

EXHIBIT A

AUGUST 11, 2006 PROTECTIVE ORDER (Docket 37)

and

OCTOBER 26, 2006 ORDER ON MOTION FOR PROTECTIVE
ORDER CLARIFICATION (Docket 67)

1 **EDWARD R. SCHWARTZ, CA Bar No. 147553**
2 **CHRISTIE, PARKER & HALE, LLP**
3 **350 West Colorado Boulevard, Suite 500**
4 **Post Office Box 7068**
5 **Pasadena, California 91109-7068**
6 **Telephone: (626) 795-9900**
7 **Facsimile: (626) 577-8800**
8 **e-mail: ers@cph.com**

9 Attorneys for Plaintiff,
10 Duhn Oil Tool, Inc.

11 UNITED STATES DISTRICT COURT
12 EASTERN DISTRICT OF CALIFORNIA

13 DUHN OIL TOOL, INC.,

14 Plaintiff,

15 vs.

16 COOPER CAMERON CORPORATION,

17 Defendant.

Case No. 1:05-CV-01411-OWW-LJO

PROTECTIVE ORDER

1 **I. INTRODUCTION.**

2 **WHEREAS**, in the course of this litigation disclosure may be sought of information
3 which a party or third party regards as being of a confidential, trade secret, and/or proprietary
4 nature; and

5 **WHEREAS**, there is a need to establish a mechanism to protect the disclosure of such
6 confidential, trade secret, or proprietary information in these actions and/or to prevent the use
7 of this information other than with regard to this litigation;

8 **GOOD CAUSE HAVING BEEN SHOWN,IT IS HEREBY ORDERED** that the
9 following protective order shall govern the disclosure and use of confidential, trade secret,
10 and/or proprietary information provided in discovery in this action by any party or third party.

11 **II. DEFINITIONS.**

The following definitions apply in this protective order:

12 **A.** The designation "CONFIDENTIAL" may be applied by a party or third party to
13 any type of information which that party or third party believes in good faith to constitute,
14 contain, reveal or reflect proprietary or confidential financial, business, technical, personnel or
15 related information.

16 **B.** The designation "CONFIDENTIAL -- ATTORNEYS' EYES ONLY" may be
17 applied by a party or third party to any type of information which it believes in good faith to
18 constitute, contain, reveal or reflect proprietary or confidential, financial, business, technical,
19 personnel or related information which is so highly sensitive and confidential as to require the
20 possession of such information to be limited to the counsel of record and their agents only.

C. "Confidential Information" refers to all information which is subject to the
designations "CONFIDENTIAL," or "CONFIDENTIAL -- ATTORNEYS' EYES ONLY" as
described above.

D. "Party" means every party to this action and every director, officer, employee,
and managing agent of every party to this action.

E. "Third Party" means every person or entity not a party to this action that
provides information, either testimonial or documentary, for use in this litigation through
discovery or otherwise.

F. "Order" means this Protective Order.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20

III. TERMS OF THE PROTECTIVE ORDER.

A. Materials Subject to Designation. All depositions, originals or copies of

1 transcripts of depositions, exhibits, answers to interrogatories and requests for admissions; and
2 all documents, materials, tangible things and information obtained by inspection of files or
3 facilities, by production of documents or by identification of documents previously gathered
(hereinafter collectively referred to as "Information") may be designated by the party or a
nonparty producing the Information in conformity with the definitions set forth above.

4 **B. Treatment of "Confidential -- Attorneys Only" Information.** Except as
5 provided in Paragraphs D and E below, Information designated as "CONFIDENTIAL --
6 ATTORNEYS' EYES ONLY" and all information derived therefrom (excluding such
7 information as is derived lawfully from an independent source) shall not be disclosed, given,
8 shown, made available or communicated in any way to any person or entity other than counsel
9 of record for a party. Such Information shall be used only for the purposes of this litigation,
and shall not directly or indirectly be used for any business, financial or other purpose
whatsoever. Improper disclosure or use of information designated as "CONFIDENTIAL --
ATTORNEYS' EYES ONLY" and all information derived therefrom shall constitute a material
violation of this Order.

