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13 Attorneys for Plaintiff, IconFind, Inc.

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

15 ICONFIND, INC.,

Case No. 2:11-cv-00319-GEB-JFM

16 Plaintiff,

**JOINT STATEMENT RE DISCOVERY
DISAGREEMENT**

17 v.

Hearing Date: July 25, 2011

18 GOOGLE INC.,

Time: 9:00 a.m.

Courtroom 10

19 Defendant.

20 Before the Honorable Judge Garland E.
Burrell, Jr.

21 Pursuant to Local Rule 251, the Parties hereby submit to the Court a Joint Statement re
22 Discovery Disagreement. One provision of the Stipulated Protective Order remains in dispute
23
24
25

1 and the Parties seek the Court's guidance on the disputed issue of Plaintiff's counsel's
2 participation in reexamination and prosecution activities.

3 **(a) Details of the conference or conferences;**

4 On April 25, 2011, Defendant Google submitted to Iconfind for its review a draft
5 Protective Order and the Parties participated in a meet and confer regarding, among other issues,
6 the draft Protective Order. Iconfind indicated during this meet and confer and in a follow up
7 email on April 26, 2011, its position that Google had not met its burden of showing that a
8 prosecution bar was warranted in this case. The Parties participated in a second meet and confer
9 on this issue on May 6, 2011. The Parties during this meet and confer were again unable to
10 reach a compromise on this issue.

11 **(b) Statement of nature of the action and its factual disputes insofar as**
12 **they are pertinent to the matters to be decided and the issues to be**
13 **determined at the hearing;**

14 On February 3, 2011, IconFind filed this suit in the United States District Court for the
15 Eastern District of California for infringement of its United States Patent No. 7,181,459 B2. The
16 Parties expect that some of the materials exchanged during the course of the litigation between
17 the Parties may contain trade secret or other confidential research, technical, cost, price,
18 marketing or other commercial information, as is contemplated by Federal Rule of Civil
19 Procedure 26(c)(7). Accordingly, a protective order is necessary to protect the confidentiality of
20 such materials during the litigation. Google proposes adding a prosecution bar to the protective
21 order. Iconfind opposes the prosecution bar.

1 (c) **Contentions of each party as to each contested issue, including a**
2 **memorandum of each party’s respective arguments concerning the**
3 **issues in dispute and the legal authorities in support thereof.**

4 (i) **Plaintiff Iconfind’s Contentions**

5 Google’s proposed prosecution bar is sweeping and unnecessary. Google’s proposed
6 prosecution bar would, in effect, prohibit **any person** that has accessed the opposing party’s
7 confidential – not just highly confidential – information produced for a period of one year from
8 the end of this case (including all appeals) from participating on behalf of **any client** in **any**
9 **activity** related to “the competitive business decisions involving the preparation or prosecution
10 (for any person or entity) of patent applications relating to coding, categorizing, and/or retrieving
11 information from a computer network.” By way of example, this provision would prevent
12 Iconfind’s attorneys who have viewed an email that Google has designated as confidential that
13 concerns Google’s marketing strategies for Google Books from participating in the prosecution
14 of any patent application related to the retrieval of information on the internet for **any client** for
15 one year following close of this case. This provision is simply an unnecessary and overly broad
16 restraint on Iconfind’s attorney’s (and any potential consultant and/or expert) from fully
17 practicing their profession and Iconfind’s ability to utilize the counsel of its choice in patent
18 related activities. The activities prohibited and subject matter covered are just too broad and
19 unjustified in comparison to any potential improper use of Google’s confidential information.

