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6 **IN THE UNITED STATES DISTRICT COURT**
7 **FOR THE DISTRICT OF ARIZONA**
8

9 Champion Power Equipment Incorporated,
10 Plaintiff,

11 v.

12 Firman Power Equipment Incorporated,
13 Defendant.
14

No. CV-23-02371-PHX-DWL

ORDER

15 In this patent infringement action, Champion Power Equipment, Inc. (“Plaintiff”) is
16 represented by Timothy Ziolkowski (“Ziolkowski”) and Jacob Fritz (“Fritz”) of the law
17 firm Ziolkowski Patent Solutions Group (“ZPS”) and by David Barker (“Barker”) and
18 Zachary Schroeder (“Schroeder”) of the law firm Snell & Wilmer LLP (“Snell”). In broad
19 strokes, Plaintiff alleges that it “directly compete[s]” with Firman Power Equipment, Inc.
20 (“Defendant”), because each company “sells single-fuel and multi-fuel generators, power
21 stations, log splitters,” and other related products, and that Defendant has infringed 13 of
22 Plaintiff’s patents related to those products. (Doc. 24 ¶¶ 1-4.)

23 Now pending before the Court is Defendant’s motion for a protective order. (Doc.
24 75.) Defendant seeks two forms of relief: *first*, a “patent prosecution bar” that would
25 preclude Ziolkowski, Fritz, Barker, and Schroeder from performing patent prosecution
26 work for Plaintiff for two years following the conclusion of this action; and *second*, an
27 order affording each side the opportunity to object before its confidential information is
28 shared with experts retained by the other side. (*Id.*)

1 The motion is fully briefed (Docs. 79, 82) and the Court concludes it may be decided
2 without oral argument. LRCiv 7.2(f). For the reasons that follow, the motion is granted in
3 part and denied in part.

4 DISCUSSION

5 I. Patent Prosecution Bar

6 A. Legal Standard

7 “Despite provisions in protective orders that specify that confidential information
8 may be used only for purposes of the current litigation, courts recognize that there may be
9 circumstances in which even the most rigorous efforts of the recipient of such information
10 to preserve confidentiality in compliance with the provisions of such a protective order
11 may not prevent inadvertent compromise.” *NeXedge, LLC v. Freescale Semiconductor, Inc.*,
12 820 F. Supp. 2d 1040, 1042 (D. Ariz. 2011) (cleaned up). “[T]o protect against such
13 inadvertent compromise, a court may issue a patent prosecution bar as part of a protective
14 order. Such a prosecution bar can operate to prevent any individual who has access to
15 highly confidential information as part of patent litigation from also participating in . . .
16 patent proceedings before the PTO [United States Patent and Trademark Office].”
17 *Helferich Patent Licensing, LLC v. Suns Legacy Partners, LLC*, 2012 WL 6049746, *1 (D.
18 Ariz. 2012).

19 1. Competitive Decisionmaking

20 The seminal decision addressing the standards for imposing a patent prosecution bar
21 is *In re Deutsche Bank Trust Co.*, 605 F.3d 1373 (Fed. Cir. 2010). Under *Deutsche Bank*,
22 the first inquiry is whether each attorney to be bound by the requested prosecution bar “is
23 involved in ‘competitive decisionmaking’ with its client.” *Id.* at 1378.

24 The term “competitive decisionmaking” is “shorthand for a counsel’s activities,
25 association, and relationship with a client that are such as to involve counsel’s advice and
26 participation in any or all of the client’s decisions (pricing, product design, etc.) made in
27 light of similar or corresponding information about a competitor.” *Id.* (cleaned up). As
28 relevant here, one way an attorney can be involved in “competitive decisionmaking” is

1 when “trial counsel [in a patent infringement case] also represent the same client in
2 prosecuting patent applications before the PTO.” *Id.* at 1379.