10 **C. Treatment of "Confidential" Information.** Except as provided in Paragraphs
11 D and E below, documents designated as "CONFIDENTIAL" and all information derived
12 therefrom (excluding such information as is derived lawfully from an independent source) shall
13 not be disclosed, given, shown, made available, or communicated in any way to any person or
14 entity other than counsel of record for a party, the parties to this action and their current
15 employees, employees and agents of any insurer of any defendants, and third-party witnesses
16 who counsel of record for a party believe have knowledge which would be reasonably
17 calculated to lead to the discovery of admissible evidence. Before disclosure to any person or
18 entity other than counsel of record for a party, the person to whom such information is to be
disclosed shall execute and deliver to the attorney of record making the disclosure a written
agreement in the form attached hereto as Exhibit A. Such information shall be used only for
the purposes of this litigation, and shall not directly or indirectly be used for any business,
financial or other purpose whatsoever. Improper disclosure or use of information designated as
"CONFIDENTIAL" and all information derived therefrom shall constitute a material violation
of this Order.

19 **D. Outside Experts and Consultants.** Documents designated as
"CONFIDENTIAL -- ATTORNEYS' EYES ONLY" and "CONFIDENTIAL" may also be

1 shown to outside experts or consultants, together with their clerical personnel, who are retained
2 by a party in connection with the preparation for trial or trial in this action, provided that before
3 disclosure to any such expert or consultant, the person to whom such information is to be
4 disclosed shall execute a written agreement in the form attached hereto as Exhibit A. The
5 foregoing notwithstanding, any such expert or consultant who is an employee of a competitor
6 of any of the parties shall not be shown or otherwise given access to documents or information
7 designated "CONFIDENTIAL" or "CONFIDENTIAL -- ATTORNEYS' EYES ONLY" and
8 any such expert or consultant that is an employee of any of the parties shall not be shown or
9 otherwise given access to documents or information designated "CONFIDENTIAL--
10 ATTORNEYS' EYES ONLY."

11 **E. Request for Additional Disclosure.** If any counsel of record desires to give,
12 show, make available or communicate to any person apart from those permitted under
13 Paragraphs B, C, and D any information designated as "CONFIDENTIAL -- ATTORNEYS'
14 EYES ONLY" or "CONFIDENTIAL," that counsel of record shall first obtain the written
15 consent of the designating party through such party's counsel of record or seek leave of Court
16 to do so. Each person to whom the Confidential Information is to be given, shown, made
17 available or communicated must execute a written confidentiality agreement, in the form
18 attached hereto as Exhibit A. Only after all of the foregoing conditions have been fully
19 satisfied may the Confidential Information be given, shown, made available or communicated
20 to any person other than those permitted under Paragraphs B, C, and D.

13 **F. Record of Disclosure.** A file shall be maintained by the counsel of record
14 making a disclosure to third parties of all written agreements signed by persons to whom
15 materials designated as "CONFIDENTIAL -- ATTORNEYS' EYES ONLY" or
16 "CONFIDENTIAL" have been given. A copy of each such agreement shall be sent to Counsel
17 of Record for the designating party within five (5) days of disclosure, and said file shall be
18 made available for inspection and copying by opposing counsel upon written request.

16 **G. Maintenance of Designated Information.** Counsel receiving designated
17 Information that is provided pursuant to this Order shall maintain such designated Information
18 in a secure and safe area and shall exercise due and proper care with respect to the storage,
19 custody and use of all designated Information, so as to prevent the unauthorized or inadvertent
20 disclosure or use of any designated Information.

1 **H. Manner of Designating Documents.** A party shall designate documents
2 containing Confidential Information by placing a legend on each page of any document that
3 party wishes to protect against disclosure or use. This legend shall state "CONFIDENTIAL --
4 ATTORNEYS' EYES ONLY," or "CONFIDENTIAL," as appropriate. A designation of
5 Confidential Information as to any thing of which inspection or sample has been requested
6 shall be made by placing a "CONFIDENTIAL -- ATTORNEYS' EYES ONLY" or
7 "CONFIDENTIAL" legend on the thing or container within which it is stored, or by some other
8 means of designation agreed upon by the parties. All documents and things shall be marked
9 prior to the provision of a physical copy thereof to the other party. Alternatively, documents
10 may be made available for an initial inspection by counsel for the requesting (receiving) party
11 prior to the furnishing party producing copies of selected items. In such cases, documents shall
12 be inspected only by counsel for the receiving party permitted access to anything designated
13 "CONFIDENTIAL -- ATTORNEYS' EYES ONLY" or "CONFIDENTIAL" pursuant to the
14 terms of this Order, prior to furnishing copies to the receiving party. Such initial inspection
15 shall not constitute waiver of confidentiality with respect to any document so inspected.