20 Google has simply failed to meet its burden of demonstrating that good cause exists for
21 why a prosecution bar should be included in this case. In re Deutsche Bank Trust Co., 605 F.3d
22 1373, 1378 (Fed. Cir. 2010) (*writ of mandamus*). “When a party seeks a patent prosecution bar,
23 it must first show that there is a risk of inadvertent disclosure of confidential information,
24 measured by the ‘competitive decisionmaking’ test articulated in U.S. Steel.” Kraft Foods
25 Global, Inc. v. Dairilean, Inc., 2011 WL 1557881, *4 (N.D. Ill. Apr. 25, 2011) (striking patent

1 prosecution bar from protective order because defendant failed to proffer evidence to
2 demonstrate that plaintiff's outside counsel was involved in competitive decisionmaking). The
3 court must then balance the risk of disclosure against the resulting harm to the party that opposes
4 the restriction. Id. This determination is fact-specific, and the Federal Circuit has rejected the
5 notion that "every patent prosecution attorney is necessarily involved in competitive
6 decisionmaking" that would justify the imposition of a patent prosecution bar. Id.; see also
7 Intellect Wireless, Inc. v. T-Mobile USA, Inc., 2010 WL 1912250, *1 (N.D. Ill. May 12, 2010)
8 ("...attorneys who litigate patent infringement, and gain access to a competitor's confidential
9 information, are not automatically barred from prosecuting patents for those same clients").
10 Accordingly, "a party seeking imposition of a patent prosecution bar must show that the
11 information designated to trigger the bar, the scope of activities prohibited by the bar, the
12 duration of the bar, and the subject matter covered by the bar reasonably reflect the risk
13 presented by the disclosure of proprietary competitive information." Deutsche Bank, 605 F.3d at
14 1381. Google has not, and cannot, meet its burden here.

15 Moreover, proper measures are already in place to protect against inadvertent disclosure
16 through the terms of the protective order, which already prohibit counsel and any third party
17 consultants or experts from using confidential information outside the context of this litigation.

18 The very inclusion of a prosecution bar **presumes that the protective order will be violated.**

19 AFP Advanced Food Products LLC v. Snyder's of Hanover Mfg., Inc., 2006 WL 47374 (E.D. Pa.
20 Jan. 6, 2006) (ruling that the possibility of inadvertent disclosure "is not enough to justify a
21 protective order barring [plaintiff's] attorneys from prosecuting similar patents for two years"
22 under Federal Circuit law and noting that "[i]n this case, there is no reason for the court to
23 believe that [plaintiff's] attorneys will not strictly follow the adopted order and refrain from
24 using, either inadvertently or intentionally, Confidential Attorney's Eyes Only information for

1 the sole purpose of this litigation”); see also SmartSignal Corp. v. Expert Microsystems, Inc.,
2 2006 WL 1343647 (N.D. Ill. May 12, 2006) (denying accused infringer's motion to modify
3 protective order to add prosecution bar provision and finding that the accused infringer failed to
4 demonstrate good cause for the modification since it failed to show an specific facts that the
5 attorney would not follow the terms of the original protective order which precluded using the
6 produced for any purposes outside of the litigation).

7 Numerous district courts, when addressing similar provisions and a similar lack of
8 support for the imposition of such a restrictive bar have declined to include one. Notably, the
9 provision at issue here is more extreme than some of the provisions rejected in the foregoing
10 cases: (1) it applies not just to Highly Confidential information, but also Confidential
11 information; (2) it applies not just to counsel, but to any party reviewing confidential or highly
12 confidential information; (3) it applies to prosecution activities for any possible client, not just
13 prosecution activities for Iconfind; and (4) the subject matter of the barred prosecution activities
14 is not narrowly tailored but broadly includes prosecution activity related to “coding,
15 categorizing, **and/or** retrieving information from a computer network.” (emphasis added).
16 Indeed, Google’s broadly written subject matter definition would bar prosecution activities on
17 basically any internet-related patent.

18 In Kraft Foods Global, Inc. v. Dairilean, Inc., 2011 WL 1557881, *4 (N.D. Ill. Apr. 25,
19 2011), the court rejected a prosecution bar less burdensome than the one proposed by Google in
20 this case. There, it applied only to outside counsel and to Highly Confidential (not merely
21 Confidential) information. The court found that “[e]ssentially, [defendant] requires a
22 prosecution bar because [plaintiff’s] litigation counsel also prosecutes patents. This type of
23 prosecution bar was squarely rejected by the Federal Circuit in *Deutsche Bank*.” Id. The court
24 struck the prosecution bar from the protective order.