3 “Because patent prosecution is not a one-dimensional endeavor and can encompass
4 a range of activities, it is shortsighted to conclude that every patent prosecution attorney is
5 necessarily involved in competitive decisionmaking.” *Id.* For example, if an attorney’s
6 “patent prosecution duties . . . involve little more than reporting office actions,” “filing
7 ancillary paperwork,” or “high-altitude oversight of patent prosecution, such as staffing
8 projects or coordinating client meetings, but [involve] no significant role in crafting the
9 content of patent applications or advising clients on the direction to take their portfolios,”
10 such work is unlikely to qualify as “competitive decisionmaking.” *Id.* at 1379-80. “On the
11 other hand, many attorneys involved in litigation are more substantially engaged with
12 prosecution. Such involvement may include obtaining disclosure materials for new
13 inventions and inventions under development, investigating prior art relating to those
14 inventions, making strategic decisions on the type and scope of patent protection that might
15 be available or worth pursuing for such inventions, writing, reviewing, or approving new
16 applications or continuations-in-part of applications to cover those inventions, or
17 strategically amending or surrendering claim scope during prosecution. For these
18 attorneys, competitive decisionmaking may be a regular part of their representation”
19 *Id.* at 1380.

20 2. Judicial Balancing

21 “A determination of the risk of inadvertent disclosure or competitive use does not
22 end the inquiry. Even if a district court is satisfied that such a risk exists, the district court
23 must balance this risk against the potential harm to the opposing party from restrictions
24 imposed on that party’s right to have the benefit of counsel of its choice. In balancing these
25 conflicting interests the district court has broad discretion to decide what degree of
26 protection is required.” *Id.* at 1380 (citations omitted).

27 As part of the balancing analysis, “the court should consider such things as the
28 extent and duration of counsel’s past history in representing the client before the PTO, the

1 degree of the client’s reliance and dependence on that past history, and the potential
2 difficulty the client might face if forced to rely on other counsel for the pending litigation
3 or engage other counsel to represent it before the PTO.” *Id.* at 1381. “This is no easy
4 balancing act . . . since the factors that make an attorney so valuable to a party’s prosecution
5 interests are often the very factors that subject him to the risk of inadvertent use or
6 disclosure of proprietary competitive information acquired during litigation.” *Id.*

7 Additionally, “a court must be satisfied that the kind of information that will trigger
8 the bar is relevant to the preparation and prosecution of patent applications before the PTO.
9 For example, financial data and other sensitive business information, even if deemed
10 confidential, would not normally be relevant to a patent application and thus would not
11 normally be expected to trigger a patent prosecution bar. On the other hand, information
12 related to new inventions and technology under development, especially those that are not
13 already the subject of pending patent applications, may pose a heightened risk of
14 inadvertent disclosure by counsel involved in prosecution-related competitive
15 decisionmaking” *Id.*

16 **B. Competitive Decisionmaking**

17 **1. The Parties’ Arguments**

18 Defendant focuses nearly all of its competitive decisionmaking arguments on
19 Ziolkowski and Fritz. (Doc. 75 at 3, 6-8.) According to Defendant, Ziolkowski and Fritz
20 are Plaintiff’s “longtime patent counsel” and have “a lengthy history of advising [Plaintiff]
21 on patent strategy in terms of prosecuting both the patents [Plaintiff] asserts in this lawsuit
22 as well as applications pending before the PTO.” (*Id.* at 3.) Defendant also notes that
23 ZPS’s website “touts—under the firm website section titled ‘Protect Your Space’—their
24 ability to draft patents to protect not just . . . your product or the invention but also the
25 space around your invention.” (*Id.*, cleaned up.) Defendant contends that “[g]iven their
26 undisputed role in crafting the content of patent applications and advising [Plaintiff] on the
27 direction to take [its] portfolios, Ziolkowski and Fritz are considered competitive
28 decisionmakers, making inadvertent disclosure a significant risk.” (*Id.* at 7, cleaned up.)

1 As for Barker and Schroeder, Defendant states in a footnote: “[Plaintiff’s] other counsel of
2 record are unlikely to trigger the prosecution bar. Based on representations by [Snell]
3 attorneys, they do not prosecute patents, let alone any in the field at issue in this lawsuit.
4 If true, then none of their activities would trigger the prosecution bar.” (*Id.* at 13 n.4.)

