rights and obligations. IBM submits that, to the best of its knowledge, Exhibits 1028 and 1029 have not been publicly disclosed.

Harm Of Disclosure: Public disclosure of Exhibits 1028 and 1029 would harm IBM because its highly sensitive business strategies and legal positions have not been previously disclosed to the public. Revealing confidential information contained in these Exhibits would also discourage entities from engaging in agreements or communicating with IBM to find business opportunities out of concern that their confidential information might not stay confidential.

IBM's Need To Rely On Exhibits 1028 and 1029: IBM intends to rely on Exhibits 1028 and 1029 because they provide probative evidence on the business relationship between IBM and SFC, which is relevant to why the Director should not discretionarily deny the IPR petition in this proceeding.

Balance Of Maintaining Confidentiality With Having Open Record: The information IBM seeks to have sealed is not necessary to provide the public with a complete and understandable record of this proceeding. For example, the public will be provided with the information that the Statements of Work were in place, but the specifics of the Statements of Work are not necessary to provide the public with an understandable record of this proceeding.

Given the harm to IBM from disclosure of Exhibits 1028 and 1029, IBM's need to rely on these exhibits, and the minimal public interest in the confidential information in these exhibits, the balance favors sealing Exhibits 1028 and 1029.

Illumina Inc. v. Ravgen, Inc., IPR2021-01271, Paper 45, 49-50 (PTAB Jan. 25, 2023).

2. IBM's Opposition To Patent Owner's Request For Discretionary Denial

IBM's Opposition to Patent Owner's Request for Discretionary Denial quotes and characterizes information in Exhibits 2015 and 2020 that Patent Owner, SFI, has designated PROTECTIVE ORDER MATERIAL and has moved to seal. *See* Paper 12. According to SFI, there is good cause to seal Exhibits 2015 and 2020. Paper 12 at 3-4. For those same reasons, IBM seeks to seal the portions of IBM's Opposition that quotes Exhibits 2015 and 2020. IBM is filing a public redacted version of the Opposition that redacts the portions that quote and characterize information in Exhibits 2015 and 2020.

C. NON-CONFIDENTIAL VERSIONS OF CONFIDENTIAL DOCUMENTS

Pursuant to Section 5(A)(ii) of the Default Protective Order, IBM hereby files a public redacted version of the Petitioner's Opposition to Patent Owner's Request for Discretionary Denial that redact any PROTECTIVE ORDER MATERIAL.

D. CERTIFICATION OF NON-PUBLICATION

The undersigned counsel certifies that the exhibits and information sought to be sealed by this Motion have not, to their knowledge, been published or otherwise

made public. Also, pursuant to 37 C.F.R. § 42.54, IBM has in good faith conferred with other affected parties in an effort to resolve any dispute on the motion to seal.

III. CONCLUSION

For the reasons discussed above, IBM respectfully requests that the Board grant its motion to seal Exhibits 1028 and 1029 and Petitioner's Opposition to Patent Owner's Request for Discretionary Denial.

Dated: October 17, 2025

Respectfully submitted,

/Taeg Sang Cho/
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CERTIFICATE OF SERVICE

The undersigned certifies that on October 17, 2025, complete copies of the foregoing was served on counsel of record for the Patent Owner by filing the documents through P-TACTS and by sending via electronic mail to the following addresses:

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