



Lack of History of Representation Before the Patent Office Favors Patent Prosecution Bar

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A District of Delaware judge recently granted a defendant’s motion to include a patent prosecution bar in its proposed protective order after determining that litigation counsel’s ability to practice before the Patent Office—without ever having represented the plaintiffs at the Patent Office in the past—weighed heavily in favor of the bar.

Plaintiffs filed suit in the District of Delaware alleging that defendant infringed patents related to LED technology. Shortly thereafter the parties began negotiating a protective order. Defendant sought to include a patent prosecution bar provision. Plaintiffs, however, disagreed and argued that a patent prosecution bar was unnecessary. After reaching an impasse, the parties submitted a joint letter to the court asking it to resolve their dispute over the inclusion of a prosecution bar in the protective order.

In making its determination, the court applied Federal Circuit precedent, which required a balancing test between the risks of inadvertent use or disclosure of proprietary information obtained during litigation and the potential harm to the opposing party from restrictions on its right to counsel of its choice. After balancing these factors, the court found that defendant had met its burden to show good cause for the issuance of a patent prosecution bar. The court first held that the risk of inadvertent use weighed in defendant’s favor, as plaintiffs had ongoing patent prosecution related to the patents-in-suit, including continuation applications that were pending at the Patent Office. The court also noted there was additional risk because many of plaintiffs’ outside counsel were qualified to practice before the Office, increasing the likelihood that they might be substantially involved in

competitive decisionmaking in future patent prosecution matters. Finally, the court was not convinced that because the parties are not direct competitors, a prosecution bar was unnecessary. In rejecting that contention, the court noted that plaintiffs requested information from defendant about its supplier's competing LED products, and thus there was a risk of possible inadvertent use of proprietary information.

Next, the court evaluated the potential harm to plaintiffs if a prosecution bar was imposed, and held that this factor weighed against the plaintiffs. While many of plaintiffs' outside counsel were qualified to practice before the Office, to date, none of them had represented plaintiffs before the Office, suggesting that plaintiffs would be able to use other attorneys for their prosecution needs.

Finally, the court evaluated the scope of defendant's proposed prosecution bar and determined that a two-year bar was appropriate. The court, however, required two revisions to the protective order to strike the proper balance between the parties' competing interests: (1) the prosecution bar would be limited to those who accessed **technical** information, as opposed to any proprietary financial data or business information, and (2) plaintiffs would be able to request exemptions from the bar on a counsel-by-counsel basis.

Practice Tip: When a dispute arises regarding the inclusion of a prosecution bar under a protective order, the requesting party bears the burden of showing good cause, and should consider facts that show a risk of inadvertent use or disclosure of confidential information. Relevant considerations include the existence of any pending continuation applications related to the patents-in-suit and litigation counsel's ability to practice before the Office. The opposing party should make clear to the court the specific harms it would suffer due to restrictions on its right to use counsel of its choice, especially if its counsel has not previously represented it before the Office.

Seoul Semiconductor Co. v. Technical Consumer Products, Inc., 1-24-cv-00579 (D. Del. Jan. 24, 2025) (J. Ranjan)

Categories

District of Delaware

Infringement

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