5 In response, Plaintiff argues that Defendant “failed to demonstrate why it is entitled
6 to a prosecution bar in the first instance, including by failing to establish that [Plaintiff’s]
7 counsel are ‘competitive decisionmakers.’” (Doc. 79 at 4.) According to Plaintiff,
8 Defendant “completely fails to make this showing for Barker and Schroeder.” (*Id.* at 5.)
9 As for Ziolkowski and Fritz, Plaintiff does not dispute that they have been involved in its
10 past prosecution efforts but contends that, under *Deutsche Bank*, such involvement does
11 not automatically result in “competitive decisionmaker” status. (*Id.* at 5-6.) Plaintiff
12 contends that “[t]he decisionmaking role” with respect to its patent prosecution efforts
13 “rests firmly with [its] management team and Director of Product Development, Greg
14 Pauken” and that “[a]lthough Ziolkowski and Fritz have worked with [Plaintiff] for a
15 number of years, there is no evidence suggesting they have morphed into [Plaintiff’s]
16 policymakers or decisionmakers.” (*Id.*) In a footnote, Plaintiff contends it should not be
17 required to provide more details about the roles that Ziolkowski and Fritz have played in
18 past prosecution efforts because doing so would require it to divulge privileged
19 information. (*Id.* at 6 n.2.)

20 In reply, Defendant argues that it has “demonstrated a high risk of inadvertent
21 disclosure given Ziolkowski and Fritz’s substantial roles in crafting patent applications and
22 advising on the direction of [Plaintiff’s] patent portfolio—facts that [Plaintiff] does not
23 deny.” (Doc. 82 at 2-3.) Defendant also accuses Plaintiff of asking the Court to “appl[y]
24 a non-existent test and . . . an impossible standard, [by] arguing the Court should deny the
25 motion because Ziolkowski and Fritz are not [Plaintiff’s] policymakers or decisionmakers
26 and do not make decisions for their client. But that’s not the test under *Deutsche Bank*,
27 and [Plaintiff] cites nothing to suggest otherwise. Nor would such a test make any sense.
28 No outside counsel would ever meet that bar because, consistent with governing rules of

1 ethics, the client always holds the ultimate decisionmaking authority.” (*Id.* at 5, cleaned
2 up.) Finally, Defendant argues that Plaintiff “fails to address, let alone rebut, the
3 heightened risk caused by the fact that Ziolkowski and Fritz practice targeted patenting to
4 help clients like [Plaintiff] maximize *market space against competitors* rather than solely
5 to protect the client’s purported inventions.” (*Id.* at 6.)

6 2. Analysis

7 As noted, the first inquiry under *Deutsche Bank* is whether each putative subject of
8 the requested prosecution bar “is involved in ‘competitive decisionmaking’ with its client.”
9 605 F.3d at 1378. Unfortunately, *Deutsche Bank* is not entirely clear on who bears the
10 burden of proof as to this issue. On the one hand, *Deutsche Bank* announces this
11 requirement immediately after explaining that “[a] party seeking a protective order carries
12 the burden of showing good cause for its issuance. The same is true for a party seeking to
13 include in a protective order a provision effecting a patent prosecution bar.” *Id.* Arguably,
14 this suggests that the movant bears the burden of proving that each attorney to be bound
15 by the requested prosecution bar is a competitive decisionmaker. However, in later
16 portions of the decision, *Deutsche Bank* states that “the party seeking an exemption from a
17 patent prosecution bar must show on a counsel-by-counsel basis . . . that counsel’s
18 representation of the client in matters before the PTO does not and is not likely to implicate
19 competitive decisionmaking related to the subject matter of the litigation.” *Id.* at 1381.
20 Arguably, this suggests that the non-movant bears the burden of proving that each attorney
21 at issue is not a competitive decisionmaker. As other courts have recognized, these
22 passages are difficult to reconcile. *DeCurtis LLC v. Carnival Corp.*, 2021 WL 38265, *4
23 n.4 (S.D. Fla. 2021) (“District courts are split on how to apply the moving party’s initial
24 burden. A majority of courts require the movant to show that the bar reasonably reflects
25 the risk of inadvertent disclosure of proprietary competitive information and that the bar as
26 applied to specific lawyers will prevent the risk of inadvertent disclosure. Other courts
27 only require the movant to show that a patent prosecution bar is reasonable, before shifting
28 the burden to the party seeking an exemption from the proposed prosecution bar to

1 demonstrate that a specific lawyer's role will not likely implicate competitive
2 decisionmaking") (citations omitted).