16 **I. Initial Failure to Designate Information.** The initial failure to designate
17 Information "CONFIDENTIAL -- ATTORNEYS' EYES ONLY" or "CONFIDENTIAL" in
18 accordance with this Order shall not preclude any party, at a later date, from so designating the
19 documents and to require such documents to be treated in accord with such designation from
20 that time forward. If such Information has previously been disclosed to persons no longer
qualified after such designation, the disclosing party shall take reasonable efforts to obtain all
such previously disclosed Information, advise such persons of the claim of confidentiality, and
have such persons execute written confidentiality agreements in the form attached hereto as
Exhibit A. With respect to any documents produced to date by either party or any depositions
that have been taken to date, either party has until 30 days after the entry of this Order in which
to designate all or part of any such document or deposition as containing "CONFIDENTIAL --
ATTORNEYS' EYES ONLY" or "CONFIDENTIAL" information.

J. Manner of Designating Depositions. Should counsel of record for any party
introduce or use any Confidential Information in a deposition, or believe that any question to a
witness at a deposition upon oral examination will disclose Confidential Information, or that
answers to any question will require such disclosure, or if documents designated as containing
Confidential Information will be used as exhibits during examination, counsel for the party to

1 whom the benefit inures from the designation of that information as Confidential Information
2 shall have a duty to see that any documents containing Confidential Information and any
3 related testimony shall be separately bound and marked as subject to this Order, and subject to
4 disclosure only under the terms and provisions set forth in this Order. This shall be
5 accomplished by instructing the reporter during the deposition, or in the event that either party
6 inadvertently fails to designate a portion as "CONFIDENTIAL," or "CONFIDENTIAL --
7 ATTORNEYS' EYES ONLY" by written notice to the reporter and all counsel of record within
8 14 days after receipt of the transcript by the deponent or his counsel, in which case all counsel
9 receiving the transcript shall be responsible for marking the copies of the designated transcript
10 in their possession or under their control as directed by the designating party. In the latter case,
11 if Confidential Information has previously been disclosed to persons no longer qualified after
12 such designation, the disclosing party shall take reasonable efforts to obtain all such previously
13 disclosed information, advise such persons of the claim of confidentiality, and have such
14 persons execute written confidentiality agreements in the form attached hereto as Exhibit A. If,
15 during the course of deposition, Confidential Information will be given to a deponent who has
16 not already signed a confidentiality agreement, each such deponent shall state under oath that
17 he or she will abide by the terms of the Protective Order and shall maintain the confidentiality
18 of any Confidential Information disclosed during the deposition. Unless otherwise ordered by
19 this Court, the designating party shall have the right to have all persons, except the deponent
20 and his counsel, outside counsel of record for the named parties, the court reporter, and such
other persons as are permitted under the terms of this Order to have access to the designated
information, excluded from a deposition during the taking therein of the testimony designated
pursuant to this Order.

K. Court Reporters. Any court reporter who reports the testimony in this action at
a deposition shall agree, before reporting any such testimony involving Confidential
Information, that all Confidential Information is and shall remain confidential and shall not be
disclosed except to the attorneys of record and any other person who is present while such
testimony is being given; that copies of any transcript, reporter's notes or any other
transcription records of any such testimony shall be retained in absolute confidentiality and
safekeeping by such reporter or shall be delivered to the attorney of record for the designating
party or to the Court subject to the provisions hereof.

