

# Should a Protective Order Bar Participation in Patent Reexamination?

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Courts Struggle with Realities of Post Grant Practice

A standard component of any patent litigation is a protective order. Such orders will invariably include a “prosecution bar.” The prosecution bar operates to ensure that individuals accessing such confidential data are not permitted to prosecute patent applications in the area of the litigated technology (usually for a fixed duration of time). Absent this bar, patent applications/claims could be fashioned by competitive decision makers involved in the litigation based on the confidential information of their rival.

With concurrent patent reexamination now commonplace with most patent litigation, the question becomes:

## Should a prosecution bar extend to patent reexamination?

The answer to that question has varied across district courts, and even across judges of the same court. Those courts permitting participation in patent reexamination would benefit from a reading of the record in *University of Virginia Patent Foundation v. General Electric Company*.

In an earlier post on this topic, [I noted the decision of one Delaware judge in \*Xerox Corp. v. Google, Inc. et al. In Xerox\*](#). In this case, as in many such cases, the inability to broaden claims in patent reexamination was found to guard against an improper use of confidential materials; as such, the litigation team was permitted to participate in the patent reexamination.

Last week, in the same Delaware court, a different judge came to the opposite conclusion in *Edwards Lifesciences AG, et. al. v. Corevalve Inc.* (DE, Wilmington). In the Order ([here](#)) the judge concluded that the risk of use/disclosure of confidential materials justified a prosecution bar forbidding litigation team participation in the patent reexamination.

Of course, different cases will have different facts and considerations. Rather than developing bright line rules, or looking at patent reexamination in the abstract, courts may find that the complexity of the technology/claim interpretation is an important factor in assessing possible competitive misuses of confidential information.

As I have pointed out previously in discussing this issue, one of the purposes of filing a patent reexamination is to force an amendment to an issued claim that will result in non-infringement. Likewise, the creation of additional estoppel/disclaimer is also a significant benefit to the parallel proceeding. In especially complex technologies, knowledge of the infringing devices can be absolutely critical in the prosecution of a patent reexamination. But, you don’t have to take my word for it, let’s look at what happened in *University of Virginia Patent Foundation v. General Electric Company*. (Last year’s post here on [intervening right issues](#))

In *Virginia*, the typical dispute played out with respect to the protective order. The Patentee argued that the prosecution bar was unnecessary since claims can only be broadened. On the other hand, G.E. argued that the plaintiff's attorneys had been exposed through discovery to the confidential operation of the "crown jewels" of G.E.'s products. G.E. argued that the litigators could effectively "gerrymander" the claims in the direction of infringement, while simultaneously avoiding the prior art, by "whispering in the ear" of the prosecutor; nevertheless, the judge allowed participation in the reexamination.

So, what happened in the patent reexamination?

Not surprisingly, no amendments were made (see earlier post linked above on claim cancellation/intervening rights issue). More importantly, and completely within their rights, *Virginia* applied a considerable amount of finesse with respect to the characterization of claim terminology in the patent reexamination.

In a March 2010 filing, after the proceeding was favorably terminated, the Patentee submitted additional comments. The comments were directed to the examiner's Statement for confirming the claims and terminating the proceeding.

*The Patent Owner believes that claim 1 is patentable over Frahm I for at least the reasons given in the "Amendment Under 37 C.F.R. § 1.111 and § 1.550..." filed November 30, 2009, hereafter, "the previous response." Those reasons did not require the claimed "magnetization recovery period" to be viewed in the manner described in the Statement. The Patent Owner believes that the scope of claim 1 of the '282 patent includes embodiments wherein the claimed "magnetization recovery period" allows either substantially complete or partial T1 and T2 relaxation to occur, depending upon the chosen duration of the "magnetization recovery period" and the T1 and T2 relaxation times of the tissue being imaged. (See, e.g., the embodiments in columns 17 and 18 where none of the "magnetization recovery periods" are long enough to allow substantially complete T1 and T2 relaxation to occur.) The Patent Owner further believes that this is clearly supported by the examples in the '282 patent, and the manner in which an artisan would interpret the glossary terms in the '282 patent related to this feature. Specifically, the use of preselected "magnetization recovery periods" in these examples that permit only partial T1 and T2 relaxation demonstrates how the recovery period can be manipulated to provide "an additional degree of freedom for controlling the image contrast ...." See, '282 patent, column 15, lines 10-14. . .*

Although unlikely, it may be that the specific relaxation timing of G.E.'s devices is public knowledge. Still, it is apparent from this filing how fairly precise information can be infused to the prosecution history of a patent reexamination. This type of filing arguably demonstrates the very "gerrymandering" and [self serving type of statement](#) argued by GE to the judge (transcript 9/2/2009), to no avail.

At least for cases relating to complex technologies, prosecution bars that prevent direct participation in patent reexamination would appear advisable.