3 The Court finds it unnecessary to take a side on this unsettled and complicated issue
4 because, regardless of who bears the burden of proof, it is clear that Ziolkowski and Fritz
5 qualify as competitive decisionmakers but Barker and Schroeder do not. *Deutsche Bank*,
6 605 F.3d at 1378 ("[W]hether an unacceptable opportunity for inadvertent disclosure exists
7 must be determined by the facts on a counsel-by-counsel basis.") (cleaned up). As for
8 Ziolkowski and Fritz, Defendant has come forward with evidence that both attorneys have
9 extensive experience prosecuting patents on behalf of Plaintiff, including some of the
10 patents at issue in this action. (*See, e.g.*, Doc. 77-1 at 9-111.) Plaintiff does not, in turn,
11 dispute their involvement in past prosecution efforts. (Doc. 79-2 ¶ 3 [declaration from
12 Plaintiff's owner that "[Plaintiff] has retained [ZPS] for many years to, among other things,
13 prosecute the Patents-in-Suit on [Plaintiff's] behalf."].) Thus, whether Ziolkowski and
14 Fritz qualify as competitive decisionmakers turns on the substance of their involvement in
15 those prosecution efforts. *Deutsche Bank*, 605 F.3d at 1379 ("Because patent prosecution
16 is not a one-dimensional endeavor and can encompass a range of activities, it is
17 shortsighted to conclude that every patent prosecution attorney is necessarily involved in
18 competitive decisionmaking. . . . The facts, not the category must inform the result.").

19 In an effort to downplay Ziolkowski's and Fritz's roles, Plaintiff has submitted a
20 declaration from its owner avowing that Plaintiff's business executives, rather than
21 Ziolkowski and Fritz, retain the ultimate authority to decide whether to file a particular
22 patent application. (Doc. 79-2 ¶¶ 7-8.) The problem with this approach is that the
23 competitive-decisionmaker inquiry does not turn on who has the ultimate authority to file
24 a patent application. Indeed, an attorney may be deemed a competitive decisionmaker
25 simply by being "substantially engaged with prosecution," through such activities as
26 "obtaining disclosure materials for new inventions and inventions under development,
27 investigating prior art relating to those inventions, making strategic decisions on the type
28 and scope of patent protection that might be available or worth pursuing for such

1 inventions, writing, reviewing, or approving new applications or continuations-in-part of
2 applications to cover those inventions, or strategically amending or surrendering claim
3 scope during prosecution.” *Deutsche Bank*, 605 F.3d at 1380. The declaration from
4 Plaintiff’s owner conspicuously does not deny that Ziolkowski and Fritz engage in such
5 activities as part of their patent prosecution work for Plaintiff and it would be surprising if
6 they did not, given their longstanding role as Plaintiff’s outside counsel for such work.
7 Indeed, Plaintiff concedes in its response brief that it “exclusively uses ZPS to prepare and
8 prosecute its patent applications.” (Doc. 79 at 11.) *Cf. Karl Storz Endoscopy-America,*
9 *Inc. v. Stryker Corp.*, 2014 WL 6629431, *3 (N.D. Cal. 2014) (“Stryker has made a
10 sufficient showing that KSEA’s counsel [Whitmyer] is engaged in competitive
11 decisionmaking for Plaintiff based on the myriad examples of his participation in
12 prosecuting patents for KSEA in subject matters related to the patents at issue in this case,
13 including post-approval amendments and other arguments in favor of patentability. The
14 most recent example of Whitmyer’s active patent prosecution on KSEA’s behalf dates from
15 May of 2014, several months after this case commenced. Far from mere administrative or
16 oversight duties, Whitmyer’s filing of such amendments indicates substantial involvement
17 in prosecution—precisely the type of activity that poses a high risk of inadvertent
18 disclosure under the *Deutsche Bank* standard.”). In a related vein, although Ziolkowski’s
19 declaration is vague as to his specific activities and responsibilities, it seems to confirm
20 that he is substantially engaged in the substance of the prosecution activities he performs
21 for Plaintiff, albeit while allowing Plaintiff to retain ultimate decisionmaking authority.
22 (Doc. 79-1 at 3 ¶ 6 [acknowledging that ZPS’s policies and procedures call for ZPS to
23 “advise clients regarding intellectual property protection and enforcement and make
24 recommendations and suggestions based on the facts presented, but ZPS never makes
25 decisions for clients”].)¹ Under these circumstances, the Court is satisfied that Ziolkowski