1 In Eli Lilly & Co. v. Actavis Elizabeth LLC, 2008 WL 2783345 (D.N.J. July 15, 2008),
2 the court rejected a prosecution bar that would preclude plaintiff's in-house counsel from
3 prosecuting patent applications in a related field for two years after the completion of the
4 litigation. In so holding, the court stated that "[d]efendants have not provided the Court with any
5 reason to believe Lilly's in-house counsel will, intentionally or otherwise, disclose or rely on
6 confidential information in any future activities. As such, they have failed to show good cause []
7 and the restriction is unwarranted." Id. at *2.

8 In AFP Advanced Food Prods., LLC v. Snyder's of Hanover Mfg., 2006 WL 47374, *3-4
9 (E.D. Pa. Jan. 6, 2006), the court struck down a similar prosecution restriction as overbroad. In
10 that case, the defendant sought to prevent the plaintiff's counsel from engaging in patent
11 prosecution relating to the technologies of the inventions of the patent-in-suit and found the
12 defendant's only basis for the restriction was the fear of inadvertent misuse of confidential
13 information. Id. at *1-2. The court stated that "barring [plaintiff's] attorneys from prosecuting
14 similar patents for two years following this suit, without some tangible reason or good cause ... is
15 the exact type of over broad and generalized fear rejected in ... *U.S. Steel* ..." Id.

16 Similarly, in Intellect Wireless, Inc., 2010 WL 1912250 (N.D. Ill. May 12, 2010), the
17 court declined to enter a prosecution bar that would have prevented any party reviewing
18 Defendants' confidential information from participating in the prosecution of patent applications.
19 In so holding the court stated:

20 Defendants have failed to articulate the competitive decision making that plaintiff's
21 counsel is involved in that would make a patent prosecution bar necessary. Defendants
22 state only generally that there is high risk of exposing defendants' confidential technical
23 information without a prosecution bar and that the plaintiff is currently prosecuting two
24 patent applications that "directly relate to the patents-in-suit." Defendant's have, thus,
25 failed to demonstrate that plaintiff's prosecution counsel is involved in the plaintiff's
competitive decision making.

Id. at *2.

1 In Warner Chilcott Laboratories Ireland Ltd. v. Impax Laboratories, Inc., 2009 WL
2 3627947 (D.N.J. Oct. 29, 2009) the court declined to include prosecution bar, reasoning:

3 The Court has not been provided with any specifics showing that anyone serving as
4 Plaintiffs' counsel will intentionally or unintentionally disclose or utilize confidential
5 information in their future activities. The restrictions Defendants ask the Court to endorse
6 are broad, blanket prohibitions applying to any lawyer that views confidential
7 information, regardless of individual circumstances. The teaching of *U.S. Steel* and its
8 progeny is that restrictions on access to confidential documents or the activities of
9 counsel will not be imposed absent some specific, identifiable showing and not on the
10 basis of broad generalizations of potential harm. The notion that good cause can be
11 shown simply by invoking the possibility of inadvertent disclosure has been rejected by
12 the authorities cited herein.

13 Id. at *3; accord Avocent Redmond Corp. v. Rose Electronics, Inc., 242 F.R.D. 574 (W.D.
14 Wash. 2007) (denying accused infringer's motion for a protective order to bar any recipient of
15 "Attorney Eyes Only" documents from prosecuting patent applications in the field for two years
16 after the litigation concluded, ruling that the defendant failed to show good cause for inclusion of
17 the prosecution bar where it would operate to exclude some of the patentee's trial counsel from
18 continuing its prosecution duties for the patentee on only generalized and vague allegations of
19 harm); accord Bergstrom, Inc. v. Glacier Bay, Inc., 2010 WL 257253, *2 (N.D. Ill. Jan. 22,
20 2010) (denying motion to bar one of the patentee's counsel from viewing protected source code
21 unless he agreed to a prosecution bar, where the counsel did not prosecute patent applications on
22 behalf of the patentee).