1 **L. Filing Documents With The Court.** All information designated as Confidential
2 Information which is filed or lodged with the court, or any pleading or memorandum
3 purporting to reproduce or paraphrase such information, shall be filed or lodged in sealed
4 containers on which shall be recorded the title to this action, the general nature of the contents,
the words "CONFIDENTIAL - ATTORNEYS' EYES ONLY" or "CONFIDENTIAL" and a
statement substantially in the following form:

5 This sealed container filed in this case contains confidential
6 materials generally identified as "CONFIDENTIAL --
7 ATTORNEYS' EYES ONLY" or "CONFIDENTIAL". Pursuant
to the Stipulated Protective Order herein, this container shall not
be opened nor the contents thereof revealed except to the Court,
including court personnel as necessary for handling of the matter.

8 After any such opening or revelation, the container shall be
9 resealed with the contents inside.

10 Upon default of the filing or lodging party properly to designate Confidential Information and
11 file or lodge such information in accordance with this Order, any party who in good faith
12 believes that designation and filing under seal is required may do so within five (5) days of
13 learning of the defective filing or lodging. Notice of such designation shall be given to all
parties. Nothing in this provision relieves a party of liability for damages caused by failure to
properly file such information under seal. This provision shall not prevent an appropriately
marked second copy of any paper specifically intended for review by the Court being hand-
delivered to the Court to assure that the same is brought promptly to the Court's attention.

14 **M. No Effect On Party's Own Use.** Nothing contained in this Order shall affect
15 the right of a party to disclose to its officers, directors, employees, partners or consultants or to
use as it desires any information designated and produced by it as "CONFIDENTIAL --
ATTORNEYS' EYES ONLY" or "CONFIDENTIAL."

16 **N. No Effect On Disclosure to Author or Addressees.** Nothing contained in this
17 Order shall affect the right of a party to disclose any information designated as
"CONFIDENTIAL -- ATTORNEYS' EYES ONLY" or "CONFIDENTIAL" to the author or
18 addressees of the document.

19 **O. No Applicability to Public Information.** The restrictions on dissemination of
confidential information shall not apply to (i) information which prior to disclosure hereunder

1 is either in the possession or knowledge of an inspecting party or person who, absent this order,
2 is under no restriction regarding its dissemination, or (ii) information which is public
3 knowledge or which after disclosure, becomes public knowledge other than through an act or
omission or a party receiving the confidential information.

4 **P. Legal Effect of Designations.** The designation by a party of any document,
5 material or information as "CONFIDENTIAL -- ATTORNEYS' EYES ONLY" or
6 "CONFIDENTIAL" is intended solely to facilitate discovery in this action, and neither such
7 designation nor treatment in conformity with such designation shall be construed in any way as
an admission or agreement by any party that the designated disclosure constitutes or contains
8 any trade secret or confidential information. Failure to so designate any document or thing
9 shall not constitute a waiver of any claim by a party that such documents or things do contain
10 trade secrets, proprietary information, and/or confidential information.

11 **Q. Final Disposition of Action.** Upon the final disposition of this action, each
12 counsel of record shall: (a) promptly return to counsel of record for the designating party all
13 information designated "CONFIDENTIAL -- ATTORNEYS' EYES ONLY" or
14 "CONFIDENTIAL" and all copies made thereof; and (b) promptly destroy or see to the
destruction of all writings related thereto, including but not limited to notes, analyses,
15 memoranda or reports provided to or by any other persons, and certify to the designating party
16 that such destruction has been done. As an exception to the above, counsel of record may
17 retain a single file copy of any document filed with the Court, a copy of any written discovery
18 response, and a transcript of any deposition testimony, together with all exhibits thereto. The
19 copy of these retained documents shall be treated as "CONFIDENTIAL -- ATTORNEYS'
EYES ONLY" and counsel of record shall immediately notify opposing counsel of record of
20 any attempt by third parties to inspect and/or copy said documents.

R. Motion For Relief From Designation. If, subsequent to a party's receipt of
information designated "CONFIDENTIAL -- ATTORNEYS' EYES ONLY" or
"CONFIDENTIAL," it shall appear to such party that any such information is not of a nature
warranting the protection afforded hereunder, such party shall first notify counsel for the
designating party in writing, providing its reasons for challenging the designation. If by 15
days after notice the parties have been unable to reach an agreement as to the designation, the
party may bring a noticed motion to be relieved of its obligations under this Order as to any

1 such Information. The producing party bears the burden of proof that any designated material
2 meets the requirements for such designation.