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27 ¹ Although *Deutsch Bank* recognizes that an attorney whose involvement in patent
28 prosecution work is limited to “reporting office actions,” “filing ancillary paperwork,” or
otherwise performing “high-altitude oversight of patent prosecution” may not qualify as a
competitive decisionmaker, 650 F.3d at 1379-80, the declarations from Plaintiff’s owner
and from Ziolkowski do not suggest that Ziolkowski’s and Fritz’s work for Plaintiff is

1 and Fritz qualify as competitive decisionmakers.

2 In contrast, Barker and Schroeder do not qualify as competitive decisionmakers. As
3 an initial matter, the Court finds it notable that, in the joint notice of discovery dispute filed
4 before the parties were authorized to pursue full briefing on Defendant's request for a
5 prosecution bar, Defendant seemed to indicate that it was not seeking such a bar as to
6 Barker and Schroeder: "Two sets of attorneys represent [Plaintiff] in this lawsuit: (1) patent
7 litigators David Barker and Zachary Schroeder of Snell & Wilmer L.L.P.; and (2) patent
8 prosecutors Timothy Ziolkowski and Jacob Fritz of Ziolkowski Patent Solutions Group.
9 [Defendant's] concern is narrowly directed at Ziolkowski and Fritz" (Doc. 65 at 3.)
10 However, Defendant's position has now apparently evolved, such that it believes Barker
11 and Schroeder should also be covered by the bar because they failed to come forward with
12 affirmative evidence to establish why they should not be covered: "As for Barker and
13 Schroeder, . . . [Defendant] would not oppose an exemption should [Plaintiff] come
14 forward with declarations confirming that these attorneys do not nor intend to prosecute
15 patents in the field of multi-fuel generators or multi-fuel engines." (Doc. 82 at 11.)
16 Although Defendant's approach is not impermissible, given the unsettled state of the law
17 as to the burden of proof, it still strikes the Court as an overly casual way to seek a very
18 significant and unusual form of relief, which could potentially restrict the affected
19 attorneys' ability to practice law and pursue a livelihood. *Encap LLC v. Scotts Co. LLC*,
20 2015 WL 12991188, *3 (E.D. Wisc. 2015) ("The Federal Circuit has made clear that a
21 patent prosecution bar on an outside attorney should not be lightly imposed.").

22 At any rate, the bottom line is that there is no evidence that Barker and Schroeder
23 have ever prosecuted patents for Plaintiff. Nor is there any evidence that they intend to
24 start doing so in the future. Against this backdrop, they cannot be considered competitive
25 decisionmakers. *Deutsche Bank*, 605 F.3d at 1379 ("The concern over inadvertent
26 disclosure manifests itself in patent infringement cases when trial counsel also represent
27 the same client in prosecuting patent applications before the PTO.").

28 _____
limited in this fashion.