23 The same logic controls here. There is simply no evidence to demonstrate that counsel
24 (or any potential expert and/or consultant) is or will be involved in any competitive decision
25 making in their respective duties to represent Iconfind or any other client. Neither Iconfind nor
the inventors of the patent-in-suit have pending patent applications -- muchless applications in
this field or any other field. Moreover, Iconfind cannot now file for any continuation of the
patent-in-suit (see 35 U.S.C. § 120) or any reissue application that could broaden the claims of

1 the patent-in-suit (see 35 U.S.C. § 251). Accordingly, any argument by Google that Iconfind
2 could somehow use Google’s confidential information in the prosecution of a continuation or
3 reissue application is of no merit. See Pall Corp. v. Entegris, Inc., 655 F. Supp. 2d 169, 175-76
4 (E.D.N.Y. 2008) (noting as factors for declining to include reexamination provision the fact that
5 plaintiff did not intend to prosecute additional patents in the same technological field and was
6 precluded from filing “any continuation patent applications that incorporate or cover any
7 allegedly confidential [Defendant] information relating to its pleaded filter [technology]”).

8 Additionally, only two of the four attorneys of record for Iconfind have passed the patent
9 bar and are, hence, eligible to act as a prosecuting attorney for Iconfind or any current or
10 potential client. Google essentially argues that a prosecution bar is necessary because two
11 members of Iconfind’s litigation team are eligible to **potentially** at some point in the future also
12 prosecute patents for some **undisclosed entity or person** that also involves “competitive
13 decision making.” These restrictions are simply overly broad, unnecessary and are unsupported
14 by the law. Placing such severe limits on Iconfind and its attorneys based upon a hypothetical
15 situation Google has itself conjured based upon absolutely no facts or evidence is improper and
16 prejudicial. Accordingly, this Court should reject Google’s attempt to include a prosecution bar
17 in the protective order in this case.

18 In addition to improperly limiting the scope of the prosecution activities, Google also
19 improperly includes a bar on certain reexamination activities again not just for Iconfind, **but for**
20 **any current or future client**. Iconfind should not be prohibited from seeking the advice and
21 expertise of litigation counsel in any future reexamination proceeding, particularly in light of the
22 financial burden a small company such as Iconfind would incur if forced to hire two separate law
23 firms to conduct two separate legal actions, one before the PTO and one before this Court.
24 Iconfind’s attorneys should similarly not be barred from participating in reexamination work for

1 other clients in the broad field Google has defined. For these reasons, the prejudice to Iconfind
2 is even more pronounced if a reexamination bar were imposed. As the court explained in Xerox
3 Corp. v. Google, Inc., 270 F.R.D. 182 (D. Del. 2010):

4 [i]n comparison to the attenuated risk of competitive misuse of defendants' confidential
5 information, the potential harm in denying plaintiff reexamination counsel of its choice is
6 significant. A plaintiff "clearly has a strong interest in choosing its own counsel –
7 particularly in the complex and technical realm of patent litigation.

8 ...

9 A plaintiff also has a legitimate interest in formulating a coherent and consistent litigation
10 strategy. While a parallel reexamination proceeding may not be formally part of [a]
11 litigation, choices made before the PTO nonetheless have consequences in this court ...
12 Trial counsel are better suited to assess claim language to this end than reexamination
13 counsel, who practice before the PTO and do not try cases to jury. Additionally, because
14 reexamination (especially *inter partes* reexamination) is an increasingly important venue
15 for challenging a patent's validity, preventing trial counsel exposed to defendants'
16 confidential information from fully participating in reexamination proceedings would
17 force plaintiff to split its resources between two fronts of the same war.