3 **S. Modification of Order.** This Order shall not prevent any of the parties from
4 applying to the Court for relief therefrom, or from applying to the Court for further or
5 additional Protective Orders, or from agreeing between themselves to modification of this
6 Protective Order, subject to the approval of the Court.

7 **T. Patenting and Patent Protected Persons.** Persons who have access to
8 information designated "CONFIDENTIAL -- ATTORNEYS' EYES ONLY" shall be restricted
9 from patenting for a party for the pendency of this action and for two years after its conclusion.

10 a. "Patenting" shall mean and include:

11 (i) preparing and/or prosecuting any patent application (or portion thereof), whether
12 design or utility, and either in the United States or abroad, in the field of isolation sleeves for
13 fracturing processes;

14 (ii) preparing patent claim(s) relating to the field listed above; and

15 (iii) providing advice, counsel, or suggestion regarding, or in any other way
16 influencing, claim scope and/or language, embodiment(s) for claim coverage, claim(s) for
17 prosecution, or products or processes for coverage by claim(s) relating to the field listed above.

18 **U. Burden of Proof.** An inspecting party or person asserting that the information is
19 not confidential or was possessed prior to disclosure, or was acquired or developed
20 independently, and therefore not subject to this Order, or is improperly categorized, shall have
the burden of establishing the validity of its position.

V. Survival of Terms. Absent written modification hereof by the parties hereto or
further order of the Court, the provisions of this Order that restrict the disclosure and use of
confidential Information shall survive the final disposition of this action and continue to be
binding on all persons subject to the terms of this Order.

W. Effect on Discovery. This Order shall not preclude or limit the right of any
party to oppose discovery on any ground which would otherwise be available.

X. Submitting to Jurisdiction of the Court. Each person to whom disclosure of
any designated Information is made shall be subject to and hereby submits to the jurisdiction of
the United States District Court for the Eastern District of California for the purpose of
contempt proceedings in the event of any violation of this Order.

19

20

1 **Y. Violation of Order.** In the event anyone shall violate or threaten to violate any
2 term of this Order, the parties agree that the aggrieved party may immediately apply to obtain
3 injunctive relief against any such person violating or threatening to violate any of the terms of
4 this Order and, in the event the aggrieved party shall do so, the respondent person subject to the
5 provisions of this Order shall not employ as a defense thereto the claim that the aggrieved party
6 possesses an adequate remedy of law. The parties and any other person subject to the terms of
7 this Order agree that this Court has jurisdiction over such person or party, for the purpose of
enforcing this Order. In the event that any confidential information is disclosed or used by a
receiving party in violation of this order, the confidential information shall not lose its status
through such disclosure or use, and the parties shall take all steps reasonably required to assure
its continued confidentiality.

Submitted by: CHRISTIE, PARKER & HALE, LLP DATED: August 10, 2006

By /s/ Edward R. Schwartz

Edward R. Schwartz

Attorneys for Plaintiff, Duhn Oil Tool, Inc.

CONLEY ROSE, P.C. DATED: August 10, 2006

By /s/ Charles J. Rogers

Charles J. Rogers

Attorneys for Defendant

Cooper Cameron Corporation

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20

EXHIBIT A

NON-DISCLOSURE AGREEMENT

I, _____, declare under penalty of perjury that:

- 1. My address is _____
- 2. My present employer is _____
- 3. My present occupation or job description is _____

I HEREBY CERTIFY AND AGREE that I have read and understand the terms of the Stipulated Protective Order ("Order") in the matter of Duhn Oil Tool, Inc. v. Cooper Cameron Corporation in the United States District Court, Eastern District of California, Case No. 1:05-CV-01411-OWW-LJO, that I will not use or disclose to anyone any of the contents of any confidential information received under the protection of the Order, and agree to be bound by the terms and conditions of the Order. I understand that I am to retain all copies of any of the materials that I receive which have been so designated as Confidential Information in a container, cabinet, drawer, room or other safe place in a manner consistent with this Order, and that all copies are to remain in my custody until I have completed my assigned or legal duties, whereupon the copies are to be returned or destroyed as specified in the Order. I acknowledge that such return or the subsequent destruction of such materials shall not relieve me from any of the continuing obligations imposed upon me by the Order.