1 **C. Judicial Balancing**

2 1. The Parties' Arguments

3 Defendant argues that a prosecution bar is necessary here in light of the nature of
4 the information to be disclosed during discovery. (Doc. 75 at 9-10.) More specifically,
5 Defendant notes that Plaintiff's discovery requests include a request for all documents
6 "relating to the design of the Accused Products," including engineering specifications and
7 circuit diagrams. (*Id.* at 3-4.) According to Defendant, the requested information thus
8 "includes [Defendant's] proprietary competitive information that is not publicly available."
9 (*Id.* at 4.) Defendant adds: "Confidential technical information is clearly relevant to a
10 patent application and thus raises a heightened risk of inadvertent disclosure." (*Id.* at 9.)
11 Defendant also identifies three reasons why it should not be required to provide, at this
12 stage of the case, a more detailed identification of the information it seeks to protect:
13 (1) *Deutsche Bank* does not require such a showing; (2) such a requirement would "make[]
14 no sense" when, as here, discovery is still in its nascent stages; and (3) regardless,
15 Defendant has already "identified data sheets, specifications, and schematics describing
16 the internal design and operation of electrical components that cannot be easily ascertained
17 through reverse engineering or dismantling generators." (*Id.* at 9-10.) Defendant also
18 defends the scope of its requested prosecution bar, arguing that "[t]he bar would only apply
19 to counsel who are involved in the prosecution of patents or patent applications," that the
20 requested two-year duration is "reasonable," and that the bar would "prohibit prosecution
21 activity with respect to multi-fuel generators or multi-fuel engines." (*Id.* at 10-12.) Finally,
22 Defendant argues that Plaintiff would not be prejudiced by the requested bar because
23 (1) Plaintiff could choose to shield Ziolkowski and Fritz from the subset of discovery
24 materials containing Defendant's "proprietary competitive technical information," in
25 which case the bar would not be triggered; and (2) "discovery has just started," so "[t]here
26 is still plenty of time" for Plaintiff to "bring in an additional firm." (*Id.* at 12-13.)

27 In response, Plaintiff argues that even if Ziolkowski and Fritz are deemed
28 competitive decisionmakers, a prosecution bar is unwarranted pursuant to the judicial

1 balancing test. (Doc. 79 at 7-15.) First, Plaintiff contends that, under *Deutsche Bank*, the
2 type of information that might warrant a prosecution bar is information related to “new
3 inventions and technology under development, especially those that are not already the
4 subject of pending patent applications,” yet Defendant has “failed to identify a single
5 document falling within this category” and instead has merely identified “documents
6 related to products already available to the general public.” (*Id.* at 7, emphasis omitted.)
7 Plaintiff also disputes Defendant’s contention that the information at issue “cannot be
8 ascertained by analyzing [Defendant’s] publicly available generators,” arguing that the
9 products at issue in this case “are not chemical components, computer codes or programs,
10 or complex biological mechanisms. They are physical, mechanical products capable of
11 being reverse engineered.” (*Id.* at 8-9.) Next, Plaintiff raises a vagueness challenge to
12 some of the categories of information Defendant seeks to protect, arguing that Defendant’s
13 reference to “proprietary competitive information . . . could conceivably cover the entire
14 universe of discovery in this case.” (*Id.* at 9.) According to Plaintiff, Defendant “makes
15 no attempt to connect the documents it seeks to protect with how those documents would
16 be relevant to the preparation or prosecution of patent applications before the PTO.” (*Id.*
17 at 10.) Next, Plaintiff argues that the scope of the proposed prosecution bar is overbroad,
18 because it would encompass such innocuous activities as paying patent maintenance fees.
19 (*Id.* at 10-11.) Next, Plaintiff argues that it would suffer irreparable harm from the
20 proposed bar because “[n]o one knows the Patents-in-Suit better than [Plaintiff’s] currently
21 employed patent counsel, and the decade of familiarity with the publicly issued patent
22 claims’ associated prosecution histories are irreplaceable without extreme and undue
23 expense.” (*Id.* at 11-13.) Plaintiff continues: “[Defendant] proposes a wrecking ball (the
24 patent prosecution bar) where a more precise tool (*e.g.*, the agreed-upon AEO [attorneys’
25 eyes only] language) is more than sufficient.” (*Id.* at 13.) Finally, Plaintiff argues that
26 Defendant did not adequately meet and confer about the specifics of the proposed
27 protective order before filing the pending motion. (*Id.* at 13-15.)