18 Id. at 184, 185.

19 In addition to posing a greater risk of prejudice to Iconfind, Google's confidential
20 information is simply irrelevant in the context of reexamination proceedings. "[T]he scope of
21 claims cannot be enlarged by amendment in a reexamination. Because reexamination involves
22 only the patent and the prior art, defendant's confidential information is 'basically irrelevant to
23 the reexamination.'" Kenexa Brassring Inc. v. Taleo Corp., 2009 WL 393782, *2 (D. Del. Feb.
24 18, 2009) (declining to apply the prosecution bar to reexamination proceedings); see also
25 Hochstein v. Microsoft Corp., 2008 WL 4387594, *2 (E.D. Mich. Sept. 24, 2008) (declining to
impose a reexamination provision, finding defendant's confidential information irrelevant
because "reexamination will only implicate matters in the public record, i.e., the subject patent
and the prior art").

1 Additionally, claims can only be narrowed in a reexamination proceeding and therefore
2 no device can infringe the narrower claims emerging from reexamination that would not have
3 infringed the original claims as well. Xerox Corp. v. Google, Inc., 270 F.R.D. 182, 184 (D. Del.
4 2010) (“Moreover, while claims may be broadened during prosecution to support new, tailor-
5 made infringement allegations, amendments made during reexamination can only serve to
6 *narrow* the original claims. Hence, no product that did not infringe a patent before
7 reexamination could ever infringe that patent following reexamination”) (citing In re Freeman,
8 30 F.3d 1459, 1464 (Fed. Cir. 1994)). Accordingly, Google’s fear that the litigation counsel
9 could use Google’s confidential information is effectively militated by this fact. See Pall Corp.
10 v. Entegris, Inc., 655 F. Supp. 2d 169, 175-76 (E.D.N.Y. 2008) (“amendments to [plaintiff’s]
11 patent claims, if necessary, will necessarily result in narrower patent coverage, a fact that only
12 benefits [Defendant] as an infringement defendant”).

13 In this case, Iconfind’s counsel should not be prohibited from assisting Iconfind and other
14 current and future clients in reexamination proceedings. The risk of inadvertent or competitive
15 use of Google’s confidential information by Iconfind’s trial counsel in evaluating potential claim
16 amendments during any potential reexamination proceeding is outweighed by the potential harm
17 in denying Iconfind the full benefit of its trial counsel in that venue. As noted above, Iconfind is
18 a small, modest company with limited resources. If Google or another party initiates
19 reexamination of the patent-in-suit, under Google’s proposal, Iconfind will be forced to retain an
20 additional law firm to represent Iconfind in reexamination proceedings before the PTO.
21 Furthermore, Google’s confidential information **cannot be considered** by the PTO (nor
22 considered by counsel per the protective order) in any reexamination proceeding and the scope of
23 the patent claims cannot be enlarged during reexamination. Accordingly, any argument that
24

1 Google’s confidential information would be used by Iconfind in any reexamination proceeding to
2 “cover” the Accused Google Products is unfounded.

3 In sum, Google has failed to show that good cause exists for including in the protective
4 order the prosecution bar provision. Iconfind respectfully requests that the Court enter the
5 proposed Protective Order included as Exhibit B to this Joint Statement (Exhibit B is a proposed
6 Protective Order that includes no prosecution bar provision). Should the Court, however, find
7 that some form of a prosecution bar is necessary in this case, the prosecution bar should only
8 apply: (1) to Prosecution Activities (as defined by Google) with respect to Iconfind and **not** any
9 other client that a party may in the future represent; (2) cover only Highly-Confidential (or
10 Source Code) information; and (3) exclude reexamination proceedings. Iconfind has included
11 this version of the proposed Protective Order as Exhibit C.