Dated: _____, 2006. Signed: _____

IT IS SO ORDERED.

Dated: August 11, 2006
66h44d

/s/ Lawrence J. O'Neill
UNITED STATES MAGISTRATE JUDGE

OCTOBER 26, 2006 ORDER ON MOTION FOR
PROTECTIVE ORDER CLARIFICATION (Docket 67)

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF CALIFORNIA**

DUHN OIL TOOL, INC.,

Plaintiff,

vs.

COOPER CAMERON CORPORATION,

Defendant.

CASE NO. CV F 05-1411 OWW LJO

**ORDER ON MOTION FOR PROTECTIVE
ORDER CLARIFICATION**
(Doc. 66.)

INTRODUCTION

In this patent infringement action, plaintiff Duhn Oil Tool, Inc. (“Duhn”) and defendant Cooper Cameron Corporation (“Cooper”) disagree on the application of a “prosecution bar” provision in their protective order. Duhn contends that the “prosecution bar” permits its law firm Christie, Parker & Hale (“Christie, Parker”) to prosecute Duhn patents, to litigate this action, and to have access to information designated “CONFIDENTIAL – ATTORNEYS’ EYES ONLY,” if Christie, Parker “builds a proper ethical wall” between patent prosecution counsel and the confidential information. Cooper contends that if Christie, Parker accepts “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” information, Christie, Parker is precluded to prosecute this action and related Duhn patents.

This Court considered the parties’ motion for clarification of the “prosecution bar” provision on the record and without the October 27, 2006 hearing or oral argument. *See* Local Rule 78-230(h). For the reasons discussed below, this Court:

- 1 1. ORDERS that the “prosecution bar” provision precludes Christie, Parker to prosecute
2 Duhn patents subject to the “prosecution bar” provision, to litigate this action, and to
3 have access to information designated “CONFIDENTIAL – ATTORNEYS’ EYES
4 ONLY” under the protective agreement; and
- 5 2. PERMITS Duhn, on the condition that all counsel and parties abide by the protective
6 order, including the “prosecution bar” provision, to:
 - 7 A. Retain counsel other than Christie, Parker to have access to and to use for
8 purposes of this action information designated “CONFIDENTIAL –
9 ATTORNEYS’ EYES ONLY” under the protective agreement; and
 - 10 B. Continue to retain Christie, Parker as permissible under the protective order,
11 including its “prosecution bar” provision.

BACKGROUND

Original “Prosecution Bar” Provision Dispute

14 Duhn designs and manufactures oil industry products which are sold in the United States. On
15 July 26, 2005, Duhn was issued a wellhead isolation tool patent (“patent”). On November 9, 2005,
16 plaintiff filed this action to allege that Cooper sells products to infringe the patent.

17 In anticipation of disclosure of confidential, trade secret and proprietary information, Duhn and
18 Cooper agreed to protect such information. The parties agreed to designate information as
19 “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” which a party “believes in good faith to constitute,
20 contain, reveal or reflect proprietary or confidential, financial, business, technical, personnel or related
21 information which is so highly sensitive and confidential as to require the possession of such information
22 to be limited to the counsel of record and their agents only.” The parties agreed that information
23 designated as “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” “shall not be disclosed, given,
24 shown, made available or communicated in any way to any person or entity other than counsel of record
25 for a party. Such information shall be used **only for the purposes of this litigation**, and shall not
26 directly or indirectly be used for any business, financial or other purpose whatsoever.” (Bold added.)
27 The parties agreed to disclosure of “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” information to
28 “outside experts or consultants” who sign a Non-Disclosure Agreement that the expert/consultant

1 understands the protective order, agrees to the protective order, will not use or disclose confidential
2 information received under the protective order, and will keep safe confidential information.

3 The parties disagreed on Cooper's proposed "prosecution bar" provision:

4 T. PATENTING AND PATENT PROTECTED PERSONS.

5 Persons who have access to information designated "CONFIDENTIAL – ATTORNEY'S
6 EYES ONLY" shall be restricted from patenting for a party for the pendency of this
action and for two years after its conclusion.