28 In reply, Defendant argues that its proposed order is based on the Northern District

1 of California’s model order (Doc. 82 at 6-7, 9); that the proposed bar is appropriately
2 narrow in scope because it would apply only to “documents containing technical
3 information of the utmost commercially sensitive nature” (*id.* at 7, emphasis omitted); that
4 a prosecution bar may permissibly apply to “hardware schematics” even if those
5 schematics do not pertain to new inventions or technology under development (*id.* at 7-8);
6 that Plaintiff’s reverse-engineering claims are “nonsensical” (*id.* at 8-9); that Plaintiff’s
7 objections regarding the scope of activities to be covered by the bar “can be easily
8 addressed” by revising paragraph 13 of the proposed order (*id.* at 9); that Plaintiff would
9 only suffer “minimal” prejudice from the proposed bar because Plaintiff could use its
10 “other litigation counsel, Barker and Schroeder” to review the sensitive documents (*id.* at
11 10-11); that Plaintiff has not done enough to meet its burden of proof (*id.* at 11); and that
12 Plaintiff’s meet-and-confer objections are meritless (*id.* at 12).

13 2. Analysis

14 The Court concludes, in its discretion and after performing the balancing analysis
15 required under *Deutsche Bank*, that Ziolkowski and Fritz should not be subjected to a
16 prosecution bar despite their status as competitive decisionmakers. This conclusion is
17 largely driven by two considerations.

18 First is the type of information that will be exchanged during the discovery process
19 in this case. In *Deutsche Bank*, the Federal Circuit explained that “financial data and other
20 sensitive business information, even if deemed confidential, would not normally be
21 relevant to a patent application and thus would not normally be expected to trigger a patent
22 prosecution bar. On the other hand, information related to new inventions and technology
23 under development, especially those that are not already the subject of pending patent
24 applications, may pose a heightened risk of inadvertent disclosure by counsel involved in
25 prosecution-related competitive decisionmaking” *Deutsche Bank*, 605 F.3d at 1381.
26 The information at issue here falls somewhere in the middle of this spectrum. Although
27 the information will include hardware schematics, which are more sensitive than financial
28 data (at least for prosecution-bar purposes), and although Defendant contends those

1 schematics relate to design features that cannot be easily reverse engineered,² Defendant
2 does not contend those schematics relate to new inventions or technology under
3 development—instead, they relate to inventions that are already patented and released on
4 the market. The Court does not foreclose the possibility that a prosecution bar could be
5 warranted in a case involving such schematics, but they do not, under *Deutsche Bank*, raise
6 the same level of heightened concern as schematics related to unreleased products and
7 inventions that are not yet the subject of patent applications. *Cf. Carlson Pet Prods., Inc.*
8 *v. North States Indus., Inc.*, 2019 WL 2991220, *6 (D. Minn. 2019) (“[T]echnical and
9 design information, *especially that which concerns unreleased products* is the very kind of
10 information that courts have identified as deserving of protection against inadvertent use.”)
11 (emphasis added).

12 Second is “the extent and duration of counsel’s past history in representing the client
13 before the PTO, the degree of the client’s reliance and dependence on that past history, and
14 the potential difficulty the client might face if forced to rely on other counsel for the
15 pending litigation or engage other counsel to represent it before the PTO.” *Deutsche Bank*,
16 650 F.3d at 1381. The evidence before the Court establishes that Ziolkowski and Fritz
17 have a lengthy and substantial history representing Plaintiff before the PTO—as noted,
18 Plaintiff “exclusively uses ZPS to prepare and prosecute its patent applications” (Doc. 79
19 at 11)—and that Plaintiff will rely heavily on that experience in this case. It follows, in
20 the Court’s view, that Plaintiff would suffer significant prejudice if forced to rely on other
21 counsel in this case. Courts have declined to impose prosecution bars under analogous
22 circumstances. *See, e.g., Helferich*, 2012 WL 6049746 at *3 (“Helferich clearly has a
23 strong interest in choosing its own counsel—particularly in the complex and technical
24 realm of patent litigation . . . [and] Counsel for Helferich . . . have represented Helferich
25 both in litigation and before the PTO for many years and are deeply familiar with the
26 patents at issue here. Depriving Helferich of the specialized representation that its counsel

27 ² Although the Court views the parties’ dispute over reverse engineering to be
28 factually underdeveloped on the current limited record (Doc. 76 ¶¶ 2-3; Doc. 79-3 ¶ 10), it
also views this dispute as immaterial to the ultimate question of whether to impose a patent
prosecution bar, for the reasons explained elsewhere in this order.