12 **(ii) Defendant Google’s Contentions**

13 A limited prosecution bar is necessary in this case given that highly technical and
14 confidential information (including Google’s source code) regarding the inner working of the
15 various accused Google’s systems will be provided by Google to opposing counsel as part of the
16 discovery process in this matter. Because persons with access to confidential information may
17 also be involved in prosecuting patents before the United States Patent and Trademark Office,
18 and because “it is very difficult for the human mind to compartmentalize and selectively
19 suppress information once learned, no matter how well-intentioned the effort may be to do so”
20 (*FTC v. Exxon Corp.*, 636 F.2d 1336, 1350 (D.C. Cir. 1980)), Google believes that the otherwise
21 agreed-to proposed protective order in this matter, should include a limited prosecution bar. *See,*
22 *generally, In re Deutsche Bank Trust Co.*, 605 F.3d 1373 (Fed. Cir. 2010). The disputed aspects
23 of the prosecution bar relates to Section II of the proposed Protective Order and is reflected in
24 the redlined portion of Exhibit 1 to this Joint Statement.

1 The need for the proposed prosecution bar is even more acute in this instance than it is in
2 the usual patent litigation. Primary counsel for IconFind in this matter, lawyers from Niro,
3 Haller & Niro, are well-known Plaintiff's attorney who have a history of representing Plaintiffs
4 in patent infringement actions against technology companies, including in multiple cases against
5 Google. That IconFind's chosen attorneys in this matter have repeatedly represented various
6 plaintiffs in other cases against Google strongly suggests that the protections sought by Google
7 in the proposed prosecution bar are particularly warranted in this matter. It would be
8 categorically unfair to allow attorneys who have viewed Google's confidential technical
9 information to use the information that they have learned through this litigation, even if merely
10 unconsciously, to help other parties craft their patent claims in such a way to capture how
11 Google's systems work. Given the Niro firm's repeat appearance as counsel adverse to Google
12 in patent litigation matters, the need for a limited prosecution bar of the type proposed by Google
13 is particularly pronounced in this matter.

14 Google's proposed prosecution bar is bi-lateral (*i.e.*, it applies equally to Google as it
15 does to IconFind) and is narrowly tailored. It consists of three parts: (1) a prohibition on
16 persons who have actually viewed confidential information¹ from working on additional
17

18 ¹ IconFind principal argument against the proposed prosecution bar is that it is overbroad
19 insofar as it relates to all confidential information and is not limited to just technical information.
20 To address this issue, Google proposes an additional production designation of
21 "PROSECUTION BAR MATERIAL" which would be applied only to material that a party
22 believes is relevant to the technologies at issue. Under this proposal, the proposed Prosecution
23 Bar would only apply to materials designated as Prosecution Bar Material. Accordingly, Google
24 proposes that the first two sentences of the proposed prosecution bar language (as contained in
25 Section II. A of the proposed Protective Order) read:

A producing material may designate any Confidential Materials,
Confidential Outside Counsel Only Materials or Source Code as
"PROSECUTION BAR MATERIAL." Any person reviewing any parties
Prosecution Bar Materials shall not, for a period commencing upon receipt
of such information and ending one year following the conclusion of this

1 prosecution for Iconfind until one year after the resolution of this matter (IconFind has agreed to
2 this provision of Google’s proposed prosecution bar); (2) a prohibition on persons who have
3 actually viewed confidential information from working on prosecution matters for anyone on
4 technology similar to what is covered by the patent-in-suit in this matter for a period of one year
5 after the last time confidential information was viewed by that person; and (3) a limited
6 prohibition on persons who have actually viewed confidential information from participating in a
7 reexamination of the patent-in-suit save with respect to the characterization of the prior art.

8 Google’s proposed prosecution bar language is specifically crafted to be narrow in scope.
9 *See, e.g., In re Deutsche Bank Trust Co.*, 605 F.3d at 1381 (“Also relevant to the threshold
10 inquiry are such factors as the scope of the activities prohibited by the bar, the duration of the
11 bar, and the definition of the subject matter covered by the bar.”). It does not apply *carte blanche*
12 to all the attorneys working at a particular firm or even to the specific attorneys working on this
13 particular case; it applies only to persons who actually view the producing party’s confidential
14 information. The prosecution bar is further tailored such that it only applies to further patent
15 work for IconFind or other parties in the same technological field as the patent-in-suit (*i.e.*,
16 attorneys who view a producing party’s confidential information are free to work on patent
17 prosecution work for clients other than IconFind in any field not directly related to the
18 technology at issue in this case). Finally, the proposed prosecution bar is limited in duration.
19 With respect to the first prohibition (*i.e.*, relating to the continued work for IconFind and to
20 which Plaintiff does not oppose), the duration on that prohibition is one year after the resolution
21 of this matter. With respect to the second proposed prohibition relating work for other clients in
22 a related area, Google’s proposal is that the prohibition only runs for a year after the last time

23 case (including any appeals) engage in any Prosecution Activity (as
24 defined below) on behalf of a party asserting a patent in this case.
This revised proposed language is included in Exhibit X to this Joint Statement.