7 a. "Patenting" shall mean and include:

8 (i) preparing and/or prosecuting any patent application (or portion
9 thereof), whether design or utility, and either in the United States or abroad, in the field
of isolation sleeves for fracturing processes;

10 (ii) preparing patent claim(s) relating to the field listed above; and

11 (iii) providing advice, counsel, or suggestion regarding, or in any other
12 way influencing, claim scope and/or language, embodiment(s) for claim coverage,
claim(s) for prosecution, or products or processes for coverage by claim(s) relating to the
13 field listed above.

14 Cooper sought the "prosecution bar" provision to preclude Duhn litigation counsel, who would
15 have access to Cooper's confidential information, to simultaneously prosecute related patents before
16 the United States Patent and Trademark Office ("Patent Office"). Duhn objected that the "prosecution
17 bar" provision prohibits Duhn's patent attorney Constantine Marantidis ("Mr. Marantidis") of Christie,
18 Parker to handle Duhn's patent portfolio and to provide patent advice. To address the dispute, this Court
19 issued its August 1, 2006 order ("August 1 order") that:

- 20 1. Duhn's current law firm [Christie, Parker] may continue to represent Duhn to
21 prosecute this action and related patents before the Patent Office without a
22 "prosecution bar" provision **but** must forego discovery materials which Cooper
23 designates as "CONFIDENTIAL – ATTORNEYS' EYES ONLY"; or
24 2. Duhn enter into the protective order with Cooper's proposed "prosecution bar"
25 provision. (Bold in original.)

26 Duhn accepted the "prosecution bar" provision, which is included in the August 11, 2006
27 protective order.

28 ///

1 Current “Prosecution Bar” Provision Dispute

2 Duhn and Cooper dispute application of the “prosecution bar” provision. Duhn contends that
3 at Christie, Parker, there is “a clear demarcation between litigation counsel and patent prosecution” as
4 to Duhn. According to Duhn, although Mr. Marantidis is Duhn’s patent prosecution counsel and has
5 provided “input and guidance regarding technical and patent prosecution matters to litigation counsel,
6 he has not acted as litigation counsel.” Duhn identifies its litigation counsel as Edward Schwartz,
7 Thomas Daly and Christopher Smith of Christie, Parker and claims they “have not, are not and will not
8 engage in any patent prosecution or related counseling for Duhn.” Duhn identifies Mr. Marantidis as
9 the sole Christie, Parker attorney to prosecute Duhn patents. Duhn understood that Cooper’s concern
10 was limited to disclosure to Mr. Marantidis of “CONFIDENTIAL – ATTORNEYS’ EYES ONLY”
11 information. Duhn pledges that any Christie, Parker attorney with access to “CONFIDENTIAL –
12 ATTORNEYS’ EYES ONLY” information will not participate in “patenting” for Duhn. Duhn asserts
13 that Mr. Marantidis may continue patent prosecution for Duhn in that he will not have access to
14 “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” information. Duhn further pledges that Christie,
15 Parker litigation counsel will “establish an effective ethical wall before any restricted information has
16 been produced.” Duhn contends that Cooper seeks “to financially burden Duhn” by forcing Duhn to
17 retain new counsel. As an alternative, Duhn suggests that it hire “outside counsel” to handle
18 “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” information **and** that Christie, Parker “remain
19 involved in this litigation and Duhn’s patent prosecution.”

20 Cooper contends that Duhn seeks reconsideration of the August 1 order as to whether the
21 “prosecution bar” provision precludes Mr. Marantidis to represent Duhn in patent matters “related to this
22 litigation.” Cooper argues that the “prosecution bar” provision allows Christie, Parker to represent Duhn
23 in this action with access to “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” information but
24 precludes Christie, Parker (including Mr. Marantidis) to prosecute related Duhn patents in the Patent
25 Office. Cooper notes that there is no clear demarcation of Christie, Parker litigation and patent
26 prosecution counsel in that Duhn power of attorney documents filed with the Patent Office and regarding
27 the patent at issue here and related patents appoint Duhn’s litigation counsel “to prosecute this

28 ///

1 application” and “to transact all business” in the Patent Office.¹ Cooper also points to two of Mr.
2 Marantidis’ pre-litigation e-mails to Cooper’s in-house counsel to address potential litigation.² Cooper
3 argues that Duhn has failed to establish timely a screening procedure to avoid improper disclosure of
4 “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” information.

