



Protective Order Forecloses Participation of Litigation Counsel in Motion to Amend Process Before the PTAB

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By: Matthew George Hartman, Rubén H. Muñoz

In keeping with precedent, a judge in the District of Delaware issued an oral order restricting the extent of permissible activities for litigation counsel before the Patent Trial and Appeal Board. The order resolved a protective order dispute over the proper scope of a patent prosecution bar, concluding that litigation counsel that had access to confidential information is restricted from participating in the motion to amend process in an IPR.

Plaintiffs brought an action in the District of Delaware alleging that defendants infringed several patents. Defendants responded by filing IPR petitions at the PTAB challenging the patentability of each asserted patent. Before discovery commenced in the district court litigation, the parties met-and-conferred on a protective order. During those negotiations, a dispute arose over the scope of a proposed prosecution bar. While both parties agreed that litigation counsel that had access to defendants' confidential information could participate generally in the IPRs, they disagreed over counsels' involvement in the IPR motion to amend process. Plaintiffs' proposed protective order language made clear that arguing the patentability of claims presented in a motion to amend should not be barred. Defendants' proposed language, on the other hand, prevented litigation counsel from participating in any way in a motion to amend, including drafting a motion to amend and arguing the patentability of the amended claims.

In advocating for their proposed protective order language, plaintiffs pointed out that claims in an IPR can only be narrowed. Therefore, arguing the patentability of amended claims presents no more risk of inadvertent disclosure of confidential information than arguing the

patentability of original claims, which defendants' proposal would permit. Plaintiffs further contended that defendants' proposed language banning litigation counsel from participating in motions to amend would severely prejudice plaintiffs by depriving them of their choice of counsel, resulting in duplication of efforts and increased costs.

Defendants disagreed and argued that allowing litigation counsel with access to defendants' confidential information to participate in the motion to amend process would subject even the most scrupulous counsel to the risk of influencing the scope of proposed amended claims with that confidential information in mind. That risk, defendants claimed, is further exacerbated by the fact that (during the motion to amend process) the patent owner can change the scope of the claims after receiving preliminary guidance from the board. According to defendants, in arguing a motion to amend, the patent owner may advance arguments that affect the claims' scope, including via claim construction or disclaimer. Because patent owners can potentially obtain new claims with different scope, in defendants' view, a bright-line rule prohibiting litigation counsel that received confidential information from participating in motions to amend is necessary. Finally, defendants argued that plaintiffs would suffer no prejudice by the ban because they could select counsel from the same law firm as litigation counsel to argue motions to amend.

Ultimately, the court adopted defendants' language and in doing so noted that it is consistent with the "balanced approach" taken previously in the District of Delaware that allowed litigation counsel to participate in IPRs except as to activities related to amending claims. The court further explained that although claims can only be narrowed in an IPR, there is still a risk that the patent owner could use confidential information to craft claims that avoid prior art but still cover defendants' product. Moreover, the court emphasized that plaintiffs failed to explain how their litigation counsel could draft or argue a motion to amend without discussing the claim amendments with the patent prosecutors. The court concluded that allowing even limited involvement in the motion to amend process "could defeat the purpose of implementing the prosecution bar in the first place."

Practice Tip: In negotiating the terms of a protective order, parties should be intimately familiar with precedent in the jurisdiction in question. If appropriate, defendants should consider seeking to include language that unambiguously restricts plaintiff's litigation counsel that had access to defendant's confidential information from working on motions to amend in any co-pending IPR. Plaintiffs, on the other hand, should consider shielding at least one attorney on their team from defendant's confidential information to ensure that the attorney

can participate in a motion to amend in the IPR, including by drafting and arguing the motion to amend.

Aerin Med. Inc., et al. v. Neurent Med. Inc., et al., Case No. 1-23-cv-00756, D.I. 66 (D. Del. May 8, 2024) (Fallon, J.).

Categories

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