1 that a person actually viewed confidential information (*i.e.*, regardless of whether the case
2 remains ongoing).

3 With respect to the reexamination prohibition of the prosecution bar, it too is narrowly
4 tailored. Google does not propose that a party's litigation counsel who views confidential
5 information should be precluded from participating in a reexamination of the patent-in-suit.
6 Rather, Google proposes that such people would be able to participate in the reexamination to the
7 extent related to the qualification of the prior art.² In other words, under Google's proposed
8 prohibition relating to reexamination, a party who has viewed confidential information could still
9 assist reexamination counsel in the bulk of the reexamination (*i.e.*, the part of the reexamination
10 dealing with detailing how the prior art is – or is not – different from what is claimed by the
11 patent) but would be prohibited, for example, from participating in any aspect of the
12 reexamination relating to adding new claims or amending existing claims. This prohibition is
13 reasonable as it balances the interests of IconFind in not having to bring two sets of attorneys up-
14 to-speed on the prior art relating to the patent-in-suit (under Google's proposal, IconFind is free
15 to rely on its litigation counsel for such analysis) with the interests of Google in not allowing
16 persons who have access to Google's internal and confidential technical documents participate in

17 ² Google's proposed restriction with respect to reexamination is designed to accomplish
18 the same effect as the restriction adopted by the court in *Document Generation Corp. v.*
19 *Allscripts, LLC*, 2009 U.S. Dist. LEXIS 52874 (E.D. Tex. June 22, 2009). The adopted
protective order in that matter read, in relevant part:

The provisions of [the prosecution bar] shall not prevent plaintiff's Outside
Counsel who has seen or reviewed the content of [AEO materials] from
reviewing communications from the United States Patent Office regarding
a re-examination proceeding or from discussing claim interpretation issues
or ways of distinguishing claims in any such reexamination from any cited
prior art, including with re-examination patent counsel; however, such
Outside Counsel may not prosecute any such reexamination and may not
reveal the content of Materials designated hereunder as [AEO material] to
re-examination patent counsel or agents.

1 amending the claims of the patent-in-suit and using that inside knowledge to draft – consciously
2 or unconsciously – claims designed to capture Google’s specific implementations of the
3 technology at issue. *See, e.g., Visto Corp. v. Seven Networks, Inc.*, 2006 U.S. Dist. LEXIS 91453
4 (E.D. Tex. Dec. 19, 2006).

5 Google respectfully requests that the Court enter the proposed Protective Order included
6 as Exhibit D to this Joint Statement (Exhibit D is the same as Exhibit A, but without the
7 redlining highlighting Google’s proposed provisions relating to the prosecution bar and including
8 the Proposed designation relating to prosecution bar material discussed in footnote 1).

9
10 Respectfully submitted,

11 /s/ Anna B. Folgers
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Attorneys for Defendant, GOOGLE INC.

1 **CERTIFICATE OF SERVICE**

2 The undersigned hereby certifies that on June 10, 2011 the foregoing

3 **JOINT STATEMENT RE DISCOVERY DISAGREEMENT**

4 was filed with the Clerk of Court using the CM/ECF system, which will then send a notification
5 of such filing to the following counsel of record.

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16 *Attorneys for Defendant Google Inc.*

17 I certify that all parties in this case are represented by counsel who are CM/ECF participants.

18 /s/ Anna B. Folgers
19 Attorneys for Plaintiff Iconfind, Inc.