1 can provide in this case would force them to rely on less knowledgeable counsel, either in
2 this litigation or before the PTO, and thus increase costs and duplicate effort.”) (cleaned
3 up); *Trading Techs. Int’l. Inc. v. GL Consultants, Inc.*, 2011 WL 148252, *7 (N.D. Ill.
4 2011) (“[T]he factors in the balancing test weigh against imposing the restriction on Mr.
5 Borsand (and on TT) that defendants seek. Mr. Borsand is TT’s lead trial counsel and is
6 intimately involved in TT’s overall litigation strategy. As such, TT would face serious
7 difficulty if forced to rely on outside counsel rather than Mr. Borsand to the extent that
8 defendants propose. . . . Defendants do not explain how Mr. Borsand could competently
9 discharge his responsibilities as TT’s lead counsel while at the same time being kept wholly
10 in the dark as to significant categories of evidence. Defendants’ alternative suggestion that
11 TT would not be prejudiced if Mr. Borsand could not continue to act as lead counsel is
12 likewise a non-starter. Mr. Borsand has been TT’s lead counsel in litigation involving the
13 patents-in-suit since 2003, and he is now its lead counsel in thirteen suits in this court
14 involving these patents. He has also tried one case involving the patents-in-suit to a
15 successful jury verdict in 2007. The idea that TT would be unscathed if it lost Mr.
16 Borsand’s involvement as lead counsel blinks reality, and ignores the weight to be given
17 to a party’s choice of what counsel will represent it in major litigation.”) (citations omitted).
18 In reaching this conclusion, the Court acknowledges that “[t]his is no easy balancing act
19 . . . since the factors that make an attorney so valuable to a party’s prosecution interests are
20 often the very factors that subject him to the risk of inadvertent use or disclosure of
21 proprietary competitive information acquired during litigation.” *Deutsche Bank*, 605 F.3d
22 at 1381.

23 II. Opportunity To Object Before Disclosure Of Confidential Information To Experts

24 A. **The Parties’ Arguments**

25 The parties agree that each side should have the right to object before information
26 that has been designated by one party as “Confidential” is disclosed to technical experts
27 retained by the opposing party. (Doc. 79 at 15-16.) However, they disagree about whether
28 this right of objection should also apply to disclosures to non-technical experts.

1 According to Defendant, the right of objection should apply to all experts “[b]ecause
2 a non-technical expert,” just like a technical expert, “cannot forget the information it learns
3 in this litigation.” (Doc. 75 at 13-14.) Defendant continues: “An accounting expert who
4 provides financial or market advice to competitors . . . is no less likely to inadvertently
5 misuse information as his technical counterparts.” (*Id.* at 14.) Defendant also cites various
6 cases in which the right of objection has been applied to all experts. (*Id.* at 14-15.)

7 In response, Plaintiff argues that Defendant has not shown “good cause” to extend
8 the objection requirement to non-technical experts and that “[t]he only benefit [Defendant]
9 will receive from requiring the advance disclosure of [Plaintiff’s] non-technical experts is
10 the ability to increase [Plaintiff’s] costs by objecting to [Plaintiff’s] experts and by gaining
11 knowledge of [Plaintiff’s] non-technical experts prior to the disclosure deadline.” (Doc.
12 79 at 16.)

13 In reply, Defendant briefly reiterates its earlier arguments. (Doc. 82 at 11.)

14 **B. Analysis**

15 The Court agrees with Defendant that good cause exists to apply the right of
16 objection to all experts, not just technical experts. The right of objection is meant to protect
17 against the possibility that a particular expert will misuse confidential information. That
18 risk is not limited to technical experts, so there is no reason to limit the right of objection
19 to technical experts. Nor has Plaintiff established that Defendant’s request for this
20 commonsense and seemingly ubiquitous procedural right is part of some nefarious scheme
21 to drive up litigation costs and derive an unfair litigation advantage.

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Accordingly,

IT IS ORDERED that Defendant’s motion for a protective order (Doc. 75) is **granted in part and denied in part.**

IT IS FURTHER ORDERED that the parties, after meeting and conferring, submit a revised proposed protective order that reflects the rulings set forth in this order.

Dated this 18th day of October, 2024.



Dominic W. Lanza
United States District Judge