5 Cooper notes that it has produced to Duhn “CONFIDENTIAL – ATTORNEYS’ EYES ONLY”
6 information related to sales of accused products but withholds other such designated information
7 pending resolution of this current dispute.

8 **DISCUSSION**

9 The August 1 order addressed the dilemma of Mr. Marantidis:

10 Nonetheless, this Court acknowledges Duhn’s claim of prejudice if Mr.
11 Marantidis is precluded to represent Duhn as patent counsel. To avoid Duhn’s loss of
12 Mr. Marantidis, this Court gives Duhn an option to forego discovery materials which
13 Cooper designates as “CONFIDENTIAL – ATTORNEYS’ EYES ONLY.” Duhn’s
14 election to forego such discovery materials would mitigate issues raised by the *Chan*
15 court [of inadvertent disclosure of confidential information] and permit Duhn’s use of
16 its current law firm, including Mr. Marantidis, in this action and in matters before the
17 Patent Office.

18 The August 1 order gave Duhn the choice to:

- 19 1. Forego “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” information **and** continue
20 to use Christie, Parker and Mr. Marantidis “in this action and in matters before the Patent
21 Office”; or
22 2. Accept access to “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” information **but**
23 forego Christie, Parker and Mr. Marantidis’ representation pursuant to the “prosecution
24 bar” provision.

25 Duhn chose option 2 to agree to and abide by the “prosecution bar” provision, which precludes persons
26 with access to “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” information to prosecute subject
27

28 ¹ Duhn responds that the Christie, Parker litigation attorneys “are listed along with virtually every other
attorney in the firm on the Power of Attorney . . . because the Patent Office requires that individuals be listed rather than the
firm as a whole.” Duhn further responds that Cooper lacks evidence that Duhn litigation counsel participated in Duhn patent
prosecution.

² Duhn responds that Cooper lacks evidence of Mr. Marantidis’ involvement in this action after the complaint
was filed.

1 patents during this action and for two years after its conclusion. By accepting the “prosecution bar”
2 provision, Duhn and in turn Christie, Parker have access to “CONFIDENTIAL – ATTORNEYS’ EYES
3 ONLY” information and are subject to the “prosecution bar” provision’s restrictions. Recognizing that
4 Mr. Marantidis is an inseparable part of Christie, Parker, this Court gave Duhn a choice, in essence, to
5 forego “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” information and maintain Christie, Parker
6 as counsel OR to obtain access to “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” information and
7 secure other counsel.

8 With Duhn’s acceptance of the “prosecution bar” provision and Christie, Parker’s access to
9 “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” information, Duhn is unable to attempt to unwind
10 the protective order and erect previously undisclosed ethical walls. Duhn appears to recognize as much
11 with its alternative suggestion to retain outside counsel. Duhn and Christie, Parker want their cake and
12 eat it too but fail to justify such a treat. In simplest terms, Duhn is bound to the protective order with
13 the “prosecution bar” provision to preclude Christie, Parker’s dual litigation and patent prosecution
14 representations and access to “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” information.

15 **CONCLUSION AND ORDER**

16 For the reasons discussed above, this Court:

- 17 1. ORDERS that the “prosecution bar” provision precludes Christie, Parker to prosecute
18 Duhn patents subject to the “prosecution bar” provision, to litigate this action, and to
19 have access to information designated “CONFIDENTIAL – ATTORNEYS’ EYES
20 ONLY” under the protective agreement; and
- 21 2. PERMITS Duhn, on the condition that all counsel and parties abide by the protective
22 order, including the “prosecution bar” provision, to:
 - 23 A. Retain counsel other than Christie, Parker to have access to and to use for
24 purposes of this action information designated “CONFIDENTIAL –
25 ATTORNEYS’ EYES ONLY” under the protective agreement; and

26 ///

27 ///

28 ///

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

B. Continue to retain Christie, Parker as permissible under the protective order, including its “prosecution bar” provision.

IT IS SO ORDERED.

Dated: October 26, 2006
66h44d

/s/ Lawrence J. O'Neill
UNITED STATES MAGISTRATE JUDGE